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**Datasheet for the decision  
of 5 April 2016**

**Case Number:** T 2462/10 - 3.5.04

**Application Number:** 03017759.6

**Publication Number:** 1359757

**IPC:** H04N7/088

**Language of the proceedings:** EN

**Title of invention:**

Media online services access system and method

**Patent Proprietor:**

OpenTV, Inc.

**Opponent:**

Interessengemeinschaft für  
Rundfunkschutzrechte e.V.

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 100(a), 56, 112(1)(a)

**Keyword:**

Inventive step - no (all requests)

Referral to the Enlarged Board of Appeal - refused (not required for the decision)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 2462/10 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 5 April 2016**

**Appellant:** OpenTV, Inc.  
(Patent Proprietor) 275 Sacramento Street  
San Francisco, CA 94111 (US)

**Representative:** Glawe, Delfs, Moll  
Partnerschaft mbB von  
Patent- und Rechtsanwälten  
Rothenbaumchaussee 58  
20148 Hamburg (DE)

**Respondent:** Interessengemeinschaft für  
(Opponent) Rundfunkschutzrechte e.V.  
Bahnstr. 62  
40210 Düsseldorf (DE)

**Representative:** Pröll, Jürgen  
Die Patenterie GbR  
Patent- und Rechtsanwaltssozietät  
Leibnizstraße 6  
95447 Bayreuth (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 18 October 2010  
revoking European patent No. 1359757 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairwoman** T. Karamanli  
**Members:** M. Paci  
R. Gerdes

## Summary of Facts and Submissions

I. This is an appeal by the patent proprietor against the decision of the opposition division revoking European patent No. 1 359 757.

II. Opposition had been filed against the patent as a whole, based on Article 100(a) EPC (novelty and inventive step).

During the proceedings before the opposition division the opponent had relied *inter alia* on the following documents:

E1: WO 97/22207 A1,

E2: DE 44 27 046 A1 and

E6: S. Breide, "Interaktives Fernsehen - Service on Demand (SoD)", FERNSEH- UND KINO-TECHNIK, 49. Jahrgang, Nr. 3/1995, pages 93 to 103.

III. In the decision under appeal, the opposition division held that:

- the priority of document E1 was validly claimed and thus document E1 was prior art under Article 54(3) EPC;
- the subject-matter of independent claims 1 and 7 of the patent as granted was not novel in view of each of prior-art documents E1 and E2; and
- the subject-matter of independent claims 1 and 7 of auxiliary requests 1 and 2 lacked novelty in view of prior-art document E1.

IV. With the statement of grounds of appeal the appellant (patent proprietor) filed amended claims according to auxiliary requests 1 to 3, which replaced the claims of auxiliary requests 1 and 2 underlying the decision under appeal, and requested that the decision under

appeal be set aside and the patent be maintained as granted or in amended form on the basis of the auxiliary requests. The appellant also requested that, if the board considered the priority of document E1 to be valid, the matter be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC. Oral proceedings were requested as a precaution.

- V. The respondent (opponent) requested that the appeal be dismissed. Oral proceedings were also requested as a precaution.
- VI. The board summoned the parties to oral proceedings and in a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal of the EPO, OJ EPO 2007, 536) informed them that they should be prepared to discuss at the oral proceedings *inter alia* novelty of the claimed subject-matter in view of document E2 and inventive step in view of documents E2 to E6.
- VII. Oral proceedings were held on 5 April 2016. Both parties were represented. During the oral proceedings, the appellant withdrew its auxiliary request 1 and renumbered auxiliary requests 2 and 3 as first and second auxiliary requests, respectively.

The appellant's final requests at the end of the oral proceedings were that the decision under appeal be set aside and the opposition be rejected (**main request**) and, as an auxiliary measure, the patent be maintained in amended form on the basis of the **first auxiliary request** which was filed as "Auxiliary Request 2" with the statement of grounds of appeal or on the basis of the **second auxiliary request** which was filed as "Auxiliary Request 3" with the statement of grounds of appeal.

The appellant also requested that the following questions, filed with letter dated 4 March 2016, be referred to the Enlarged Board of Appeal according to Article 112(1)(a) EPC:

"1. Does the validity of a priority claim of a Euro-PCT-application for the purpose of citing said application as state of the art according to Art. 54 (3) EPC have to be assessed on the basis of Art. 8 PCT in connection with Art. 4 of the Paris convention?

2. If question 1 is answered yes, does Art. 4 of the Paris Convention grant the right to priority to nationals of non-member states?

3. Depending on question 1, may the validity of priority claim of a Euro-PCT-application may be assessed on a different set of rules (especially either PCT or EPC rules) in proceedings directly pertaining to the Euro-PCT-application (e.g. examination and/or opposition proceedings for the Euro-PCT-application)?"

The respondent's final request at the end of the oral proceedings was that the appeal be dismissed.

Before closing the oral proceedings the chairwoman announced the board's decision.

VIII. Claim 1 according to the appellant's **main request** (patent as granted) reads as follows:

"A method of providing to a user of online information services automatic and direct access to online information, comprising the steps of:

providing an audio or video program represented by an electronic signal carrying an address associated with an online service source;  
indicating to the user that an address has been provided; and  
in response to a user initiated command electronically extracting said address and automatically establishing a direct communication link with the online service source associated with the extracted address so that the user has direct access to the online information."

IX. Claim 1 according to the appellant's **first auxiliary request** reads as follows (additional text relative to claim 1 of the main request is underlined; no text was deleted):

"A method of providing to a user of online information services automatic and direct access to online information, comprising the steps of:  
providing an audio or video program represented by an electronic signal carrying an address associated with an online service source;  
indicating to the user that an address has been provided; and  
after the indicating, in response to and only after receiving a user initiated command electronically extracting said address from the electronic signal and automatically establishing a direct communication link with the online service source associated with the extracted address so that the user has direct access to the online information."

- X. Claim 1 according to the appellant's **second auxiliary request** reads as follows (additional text relative to claim 1 of the main request is underlined; no text was deleted):

"A method of providing to a user of online information services automatic and direct access to online information, comprising the steps of:  
providing an audio or video program represented by an electronic signal carrying an address associated with an online service source;  
indicating to the user that an address has been provided, where the video or audio program as produced incorporates a visual or auditory indicator; and after the indicating, in response to and only after receiving a user initiated command electronically extracting said address from the electronic signal and automatically establishing a direct communication link with the online service source associated with the extracted address so that the user has direct access to the online information."

- XI. The reasoning in the decision under appeal of relevance to the present decision can be summarised as follows:

The subject-matter of claim 1 of the patent as granted (main request) lacked novelty (under Article 54(1) and (2) EPC) in view of document E2 because the expression "extracting said address" in claim 1 did not exclude that the address was extracted from a RAM memory as in the television receiver of E2 and the expression "in response to" in claim 1 did not imply that the extracting was performed for the first time.



XII. The appellant (patent proprietor) essentially argued as follows regarding the issues relevant to the present decision:

*Main request - construction of claim 1 and novelty in view of E2*

The method of claim 1 was novel in view of E2 because the following features/steps were not disclosed in E2:

- (a) "an address associated with an online service source";
- (b) after the indicating step and "in response to a user initiated command electronically extracting said address"; and
- (c) "the user has direct access to the online information".

Regarding features (a) and (c), the appellant essentially argued that E2 only disclosed sending product ordering information to a remote site via a modem and a telephone line. For this purpose, the telephone number of the remote site was inserted into the television signal. However, the telephone number of E2 was not an "address", the remote site of E2 was not "online" and the user had no "direct access to online information".

Regarding feature (b), the appellant submitted that in E2 the telephone number was extracted from the television signal and stored in a RAM before the user was informed that a telephone number has been provided. Subsequently and in response to a user request, the telephone number was read from the RAM, not from the television signal. The extraction of the telephone number in E2 thus never met both conditions of being

from the electronic signal and in response to a user initiated command.

*Main request - inventive step starting from E2*

Document E6 provided a rather generic discussion of various concepts of interactive television and a general outlook of this technology. The skilled person would have found no hint and had no incentive to apply these concepts to the method/system of E2.

*First auxiliary request - inventive step starting from E2*

Claim 1 according to the first auxiliary request further clarified that the address was extracted from the electronic signal after it had been indicated to the user that an address had been provided. This was the opposite of what was done in E2, in which the telephone number (corresponding to the "address" in claim 1) was extracted from the electronic signal and stored in a RAM as soon as it was received, i.e. before the user was informed of its arrival; thereafter, the telephone number was extracted only from the RAM, not from the electronic signal.

This additional distinguishing feature of claim 1 provided the advantage that successively received addresses were not automatically extracted from the electronic signal and stored, often for nothing, but only extracted in response to a user request, thereby reducing the processing and memory requirements of the user's device.

There was nothing in E2 or E6 to lead the skilled person to this better solution. Hence the subject-

matter of claim 1 was not rendered obvious by E2 and E6.

*Second auxiliary request - inventive step starting from E2*

Claim 1 according to the second auxiliary request comprised the further distinguishing feature that "the video or audio program as produced incorporates a visual or auditory indicator". This feature provided the additional advantage that the user's device did not have to produce this indicator, because it was already embedded in the program "as produced", thereby further reducing the hardware and the processing in the user's device.

In contrast, the indicator in E2 was produced locally by the user's device, for instance as a logo which was superimposed on the television images in a corner of the screen.

As this advantageous feature was suggested neither by E2 nor E6, the subject-matter of claim 1 according to the second auxiliary request was not obvious in view of these two prior-art documents.

*Request for referral to the Enlarged Board of Appeal*

Unless the board declared the priority of E1 to be invalid, the questions prepared by the appellant should be referred to the Enlarged Board of Appeal under Article 112(1) (a) EPC.

XIII. The respondent's arguments regarding the issues relevant to the present decision can be summarised as follows:

*Main request - construction of claim 1 and novelty in view of E2*

The wording of the claim was broader than argued by the appellant. In E2, the telephone number inserted into the television signal was functionally an "address" which gave direct access to "online information" at the remote site. The address (telephone number) was extracted from the RAM of the television receiver after it was indicated to the user that an address had been provided. Claim 1 did not specify wherefrom the address was extracted; hence the wording of claim 1 also covered the extraction of the address from a RAM.

The method of claim 1 thus lacked novelty in view of E2.

*Main request - inventive step starting from E2*

Document E6 was from the same technical field as document E2. The skilled person would have had a strong incentive in using the teachings of E6 to enlarge the limited possibilities of the television receiver of E2 by making it capable of interactive access to online services. In order to do so, it would have been sufficient to replace the telephone number in E2 by a network address to an online information source and, for further convenience and speed, the modem could also have been replaced by a router.

For the above reasons, the skilled person would have arrived without an inventive step at the subject-matter of claim 1 by combining the teachings of E2 and E6.

*First auxiliary request - inventive step starting from E2*

Extracting the address (telephone number) from the television signal only after a user-initiated request was an obvious alternative to extracting the address as soon as it was received and storing it in a RAM, as was done in E2. E2 also had pointers towards this solution because certain actions, such as displaying additional information ("Klarschriftinformation") or purchasing a product via the modem, were only performed in response to a user request (i.e. the user pressing a key).

Therefore, the subject-matter of claim 1 of the first auxiliary request did not involve an inventive step in view of E2, E6 and common general knowledge.

*Second auxiliary request - inventive step starting from E2*

The insertion by a television producer of a logo in a top corner of television images was notorious common general knowledge. The addition of such a common feature could not support the presence of an inventive step.

*Request for referral to the Enlarged Board of Appeal*

The appellant's request for a referral of questions to the Enlarged Board of Appeal under Article 112(1)(a) EPC should be refused because the questions related to

an issue which was not decisive for the board's decision.

### **Reasons for the Decision**

1. The appeal is admissible.

#### *The invention*

2. The present invention relates to an electronic information access system which provides automatic and direct access to online information by extracting an address which is associated with an online service and is embedded in an electronic signal of an audio or video program.

#### *Main request - construction of claim 1 and novelty in view of E2*

3. It is undisputed that document E2 discloses a television system in which additional information relating to a product being advertised on television is inserted into the teletext portion of the television signal. The additional information includes, for example, a product description, a product price, a product number and a telephone number for ordering the product (see column 2, lines 5 to 13, and figure 1a). The additional information is detected by the user's television receiver, extracted from the television signal and stored in a RAM. An indicator (e.g. a flashing LED or a logo appearing in a corner of the television screen) indicates to the user that additional information is available for the product being advertised (see column 2, lines 37 to 54). In response to the user pressing a key, the product

description is read from the RAM and displayed on the television screen (see column 2, lines 55 to 66). In response to the user pressing the key for a second time, the telephone number is read from the RAM and used by the modem of the television receiver to order the advertised product by calling a remote site and transmitting the product number and the user's television receiver number (see from column 2, line 67, to column 3, line 10). Upon successful completion of the data transmission and ordering process, the user's television receiver receives a message from the remote site which is displayed on the television screen (see column 1, lines 56 and 57, column 3, lines 15 to 18, and column 4, lines 10 to 13).

The appellant submitted that the following features of the method of claim 1 were not disclosed in E2:

- (a) "an address associated with an online service source";
- (b) after the indicating step and "in response to a user initiated command electronically extracting said address"; and
- (c) "the user has direct access to the online information".

The appellant essentially argued that the remote site in E2 was not an "online service source", that the telephone number was not an "address", that the remote site did not provide the user with "direct access to online information" and that the extraction of the telephone number in E2 never met both conditions of being from the electronic signal and in response to a user initiated command (see section XII *supra*).

The respondent countered that the wording of claim 1 was broader than argued by the appellant and that therefore none of these features were novel in view of E2 (see section XIII *supra*).

For the reasons set out below, the board concurs with the respondent that features (a) and (b) are known from E2, but agrees with the appellant that feature (c) is not disclosed.

*Regarding feature (a)*

In E2, the telephone number allows the modem to establish a communication over a telephone line with the remote site where the product ordering is processed (see from column 2, line 67, to column 3, line 10, column 1, lines 56 and 57, column 3, lines 15 to 18, and column 4, lines 10 to 13). The remote site is therefore accessible "online", i.e via a telephone line, and provides a "service". The remote site is thus an "online service source". Since the telephone number enables a direct communication with this remote site, it is an "address" to this "online service source". The board notes that there is nothing in the patent specification which would justify a narrower interpretation of the expression "an address associated with an online service source" excluding the telephone number of E2 from being such an address (see, in particular, paragraph [0021] of the description of the patent specification). Hence **feature (a)** is **known** from document E2.

*Regarding feature (b)*

The wording of claim 1 only states that the address is "electronically extracted", without indicating



wherefrom. The board thus concurs with the respondent and the opposition division that this expression covers both an extraction from a television signal and an extraction from a RAM memory. Since in E2 the address (telephone number) is read out from the RAM **after** it has been indicated to the user that an address has been provided **and in response to** a user-initiated command, **feature (b)** is also **known** from document E2.

*Regarding feature (c)*

The board considers that the usual technical meaning of the expression "direct access to online information" is that it refers to information which is **present** at the remote site and can be directly accessed there. In other words, it is information which **already exists** "online" at the remote site before it is accessed. In E2, the only information which is sent back by the remote site to the user's receiver is an acknowledgement that the data transmission and the product ordering process were successfully completed (see column 1, lines 56 and 57, column 3, lines 15 to 18, and column 4, lines 10 to 13). In other words, the only information on the remote site to which the user has access is information which **did not exist** at the remote site before the data transmission was established and the product ordering was processed. For these reasons, the board considers that this acknowledgement does not qualify as "online information" within the meaning of claim 1. Hence, **feature (c)** is **not** disclosed in the prior-art document E2.

*Conclusion on novelty*

In the light of the above, the board concludes that the subject-matter of claim 1 is novel in view of document E2.

*Main request - inventive step starting from E2*

4. Objective technical problem

The appellant submitted that the **objective technical problem** solved by distinguishing feature (c) should be formulated as how to make additional information readily accessible to the user.

The respondent replied that the objective technical problem should be, in accordance with paragraph [0009] of the patent specification, how to provide interactive access to many online services.

The board notes that both formulations are not very different, but regards the objective technical problem proposed by the appellant as the correct one, because it does not contain any pointer to the solution, whereas the respondent's problem mentions interactive online services, which is an element of the solution.

5. Obviousness

It is undisputed that document E6, which was published approximately 6 months before the priority date of the patent in suit, gives an overview of the state of research advancement on "interactive television" (see Abstract of E6). The idea behind interactive television is to give the user access via his/her television receiver to online interactive services. Examples of

these online services, which are also commonly referred to as "Services-on-Demand (SoD)", are given in Table 1 on page 94 of E6 and include *inter alia* Video-on-Demand (VoD) and home-shopping.

The appellant argued that the skilled person would have had no incentive to apply the rather generic discussion of various concepts of interactive television in document E6 to the system of E2, because the system of E2 was not concerned with providing access to online information. Moreover, document E6 related mostly to video-on-demand (VoD), a concept which was inexistent in the system of E2.

The board is not persuaded by these arguments. As pointed out by the respondent, according to E6 the concept of "interactive television" was a hot topic pursued in several pilot projects around the world (see Abstract of E6). Already for this reason, the skilled person in the field of television could not have ignored this widespread interest in interactive television. Moreover, E6 states that interactive television covers many online services, with Video-on-Demand being only one of them. Another online interactive service mentioned several times in E6 is home-shopping (see, for instance, page 93, right column, and page 94, Table 1). Since the system of E2 relates to home-shopping, the skilled person would have had a strong interest in using the relevant teachings of document E6 for improving the home-shopping functionalities of the system of E2.

The board concurs with the respondent that it would have posed no particular technical difficulty to adapt the system of E2 to provide interactive online access to a home-shopping service. Indeed, the television

receiver of E2 already has direct access via a modem and a telephone line to a remote site for ordering the advertised product. All that is needed in order to make the communication more interactive is to increase the type and amount of data which could be bidirectionally exchanged over the telephone line between the television receiver and the remote home-shopping site. As evidenced in E6, a communication channel with a narrow bandwidth, such as the telephone line in E2, was no obstacle to interactive access to a home-shopping site (see E6, page 93, right column, "Digitale Dienste mit schmalbandigem Online-Rückkanal zur Interaktion (zum Beispiel für VoD oder Home-shopping-Anwendungen)").

For the above reasons, the board considers that the skilled person would have wanted, in view of E6, to adapt the system of E2 to provide the user with a more interactive online access to a home-shopping remote site, e.g. to allow the user to access further information about the products being advertised on television, and that by doing so it would have arrived at the method of claim 1 without an inventive step.

Hence the subject-matter of claim 1 according to the main request does not involve an inventive step in view of E2 and E6.

*Conclusion on the main request*

6. For the above reasons, the ground for opposition under Articles 100(a) and 56 EPC 1973 prejudices the maintenance of the patent as granted (appellant's main request).

*First auxiliary request - amendments*

7. Claim 1 according to the first auxiliary request differs from claim 1 according to the main request essentially in that it clarifies that the extraction of the address (see feature (b) under point 3 *supra*) is "from the electronic signal". This amended feature (b) is hereinafter referred to as **feature (b1)** and reads:

(b1) after the indicating step and "in response to and only after receiving a user initiated command electronically extracting said address from the electronic signal".

*First auxiliary request - inventive step starting from E2*

8. Distinguishing features

As explained under point 3 *supra*, E2 does not disclose the extraction of the telephone number (address) from the television signal (electronic signal) **after** it has been indicated that the telephone number has been provided **and in response to** a user-initiated request.

The method of claim 1 thus differs from that of E2 by distinguishing features (b1) and (c).

9. Objective technical problem(s)

The appellant stated that the technical effect achieved by distinguishing feature (b1) was to reduce the processing and memory requirements of the user's device, because only the addresses actually requested by the user were extracted and stored, as opposed to all received addresses (telephone numbers) in E2.

The associated objective technical problem was therefore how to reduce the processing and memory requirements of the user's device.

The appellant did not dispute that distinguishing features (b1) and (c) thus solved the following partial problems, respectively:

- (P1) how to reduce the processing and memory requirements of the user's device; and
- (P2) how to make additional information readily accessible to the user.

10. Obviousness

In accordance with the established jurisprudence of the boards of appeal, the obviousness of distinguishing features solving different partial problems is to be assessed separately for each partial problem (see Case Law of the Boards of Appeal of the European Patent Office, 7th Edition, September 2013, section I.D. 9.2.2).

*Regarding distinguishing feature (b1) and partial problem (P1)*

The appellant submitted that the skilled person would have had no incentive, from neither E2 nor E6, to change the system of E2 to arrive at feature (b1).

The respondent argued that feature (b1) was an obvious alternative to which the skilled person would have arrived using common general knowledge.

The board concurs with the respondent for the following reasons:

In E2, the address (telephone number) is extracted from the television signal as soon as it is received and stored in a RAM. The address is then read out from the RAM in response to a user request. The pros and cons of this procedure are apparent to the skilled person. The advantage is that the address is immediately available if the user requests it. The disadvantage is that the address might be extracted for nothing if the user does not request it, which may waste some computing time and memory space.

The claimed solution using feature (b1) also has pros and cons which are apparent to the skilled person and are essentially the opposite of the above pros and cons in E2. The advantage is that it may save some computing time and memory space, if the user does not request each received address. The disadvantage is that the address is not immediately available when the user requests it. Indeed, the first time that the address is received, it is not extracted because the user is not yet informed of its arrival. The address must thus be sent repeatedly during the whole duration of the advertisement, preferably at small regular intervals so that the user does not have to wait for long, in order to enable the user's device to extract the address from the electronic signal.

The board concurs with the respondent that both the solution in E2 (automatic extraction and storage) and the solution of feature (b1) (extraction only on request) are two straightforward alternative ways of extracting an address from a television signal, which have pros and cons which were obvious to the skilled

person in view of its common general knowledge. The fact that in E2 the first alternative way was chosen, does not make the second one inventive, because it would have been clear to the skilled person that both had pros and cons and that choosing one or the other was just a matter of routine design depending on external factors.

*Regarding distinguishing feature (c) and partial problem (P2)*

See points 4 and 5 *supra*.

11. Conclusion on inventive step

For the above reasons, the subject-matter of claim 1 according to the first auxiliary request does not involve an inventive step (Article 56 EPC 1973) in view of E2, E6 and common general knowledge.

*Conclusion on the first auxiliary request*

12. In the light of the above, the patent cannot be maintained in amended form on the basis of the appellant's first auxiliary request.

*Second auxiliary request - amendments*

13. Claim 1 according to the second auxiliary request differs from claim 1 according to the first auxiliary request by the following additional feature:

(d) "where the video or audio program as produced incorporates a visual or auditory indicator".



*Second auxiliary request - inventive step starting from E2*

14. Distinguishing features

It is common ground that feature (d) is not disclosed in E2 because the indicator in E2, e.g. a logo added in a corner of the television screen, is not incorporated in the program "as produced" but generated and added by the user's device.

15. Objective technical problem(s)

The appellant submitted that distinguishing feature (d) contributed to solving partial objective technical problem (P2) by further reducing the processing and memory requirements. Indeed, since the visual or auditory indicator was already incorporated in the video or audio program as produced, the user's device did not have to generate it.

The board notes that feature (d) is only disclosed in one sentence of paragraph [0035] of the patent specification and that the patent specification is silent as to what advantage or technical effect is achieved by this feature. The appellant's alleged technical effect, i.e. a further reduction of the processing and memory requirements of the user's device, might depend on how the indicator is incorporated in the video or audio program. However, in the present case, the board will assume *arguendo*, in the appellant's favour, that this technical effect is achieved and that therefore distinguishing feature (d) contributes to solving technical problem (P2).

16. Obviousness

The appellant explained that document E2 taught to generate the indicator **locally** at the user's device, for instance as a logo which was superimposed on the television images in a corner of the screen (see E2, column 2, lines 47 to 54). In other words, document E2 taught away from having an indicator already incorporated in the video program **as produced**, i.e. as received by the user's device. Hence, the advantageous feature (d) was obvious from neither E2, nor E6, nor common general knowledge.

The respondent essentially argued that the insertion of a logo by a television producer in a top corner of a television program was notorious common general knowledge and that the addition of such a common feature could not support the presence of an inventive step.

The board concurs with the respondent for the following reasons:

In E2, a logo is added by the user's device in a corner of the television images in order to indicate to the user the presence of an address (telephone number in E2) in the electronic signal (see E2, column 2, lines 47 to 54). The use of the German word "kann" ("can" in English) on column 2, line 47, of E2 suggests that the display of the logo is an optional feature which could be turned off.

In contrast, according to feature (d) of claim 1, the indicator is incorporated in the video or audio program "as produced", i.e. it is already incorporated in the program received by the user's device.

The board notes that the appellant did not dispute that it was common general knowledge for television program producers or distributors to add a logo in a corner of a television program. In view of this undisputed fact, the board considers that it would immediately have crossed the mind of the skilled person reading E2 that, as an alternative to a local insertion of the logo by the user's device, the logo could be inserted in the television images at a more upstream stage, for instance at the same time as the telephone number is inserted in the teletext portion of the television signal.

Thus, in the present case, the relevant question for inventive step is not whether the skilled person would have considered this alternative, but whether he/she would have had any incentive to adopt it in the expectation of a foreseeable advantage.

In the board's view, the following pros and cons of that alternative would have been apparent to the skilled person:

As an advantage, the user's device would not have had to add the logo, thereby reducing the processing requirements in the user's device.

As a disadvantage, the logo would have become an integral part of the program and thus would have constantly been visible in a corner of the screen, regardless of whether the user was interested in accessing further online information. This automatic and unavoidable display of the logo could have been perceived as a nuisance by some users.

In the light of the above, the skilled person would thus have had a strong incentive to choose the above obvious alternative to E2 (upstream insertion of the logo in the images) in situations in which giving the user control on whether to display a logo is deemed less important than reducing the processing requirements on the user's device.

17. Conclusion on inventive step

For the above reasons, the subject-matter of claim 1 according to the second auxiliary request does not involve an inventive step (Article 56 EPC 1973) in view of E2, E6 and common general knowledge.

*Conclusion on the second auxiliary request*

In the light of the above, the patent cannot be maintained in amended form on the basis of the appellant's second auxiliary request.

*Request for referral to the Enlarged Board of Appeal*

18. The appellant requested that several questions be referred to the Enlarged Board of Appeal (see point VII above). These questions relate exclusively to the validity of the priority claimed for document E1 which was considered as novelty-destroying prior art under Article 54(3) EPC in the decision under appeal.

Under Article 112(1)(a) EPC 1973, a board of appeal, either of its own motion or upon request from a party, refers any questions of law to the Enlarged Board of Appeal in order to ensure uniform application of the law, or if an important point of law arises, if it

considers that a decision is required for the above purposes.

As is clear from the foregoing reasoning (points 2 to 17 above), document E1 is not taken into account for assessing the patentability of the subject-matter of claim 1 of the appellant's main request and first and second auxiliary requests. Hence, the validity of the priority claimed for document E1 is not relevant for the board's decision.

Consequently, the board does not see any necessity to refer the appellants' questions to the Enlarged Board of Appeal and the appellant's request must therefore be refused.

## Order

### For these reasons it is decided that:

1. The request for a referral to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:

The Chairwoman:



K. Boelicke

T. Karamanli

Decision electronically authenticated