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**Datasheet for the decision  
of 10 January 2012**

**Case Number:** T 0346/11 - 3.5.04

**Application Number:** 04773789.5

**Publication Number:** 1677302

**IPC:** G11B27/10

**Language of the proceedings:** EN

**Title of invention:**

RECORDING MEDIUM, PLAYBACK APPARATUS, PROGRAM, AND PLAYBACK METHOD

**Applicant:**

Panasonic Corporation

**Headword:**

**Relevant legal provisions:**

RPBA Art. 12(2), Art. 13(1)  
EPC Art. 123(2)

**Keyword:**

Admission of late filed requests - no  
Added subject-matter - yes

**Decisions cited:**

**Catchword:**

see point 4



Case Number: T0346/11 - 3.5.04

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.04**  
**of 10 January 2012**

**Appellant:** Panasonic Corporation  
(Applicant) 1006, Oaza Kadoma  
Kadoma-shi  
Osaka 571-8501 (JAPON)

**Representative:** Grünecker, Kinkeldey,  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted 6 August 2010  
refusing European patent application No.  
04773789.5 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** R. Gerdes  
C. Vallet

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the examining division to refuse European patent application No. 04 773 789.5.
- II. The patent application was refused by the examining division according to Article 97(2) EPC because the subject-matter of claim 1 of the applicant's main request as well as of the first and second auxiliary requests was found to lack clarity.
- III. With the statement setting out the grounds of appeal, the appellant submitted a new set of claims to replace the claims underlying the decision under appeal.
- IV. In the communication annexed to the summons to oral proceedings, the board expressed its provisional opinion that the amended claims contained subject-matter extending beyond the content of the application as filed (Article 123(2) EPC) and lacked clarity (Article 84 EPC 1973).
- V. With a letter dated 7 December 2011 the appellant filed a new set of claims to replace all previous claims.
- VI. At the end of the oral proceedings, which were held on 10 January 2012, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of new claim 1 of the main request submitted in the oral proceedings and accordingly adapted claims 2 to 4 as filed with letter of 7 December 2011, or alternatively, as a first auxiliary request on the basis of claims 1 to 4 filed with letter of 7 December 2011, or alternatively, as a second auxiliary request that the case be remitted to the

first instance for further prosecution on the basis of claims 1 to 7 of the main request filed with letter of 7 May 2010.

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

"A recording medium on which is recoded [sic] a plurality of titles between which branching is possible, a first module control program and a second module control table, the recording medium supplying either of the first module control program and the second module control table to a playback apparatus,

characterized in that

the first module control program includes a sequence of navigation commands to be executed by the playback apparatus;

when executed, the sequence of navigation commands causes the playback apparatus to (i) set a player status register of the playback apparatus, and (ii) execute playback control; the second module control table includes an application management table showing an application ID with a run attribute, and

if an application identified by the application ID has a non-run status in a branch origin title and the run attribute in a branch destination title is an autorun attribute, said run attribute is adapted to indicate to the application manger [sic] that, the application identified by the application ID is to be loaded to a heap area of the playback apparatus and automatically executed by a Java virtual machine included in a platform of the playback apparatus."

VIII. Claim 1 of the first auxiliary request reads as follows.

"A recording medium on which is recoded [sic] an index table, a first module control program and a second module control table, the recording medium supplying either of the first module control program and the second module control table to a playback apparatus,

characterized in that

the index table shows each title number in correspondence with one of the first module control program and the second module control table,

the first module control program includes a sequence of navigation commands to be executed by the playback apparatus when a title number corresponding to the first module control program is set in the title number register as the current title number,

when executed, the sequence of navigation commands causes the playback apparatus to (i) set a player status register of the playback apparatus, and (ii) execute playback control the second module control table includes an application management table showing an application ID with a run attribute, and

if the run attribute is an autorun attribute, said run attribute is adapted to indicate to the application manger [sic] that, when a title number corresponding to the second module control table is set in the title number register as the current title number, an application identified by the application ID is to be load [sic] to a heap area of the playback apparatus and

automatically executed by a Java virtual machine included in a platform of the playback apparatus."

IX. Claim 1 of the second auxiliary request reads as follows.

"A recording medium (100) on which is recorded an index table, management tables, a [sic] least one application, a plurality of titles and operation mode objects, wherein the index table shows a one-to-one correspondence between title numbers and identifiers of operation mode objects,

a first operation mode object corresponds to a mode for operating a playback apparatus on a command base, and a second operation mode object prescribes a control procedure for operating the playback apparatus on a programming base of a Java programming language,

characterized in that

one of the titles is a top menu title that is a root of a hierarchical structure of titles,

the second operation mode object stores a management table and prescribes a control procedure for operating the playback apparatus by means of an application specified in the management table, the application is a program written in a Java programming language, each management table shows, in correspondence, the application and a run attribute of the application, and the run attribute corresponding to one of the titles that has to be a branch destination is an automatic run attribute for automatically running the application, if the application has a non-run status in a branch origin title."

- X. As regards the admissibility of the main request submitted in the oral proceedings, the appellant argued that amended claim 1 was intended to overcome the objections under Article 84 EPC 1973 and Article 123(2) EPC raised in the board's communication and in the oral proceedings. It should be admitted as a justified reaction to these objections.
- XI. Regarding the first auxiliary request, the appellant argued that the features of claim 1 relating to the title number register were disclosed in the application as filed. According to page 35, lines 4 to 15, the HDMV module issues a function call to the playback control engine (see also figure 19). The playback control engine sets the status of the playback apparatus in response to this function call (page 34, lines 17 to 26) and when performing branch control, the module manager receives a title number from the title number register (page 31, lines 20 to 29 and page 35, lines 16 to 26).
- XII. The appellant's arguments in respect of the admissibility of the second auxiliary request may be summarised as follows.

The claims are those of the main request underlying the decision under appeal. They were found by the examining division to lack clarity regarding the term "title". It was understood from the discussion during the oral proceedings that the board did not share this opinion. Hence, the examining division's reasons for the refusal did not persist in this respect. Therefore the case should be remitted to the examining division to continue examination on the basis of these claims.

## Reasons for the Decision

1. The appeal is admissible.
2. *Main Request*
  - 2.1 According to Article 13(1) RPBA (Rules of Procedure of the Boards of Appeal, 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. The board's 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 If an applicant for a patent desires to submit amendments in the course of appeal proceedings, this should be done at the earliest possible moment. It is only in exceptional circumstances, where there is some clear justification both for the amendment and for its late submission, that it is likely that an amendment not submitted in good time before oral proceedings will be considered on its merits in the proceedings (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, section VII.E.16.3).
  - 2.3 Claim 1 of the main request was presented at the oral proceedings. It essentially differs from claim 1 as submitted by letter of 7 December 2011 in that all references to the title number register and the index table were deleted. Additionally, the first and last features of claim 1 were amended to read (added passages underlined by the board):



- a) "A recording medium on which is recoded [sic] a plurality of titles between which branching is possible" and
- b) "if an application identified by the application ID has a non-run status in a branch origin title and the run attribute in a branch destination title is an autorun attribute, said run attribute is adapted to indicate to the application manger [sic] that, the application identified by the application ID is to be loaded to a heap area of the playback apparatus and automatically executed by a Java virtual machine included in a platform of the playback apparatus."

2.4 The board sees no justification for these amendments only being submitted during the oral proceedings. Contrary to the appellant's argument the board does not consider these amendments to be a justified reaction to new objections since the communication accompanying the summons (penultimate paragraph on page 3) had already set out that "branching between an origin title and a destination title appears to be essential for the present case".

2.5 Furthermore, the deletion of the reference to the index table raises new questions with respect to the clarity of the amended claims. According to the application (see page 89, lines 2 to 8) "the optical disk of the present invention is characterized by the recorded dynamic scenarios and the Index Table, ...". The passage continues: "[a]ny form of recording media is applicable as long as there exists the capacity to record dynamic scenarios and Index Tables". It therefore appears that the concept of an index table showing title numbers in correspondence with first module control programs and second module control

tables is essential for branching between titles. Optimisation of branching between titles and in particular avoiding long title boundaries when branching between titles is described as the technical problem addressed by the application (see page 1, line 27 to page 2, line 12). Consequently, the amendments made were not clearly allowable, but rather raised new issues of clarity and support by a description of over ninety pages, which would have made it much more complex for the board to arrive at a decision during the oral proceedings than if those amendments had been filed in time.

2.6 Since, in conclusion, there was no clear justification both for at least some of the amendments and for their late submission, the board decided not to admit the main request.

### 3. *First Auxiliary Request*

3.1 According to Article 123(2) EPC the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. In accordance with the established case law, an amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed if the overall change in the content of the application results in the skilled person being presented with information which is not directly and unambiguously derivable from the application as originally filed.

3.2 The last feature of claim 1 specifies that "when a title number corresponding to the second module control table is set in the title number register as the current title number", an autorun attribute indicates

to the application manager that an application identified by its application ID is to be loaded to a heap area of the playback apparatus.

3.3 According to the description as filed, the playback apparatus comprises "a register ... composed of 64 Player Status Registers (PSR) ...". One of these 64 registers is denominated "PSR 4" and "indicate[s] a Title to which the current playback position belongs" (page 31, lines 20 to 29). Together with the further registers PSR5 to PSR8 "it is possible to identify the current playback position" (page 32, lines 1 to 14). Hence, even though the expression "title number register" used in claim 1 is not explicitly disclosed in the application as filed, it is understood to refer to the register PSR 4.

3.4 There are no further passages in the application as filed referring to register PSR 4, i.e. to the title number register.

In particular, the passage on page 34, lines 17 to 26, only refers to obtaining and setting statuses in the playback apparatus without providing details of the functionality of individual registers. It discloses that "[t]he playback control engine (PCE) 32 performs functions that include ... (ii) status obtaining/setting function for obtaining and setting statuses in the playback apparatus". Function (ii) is "performed in response to the function calls that are issued by the HDMV module 33, the module manager 34 and the BD-J module 35". This passage does not disclose whether the title number register can be set in response to a function call or whether, for example, it can only be read. More importantly, this passage does not specify under what conditions the register is set and which

operations in the playback apparatus are conditional on the fact that a title number "corresponding to the second module control table is set in the title number register as the current title number".

Hence, the condition specified in the last feature of claim 1 is not directly and unambiguously disclosed in the application as filed. As a result, claim 1 contravenes Article 123(2) EPC.

3.5 The appellant additionally referred to page 35, lines 4 to 26, of the description as a basis for the amendment. This passage describes a branch operation between two titles. The sequence of operations in this mode is illustrated with reference to figure 19, which applies to branching in movie mode. The corresponding sequence of operations for branching in BD-J mode is shown in figure 20. The appellant argued that the second part of the above passage starting from line 16 discloses that the module manager receives a title number from the title number register.

The title number register is, however, not referred to in the passage on page 35. In particular, the passage does not specify that loading and starting of applications may be conditional on the content of the title number register.

There is also no implicit disclosure in this passage which would allow the conclusion that the title number register had to contain the title number of the branch destination title before applications were processed according to their attributes in the application manager. Page 35, lines 18 to 22, refers to "receiving a Title number that is a jump destination when the HDMV module 33 has executed a JumpTitle command or when the

BD-J module 35 has issued a Title jump API". Figure 8b shows an xlet containing a jump title function call. This function call includes the branch destination title number as an argument (see last line of the xlet: "Jump Title(Title #1);" and page 18, lines 7 to 9: "[t]his function API instructs the playback apparatus to branch to another Title (Title#1 in Fig. 8B)"). Since - according to these passages - the title number of the branch destination title is available at the HDMV module in movie mode or at the BD-J module in BD-J mode, there is no necessity for extracting the title number of the branch destination from another source such as the title number register. As a result there is no implicit disclosure to the effect that the title number register contained the title number of the branch destination title before applications were processed by the application manager according to their attributes.

3.6 In conclusion, the last feature of claim 1 is neither explicitly nor implicitly disclosed in the application as filed. Hence, claim 1 of the first auxiliary request contravenes Article 123(2) EPC.

#### 4. *Second Auxiliary Request*

4.1 According to Article 12(2) RPBA, the statement of grounds of appeal shall contain a party's complete case. It shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed or amended.

The provision of Article 13(1) RPBA, also relevant in this context, has already been cited under point 2.1 above.

4.2 In the present case, the appellant requested, as a second auxiliary request, at the very end of the oral proceedings that the case be remitted to the first instance for further prosecution on the basis of the then main request filed on 7 May 2010, i.e. the request which is the subject-matter of the contested decision and was found not to meet the clarity requirements.

4.3 The board considers it inappropriate for the appellant to accept (by filing amended claims with the statement of grounds of appeal) the objection of lack of clarity raised by the first instance and then to change its mind at an extremely late stage of the proceedings, requesting in fact that the board reverse the reasoning of the first instance on clarity, which had hitherto not been the subject-matter of the debate.

It must be borne in mind that it is the duty of the appellant to define the scope of the appeal as set out in the above cited Article 12(1) RPBA. The appellant has the discretion to appeal against the decision only in part and to argue accordingly in the statement of grounds. However, a new request which changes the scope of the appeal, in particular if, as in the present case, it is not supported by any reasoning as to why the contested decision should be reversed and is submitted at a very late stage of the proceedings, cannot be admitted into the proceedings in accordance with Article 13(1) RPBA.

The second auxiliary request is thus not admissible.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger