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**Datasheet for the decision  
of 30 May 2017**

**Case Number:** T 0360/12 - 3.5.04

**Application Number:** 05077271.4

**Publication Number:** 1613065

**IPC:** H04N5/445, H04N5/765

**Language of the proceedings:** EN

**Title of invention:**

Electronic program guide with digital storage

**Patent Proprietor:**

Rovi Guides, Inc.

**Opponents:**

Banford/Every/Holmes/Kenrick/Roberts (former opponents)  
Brunner, John M. O./Williamson, Claire Louise  
Canal+ France (former opponent)  
Virgin Media Limited  
TechniSat Digital GmbH (former opponent)  
Tele Columbus Multimedia GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)  
EPC 1973 Art. 56  
RPBA Art. 13(1), 13(3)

**Keyword:**

Late-filed main request - admitted (yes)  
Late-filed first auxiliary request - need for additional search (yes)  
Late-filed second and third auxiliary requests - admitted (yes)  
Main request - Amendments - added subject-matter (yes)  
Inventive step - second and third auxiliary requests (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0360/12 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 30 May 2017**

**Appellant:** Rovi Guides, Inc.  
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**Decision under appeal:**      **Decision of the Opposition Division of the  
European Patent Office posted on 29 December  
2011 revoking European patent No. 1613065  
pursuant to Articles 101(2) and 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**                    C. Kunzelmann  
**Members:**                 B. Willems  
                                  T. Karamanli

## Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division to revoke European patent No. 1 613 065 "*in accordance with Articles 101(2) and 101(3)(b) EPC*". The patent is based on European patent application No. 05 077 271.4 which is a divisional application of earlier European patent application No. 99 948 321.7.
- II. Oppositions to the patent were filed *inter alia* jointly by John Michael Owen Brunner and Claire Louise Williamson (henceforth joint respondents I) and by Virgin Media Limited (henceforth respondent II). In the course of the opposition procedure, an admissible intervention was filed by the assumed infringer Tele Columbus Multimedia GmbH (henceforth respondent III). The oppositions were based on the grounds for opposition under Article 100(a), (b) and (c) EPC.
- III. The patent was revoked on the grounds that the subject-matter of the claims of the patent proprietor's main request and first and second auxiliary requests extended beyond the disclosure of the divisional application as filed or the disclosure of the parent application as filed and the subject-matter of claim 1 of its fourth auxiliary request lacked inventive step over the combination of the disclosures of documents O1/E3 (WO 90/15507) and O5/E5 (US 5,701,383) and the common general knowledge of the person skilled in the art. The patent proprietor's third auxiliary request was not admitted into the opposition proceedings.
- IV. The patent proprietor filed an appeal against this decision and requested that the decision be set aside and that the oppositions be rejected, or in the alternative, that the patent be maintained in amended

form on the basis of one of the first to third auxiliary requests forming the basis for the impugned decision. With the statement of grounds of appeal, the appellant filed amended claims according to a fourth auxiliary request and submitted arguments as to why these requests overcame the objections raised in the decision under appeal.

V. Only respondent III filed a reply to the appeal, and requested that the appeal be dismissed.

VI. In a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536), annexed to the summons to oral proceedings, the board indicated that it would have to be discussed whether:

(a) the feature

*"relates to at least one/a storage setting configured to control **how** programs are to be digitally stored"* (emphasis added)

of independent claims 1, 8, 15 and 22 of the then main request (Article 100(c) EPC), claims 1 and 8 of the first auxiliary request and claims 1 and 5 of the second auxiliary request (Article 123(2) EPC) could be directly and unambiguously derived from setting the *"automatic erasure"* and the *"parental control"* options referred to in the divisional application as filed;

(b) the selection of storage options for each programme individually as specified in independent claims 8 and 22 of the main request (Article 100(c) EPC) could be directly and unambiguously derived from the disclosure of the parent application as filed;

(c) the third auxiliary request should be admitted into the appeal proceedings in view of Article 12(4) RPBA;

(d) the subject-matter of claim 1 of the fourth auxiliary request involved an inventive step with respect to the combination of the disclosures of documents O1/E3 and O5/E5 (Article 56 EPC 1973).

VII. Joint respondents I informed the board with a letter dated 21 March 2017 that they would not be represented at the oral proceedings.

VIII. In reply to the summons, the appellant filed amended claims according to new first to fourth auxiliary requests and submitted a copy of the claims according to the main request on file. The appellant put forward arguments as to why the subject-matter of the claims of all requests was directly and unambiguously derivable from both the earlier application as filed and the divisional application as filed, and why the subject-matter was new and involved an inventive step.

IX. Oral proceedings before the board were held on 30 May 2017 in the absence of joint respondents I.

During the oral proceedings, the appellant filed amended claims according to a main request and according to a third auxiliary request. Further, the appellant re-submitted, as the appellant's second auxiliary request, the fourth auxiliary request filed with the statement of grounds of appeal and replaced with its auxiliary requests filed with letter dated 30 April 2017.

After deliberation by the board, the Chairman informed the parties that the re-filed second auxiliary request was admitted into the appeal proceedings and asked respondents II and III whether they had any objections to its allowability. They argued that the re-submitted request did not comply with Articles 84 and 123(2) EPC. After deliberation by the board, the Chairman informed the parties that the respondents' new objections of added subject-matter were admitted into the appeal proceedings since they were a reaction to the appellant's re-filed second auxiliary request which had just been admitted into the appeal proceedings. After a discussion on the objection of added subject-matter with respect to the divisional application as filed on which the patent was based and a subsequent deliberation by the board, the Chairman informed the parties that any conclusion on Article 123(2) EPC would be preceded by a discussion on inventive step.

The parties confirmed their final requests as follows:

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims of the main request filed at the oral proceedings of 30 May 2017, or of one of the first auxiliary request filed with letter dated 30 April 2017, the second auxiliary request filed as fourth auxiliary request with the statement of grounds of appeal, or the third auxiliary request filed at the oral proceedings of 30 May 2017.

Respondents II and III requested that the appeal be dismissed.



The Chairman noted that joint respondents I had not filed any request.

At the end of the oral proceedings the Chairman announced the board's decision.

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

"A method for allowing a user to select storage options (122) for storing programs using an interactive television program guide implemented on user television equipment (22), the method comprising:

receiving program guide data, including program listings, transmitted as data signals using a communications path from a distribution facility;

enabling the user to select at least one storage option (122) for storing a program to be recorded, wherein the at least one storage option (122) relates to at least one storage setting configured to control how programs are to be digitally stored;

in response to a user selection of the at least one storage option (122), modifying the at least one storage setting;

displaying in the interactive television program guide at least one received program listing (61) related to at least one program;

enabling the user to select a program listing (61) from the at least one displayed program listing (61) for recording on a random access digital storage device (31); and

recording the program on the random access digital storage device (31), wherein the program is stored in accordance with the modification of the at least one storage setting."

XI. Claim 1 of the first auxiliary request reads as follows:

"A method for allowing a user to select storage options (122) for storing programs using an interactive television program guide implemented on user television equipment (22), the method comprising:

receiving program guide data, including program listings, transmitted as data signals using a communications path from a distribution facility;

enabling the user to select a storage option (122) for storing programs to be recorded, wherein the storage option (122) relates to a storage setting configured to control how programs are to be digitally stored by selecting a video format for recording programs;

in response to a user selection of the storage option (122), modifying the storage setting;

displaying in the interactive television program guide received program listings (61) each related to a program;

enabling the user to select a program listing (61) from the displayed program listings (61) for recording the program of the selected program listing (61) on a random access digital storage device (31); and

recording the program of the selected program listing (61) on the random access digital storage device (31), wherein the program is stored in accordance with the modification of the storage setting, wherein the program is supplied in a plurality of video formats and only the video format which matches the selected video format for recording programs is stored."

XII. Claim 1 of the second auxiliary request reads as follows:

"A method for allowing a user to select storage options (122) for storing programs using an interactive television program guide implemented on user television equipment (22), the method comprising:

receiving program guide data, including program listings, transmitted as data signals using a communications path from a distribution facility;

enabling the user to select a storage option (122) for storing programs to be recorded, wherein the storage option (122) relates to a storage setting configured to control how programs are to be digitally stored by selecting a video format for recording programs;

in response to a user selection of the storage option (122), modifying the storage setting;

displaying in the interactive television program guide received program listings (61) related to programs;

enabling the user to select program listings (61) from the displayed program listings (61) for recording on a random access digital storage device (31); and

recording the programs on the random access digital storage device (31), wherein the programs are stored in accordance with the modification of the storage setting."

XIII. Claim 1 of the third auxiliary request reads as follows:

"A method for allowing a user to select storage options (122) for storing programs using an interactive television program guide implemented on user television equipment (22), the method comprising:

receiving program guide data, including program listings, transmitted as data signals using a communications path from a distribution facility;

enabling the user to select a storage option (122) for storing programs to be recorded, wherein the storage option (122) relates to a storage setting configured to control how programs are to be digitally stored by selecting a video format for recording programs;

in response to a user selection of the storage option (122), modifying the storage setting;

displaying in the interactive television program guide received program listings (61) related to programs;

enabling the user to select program listings (61) from the displayed program listings (61) for recording on a random access digital storage device (31); and

recording the programs on the random access digital storage device (31), wherein the programs are stored in

accordance with the modification of the storage setting,

wherein the video format is one of high definition television and normal television format."

XIV. The opposition division's arguments, as far as they are relevant for the present decision, may be summarised as follows:

- (a) The subject-matter of claim 1 of the then main request and the then first and second auxiliary requests extended beyond the disclosure of the divisional application as filed, because the term "*how*" was not a proper generalisation of the examples disclosed in the application as filed. The "*automatic erasure*" and the "*parental control*" settings referred to in the description did not necessarily result in a modification of the stored programmes. Furthermore, the single occurrence of "*For example*" in the description did not justify broadening the scope of protection to storage options which had not been mentioned.
- (b) Document 01/E3 was identified as the closest prior art for the assessment of inventive step (Article 56 EPC). The opposition division reasoned that starting from the disclosure of document 01/E3 the skilled person would substitute the analog video recorder with a random access digital storage device and would provide user options to select compression algorithms or compression ratios for storing programmes as suggested by document 05/E5. The skilled person would incorporate these additional options into the existing interactive programme guide.

XV. The appellant's arguments, as far as they are relevant for the present decision, may be summarised as follows:

*(a) Concerning the admissibility of the requests:*

- (i) In response to the objections raised in the summons, the main request had been amended by deleting claims from the main request previously on file. In the remaining claims only the claim numbering had been adapted.
- (ii) Claim 1 of the first auxiliary request basically corresponded to claim 1 of the fourth auxiliary request filed with the statement of grounds of appeal, with the addition of a feature from the description. The amendment was a response to the objection raised against the fourth auxiliary request in the annex to the summons to oral proceedings, and further specified features already present in the claim.
- (iii) The second auxiliary request corresponded to the fourth auxiliary request filed with the statement of grounds of appeal and had been submitted as a reaction to the board not admitting the first auxiliary request into the appeal proceedings.
- (iv) Claim 1 of the third auxiliary request corresponded to the combination of independent claim 1 with dependent claim 3 of the second auxiliary request.

*(b) Concerning added subject-matter:*

The divisional application as filed disclosed that the user could select the language tracks or video formats to be stored with a programme. Similarly, additional subtitles could be stored with the programme. The wording "*storage setting configured to control **how** programs are to be digitally stored*" [emphasis added] was an appropriate generalisation of these examples of how a programme could be stored.

*(c) Concerning inventive step:*

Document 01/E3 merely disclosed recording a programme or not, depending on parental control settings. The limited digital storage space available in the apparatus known from document 05/E5 was not suitable for recording selected programmes. The different compression ratios referred to in document 05/E5 were not comparable to the formats specified in the claims. The opposition division had only evaluated whether the person skilled in the art could have arrived at the invention, not whether the person skilled in the art would have done.

XVI. Joint respondents I did not submit any arguments in writing.

XVII. The arguments of respondent II, as far as they are relevant for the present decision, may be summarised as follows:

*(a) Concerning the admissibility of the requests:*

- (i) The main request should have been filed with the statement of grounds of appeal.

- (ii) So should the first auxiliary request. The introduction of a feature from the description into claim 1 of the first auxiliary request obliged the opponents to perform a further search. Not all amendments had been occasioned by a ground for opposition, and the amended claim was *prima facie* not compliant with Articles 84 and 123(2) EPC.
  
- (iii) The second auxiliary request corresponded to a request which had been withdrawn. Claim 1 of the request was *prima facie* not allowable for the reasons set out in the summons with respect to the fourth auxiliary request.
  
- (iv) The third auxiliary request should have been filed with the statement of grounds of appeal. It did not *prima facie* overcome the inventive-step objection raised against claim 1 of the second auxiliary request.

*(b) Concerning added subject-matter:*

The language tracks referred to by the appellant were stored **with** the programme [emphasis added]. Even if storing the language tracks could be considered as relating to storing the programme itself, the application as filed only disclosed two examples of setting options which affected which programme data was stored, namely language tracks and video format. These examples did not justify a generalisation to the wording of the claim.



*(c) Concerning inventive step:*

Respondent II referred to the annex to the summons to oral proceedings. The formats listed in claim 1 of the third auxiliary request merely implied that either a format with higher definition or a format with lower definition could be selected for recording programmes.

XVIII. The arguments of respondent III, as far as they are relevant for the present decision, may be summarised as follows:

*(a) Concerning the admissibility of the requests:*

- (i)* In view of the restrictive case law of the boards of appeal concerning the filing of requests after the statement of grounds of appeal, the main request should have been filed with the statement of grounds of appeal.
- (ii)* The conditions or "*guidelines*" for allowing requests after the arrangement of oral proceedings, as set out in the Case Law of the Boards of Appeal of the European Patent Office, 8th edition, 2016, section IV.E.4.2.5, were not met. Moreover, the introduction of a feature from the description into claim 1 of the first auxiliary request obliged the opponents to perform a further search.
- (iii)* The reintroduction of a request previously on file and replaced by another request would be in breach of the principle of procedural fairness. Nothing in the

respondent's behaviour could have prompted the appellant to file the second auxiliary request.

- (iv) Respondent III agreed with the reasons given by respondent II for not admitting the third auxiliary request into the proceedings (see point XVII(a)(iv) above).

*(b) Concerning added subject-matter:*

Both the divisional application as filed and the earlier application as filed referred to storing additional components which were clearly not part of the programme as such. Further, in both applications a clear distinction was made between storing programmes and storing programme-associated data.

*(c) Concerning inventive step:*

In the written submission of respondent III, document O1/E3 was identified as the closest prior art to the subject-matter of claim 1 of the fourth auxiliary request filed with the statement of grounds of appeal. It argued that the person skilled in the art would have considered replacing the analog tape known from document O1/E3 with a digital storage medium. Further, selecting a video format for storing data was known from document O5/E5. During the oral proceedings, respondent III concurred with the arguments presented by respondent II.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Request of respondent II and respondent III that the appellant's main request not be admitted into the proceedings*
  - 2.1 The appellant's main request was filed in the oral proceedings before the board. It thus constitutes an amendment to the appellant's case after the grounds of appeal had been filed and may be admitted and considered at the board's discretion (Article 13(1) RPBA), this discretion being 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. Moreover the new request is an amendment to the appellant's case after oral proceedings had been arranged and thus, in accordance with Article 13(3) RPBA, it should not be admitted if it raises issues which the board or the other parties could not reasonably be expected to deal with without adjournment of the oral proceedings.
  - 2.2 The present main request differs from the main request forming the basis of the decision under appeal in that claims 8 to 14 and 22 to 28 have been deleted and the remaining claims have been renumbered. Deleting these claims facilitated the proceedings and did not raise any issues the other parties or the board could not reasonably be expected to deal with without adjournment of the oral proceedings.

- 2.3 In view of the above, the board, exercising its discretion under Article 13(1) and (3) RPBA, admitted the appellant's main request into the proceedings.
3. *Request of respondent II and respondent III that the appellant's first auxiliary request not be admitted into the proceedings*
- 3.1 According to the consistent case law of the boards of appeal, if an additional search is needed to assess the patentability of claims amended with features from the description at such a late stage that either the oral proceedings must be adjourned or the case must be remitted to the department of first instance for further prosecution, Article 13(3) RPBA is against the admissibility of such claim requests (Case Law of the Boards of Appeal of the European Patent Office, 8th edition, 2016, section IV.E.4.4.8 b), Features taken from the description - Art. 13(3) RPBA).
- 3.2 In comparison with claim 1 of the main request, claim 1 of the first auxiliary request has been amended by including the feature "*wherein the program is supplied in a plurality of video formats and only the video format which matches the selected video format for recording programs is stored*".
- 3.3 The appellant's first auxiliary request was filed one month before the oral proceedings and the newly introduced feature had been taken from the description. Respondent II submitted that although a preliminary search had been carried out in preparation for the oral proceedings, a comprehensive search would require more time. Respondent III submitted that the subject-matter of amended claim 1 according to the first auxiliary request could not have been searched yet and therefore

the oral proceedings should be adjourned. The board agrees that the assessment of novelty and inventive step of the subject-matter of amended claim 1 would require the respondents to carry out an additional search, even if the newly introduced feature merely further specified the selection of video formats already present in previously filed claims.

3.4 Further, in section 7 of its communication annexed to the summons and, in particular, in point 7.5, the board agreed with the opposition division's findings on inventive step without introducing any new reasoning. Therefore, the board is not persuaded that the amendment was introduced as a prompt reaction to the objections raised by the board in its communication.

3.5 In view of the above, the board, exercising its discretion under Article 13(1) and (3) RPBA, decided not to admit the appellant's first auxiliary request into the proceedings.

4. *Request of respondent II and respondent III that the appellant's second and third auxiliary requests not be admitted into the proceedings*

4.1 The second auxiliary request is the previous fourth auxiliary request filed with the statement of grounds of appeal, and thus a re-filed request.

4.2 The board does not see the "*approach frequently adopted by the boards*" for admitting amendments after the arrangement of oral proceedings (Case Law of the Boards of Appeal of the European Patent Office, 8th edition, 2016, section IV.E.4.2.5) as a set of rules or "*guidelines*" which must be followed when deciding on the admission of requests. An obligation to apply this

set of rules would prevent the board from exercising the discretion conferred on it by Article 13 RPBA.

4.3 The board notes that the respondents had ample opportunity to provide their comments on the claims according to the fourth auxiliary request filed with the statement of grounds of appeal. Respondent III filed comments on the patentability of the subject-matter of these claims. Respondent II did not submit any comments in writing. The fourth auxiliary request filed with the statement of grounds of appeal was replaced by the auxiliary requests filed with letter dated 30 April 2017 after the respondents had been given the opportunity to comment on this request. Moreover, no new subject-matter (over that of the claims of the fourth auxiliary request filed with the statement of grounds of appeal) was introduced in the second auxiliary request. In view of the above, the board, exercising its discretion under Article 13(1) RPBA, admitted the appellant's second auxiliary request into the proceedings.

4.4 The third auxiliary request is derived from the second auxiliary request as follows: claims 1 and 2 of the third auxiliary request differ from claims 1 and 4 of the second auxiliary request in that the features of dependent claims 3 and 6 of that request have been incorporated into the respective independent claims. Moreover, in the third auxiliary request the remaining dependent claims of the second auxiliary request have been deleted. In view of the fact that the claims according to the third auxiliary request were a combination of claims of the second auxiliary request, the board, exercising its discretion under Article 13(1) RPBA, admitted the appellant's third auxiliary request into the proceedings.

5. *Main request - added subject-matter (Article 123(2) EPC)*

5.1 Claim 1 of the main request specifies that at least one storage option

*"relates to at least one storage setting configured to control **how** programs are to be digitally stored"*  
(emphasis added).

5.2 The appellant provided the following passages in the description of the divisional application as filed as a basis for said wording:

*page 36, lines 6 to 16: "Storage option area 122 allows the user to select options relating to storage. For example, the user can select the language tracks or video formats for storing with a program";*

*Figure 14;*

*page 20, line 14 to page 21, line 2: "The program guide may also store associated program data in a directory entry of digital storage device 49 ... Along with the program and associated program data, the program guide may also store additional components of a program on digital storage device 49. This can include additional video formats, additional languages, additional subtitles, or other data that cannot be stored in a directory entry. The program guide will either store all of the supplied video formats and languages, or store only the variant that matches the current viewer profile preferences".*

5.3 The appellant reasoned that from the cited passages, when read in conjunction, it was immediately apparent that the programme data was stored as a programme package including video data in a selected format, selected language tracks and selected subtitles for storing with the programme data. The divisional application as filed clearly distinguished between this programme data and programme-associated data which was stored separately. Thus, the user could select video formats, languages and subtitles and this selection affected which components were included in the programme package, i.e. how this programme package was stored. Further, the appellant argued that the skilled person could easily imagine additional components or data to be stored in the programme package if selected by a user.

5.4 The board shares the doubts raised by respondent II as to whether the language tracks stored "*[a]long with the program*" could possibly be an example of how programmes are stored. Language tracks and subtitles are primarily an example of which components are stored rather than the manner in which (how) the programmes are stored. Only the example of video formats affects how programmes are stored in the sense that programmes are to be digitally stored in one format or another format. The board also shares the respondents' view that Figure 14 and the passages on pages 20 and 36 do not disclose that the user can influence which subtitles, if any, are stored. Thus, the description only discloses one, arguably two, example(s) of a setting configured to control how programmes are stored, namely format and possibly language. However, there is no disclosure that, let alone to what extent, the example(s) disclosed in the application as filed may be generalised. Therefore, the board agrees with the



objection set out in the impugned decision that the term "*how*" is not a proper generalisation of the example(s) given in the description of the divisional application as filed.

5.5 Therefore, the board concludes that the subject-matter of claim 1 of the main request extends beyond the disclosure of the divisional application as filed (Article 123(2) EPC).

6. *Second auxiliary request - inventive step (Article 56 EPC 1973)*

6.1 Claim 1 of the second auxiliary request is the same as claim 1 of the fourth auxiliary request filed with the statement of grounds of appeal and claim 1 of the fourth auxiliary request forming the basis for the decision under appeal.

6.2 The opposition division found document O1/E3 to be the closest prior art for the assessment of inventive step. The opposition division also found that document O1/E3 did not disclose the following features:

- (a) the interactive television programme guide uses a random access digital storage device, and
- (b) a storage setting configured to control how programmes are to be digitally stored by selecting a video format for recording.

The appellant did not contest these findings.

6.3 The board agrees with the appellant that the objective technical problem to be solved may be formulated as how to extend the functionality of the interactive

television programme guide to improve the user experience.

6.4 Unlike the appellant, the board concurs with the assessment of the opposition division that the skilled person would have replaced "*the analog tape recorder known from 01/D3 [sic] by a random access storage*" and would have been "*able to implement the compromises for trading off quality vs. recording time known from 05/E5 as part of an interactive program guide without the exercise of an inventive step*" (see decision under appeal, pages 20 and 21).

6.5 The appellant submitted the following arguments to refute this assessment:

6.5.1 The skilled person would have had no incentive to replace the analog tape used in document 01/E3 for recording programmes with a random access digital storage device even though document 05/E5 disclosed a digital storage device, because:

in document 05/E5 the digital storage device had limited capacity and was only used for intermediate storage of programmes before they were recorded on tape; and

the high costs of digital storage devices would have prevented the skilled person from using such devices for permanently storing programmes.

6.5.2 Document 01/E3 was clearly limited to setting parental control options for configuring whether a programme was to be recorded or not. Choosing to record a programme or not was remote from the decision in which format to record the programme. There was no hint in document

O1/E3 to offer further storage options to the user. Document O5/E5 should not be considered as appropriate prior art because it disclosed a video time-shifting system and made no reference to electronic programme guides. Even if the person skilled in the art were to consult document O5/E5, this document would not have offered a solution to the problem to be solved, because the different compression ratios disclosed in the document were completely unrelated to the video formats of claim 1.

- 6.6 The appellant's arguments did not convince the board for the following reasons:
- 6.6.1 As pointed out by respondent III, document O5/E5, column 5, lines 47 to 52, disclosed recording video programmes not only on a magnetic disk drive, but alternatively in a solid state memory such as a video RAM. The board is of the opinion that neither the limited storage space, which according to document O5/E5, Figures 2A, 2B and 2C nevertheless suffices to record 2 hours of video programmes, nor the alleged high costs would have prevented the person skilled in the art from following the continuous technical development to replace analog storage devices with digital ones.
- 6.6.2 The appellant's arguments relating to the selection of a video format are clearly based on the assumption that according to the claimed method a programme is broadcast and received in different formats from which the user can select one for recording the programme. The board concurs with the respondents that claim 1 does not specify receiving a programme in different formats, and hence the claim also covers the "television equipment" receiving the programme and

converting it to a user-selected video format for recording. Moreover, the term "*video format*" has no special meaning distinguishing it from the different resolutions or definitions generated by the "*spatial or temporal processing, frame-rate reduction*" listed in O5/E5, column 8, lines 4 to 6. The board is convinced that the person skilled in the art would have extended the functionality of the programme guide known from document O1/E3 by including in the menu shown in Figure 4 further options for a user to select. The options known from document O5/E5 are an obvious example of a possible extension of the functionality of the guide.

6.7 Therefore, the board concludes that the subject-matter of claim 1 of the second auxiliary request lacks inventive step with respect to the combination of the disclosures of documents O1/E3 and O5/E5 and the common general knowledge of the person skilled in the art (Article 56 EPC 1973).

6.8 Consequently, the respondents' objection of added subject-matter is no longer relevant.

7. *Third auxiliary request - inventive step (Article 56 EPC 1973)*

7.1 In comparison with claim 1 of the second auxiliary request, claim 1 of the third auxiliary request further specifies that "*the video format is one of high definition television and normal television format*".

7.2 The board agrees with the respondents' interpretation according to which the general reference to a "*high definition television format*" is not to be understood as a reference to a format with a particular spatial or

temporal resolution which might be specified in any relevant standard. Hence, the claim merely implies that either a format with higher "*definition*" or a format with lower "*definition*" can be selected for recording programmes. As already set out in point 6.6.2 above, such a selection is known from document O5/E5.

7.3 Thus, the board concludes that for the reasons set out in section 6 above, the subject-matter of claim 1 of the third auxiliary request lacks inventive step with respect to the combination of the disclosures of documents O1/E3 and O5/E5 and the common general knowledge of the person skilled in the art (Article 56 EPC 1973). Hence, the patent cannot be maintained in amended form on the basis of the third auxiliary request.

8. In view of the above, none of the appellant's requests is 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

C. Kunzelmann

Decision electronically authenticated