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**Datasheet for the decision
of 11 July 2018**

Case Number: T 0990/13 - 3.5.04

Application Number: 01993120.3

Publication Number: 1332614

IPC: H04N5/445

Language of the proceedings: EN

Title of invention:

Method and apparatus for automatic generation of query search terms for a program recommender

Applicant:

S.I.SV.EL. SOCIETA' ITALIANA PER LO SVILUPPO
DELL'ELETTRONICA S.P.A.

Headword:

Relevant legal provisions:

EPC 1973 Art. 54(1), 54(2), 111(1)
RPBA Art. 13(1), 15
EPC 1973 R. 71(2)

Keyword:

Main request - lack of novelty (yes)
Late-filed auxiliary request - admitted (no)

Decisions cited:

T 0602/03, T 1704/06, T 1587/07

Catchword:



Beschwerdekammern
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Case Number: T 0990/13 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 11 July 2018

Appellant: S.I.SV.EL. SOCIETA' ITALIANA PER LO SVILUPPO
(Applicant) DELL'ELETTRONICA S.P.A.
Via Sestriere 100
10060 None (TO) (IT)

Representative: Camolese, Marco
Metroconsult S.r.l.
Via Sestriere 100
10060 None (TO) (IT)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 4 December 2012
refusing European patent application
No. 01993120.3 pursuant to Article 97(2) EPC**

Composition of the Board:

Chairwoman T. Karamanli
Members: R. Gerdes
A. Dumont

Summary of Facts and Submissions

I. The appeal is directed against the decision to refuse European patent application No. 01 993 120.3, published as international application WO 02/37839 A2.

II. The patent application was refused by the examining division on the grounds that the subject-matter of independent claims 1 and 8 of the then sole request lacked novelty (Article 54(1) and (2) EPC) *inter alia* in view of the following document:

D1: US 6 005 565 A1.

III. The applicant appealed against this decision and requested that the decision under appeal be set aside and that a patent be granted on the basis of the sole set of claims underlying the decision under appeal and re-filed as the main request with the statement of grounds of appeal. In the alternative, the appellant requested that the decision "that the claims lack novelty" be set aside and that the case be remitted to the examining division for further examination (first auxiliary request). As a second auxiliary request, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the second auxiliary request filed with the statement of grounds of appeal or that the case be remitted to the examining division for further examination. As a third auxiliary request, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the third auxiliary request filed with the statement of grounds of appeal or that the case be remitted to the examining division for further

examination.

- IV. The board sent a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536), which was annexed to a summons to oral proceedings dated 27 April 2018 and contained the board's preliminary opinion.

The board indicated *inter alia* that it tended to concur with the examining division's opinion with respect to the novelty of the subject-matter of claim 1 of the main request filed with the statement of grounds of appeal. It also expressed its preliminary view that the subject-matter of claim 1 of the second auxiliary request appeared to lack novelty in view of D1 and that the subject-matter of claim 1 of the third auxiliary request appeared not to involve an inventive step. It further indicated that it was not inclined to remit the case to the examining division for further examination. The appellant was also reminded of the provisions of Article 13 RPBA.

- V. With its reply dated 7 June 2018, the appellant submitted new claims of a main request and a first auxiliary request. The last page of the reply contained the following paragraph:

"Prosecution of the application

It is hereby requested to grant the patent according to the Main Request or according to the first Auxiliary Request or, a second Auxiliary Request, to remit the case to the Examining Division, set in order of preference."

VI. By letter of 6 July 2018 the appellant's representative informed the board that it would not be attending the oral proceedings.

VII. Oral proceedings were held before the board on 11 July 2018 in the absence of the duly summoned appellant.

In the oral proceedings, the chairwoman noted that the appellant had requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the claims according to the main request or, in the alternative, on the basis of the claims of the first auxiliary request, both requests as filed by letter of 7 June 2018, or that the case be remitted to the examining division for further examination.

The board understood that these requests replaced all previously filed requests.

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

"A method for constructing an automatic query of an electronic program guide (110), comprising the step of:

a television program recommender (100) receiving a command from a user initiating said automatic query;

the television program recommender (100) retrieving one or more prior queries performed by said user;

characterized in that said method comprises:

the television program recommender (100), in response to the command, generating said automatic query

comprised of at least one attribute-value pair (450) for each of a plurality of program attributes (340, 345, 350, 355), wherein the television program recommender (100) automatically selects at least one of said attribute-value pairs (450) based on said one or more prior queries."

IX. Claim 1 of the first auxiliary request is worded as follows:

"A method for constructing an automatic query of an electronic program guide (110), comprising the steps of:

a television program recommender (100) receiving a command from a user initiating said automatic query;

the television program recommender (100) retrieving one or more prior queries performed by said user;

characterized in that said method comprises the following steps:

the television program recommender (100) receiving one or more default attribute-value pairs;

the television program recommender (100), in response to the command, generating said automatic query comprised of at least one attribute-value pair (450) for each of a plurality of program attributes (340, 345, 350, 355), wherein the television program recommender automatically selects at least one of said attribute-value pairs (450) based on said one or more prior queries, wherein said at least one of said attribute-value pairs (450) selected based on said one or more prior queries is obtained using the top-N

attribute-value pairs, where N is a positive number, that have been previously used in a query and wherein said one or more default attribute-value pairs supersede said corresponding top-N search attribute-value pairs."

- X. The examining division's stance on the lack of novelty of the then valid claim 1 in view of D1 was essentially as follows (see communication dated 29 August 2012 to which the decision under appeal refers, point 2):

D1 disclosed a method for constructing a query of an electronic program guide (see column 3, line 11, to column 4, line 34), comprising the steps of: receiving a command from a user initiating said query (see the "go" button); retrieving one or more prior queries performed by said user (see the "filter logs"); and generating said query comprised of at least one attribute-value pair (herein called "search criteria" or "filter element") for each of a plurality of program attributes (topic, category, cost, rating, length, start time, end time), wherein at least one of said attribute-value pairs was selected based on said one or more prior queries (see the "filter logs [...] such that the search can be re-performed").

Therefore, the subject-matter of method claim 1 (and of corresponding system claim 8) lacked novelty with regard to the disclosure of D1.

- XI. The appellant's arguments where relevant for the present decision may be summarised as follows:

D1 failed to disclose the construction of a new query based on the automatic selection of attribute-value

pairs already used in prior queries. In particular, it did not disclose the construction of said query upon detection of a user command for triggering such automatic procedure. The difference between the present invention and D1 was represented by the feature whereby the "television program recommender (100) automatically selects at least one of said attribute-value pairs (450) based on said one or more prior queries".

In D1 the user needed to create or, alternatively, to manually select the filter he wanted to be executed in the query. Nothing in D1 suggested automatically constructing or selecting filters upon receiving a command from a user. In D1 the "go" button was used to trigger the search on the basis of the filter previously constructed or explicitly selected by the user. Nothing in D1 suggested enabling the user to use a command to instruct the program recommender to generate a query by itself. Furthermore, in D1 there was no mention of using attribute-value pairs from the selected filters in the generation of a query, i.e. in constructing a query as required by claim 1.

The terms "filter", "query" and "search" which were used in D1 had to be distinguished from one another. A "search" indicated the act of looking into a database. D1, as well as the present invention, focused on search engines based on queries. A query could be defined as a "precise request for information retrieval within database and information systems". Descriptive information about the desired item in a query corresponded to a filter in D1 and to attribute-value pairs in the present invention (see statement of grounds of appeal, points 11, 12 and 19, as well as letter of 7 June 2018, pages 3 to 5).

If none of the main or first auxiliary requests were allowable, the case should be remitted to the examining division for further examination. No examination of the dependent claims appeared to have been performed, or at least the examining division's communications had never discussed the dependent claims (see statement of grounds of appeal, point 20).

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural matters*
 - 2.1 The duly summoned appellant did not attend the oral proceedings. According to Rule 71(2) EPC 1973, however, it was possible for the proceedings to continue without it. In accordance with Article 15(3) RPBA the board relied for its decision only on the appellant's written submissions. The board was in a position to decide at the conclusion of the oral proceedings, since the case was ready for decision (Article 15(5) and (6) RPBA), and the voluntary absence of the appellant was not a reason for delaying a decision (Article 15(3) RPBA).
 - 2.2 It is established case law of the boards of appeal that an appellant who submits new amended claims shortly before the oral proceedings and subsequently does not attend those proceedings must expect a decision based on objections which may arise against such claims in its absence (see e.g. T 602/03, point 7 of the Reasons). It is for instance to be expected that the board will refuse the new claims for substantive reasons even if they have not been discussed before and were filed in good time before the oral proceedings

(T 1704/06, point 7.6 of the Reasons). For example, the board can decide that the new claims are not allowable because of lack of inventive step (see e.g. T 1704/06, point 7.6 of the Reasons). This will be the case in particular if an examination of these substantive requirements is to be expected in the light of the prevailing legal and factual situation.

In the present case, amended claims according to the appellant's present main request were submitted one month before the date of the oral proceedings before the board. These claims correspond essentially to those of the second auxiliary request filed with the statement of grounds of appeal. Since the board's communication under Article 15(1) RPBA clearly indicated that the main issue at the oral proceedings with respect to the then second auxiliary request would be novelty, an assessment of novelty with respect to the claims of the appellant's present main request was indeed to be expected.

2.3 Furthermore, an appellant who submits a request comprising new amended claims shortly before the oral proceedings and subsequently does not attend those proceedings must also expect a decision not to admit that request into appeal proceedings pursuant to Article 13 RPBA to be taken in its absence (see e.g. T 1587/07, point 2.2 of the Reasons). This is the case in particular if, as in the present case, the appellant's attention has been drawn to the provisions of Article 13 RPBA in the board's communication under Article 15(1) RPBA.

3. *Main request*

3.1 D1 discloses a method for constructing an automatic query of an electronic program guide, comprising the steps of (with corresponding text passages of D1 indicated in brackets):

a television program recommender receiving a command from a user initiating said automatic query (see column 4, lines 16 to 18);

the television program recommender retrieving one or more prior queries performed by said user (column 3, lines 57 and 58, together with column 4, lines 1 to 3),

wherein

the television program recommender, in response to the command, generates said automatic query comprised of at least one attribute-value pair ("filter element", see column 2, lines 62 to 64) for each of a plurality of program attributes (see column 4, lines 5 to 9), wherein the television program recommender automatically selects at least one of said attribute-value pairs based on said one or more prior queries (see column 4, lines 24 to 34).

3.2 Concerning the correspondence of terms in the present application and D1, the appellant considered the term "attribute-value pair" of the present application to relate to descriptive information about the desired item(s) in a query and to correspond to a filter in D1. The board agrees with the definition of the term "attribute-value pair" and considers "attribute-value pairs" to correspond to the "filter elements" or "filter terms" of D1 rather than to a filter (see D1,

column 2, lines 62 to 64; column 3, lines 11 to 14, lines 57 and 58, and line 67 to column 4, line 1).

- 3.3 The board agrees with the appellant that in D1 a filter needs to be manually selected by the user. Subsequently the "go" button is used to trigger the search on the basis of the selected filter. In contrast, according to the present application, a new query may be based on the automatic selection of attribute-value pairs already used in prior queries without such manual selection of a filter. The appellant argued that this difference was reflected by the feature whereby the "television program recommender (100) automatically selects at least one of said attribute-value pairs (450) based on said one or more prior queries".

The board is not persuaded by this argument. The automatic selection of an attribute-value pair, i.e. a filter element in the terminology of D1, does not exclude manual selection of the filter containing that filter element before issuing a command initiating the automatic search. D1 discloses the generation of a script from the selected filter after issuing a "go" command, which implies that the filter elements of the filter are automatically selected in order to execute a search of the EPG.

- 3.4 It is therefore concluded that the subject-matter of claim 1 according to the main request lacks novelty under Article 54(1) EPC 1973, having regard to the disclosure of document D1.

4. *First auxiliary request*

- 4.1 According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal

may be admitted and considered at the board's discretion, which is to be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

4.2 Claim 1 of the first auxiliary request when compared with claim 1 of the present main request contains the following additional steps:

(a) "the television program recommender (100) receiving one or more default attribute-value pairs;"

(b) "wherein said at least one of said attribute-value pairs (450) selected based on said one or more prior queries is obtained using the top-N attribute-value pairs, where N is a positive number, that have been previously used in a query and"

(c) "wherein said one or more default attribute-value pairs supersede said corresponding top-N search attribute-value pairs."

4.3 Features (a) to (c) correspond essentially to the features of dependent claims 3 and 4 of the present main request. They were incorporated into claim 1 of the auxiliary request only in reply to the summons to oral proceedings.

The filing of these new claims was not accompanied by any justification as to why the above amendments were carried out only after the summons to oral proceedings before the board.

Moreover, the board indicated in its communication under Article 15(1) RPBA that it had doubts whether some of the claim features, in particular feature (b), contributed to the technical character of the invention and stated that "if distinguishing features are identified, the appellant should be prepared to discuss at the oral proceedings whether these features in their context have a technical effect." In addition, it stated that the respective comments also appeared to apply to the dependent claims (see the board's communication, points 4, 7 and 8). It follows that there was no indication in the summons which could have led the appellant to assume that the amendments to claim 1 of the present first auxiliary request rendered the claimed subject-matter inventive.

4.4 Hence, the filing of the claims of the first auxiliary request was not appropriate from the point of view of procedural economy and the state of the proceedings.

4.5 In view of the above, the board, exercising its discretion under Article 13(1) RPBA, decided not to admit the first auxiliary request into the appeal proceedings.

5. *Request for remittal*

5.1 The appellant requested that the case be remitted to the examining division if neither the main nor the first auxiliary request could be allowed.

5.2 According to Article 111(1), second sentence, EPC 1973, the board of appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

In the present case, the board has come to the conclusion that the appellant's main request is not allowable, and it has exercised its discretion under Article 13(1) RPBA and not admitted the appellant's first auxiliary request into the appeal proceedings. It follows that the board, exercising its discretion under Article 111(1), second sentence, EPC 1973, has examined and decided within the competence of the examining division on the appellant's main and first auxiliary requests. It has thus itself decided on the merits of the present appeal. Therefore, there is no reason to remit the case to the examining division. Consequently, the appellant's request for remittal cannot be allowed.

6. *Conclusion*

It follows from the above that none of the appellant's requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



K. Boelicke

T. Karamanli

Decision electronically authenticated