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**Datasheet for the decision
of 30 April 2014**

Case Number: T 1354/13 - 3.5.04

Application Number: 01924569.5

Publication Number: 1273174

IPC: H04N7/24, H04N7/52

Language of the proceedings: EN

Title of invention:

INSERTION OF ASYNCHRONOUS DATA INTO A SYNCHRONOUS STREAM

Applicant:

OpenTV, Inc.

Headword:

Relevant legal provisions:

EPC 1973 R. 67

EPC R. 137(3), R. 137(4) (2007)

Keyword:

Remittal to the department of first instance -
fundamental deficiency in first-instance proceedings (no)
Reimbursement of appeal fee - (no)

Decisions cited:

G 0001/89, J 0010/07, T 0630/08, T 2334/11

Catchword:

see section 6



**Beschwerdekammern
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Case Number: T 1354/13 - 3.5.04

**D E C I S I O N
of Technical Board of Appeal 3.5.04
of 30 April 2014**

Appellant: OpenTV, Inc.
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San Francisco, CA 94111 (US)

Representative: Wenger, Joel-Théophile
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 24 January 2013
refusing European patent application
No. 01924569.5 pursuant to Article 97(2) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appeal is directed against the decision to refuse European patent application No. 01 924 569.5, published as international application WO 01/74084 A2.
- II. On 16 November 2006 the examining division issued a first communication pursuant to Article 96(2) EPC 1973. The examining division objected essentially that the claims on file did not comply with Articles 54(1), (2) and 56 EPC.
- III. With a letter of 24 May 2007 the applicant filed a set of new claims to overcome the examining division's objections.
- IV. In reply, the examining division issued a summons to oral proceedings to be held on 29 November 2012 and raised objections concerning extension of subject-matter for claim 1 and lack of inventive step for all claims.
- V. With a letter dated 29 October 2012 the applicant filed amended claims of a main request and first to fourth auxiliary requests.
- VI. A telephone consultation between the first examiner and the applicant's representative took place on 21 November 2012. According to the minutes of the consultation posted on 30 November 2012, the applicant's representative "was informed about the examining division's provisional intention of making use of its discretion of not admitting (Rule 137(3) EPC, GL H-II-2.3) any of the requests submitted by the representative with letter of 29.10.2012".

VII. Oral proceedings before the examining division were held as scheduled on 29 November 2012. According to the minutes of the oral proceedings, the main request was "not admitted into the proceedings as the subject-matter of independent claim 1 does not combine in a unitary manner with the claims as originally filed and for which a search has been carried out (Rule 137(5) EPC)." The representative "asked whether it would be possible to continue in writing in order to allow the Examining Division to perform a new search directed to the new direction." This request was declined by the examining division. After a break of twenty minutes the representative submitted a further request "replacing all other requests previously on file." The further request was not admitted into the proceedings "using the discretion of the Examining Division derived from Rule 137(3) EPC", because "the subject-matter of independent claim 1 prima facie does not meet the requirements of inventive step (Article 56 EPC)."

At the end of the oral proceedings the examining division refused the application.

VIII. With a letter of 7 January 2013 the applicant responded to the minutes of the telephone consultation held on 21 November 2012. The applicant stated that it disagreed "that the Examiner mentioned the division's provisional intention to make use of Rule 137(3) EPC." The applicant's representative submitted a declaration by a patent engineer, who "was in my office with me during the consultation call, which was relayed on the telephone's loudspeaker, and neither he nor I remember any mention of Rule 137(3) EPC."

IX. The written decision and the minutes of the oral proceedings were posted on 24 January 2013.

- X. The reasons of the decision under appeal can be summarised as follows.

The claims searched and the sets of amended claims submitted up until the summons to oral proceedings had been directed towards a method of calculating a transfer interval based on available bandwidth. The claims of the main request submitted in reply to the summons to oral proceedings were, "contrary to the claims searched and the amended claims submitted up until the summons to oral proceedings, directed to a specific method of signalling when to insert, and when to present, metadata." The subject-matter according to the main request was therefore not searched.

The division held that because "the originally claimed invention - addressing the problem of timely transmitting additional data in a rate constrained environment by the calculation of a transfer interval - lacks novelty over D1 (cf. summons to the oral proceedings, item 2 therein) there can exist no single general inventive concept with the subject-matter of the main request submitted with letter of 29.10.2012 - addressing the problem of signalling insertion points of additional data into primary content by the use of trigger points and assets."

Hence, the claims of the main request related to unsearched subject-matter which did not combine with the originally claimed invention to form a single general inventive concept. As a consequence, based on Rule 137(5) EPC, it was decided not to admit the main request into the proceedings (see decision under appeal, Reasons 12).

The set of claims submitted during the oral proceedings (henceforth auxiliary request) prima facie did not meet the requirements of inventive step. Hence, the claims were not clearly allowable in the sense of the Guidelines H-II, 2.7. As a consequence, the examining division "decided to make use of its discretionary power of not admitting the late submitted request into the procedure based on the provisions of Rules 116(2) and 137(3) EPC" (see decision under appeal, Reasons 13).

The application was therefore refused for "lack of claims submitted by the applicant on which a decision can be based (Article 113(2) EPC)."

XI. With the statement of grounds of appeal the appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division with the order to grant a patent according to a sole set of claims submitted together with the statement of grounds of appeal and a description to be adapted thereto. In the alternative the appellant requested that the case be remitted for further prosecution on the basis of these claims. Furthermore the appellant requested that the appeal fee be reimbursed under Rule 103(a) EPC, as such reimbursement was equitable in view of substantial procedural violations which had occurred during examination of the application. The appellant also requested oral proceedings if the board could not accede to the appellant's requests in the written procedure.

XII. The appellant's arguments with respect to the alleged procedural violations may be summarised as follows.

The appellant was surprised by the objection under Rule 137(5) EPC, which had only been raised in the oral proceedings and which did not leave sufficient time to prepare comments. It had been requested that the proceedings be continued in writing, but only twenty minutes had been allowed for the applicant to prepare a new set of claims.

The examining division had not admitted the new set of claims submitted during oral proceedings. This was also in breach of the applicant's right to have an opportunity to present comments, because the applicant was not allowed sufficient time to prepare such comments.

Furthermore, the appellant argued that the examining division had not exercised its discretion in a proper way when it decided not to admit the auxiliary request pursuant to Rules 116 and 137(3) EPC. The request had not been late compared to the delay in the Office's communications. Moreover, by submitting this request the appellant had overcome the objection under Rule 137(5) EPC and was prepared to discuss inventive step.

XIII. In an annex to a communication pursuant to Article 15(1) RPBA the board indicated that it intended to remit the case to the department of first instance for further prosecution on the basis of the set of claims filed with the statement of grounds of appeal. It also gave its provisional opinion as to why it did not consider reimbursement of the appeal fee to be equitable in the present case.

XIV. In a reply dated 7 January 2014 the appellant withdrew its request for oral proceedings. It did not comment on

the board's provisional opinion on reimbursement of the appeal fee.

XV. Independent claim 1 of the appellant's sole request reads as follows:

"A method for inserting asynchronous data into a synchronous data stream, said asynchronous data comprising a first metadata package (204, 304, 404, 504) having a first size, said method comprising: receiving information including a first time value when said asynchronous data may be used; determining a transfer interval for said asynchronous data, the transfer interval being determined as a function of a constant minimum bandwidth for metadata transmission and said first size of the metadata package; inserting said asynchronous data into said synchronous data stream at a time prior to said first time value by an amount that is greater than or equal to said transfer interval; characterised in that: said first metadata package (204, 304, 404, 504) corresponds to a first event trigger (202, 302, 402, 502); and that the method further comprises: inserting the first event trigger (202, 302, 402, 502) at a point in the synchronous data stream corresponding to said first time value."

Reasons for the Decision

1. Applicable version of Rule 137 EPC

Rule 137 EPC was amended by Decision of the Administrative Council of 25 March 2009 (OJ EPO 2009,

299). According to Article 2 of that decision, the amended rule applies to European patent applications for which the European search report or the supplementary European search report was drawn up on or after 1 April 2010. In the present case, the search report was drawn up on 8 October 2001, and therefore the amended rule does not apply.

Rule 137(4) EPC in the applicable version is identical to the first sentence of Rule 137(5) EPC to which the decision under appeal referred and reads: "Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept." In the following, the board will refer to Rule 137 EPC in the applicable version.

2. *Admissibility of the appeal*

2.1 Article 108, third sentence, EPC provides that within four months of notification of the decision, "a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations." According to Rule 99(2) EPC, in the statement of grounds of appeal "the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based." An appeal which does not comply with these requirements shall be rejected as inadmissible (Rule 101(1) EPC).

2.2 In the present case, the applicant had requested the grant of a patent on the basis of amended sets of claims to whose admission to the proceedings the examining division had not given its consent under Rule 137 EPC. The application was therefore refused under Article 97(2) EPC for lack of claims submitted by

the applicant on which a decision can be based (Article 113(2) EPC).

The board notes that the examining division, pursuant to Article 113(2) EPC 1973, was bound to decide on a text submitted to it, or agreed by the applicant. Thus the decision under appeal was based on the ground that there was no set of claims upon which the examining division could decide. Implicitly this meant that a patent could not be granted (Article 97(1) EPC in conjunction with Article 78(1)(c) EPC 1973) and that the application consequently had to be refused (Article 97(2) EPC).

2.3 In the statement of grounds of appeal the appellant asserted that the examining division had exercised its discretion in deciding whether or not to admit the claims of the main request and the auxiliary request in violation of the appellant's right to be heard (Article 113(1) EPC). With respect to the auxiliary request the appellant submitted in addition that the examining division, in exercising its discretion, had also infringed Rule 137(3) EPC (see point XII above). Hence, the appellant provided arguments why non-admission of its requests had allegedly resulted in a decision tainted by substantial procedural violations, which should therefore be set aside. If found to be justified, the contested procedural decisions of the examining division would deprive the decision of its legal basis. It follows that there is a causal link between the alleged procedural violations and the decision to refuse the application, which made it necessary to appeal the decision.

2.4 The board concludes that the requirements of Rule 99(2) EPC are fulfilled. Since the appeal also complies with

the further requirements of Rule 101 EPC, it is admissible.

3. *The decision under appeal*

The appellant chose not to maintain the requests underlying the decision under appeal. Instead, it submitted an amended set of claims and requested that a patent be granted on the basis of these claims.

Pursuant to Article 113(2) EPC 1973 the European Patent Office shall consider and decide upon the European patent application only in the text submitted to it, or agreed, by the applicant. Hence, the patentability of the claims underlying the decision under appeal do not form a subject of the appeal proceedings. As a consequence, the board only needs to review the examining division's decision in respect of the alleged substantial procedural violations having led to this decision.

4. *Admissibility of the main and auxiliary requests*

4.1 With its statement of grounds of appeal the appellant seeks grant of a patent on the basis of the main request, i.e. new claims filed with the statement of grounds, and a description to be adapted thereto. In the alternative, the appellant requested that the case be remitted for further prosecution based on these claims.

4.2 According to Article 12(4) RPBA the board may hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings.

4.3 New claim 1 contains all the features of claim 1 as originally filed. The amendments to claim 1 (and similarly also those to the further independent claim 4) relate to a first metadata package and an event trigger. The claimed subject-matter resulting from the incorporation of these additional features combines the originally claimed invention with additional features narrowing down the original concept. In particular, the specification of an event trigger is explicitly included in the concept set out in the description from page 2, fourth paragraph, to page 3, first paragraph. It may be summarised as managing the transfer of metadata so as to allow maximum data size that may be transferred for each trigger event. A search "on the basis of the claims, with due regard to the description and any drawings" (see Article 92(1) EPC 1973) may thus be assumed to have covered this subject-matter.

4.4 Hence, the amended claims can be considered a *bona fide* reaction of the appellant to overcome the objections that were raised in the oral proceedings before the examining division. In view of the circumstances of the present case (see points VI to VIII) it is apparent that the failure to file appropriate alternative requests before the department of first instance resulted from an incorrect understanding of the procedure rather than from any tactical abuse.

4.5 The new set of claims also complies with Rule 137(4) EPC in the applicable version (see above, point 1), on which basis the examining division had declined to admit the main request in the version before it (see decision under appeal, points 12.1, 12.2 and 12.5, referring to corresponding Rule 137(5)). The board agrees with the view taken in decision T 2334/11 (see

Reasons 2.2.2) that a presumed lack of novelty of the subject-matter of original claim 1 does not necessarily entail the consequence of a lack of a single general inventive concept in the sense of Rule 137(4) EPC. Instead, if an originally filed claim is amended by adding a feature to it, it has to be examined whether the added feature forms part of a single general inventive concept (in the meaning of one invention only; see e.g. G 1/89, OJ EPO 1991, 155, point 4) as it can be understood from the application as originally filed.

In the present case and as set out above (see point 4.3), the inventive concept can be perceived as managing the transfer of metadata so as to allow maximum data size that may be transferred for each trigger event. As a result, the additional features specifying a first metadata package and an event trigger narrow down the original inventive concept and therefore the amended claims relate to subject-matter which combines with the originally claimed invention to form a single general inventive concept.

4.6 As a result the board decides to admit the amended claims of the main and auxiliary requests.

5. *Remittal*

5.1 The subject-matter of the amended claims including the features that were taken from the description has not yet been examined by the department of first instance with respect to the substantive requirements of the EPC. Hence, the board considers it inappropriate at the present stage of the proceedings to carry out examination of the amended claims itself. As a consequence it cannot accede to the appellant's request

to grant a patent on the basis of the claims of the main request submitted with the statement of grounds.

- 5.2 Instead, the board follows the appellant's alternative request and exercises its discretion under Article 111(1) EPC 1973 in remitting the case to the examining division for further prosecution on the basis of the claims of the main request submitted with the statement of grounds of appeal.

6. *Substantial procedural violations*

- 6.1 With respect to the request for reimbursement of the appeal fee it is Rule 67 EPC 1973 that applies to the present case and which corresponds to Rule 103(1) (a) EPC (see J 10/07 (OJ EPO 2008, 567), point 7, and T 630/08, point 1).

- 6.2 According to Rule 67, first sentence, EPC 1973 the reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the board of appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

- 6.3 The appellant argued that its right to be heard had been infringed for essentially two reasons:

- a) The applicant was only informed during the oral proceedings about the objection under Rule 137(4) EPC (referred to as Rule 137(5) EPC), which did not leave sufficient time to prepare comments. Only twenty minutes were allowed for the applicant to prepare a new set of claims despite its request to continue the proceedings in writing.

- b) The examining division did not admit the auxiliary request submitted during oral proceedings, and the applicant was not allowed sufficient time to prepare comments.

6.4 Article 123 EPC governs the right to amend an application, with Rule 137 EPC being an implementing rule to Article 123(1) EPC.

Regardless of whether the examining division's decision to not admit the claims according to the appellant's requests was correct, the board considers that an applicant who presents extensively revised claims at a late stage of the proceedings has to be prepared for the possibility that the admissibility of these claims will be considered in accordance with Article 123 and Rule 137 EPC. In the present case the claims were extensively revised in preparation for the oral proceedings, with the revision including the deletion of features. Furthermore, the appellant did not contest that the claims submitted on 29 October 2012 shifted the focus of the invention from the calculation of transfer intervals to the signalling of when to present data (see minutes of oral proceedings, point 2, third paragraph, and statement of grounds, page 2, penultimate paragraph). Hence, the applicant should have expected an examination of the amended claims for compliance with Article 123 and Rule 137 EPC. There was no obligation to inform the applicant in the telephone consultation of 21 November 2012 about a possible corresponding objection, and the examining division was free to raise such an objection in the oral proceedings and to decide not to admit the amended claims. Hence, in the present case it is not relevant whether or not the appellant was actually informed prior to the oral proceedings about a possible objection under Rule 137

EPC (see points VI and VIII above). Furthermore, against the backdrop of Rule 137(3) EPC subjecting admission of further amendments to the examining division's consent, the board does not see special circumstances which would have required the examining division to provide more than twenty minutes for preparing a new set of claims during the oral proceedings or to continue the proceedings in writing.

- 6.5 With respect to point (b) the board concludes from the minutes of the oral proceedings (see point 3, last two paragraphs starting with "The professional representative replied ...") and from the Reasons of the decision under appeal (see point 13.2) that the appellant's representative was given an opportunity to present comments and that he actually availed himself of this opportunity. It follows that the right to be heard was not infringed as regards the auxiliary request.
- 6.6 For the reasons set out above relating to Rule 137(3) EPC, which gives an examining division the power to refuse its consent to further amendments, the appellant's argument that the filing of the request was not late compared to the delay in the Office's communications is not relevant to the present decision.
- 6.7 Hence, the board cannot see that the proceedings before the department of first instance were tainted by a substantial procedural violation. As a consequence, the requirements of Rule 67, first sentence, EPC 1973 for reimbursement of the appeal fee are not met in the present case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



U. Bultmann

F. Edlinger

Decision electronically authenticated