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**Datasheet for the decision  
of 23 January 2015**

**Case Number:** T 0623/14 - 3.5.04

**Application Number:** 01905315.6

**Publication Number:** 1302072

**IPC:** H04N5/782

**Language of the proceedings:** EN

**Title of invention:**

Systems and methods for incorporating promotions within recorded programmes

**Patent Proprietor:**

United Video Properties, Inc.

**Opponent:**

Virgin Media Limited

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 100(c)  
EPC Art. 123(2)  
RPBA Art. 13(1), 13(3)

**Keyword:**

Grounds for opposition - extension of subject-matter (yes)  
Late-filed auxiliary request - admitted (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
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Case Number: T 0623/14 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 23 January 2015**

**Appellant:** United Video Properties, Inc.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 8 January 2014  
revoking European patent No. 1302072 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** F. Edlinger  
**Members:** R. Gerdes  
T. Karamanli

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the opposition division revoking European patent No. 1 302 072. The corresponding patent application No. 01 905 315.6 originated from an international application published as WO 01/58154 A2.
  
- II. The opposition was based on the grounds of lack of novelty and inventive step (Article 100(a) EPC in conjunction with Articles 54 and 56 EPC) and extension of subject-matter (Article 100(c) EPC). The opposition division revoked the patent on the grounds that the independent claims according to the patent proprietor's main request, i.e. the patent as granted, and its first to third auxiliary requests contained subject-matter extending beyond the content of the application as filed (Articles 100(c) and 123(2) EPC, respectively). The fourth auxiliary request filed during the oral proceedings was not admitted into the proceedings (Rule 116(1) EPC).
  
- III. The patent proprietor (appellant) filed an appeal against this decision. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, alternatively, in amended form on the basis of the claims of one of the first to seventh auxiliary requests submitted with the statement of grounds.
  
- IV. The opponent (respondent) filed a written reply dated 2 October 2014 and requested that the appeal be dismissed.
  
- V. The board sent a communication annexed to a summons to oral proceedings, indicating that the only issue to be

- discussed at the oral proceedings was whether the claims according to the appellant's requests contained added subject-matter.
- VI. In a reply letter dated 23 December 2014 the appellant submitted claims according to an eighth and ninth auxiliary request. In a subsequent letter dated 7 January 2015 a new representative informed the board that a transfer of representation had taken place and withdrew the first to seventh auxiliary requests then on file. The appellant filed clean and annotated versions of the eighth and ninth auxiliary requests then on file, which were renumbered as first and second auxiliary requests.
- VII. Oral proceedings were held on 23 January 2015. The appellant withdrew all previous auxiliary requests filed in writing and submitted a new (sole) auxiliary request. The appellant requested that the decision under appeal be set aside and the case remitted to the opposition division for further prosecution on the basis of the main request filed with the statement of grounds of appeal or the auxiliary request submitted in the oral proceedings before the board. The respondent requested that the new auxiliary request be not admitted. The respondent requested that the appeal be dismissed.
- VIII. Claims 1 and 3 to 5 of the main request (patent as granted) read as follows (references to features (i) to (v) inserted as used in the decision under appeal):
- "1. A method for providing promotions with recorded programs comprising:
- (i) receiving (210) a selected program to record at a user input device;

- (ii) using a processor to determine whether the selected program is to be recorded;
- (iii) in response to determining whether the selected program is to be recorded, the processor:
- (iv) selects (320) a promotion to record for inclusion with the selected program; and
- (v) causes (330) the program and the promotion to be recorded such that the promotion is presented when a user plays the recorded program."

"3. The method of claim 1 wherein the program is selected based on user input.

4. The method of claim 3 wherein the user input is a selection (310) of a specific program.

5. The method of claim 3 wherein the user input is a program designation."

IX. Claim 1 of the auxiliary request is worded as follows (amendments with respect to claim 1 of the main request are marked in bold, deletions in strike-through):

"A method for providing promotions with recorded programs comprising:  
receiving (210) **at a user input device a user input comprising a user designation to be used by a processor to search for** a selected programs ~~to record at a user input device;~~  
using a **the** processor to determine whether ~~the selected~~ **a program is a selected program** to be recorded;  
in response to determining whether the selected program is to be recorded, the processor:  
selects (320) a promotion to record for inclusion with the selected program; and

causes (330) the program and the promotion to be recorded such that the promotion is presented when a user plays the recorded program."

- X. The further claims of the main and auxiliary requests have no bearing on the present decision.
- XI. In the following, unless otherwise indicated, citations refer to the international application as published.
- XII. The reasoning in the decision under appeal with respect to added subject-matter in claim 1 according to the main request can be summarised as follows:

With respect to feature (i) the opposition division stated that the term "selected program" in claim 1 of the granted patent was ambiguous. A programme could be selected by the processor or by the user. In either case, the term "selected program" referred to the programme after selection had taken place. There was no basis in the application as originally filed for the subsequent feature (ii) indicating that the processor determines whether or not to record the programme it has selected. A conditionality was implied by the words "determine" and "whether" which was not disclosed in the original application.

It was not excluded from the scope of claim 1 that method step (ii) took place after receiving the selected programme. This had no basis in the application as filed and was not contrary to any normal technical understanding. There might have been a necessity for the processor to override a user's request to record a programme at the moment when the programme was received, for example to check whether there was sufficient space for recording the programme

on a storage medium provided for that purpose. Therefore, the wording of feature (ii) added technically relevant pieces of information to the application as filed.

XIII. The appellant's arguments with respect to the main request may be summarised as follows.

The opposition division had used an inappropriate test for added subject-matter, the relevant consideration not being the scope of the claim, but what the claim disclosed. The description of the patent was not limited to one specific order of events. Correspondingly, the claims were not limited in that sense. The opposition division had proposed a specific order of events alleged to be within the scope of the claim and noted that this order was not explicitly disclosed in the application as filed. This was not the appropriate test for added subject-matter.

It was apparent that the opposition division had read feature (ii) as implying determining "whether or not" the selected programme was to be recorded. However, the claim merely related to the situation in which the processor determined that the programme was to be recorded.

In the statement of grounds the appellant construed claim 1 to the effect that the selection in feature (i) corresponded to the user selection that was referred to on page 5, lines 16 to 18, whereas the determination in feature (ii) corresponded to the processor's selection based on user input as disclosed in the same passage. In addition, the appellant referred to claims 35, 37 and 38 as originally filed as a basis for this understanding of the claim.



In the oral proceedings the appellant relied additionally on a different interpretation of the claim. Claim 1, feature (i), was unclear, which made it necessary to refer to the description in order to construe the claim. According to the description the selection referred to in feature (i) could happen before, during or after the transmitted programme was received by the user equipment, see page 4, lines 28 to 32 and page 12, lines 31 to 33. In the light of these passages, feature (i) should be interpreted as referring to the reception of a selected programme (i.e. of its transmitted signals) at the user equipment (see figure 2: 150 and 210) and not at the user input device (280, 290). Feature (ii) designated the identification of the (corresponding) programme as the selected programme by the processor. This identification was inherent to every processor that received items (e. g. input commands) and had to filter them in order to determine whether an item was a user selected item. Hence, feature (ii) was implicitly disclosed in the original application.

Concerning the admissibility of the auxiliary request the appellant argued that the request had been filed as a reaction to the discussion in the oral proceedings in order to overcome the objection of added subject-matter. The amendments were based on page 5, lines 16 to 32 of the description, which did not raise complex issues to be decided by the board.

XIV. The respondent essentially argued as follows.

It followed from the combination of claims 1, 3 and 4, as well as claims 1, 3 and 5 of the patent in suit and page 5, lines 16 to 21 of the application as published,

that the user selection in feature (i) took place before the programme was received at the user equipment. Feature (ii) clearly specified that the processor made a decision regarding the selected programme, which could only be interpreted in the sense of an additional conditionality. The reference to the selected programme in feature (ii) could only be understood as referring to the programme selected in the previous feature.

With respect to the appellant's interpretation provided in the oral proceedings, the respondent argued that the user input device of feature (i) could not be equated to the user equipment. According to claim 35 as originally filed and figure 2 as well as claim 16 as granted, the user input device and the processor were disparate entities. The user equipment comprised both entities.

Concerning the admissibility of the auxiliary request the respondent argued that the reasoning supporting the objection of added subject-matter provided in the oral proceedings did not differ from that in the decision under appeal. The attempt of the appellant to provide different interpretations of the claim was a divergent approach. The basis for the amendments that was indicated by the appellant related to automatic search-and-record functions and user-specified themes (see page 5, lines 16 to 34) which were not present in the claims. Instead, the amendments related to generalisations of these features. Therefore the appellant's amendments should not be admitted.

## **Reasons for the Decision**

1. The appeal is admissible.

### *The patent in suit*

2. The disputed patent relates to a method and a system to incorporate promotions (such as advertisements) into a programme to be recorded such that the promotions are presented together with the programme when a user plays the recorded programme. The programmes and promotions may be received by user equipment through a communications network either via the same or different communication channels. If a user selects a programme for recording at the user equipment, a processor in the user equipment selects a promotion to be recorded and played together with the programme. The promotion may be selected based on the content of the selected programme or on the basis of time, user demographics, or any other criterion (see paragraphs [0001], [0002], [0007] to [0010] and [0016]; figures 1 to 3 of the patent specification).

A user may select a programme for recording, using a user input device such as a remote control or a keyboard which provides an interface to the processor. The user input may be a selection of a specific programme or a so-called user or programme "designation" consisting of a viewing time, a programme channel or specific content, such as a programme theme. A user designation causes the processor to perform an automatic search-and-record function for programmes that match the designated criteria (see paragraph [0015]; claims 3 to 5).

*Main request*

3. According to Article 100(c) EPC 1973 an opposition may be filed on the grounds that the subject-matter of a European patent extends beyond the content of the application as filed.
- 3.1 The board agrees with the appellant that the appropriate procedure for deciding whether a claim as granted infringes Article 100(c) EPC 1973 is to properly interpret the claim as a whole and to subsequently consider whether the claim according to that interpretation contains added subject-matter, applying the criterion that, like any amendment made to an application or a patent, the subject-matter of the granted claim has to be directly and unambiguously derivable from the application as filed (see also Case Law of the Boards of Appeal of the European Patent Office, 7th edition, 2013, section II.E.1.7). Ambiguities should be removed taking into account the overall disclosure of the patent, and in particular the different embodiments the patent as granted was intended to cover.
- 3.2 It was common ground in the oral proceedings that feature (i) needed to be interpreted in the light of the description and the dependent claims, since a literal interpretation of the feature makes no technical sense. Claim 1 refers to two different meanings of the term "program". On the one hand, in the context of selecting, it refers to an indication of items which are to be scheduled for recording. On the other hand, claim 1 refers to the programme signals (representing content corresponding to the selected programme item) which are recorded together with promotions. In the context of the receiving step (i) it

could mean receiving either the indication of an item or items (at a user input device) which is or are selected for recording, or the transmitted programme signals which are received by the user equipment (receiver 220).

3.3 According to dependent claims 3 to 5 of the patent in suit, a programme is selected (by the processor) based on user input, wherein the user input (at the user input device) may be the selection of a specific programme or a programme designation (see also paragraphs [0016], [0028] to [0033] and [0043]). Hence, in order to ensure consistency of interpretation with the dependent claims and the description, the term "selected program" in claim 1 has to be understood as referring to a programme that was selected by the processor based on user input of either a specific programme or a programme designation. The board therefore finds that feature (i) has to be interpreted as including the steps of receiving a user input at a user input device and processing the input to select a programme.

According to feature (ii) a processor is used to determine whether the selected programme is to be recorded. The board understands this step as referring to a choice in the sense of a decision to be made by the processor whether or not the selected programme is to be recorded.

The subsequent features (iii) to (v) are consistent with this interpretation of claim 1. They indicate the steps that follow if a decision has been taken to record the selected programme. These steps comprise the selection of a promotion for inclusion in the selected programme, and the recording of the selected programme

(the signals corresponding to the selected item) and the promotion such that the promotion is presented when a user plays the recorded programme. It is noted that features (iii) to (v) consistently refer to the "selected program" and not to the "determined program". This confirms that feature (ii) only relates to a choice as to whether or not to record the programme that has already been selected by the processor based on user input.

3.4 The board agrees with the decision under appeal that the conditionality implied by feature (ii) is not directly and unambiguously disclosed in the application as filed. There is no reference in the original application to determining whether or not to record the selected programme. Hence feature (ii) is not disclosed in the original application documents.

3.5 The appellant's arguments did not convince the board.

The appellant argued that features (i) and (ii) did not imply a specific order of events. However, feature (ii) explicitly specifies that the selected programme is subject to determining whether it is to be recorded. Hence, the programme has to be selected prior to that determination.

The appellant also argued that the claim merely related to the situation in which the processor determined positively that the programme was to be recorded (see also statement of grounds, page 4, penultimate paragraph). The board agrees that features (iii) to (v) only specify the further steps to be carried out in reaction to a positive determination. However, the fact that further steps ensuing from a negative determination are not specified does not mean that

feature (ii) does not imply a choice having more than one possible outcome.

The appellant's interpretation of claim 1 as brought forward in the statement of grounds is not considered consistent with the dependent claims and the description. In the statement of grounds the appellant construed the claim to the effect that the selection in feature (i) corresponded to the user selection referred to on page 5, lines 16 to 18 (see paragraph [0015] of the patent specification), whereas the determination in feature (ii) corresponded to the processor's selection "based on a user's input" as disclosed in the same passage. Dependent claims 3 to 5 of the patent in suit specify that "the program is selected based on user input", the user input being either the selection of a specific programme or a programme designation. Hence, the selected programme in claim 3 must be understood as the programme selected by the processor. It is also noted that claim 1 would make no technical sense if features (i) and (ii) were construed as a reference to a specific programme selected by the user or as the specification of a programme designation. In that case feature (ii) would imply determining whether a programme designation was to be recorded. However, this would be not technically meaningful.

The second interpretation provided by the appellant in the oral proceedings likewise failed to convince the board. According to the appellant, feature (i) should be interpreted as referring to the reception of a selected programme (signals of a selected programme item) at the user equipment. This interpretation disregards the wording of feature (i), which refers to "receiving ... at a user input device" and not to receiving at the user equipment. The user input device

designates the entity that receives a user input, i.e. either the selection of a specific programme or of a programme designation. Hence, the user input device is distinct from the processor. In figure 2 the user input device corresponds to the remote control unit 280 whereas the user equipment 150 comprises both the processor 270 and the remote control 280 as well as the receiver 220 (see claim 16 and paragraphs [0028] and [0031] of the patent specification). The board was also not convinced by the appellant's interpretation of feature (ii) as pertaining to an identification of the programme as the selected programme by the processor. The appellant argued that this identification was inherent to every processor that received items and that had to filter these items in order to determine a user-selected item. However, feature (ii) does not refer to determining whether a programme is a selected programme, but to determining whether the selected programme is to be recorded. Hence, the appellant's arguments did not convince the board.

- 3.6 It follows from the above that claim 1 of the granted patent contains subject-matter extending beyond the content of the application as filed. Hence, the ground for opposition under Article 100(c) EPC 1973 prejudices the maintenance of the granted patent.

*Auxiliary request*

4. 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. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter, the current state of the proceedings and the need for procedural economy. According to Article 13(3) RPBA,



amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

4.1 In the present case the claims of the auxiliary request were filed during the oral proceedings. Hence, they constitute amendments to the appellant's case within the meaning of Article 13(1) RPBA and consequently may be admitted and considered at the board's discretion. Furthermore, the board's discretion is limited pursuant to Article 13(3) RPBA.

4.2 Compared with claim 1 of the main request, claim 1 of the auxiliary request comprises amendments in features (i) and (ii) (see point IX above). The appellant referred to page 5, lines 16 to 32 of the description of the published application as a basis for these amendments. Hence, the amendments are not exclusively based on dependent claims and they comprise terminology that was disclosed in the context of further features, for example an automatic search-and-record function of the processor to determine selected programmes on the basis of a user designation. This poses new problems as to whether the amended features can be extracted from their context without infringing Article 123(2) EPC. In addition, the wording of amended claim 1 leaves doubts as to whether the claim is restricted to a user designation as a user input, since modified feature (i) refers to "a user input comprising a user designation". At this very late stage of the proceedings, this would have led to a further debate on new issues including the question of whether the amendments contravened Article 123(3) EPC.

4.3 Hence, admitting the appellant's auxiliary request would have required further investigations including a possible adjournment of the oral proceedings in order to give the respondent a fair chance to deal with these issues.

4.4 The appellant's argument that the amendments to its case should be admitted as a reaction to the discussion in the oral proceedings did not convince the board. The board's interpretation of claim 1 of the main request did not essentially differ from that in the decision under appeal. The board also did not deviate from the opposition division's finding that feature (ii) was not disclosed in the original application documents. Any new aspect discussed in the oral proceedings was caused by a new line of the appellant's arguments which was presented for the first time in the oral proceedings and diverged from that in the statement of grounds of appeal. Hence, the outcome of the discussion of the main request in the oral proceedings cannot have come as a surprise to the appellant.

4.5 In view of the above the board decided not to admit the auxiliary request into the appeal proceedings under Article 13(1) and (3) RPBA.

*Conclusion*

5. Since the appellant's main request is not allowable and its auxiliary request was not admitted into the proceedings, the appeal must be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



D. Magliano

F. Edlinger

Decision electronically authenticated