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**Datasheet for the decision
of 27 September 2018**

Case Number: T 1151/14 - 3.5.07

Application Number: 07862633.0

Publication Number: 2105013

IPC: G11B27/00, G11B27/036,
H04N21/432, H04N21/458,
H04N21/6587, H04N21/81,
H04N5/76

Language of the proceedings: EN

Title of invention:

Systems and methods for viewing substitute media while fast forwarding past an advertisement

Patent Proprietor:

Rovi Guides, Inc.

Headword:

Viewing substitute media while fast forwarding/ROVI GUIDES

Relevant legal provisions:

EPC Art. 83, 123(2), 123(3)

Keyword:

Amendments - added subject-matter (no)
Sufficiency of disclosure - (yes)
Remittal to the department of first instance - (yes)

Decisions cited:

G 0009/92, T 0331/87, T 0629/90, T 0274/99, T 0149/02,
T 1843/09



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Case Number: T 1151/14 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 27 September 2018

Appellant: Rovi Guides, Inc.
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San Jose, CA 95002 (US)

Representative: Pisani, Diana Jean
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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
10 March 2014 concerning maintenance of the
European Patent No. 2105013 in amended form.

Composition of the Board:

Chairman R. Moufang
Members: P. San-Bento Furtado
M. Jaedicke

Summary of Facts and Submissions

- I. The then proprietor of the patent (United Video Properties, Inc.) lodged an appeal against the interlocutory decision of the Opposition Division according to which European patent No. 2 105 013 can be maintained in amended form. The patent was granted on European application 07862633.0, which was originally filed as international application PCT/US2007/025084, published as WO 2008/088508.
- II. The then opponent (Virgin Media Limited) likewise lodged an appeal. However, it later withdrew its opposition and the appeal with a letter dated 9 November 2017.
- III. With effect from 30 July 2015, a transfer of the patent ownership was registered from United Video Properties, Inc. to Rovi Guides, Inc., which thereby obtained the status of appellant. When the term "appellant" is used in the following, it refers to the legal entity being patent proprietor which had the appellant status at the relevant time.
- IV. The opposition had been filed on the grounds of lack of novelty and inventive step (Article 100(a) EPC), insufficiency of disclosure (Article 100(b) EPC) and added subject-matter (Article 100(c) EPC).
- V. In the contested decision, the Opposition Division came to the conclusion that the proprietor's requests to maintain the patent as granted and to maintain the patent as amended according to the claims of a first auxiliary request were not allowable under Article 123(2) and 100(c) EPC, but it held that the grounds for opposition did not prejudice the

maintenance of the patent as amended according to the proprietor's second auxiliary request.

- VI. With its notice of appeal, the appellant requested that the decision under appeal be set aside in respect of the decision to refuse the main and first auxiliary requests, i.e. those aspects by which it was adversely affected.
- VII. With its grounds of appeal, the appellant requested that the patent be maintained as granted or as amended on the basis of the first or second auxiliary requests considered in the contested decision. It submitted arguments why the decision's findings of added subject-matter were not correct and enclosed documents PD1 to PD4 (see section XIV below).
- VIII. The then opponent argued, with its grounds of appeal, that claim 1 of the second auxiliary request was not allowable under Article 100(a), (b) and (c) EPC. In support of its objections concerning inventive step, it submitted new documents OD8, OD9, OD10, OD11a and OD11b (see section XIV below) and requested that they be admitted into the appeal proceedings.
- IX. In response, the appellant argued that documents OD8, OD9, OD10, OD11a and OD11b should not be admitted into the proceedings.
- X. With further submissions the then opponent cited new documents OD12 to OD19 (see section XIV below) "as evidence of the factual knowledge of the skilled person", in particular as regards MPEG-4, and "in response to the patentee's Grounds of Appeal", especially "in response to the references to the various MPEG standards accompanying those grounds". It

also argued against the appellant's position that the main and first auxiliary requests complied with Articles 100(c) and 123(2) EPC.

- XI. After the withdrawal of the opposition, the appellant resubmitted the sets of claims according to the main and first auxiliary requests and submitted a new second auxiliary request.
- XII. In a communication accompanying the summons to oral proceedings, the Board asked the appellant to clarify its position with regard to the set of claims considered allowable by the decision under appeal. The Board explained that, while it could not challenge the maintenance of the patent as maintained by the decision under appeal, the prohibition of *reformatio in peius* did not apply separately to each point decided by the Opposition Division in favour of the appellant. It discussed the objections on file with regard to Article 100(b) and (c) EPC and explained that it was not inclined to deal itself with the ground for opposition under Article 100(a) EPC.
- XIII. With a letter of reply dated 24 August 2018 the appellant confirmed the requests on file. It re-submitted the claims of the three requests, correcting a typographical error in claim 6 of the second auxiliary request. It discussed added subject-matter and insufficiency of disclosure and stated that if the present appeal were dismissed, the decision of the opposition division would become binding.
- XIV. The following is a list of the documents cited in the appeal proceedings by the appellant (PD1 to PD4) and by the former opponent in its grounds of appeal (OD8 to OD11b) and in its later submissions (OD12 to OD19):

- PD1: ISO/IEC 14496-2: "Information technology - Coding of audio-visual objects - Part 2: Visual", 2001;
- PD2: ISO/IEC 13818-2: "Information technology - Generic coding of moving pictures and associated audio information: Video", 2000;
- PD3: ITU-T Recommendation H.262: "Information Technology - Generic Coding of Moving Pictures and Associated Audio Information: Video", 1995;
- PD4: "MPEG-1 Video";
- OD8: US 2003/0184679, published on 2 October 2003;
- OD9: US 2005/0191041, published on 1 September 2005;
- OD10: US 2004/0179827, published on 16 September 2004;
- OD11a:US 2001/0005449, published on 28 June 2001;
- OD11b:JP 2001/103465, published on 13 April 2001 (and machine translation);
- OD12: MPEG-4 Part 2 - Wikipedia;
- OD13: H.264/MPEG-4 AVC - Wikipedia;
- OD14: (MPEG-4) Network Abstraction Layer - Wikipedia;
- OD15: Siddaraju, N. and Rao, K.R.: "Multiplexing the Elementary Streams of H.264 Video and MPEG4 HE AAC v2 Audio, De-multiplexing and Achieving Lip Synchronisation", American Journal of Signal Processing 2012, 2 (3), pages 52 to 59;
- OD16: "H.264 encoding guide" downloaded from <http://www.avidemux.org/admWiki/doku.php?id=tutorial:h.264>;
- OD17: Wiegand, T. et al.: "Overview of the H.264/AVC Video Coding Standard", IEEE Transactions on Circuits and Systems for Video Technology, 13(7), July 2003, pages 560 to 576;
- OD18: Wenger, S.: "H.264/AVC Over IP", IEEE Transactions on Circuits and Systems for Video Technology, 13(7), July 2003, pages 645 to 656;
- OD19: Ghandi, M.M. and Ghanbari, M.: "The H.264/AVC Video Coding Standard for the Next Generation Multimedia Communication", Journal of Iranian

Association of Electrical and Electronics
Engineers, Vol. 1, No. 2, 2004.

- XV. Oral proceedings were held on 27 September 2018. During the oral proceedings the appellant replaced the main request by a new amended main request, and confirmed that in case its pending requests submitted in appeal were not considered allowable, it did not oppose the maintenance of the patent in amended form on the basis of the set of claims considered allowable by the decision under appeal. At the end of the oral proceedings, the chairman pronounced the Board's decision.
- XVI. The appellant's final requests were that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request filed during oral proceedings before the Board, consisting of claims 1 to 10, or on the basis of the first and second auxiliary requests filed with the letter dated 24 August 2018.
- XVII. Claim 1 of the main request reads as follows:
"A method for incorporating substitute media in a video comprising intracoding frames, forward prediction and bidirectional prediction frames between the intracoding frames defining a group of pictures structure comprising an intracoding frame and the forward and bidirectional prediction frames following the intracoding frame, such that the substitute media is displayed when the video is fast forwarded on equipment (110) in an interactive media system, characterized by:
incorporating video frames of the substitute media among the video frames of the video by inserting the video frames of the substitute media encoded as

intracoding frames between adjacent groups of pictures of the video so that (i) the substitute media is displayed in a manner perceptible by a user when the user fast forwards the video with the equipment (110) and (ii) the substitute media is not perceptible by the user during normal playback of the video;

distributing the video incorporating the substitute media to the equipment (110)."

XVIII. Independent claim 6 is directed to a system and defines subject-matter essentially corresponding to that of claim 1. Dependent claims 2 to 5 and 7 to 10 correspond to those of the patent as granted.

XIX. The claims of the first and second auxiliary requests are not relevant to the outcome of the present appeal.

XX. The arguments of the appellant and the former opponent, where relevant to this decision, are discussed in detail below.

Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

Extent of the examination in the appeal proceedings

2. In the event of withdrawal of an opposition in appeal proceedings, the proceedings have to be continued if the proprietor has appealed the contested decision. In such cases, a substantive examination of the opposition division's decision must be carried out. The board's evaluation can include the examination of evidence submitted by the opponent prior to the withdrawal of the opposition (see Case Law of the Boards of Appeal of

the EPO, 8th edition, IV.C.4.3.3, T 629/90, OJ EPO 1992, 654, reasons 2.2).

2.1 In the present appeal, the proprietor has become the sole appellant against the decision maintaining the patent in amended form. As a consequence, the Board cannot challenge the maintenance of the patent as thus amended (G 9/92, OJ EPO 1994, 875, order 1; T 149/02 of 25 July 2003, reasons 2). However, the prohibition of *reformatio in peius* does not apply separately to each point decided by the Opposition Division in favour of the appellant. Thus, the Board can in principle review the findings of the contested decision for each of the three grounds for opposition raised by the former opponent with regard to each of the requests other than the one maintained by the decision under appeal. Those requests also define the limits for the Board when it comes to applying the provisions of Article 114(1) EPC (see also T 149/02, reasons 3.2.1, and decisions cited in Case Law of the Boards of Appeal of the EPO, 8th edition, IV.E.3.1.1).

As explained in its preliminary opinion, the Board may nevertheless decide, where appropriate taking into account the course of the proceedings and other applicable criteria, not to deal with a specific ground for opposition and instead make use of its power under Article 111(1) EPC to remit the case to the department of first instance for further prosecution.

Amendment to claim 1

3. Claim 1 of the main request differs from that of the patent as granted in that the following text of one of the claim features, i.e. "feature (f)" according to the Opposition Division's itemization (see point 4 of the

contested decision), was amended: "the substitute media is displayed when a user fast forwards the video with the equipment". That text was replaced with the following features

- "(i) the substitute media is displayed in a manner perceptible by a user when the user fast forwards the video with the equipment and
- (ii) the substitute media is not perceptible by the user during normal playback of the video".

Article 123(2) EPC - added subject-matter

4. At the oral proceedings before the Board, the appellant stated that the basis for claim 1 could be found in claim 14 and paragraphs [0004], [0007], [0008], [0070] and [0072] of the application as originally filed. The hidden video frames mentioned in paragraphs [0070] and [0072] were to be understood as frames which were not shown perceivably during normal playback. The limitation to a single frame incorporated between the groups of pictures (= GOPs, comprising intracoding, and forward and bidirectional prediction frames, i.e. I, P and B-frames) was not required in the claim.

Part of paragraph [0008] has been deleted from the patent specification, whereas the other paragraphs cited by the appellant are also part of the patent specification. Even though a more detailed description of the embodiment of original claim 14 has been excised from the description of the patent specification, the general embodiment of original claim 14 is also described in paragraphs [0007] and [0008].

- 4.1 In the proceedings thus far, two main objections were raised under Articles 100(c) and 123(2) EPC against claim 1 of the requests pending before and decided upon

by the Opposition Division. Both objections were based on the argument that the claimed subject-matter was not unambiguously disclosed in the application as filed since it unduly generalised the original teaching by omitting several of its features.

5. *Omission of features (I) to (III)*

The first objection raised by the former opponent regarded the omission of three features contained in originally filed claim 14 on which claim 1 was based. These features were

- (I) "identifying substitute media",
- (II) "selecting video frames", and
- (III) "the substitute media is displayed and persists in the user's field of view sufficiently long that the substitute media is perceptible when the user fast forwards".

5.1 The former opponent emphasised that the application as filed described two different techniques which could be used to display substitute media when a user fast forwarded: identifying specific frames of the substitute media (paragraphs [0062] to [0064]) and incorporating hidden I-frames into the MPEG stream of pictures (paragraphs [0070] to [0072]). Whilst it was true that the application as filed stated that the hidden I-frames "**may** be identified", this was because there was another alternative described in the application, that of tagging the hidden I-frames. There was no basis for deleting subject-matter relating to both alternatives. The feature describing the sufficiently long persistence of the substitute media was part of the principle behind the invention and was an essential feature.

5.2 In the decision under appeal, the Opposition Division followed the appellant's argument according to which it was possible to deduct from the following passage of paragraph [0060] of the patent specification (original paragraph [0070]) that fast forwarding as such without identification made additional frames perceptible:

"In response to a fast forward instruction, the additional video frames are displayed substantially closer in time (e.g., one after the other) or repeated for emphasis such that the video frames, and the substitute media the video frames depict, becomes perceptible or emphasized".

5.3 The objection against the omission of feature (III) no longer applies to current claim 1. The claim has been amended to mention displaying in a perceptible manner, which implies that the substitute media persists in the user's field of view for a sufficiently long period of time.

In the Board's view, features (I) and (II) do not have to be specified in the claim either, as explained in the following.

5.3.1 The former opponent's argument that undisclosed matter was added in view of different language used, on the one hand, in claim 1 and, on the other hand, in original claim 14, is not convincing. That claim relates to a "method for constructing an advertisement that includes substitute media" which is performed in advance of displaying the video e.g. by an operator using an advertisement tool (see the originally filed application, paragraphs [0010] and [0109] and claim 21 dependent on claim 14). In that claim, the step of feature (I) of identifying substitute media relates to the selection by the operator of the substitute media

before editing the video. Such a step of identifying the substitute media is implicit in present claim 1 and in the Board's view does not have to be explicitly defined.

Similarly, feature (II), which in its context in original claim 14 reads "selecting video frames such that the substitute media is displayed and persists ...", is implicit in the feature "incorporating video frames of the substitute media among the video frames of the video ... such that (i) the substitute media is displayed in a manner perceptible by a user ..." of claim 1.

5.3.2 The Board cannot follow the former opponent's further line of argument either, which relied on the lack of identification of I-frames during video display. As explained in the decision under appeal, the passage cited under point 5.2 above teaches that the additional video frames can become perceptible without an explicit identification as they are displayed closer in time. It is clear from paragraphs [0070] and [0072] of the original description that the identification of hidden I-frames is optional.

6. *Omission of "MPEG-2"*

The second objection of undue generalization under Articles 100(c) and 123(2) EPC was raised against independent claims not limited to an MPEG-2 video.

6.1 The Opposition Division took the view that paragraphs [0057] and [0072] of the originally filed description were clearly limited to MPEG-2. The passages of the original description referring to MPEG-4 which had later been deleted, like part of

paragraph [0008] and paragraph [0073], could not be used to interpret paragraphs [0049] and [0062] of the patent specification. The subject-matter of granted claim 1 thus constituted an undisclosed generalisation.

- 6.2 The appellant argued that it was well-known in the art at the priority date of the application that the use of a Group of Pictures (GOPs) structure comprising I, P and B-frames was one of the predominant underlying principles of video compression formats. It was common knowledge that not only the standardised format MPEG-2 (commonly referred to as MPEG-2/H.262), but also its predecessor MPEG-1 and its successor MPEG-4 utilised such a GOP structure, even though MPEG-4 built upon the GOP structure to form a much more complex system that allowed for individual objects within an image to be dealt with separately.

When reading the originally filed description, taking into consideration the common general knowledge set out above, it would be implicit to the skilled person from paragraphs [0057] through to [0072] that the invention was not limited to MPEG-2, but could be used for any GOP-encoded video.

The incorporation into claim 1 of the insertion of substitute I-frames between GOPs without a limitation to MPEG-2 was not an undisclosed intermediate generalisation. The GOPs structure was the video compression technique common to the various standards and MPEG-2 differed from the other standards in ways that were irrelevant to the invention. The feature was not related or inextricably linked to the other features of the embodiment; its removal passed the essentially test and the overall disclosure justified the generalisation, if one was even present.

Some MPEG standards, e.g MPEG-7, did not relate to the playback of multimedia. Nevertheless, the skilled person understood that the specification of GOPs in the claim was clearly referring to those standards that related to the playback of video.

6.3 The former opponent argued that the application as filed treated MPEG-2 and MPEG-4 differently and the two were technically incompatible in a manner which was relevant to the operation of the claimed invention.

In the application as filed, the use of MPEG-2 and MPEG-4 was described as examples of different ways in which substitute media could be incorporated in hidden video frames. The claimed subject-matter related to only one of these, the examples described using MPEG-2, and to broaden this to any form of MPEG video compression was clearly an impermissible generalisation.

The former opponent discussed the MPEG-4 standard, in particular Part 2 and Part 10 which had superseded Part 2. It argued that MPEG-4 Part 10 had a much more complicated structure, in which multiple reference frames could be used to encode, for example, periodic motion, alternating camera angles, translating motion and occlusion, the complicated coding operating over slices representing samples of the video picture. A consequence of that was that normal I-frames could not be used for random access into the video stream, nor could a "normal" type of I-frame be inserted into the video stream in the manner described and claimed in the patent. Instead, special frames known as IDR (instantaneous decoder refresh) frames had to be employed for that purpose. Documents OD14 to OD18

demonstrated that point. The omission of a limitation to MPEG-2 failed all the steps of the test laid out in decision T 331/87 (OJ EPO 1991, 22).

6.4 The Board does not find the former opponent's arguments convincing, as explained in the following.

6.4.1 For its assessment concerning added subject-matter, the Board considers document OD16 although the appeal proceedings did not deal with the question of whether that document should be admitted into the proceedings. Document OD16 is only used to illustrate common general knowledge. It provides a better understanding of the aspects of the MPEG-4 standard mentioned in the former opponent's reasoning and is obviously relevant in considering that reasoning. It can thus be considered under Article 114(1) EPC (see also T 274/99 of 16 May 2001, reasons 2.2.2).

6.4.2 According to document OD16, an MPEG-4 video stream includes IDR frames and "normal", or non-IDR, I-frames, where "an IDR frame is what has been traditionally known as an I frame" (page 20, first paragraph). It is true that, as argued by the former opponent, in MPEG-4 the B/P-frames before or after a "normal" I-frame may reference the B/P-frames after or before the I-frame. As a consequence, it is not possible to start playing back a video on a normal I-frame in MPEG-4 (in normal mode), as document OD16 explains (see page 9, last two paragraphs, and page 20, first paragraph). However, that does not mean that it is impossible to access the I-frames individually and, as explained in OD16 (see page 9, penultimate paragraph), IDR I-frames do not have that problem. In MPEG-4 at least IDR I-frames can be accessed independently of the other frames, for example for fast forwarding.

The Board can thus not see how the claimed invention is technically incompatible with the MPEG-4 standard.

6.4.3 With regard to the complex structure of MPEG-4, and the reference in the original disclosure to video object planes (VOPs) for the MPEG-4 embodiments, the appellant argued, in reply to the Board's preliminary opinion, that the skilled person knew that the MPEG-4 standard, while using different terminology, was still built to apply the same coding principles (I, P and B modes) as the MPEG-2 standard. The appellant cited several passages of document PD1.

In the Board's view, those passages of PD1 confirm that the GOP structure of MPEG-4 is similar to that of MPEG-2. In particular, there are four types of VOPs, including intra-, predictive- and bidirectionally predictive-coded VOPs, I-VOPs being intended "to assist random access into the sequence" (sections 6.1.3.4 and 6.1.3.5 on pages 18 and 19). The VOP I, P and B modes are similar to the modes of MPEG-2 (section M.1 on page 487).

The Board is hence persuaded that the skilled person understands the invention of the original disclosure, in its more general form, to apply to the MPEG-4 standard as well as to general GOP-based structures. Paragraphs [0004], [0007] and [0070] provide a general definition of the invention and do not mention MPEG-2 or any other standard. In the context of the description, the skilled reader understands that the hidden frames mentioned in those paragraphs are implemented by intracoding frames in a video stream with a GOP structure. The references to MPEG-2 and MPEG-4 in paragraphs [0008] and [0072] and other

passages of the application are understood as mere examples of how the invention could be implemented in video streams with those formats.

7. In the light of the foregoing, claim 1 of the main request fulfils the requirements of Article 123(2) EPC.

Article 123(3) EPC - extension of protection

8. Features (i) and (ii) define feature (f) of the granted patent in clearer and more detailed terms on the basis of passages of the description, for example paragraphs [0060] and [0062] of the patent specification.

From the above assessment of added subject-matter it follows that, in the Board's opinion, claim 1 as amended does not have a broader scope than claim 1 as granted, both interpreted in the context of the patent specification which was not amended.

Claim 1 of the main request therefore does not extend the protection conferred and fulfils the requirements of Article 123(3) EPC.

Articles 84 and 101(3) EPC - clarity of amendments

9. The amended features (i) and (ii) are clear and concise, also in combination with the other features of the claims. In addition, it follows from the above discussion that the amended features are supported by the description. Claim 1 therefore fulfils the requirements of Article 84 EPC for the purposes of Article 101(3)(a) EPC.

Article 83 EPC - sufficiency of disclosure

10. In its grounds of appeal, the former opponent argued that claim 1 as granted had no limitation to either the substitute-media frames being tagged, or to the substitute media being displayed fast/long enough to be perceptible during fast forwarding. Nonetheless, one of those was required for the substitute media to be visible. If "displayed" required perceptible display, it could only be achieved by displaying hidden I-frames fast/long enough. If "displayed" covered either perceptible or not (only when a user fast forwards), then that could not be achieved by the use of hidden I-frames, since these were always displayed, even though they were not always perceptible. Independently of how the claims were interpreted, since claim 1 did not define at least one of the two options based on tags or on I-frames, the claim was broader than supported by the description. A skilled person was not taught how to put into effect an invention which displays substitute media only when a user fast forwards without either tagging substitute media frames or displaying hidden I-frames sufficiently long/fast that they are perceptible.

10.1 In its reply to those arguments, the appellant was of the view that the former opponent had not provided any reasoning as to why the skilled person, using their common general knowledge, would not be able to work the invention across the breadth of the claimed invention. The former opponent had not disputed the contested decision on this point and had not presented any new arguments or evidence.

At the oral proceedings before the Board the appellant argued that the application described how to

incorporate substitute media in such a way that it would be perceptible during fast forward. It described the use of flags, but also the insertion of I-frames at a fixed rate. Video devices worked with fixed fast-forward rates and the skilled person would know how to insert I-frames with a fixed rate into the video. No further knowledge about the video device was required. The problem of different GOP sizes could be solved easily, for instance by throwing out some frames of a GOP. Such a change would not harm the entire video and was a matter of routine practice for the skilled person.

The invention might not work for some rare cases of video devices with unusual fast-forwarding functionality but it worked for all other cases. The expression "so that" in the claim should be interpreted as limiting the claimed subject-matter to those embodiments in which the effect of perceptibly displaying was present when fast forwarding, and therefore to the embodiments which worked. Since the claim mentioned intracoding, forward prediction and bidirectional prediction frames it was restricted to those implementations supporting a GOP structure, to which the claimed solution applied.

10.2 The Board does not find persuasive the former opponent's reasoning against sufficiency of disclosure.

The question of whether the skilled person would be able without undue burden to carry out the invention without tagging the substitute media frames or without displaying hidden I-frames long enough to be perceptible is not relevant to the question of sufficiency of disclosure, since claim 1 does not disclaim such options.

In order to fulfil the requirements of sufficiency of disclosure within the meaning of the EPC, it is sufficient that at least one way of carrying out the invention is described in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art. The former opponent seems to have acknowledged that the patent specification provides at least two solutions to implement the invention of claim 1 as granted.

One of the former opponent's arguments was that the feature "the substitute media is displayed when the video is fast forwarded" was not sufficiently disclosed because the I-frames are always "displayed", although the display is only perceptible during fast forwarding. This argument concerns the interpretation of the claim, rather than the question of how the skilled person carries out the invention. It has in any case been rendered moot by the amendments, which now distinguish in features (i) and (ii) between displaying in a manner perceptible and not perceptible by a user.

The former opponent did not convincingly explain why the passages of the patent specification relevant to the implementation of the invention, for example paragraphs [0060] and [0062] cited in this context in the decision under appeal, did not enable the skilled person to implement the invention, in particular to implement one of the two solutions mentioned by the former opponent with regard to feature (f).

The Board finds that, as argued by the appellant, the skilled person would be able to carry out the invention on the basis of the description. Paragraph [0060] of the patent specification explains the principle of

persistence of vision, by which "the perceptual process of the brain retains an image for a brief moment, and therefore cannot perceive each individual frame that is displayed in the advertisement". It then explains that the substitute media may be incorporated in additional frames distributed throughout the advertisement such that the additional video frames are not individually perceptible at playback speed (i.e. 1x rate), but become perceptible when they are displayed substantially closer in time (e.g. one after the other) due to fast forwarding. Paragraph [0051] of the patent specification explains that during fast forwarding of an MPEG-2 playback-stream, only I-frames and possibly a subset of the B- and P-frames are displayed. Paragraph [0062] gives an example of fast forwarding a frame sequence including I-, B- and P-frames, as well as hidden I-frames (Ih). Paragraph [0057] illustrates how fast-forward rates determine the number of skipped frames. In the Board's view, the skilled person would, on the basis of that information and using their ordinary skills, be able to incorporate I-frames in a video so that the frames become perceptible only when fast forwarded at specific rates.

- 10.3 The Board therefore concludes that the subject-matter of claim 1 of the main request fulfils the requirements of Article 83 EPC.

Further claims of the main request

11. The above conclusions reached for claim 1 of the main request with regard to the requirements of Articles 83, 84, 100(c) and 123(2) and (3) EPC equally apply to the other claims of the main request. In particular, the amendments made to independent claim 6 which essentially correspond to those made to claim 1 comply

with Article 84 EPC in combination with Article 101(3) (a) EPC.

Further prosecution

12. In the present appeal proceedings, the former opponent filed several documents and put forward new lines of reasoning with regard to inventive step. Those submissions represent a new case. Furthermore, the claims have been amended and clarified in the appeal proceedings, the new claims being broader than those considered inventive by the decision under appeal.
 - 12.1 Under those circumstances, the question of whether the new submissions should be admitted into the proceedings and, if admitted, the assessment of inventive step of the current claims along those new lines of reasoning should be left to the Opposition Division. This will give the appellant the opportunity to possibly argue its case before two instances.
 - 12.2 The Board therefore finds it appropriate to exercise its power under Article 111(1) EPC to remit the case to the department of first instance for further prosecution.
13. The prohibition of *reformatio in peius* with respect to the then second auxiliary request considered allowable by the opposition division prevails until the final settlement of the opposition case (T 1843/09, OJ EPO 2013, 508, reasons 2.3.1). In the further prosecution of the present case, the Opposition Division is thus bound by that prohibition within the terms detailed under point 2.1 above.

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.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated