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**Datasheet for the decision
of 19 September 2019**

Case Number: T 1191/14 - 3.5.04

Application Number: 02719480.2

Publication Number: 1382199

IPC: H04N7/06

Language of the proceedings: EN

Title of invention:

PERSONAL VIDEO RECORDER SYSTEMS AND METHODS

Applicant:

Rovi Guides, Inc.

Headword:

Relevant legal provisions:

EPC 1973 Art. 84

Keyword:

Claims - clarity - all requests (no)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1191/14 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 19 September 2019

Appellant: Rovi Guides, Inc.
(Applicant) 2160 Gold Street
San Jose, CA 95002 (US)

Representative: Pisani, Diana Jean
Haley Guiliano International LLP
Central Court
25 Southampton Buildings
London WC2A 1AL (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 9 December 2013
refusing European patent application
No. 02719480.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman C. Kunzelmann
Members: B. Willems
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division dated 9 December 2013 refusing European patent application No. 02 719 480.2, which was published as international application WO 02/078317 A2.
- II. The documents cited in the decision under appeal included the following:
- D5: WO 02/19691 A2;
- priority document P1: application number US 60/278079;
- priority document P2: application number US 60/284951;
- priority document P3: application number US 60/290714.
- III. The application was refused on the grounds that in none of the requests on file at the time claim 1 validly claimed priority of any of P1, P2 or P3, document D5 was prior art under Article 54(2) EPC and the subject-matter of claim 1 of each of the requests lacked inventive step over the disclosure of D5 combined with the common general knowledge of the person skilled in the art (Article 56 EPC).
- IV. The applicant filed notice of appeal. With the statement of grounds of appeal, the appellant submitted claims according to a main request and first, second, third, fourth and fifth auxiliary requests and submitted reasons as to why the priority of P2 was valid and why claim 1 of each of the requests met the requirements of Article 56 EPC.

V. The board issued a summons to oral proceedings. In a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ 2007, 536), annexed to the summons, the board introduced the following documents into the proceedings:

D8: WO 00/04709 A1;

D9: US 6,032,202 A.

The board gave the following provisional opinion.

- Claim 1 did not meet the requirements of Article 84 EPC 1973 in any of the requests, because the vague phrase "*personal video recorder extensions*" meant there were at least two equally valid interpretations of the claims.
- The subject-matter of the claims did not validly claim priority of P1, P2 or P3 (Article 87(1) EPC 1973) in any of the requests and document D5 was prior art under Article 54(2) EPC 1973.
- Claim 1 of the main request did not meet the requirements of Article 56 EPC 1973 because the claimed subject-matter lacked inventive step over the disclosure of D5 combined with the common general knowledge of the person skilled in the art.
- Claim 1 of the main request and the first, second, third and fifth auxiliary requests did not meet the requirements of Article 56 EPC 1973, because the claimed subject-matter lacked inventive step over the disclosure of D8 combined with the common general knowledge of the person skilled in the art.

- Claim 1 of the fourth auxiliary request did not meet the requirements of Article 56 EPC 1973 because the claimed subject-matter lacked inventive step over the disclosure of D8 and the common general knowledge of applicable standards as exemplified by document D9.

VI. With the reply dated 18 August 2019, the appellant filed amended claims according to first and second auxiliary requests. It submitted arguments as to why the claims of the main and the first auxiliary request met the requirements of Article 84 EPC and the claims of the main and the first and second auxiliary requests met the requirements of Article 56 EPC.

VII. The board held oral proceedings on 18 and 19 September 2019.

The appellant's final requests were that the decision under appeal be set aside and that a European patent be granted on the basis of the claims of the main request filed with the statement of grounds of appeal, or the first auxiliary request filed with the letter dated 18 August 2019, or the second auxiliary request filed during the oral proceedings on 18 September 2019, or the third auxiliary request filed as second auxiliary request with the letter dated 18 August 2019.

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

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

"An interactive television system for providing a user with the ability to record television programming, the system comprising:

a personal video recorder compliant device that is useable by the user to interact with the interactive television system, the personal video recorder compliant device comprising:

software and hardware configured to implement an interactive television program guide, and

software and hardware configured to implement personal video recorder extensions; and

a personal video recorder device coupled to the personal video recorder compliant device, wherein a plurality of application programming interfaces are configured to facilitate communications between the personal video recorder device and the personal video recorder compliant device,

wherein the interactive television program guide is a first interactive television program guide and wherein the personal video recorder device comprises software and hardware configured to implement a second interactive television program guide, and wherein the first and second interactive television program guides each provide the same features and functionality."

IX. Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the "wherein" clause reads as follows:

"wherein the interactive television program guide is a first interactive television program guide and wherein the personal video recorder device comprises software and hardware configured to implement a second interactive television program guide for recording television programming, and wherein the personal video

recorder extensions enable the first interactive television program guide to provide the same personal video recording functionality for recordings executed by the personal video recorder device as the second interactive television program guide".

- X. Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the "wherein" clause reads as follows:

"wherein the interactive television program guide is a first interactive television program guide and wherein the personal video recorder device comprises software and hardware configured to implement a second interactive television program guide for recording television programming, and wherein the personal video recorder extensions on the personal video recorder compliant device enable the first interactive television program guide to provide the same personal video recording functionality as the second interactive television program guide, the functionality including a recording option on a display screen of the personal video recording compliant device for recordings to be executed by the personal video recorder device".

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

"An interactive television system for providing a user with the ability to record television programming, the system comprising:

a personal video recorder compliant device that is useable by the user to interact with the interactive television system, the personal video recorder compliant device comprising:

software and hardware configured to implement an interactive television program guide, and

software and hardware, including a plurality of application programming interfaces, configured to implement personal video recorder extensions; and

a personal video recorder device coupled to the personal video recorder compliant device, wherein the plurality of application programming interfaces are configured to facilitate communications between the personal video recorder device and the personal video recorder compliant device, and wherein the personal video recorder compliant device is configured to determine a type of the personal video recorder device and wherein the application programming interfaces are selected based on the determined type,

wherein the interactive television program guide is a first interactive television program guide and wherein the personal video recorder device comprises software and hardware configured to implement a second interactive television program guide for recording television programming, and wherein the personal video recorder extensions enable the first second [sic] interactive television program guide to provide the same personal video recording functionality for recordings executed by the personal video recorder device as the second interactive television program guide."

XII. The appellant's arguments, where relevant to the present decision, may be summarised as follows:

(a) The fact that claim 1 of the main request covered two alternatives did not make the claim unclear

per se (see letter dated 18 September 2019, page 1, last paragraph).

- (b) The personal video recorder (PVR) extensions provided PVR functionality on the compliant device irrespective of whether they were implemented in hardware or software, or whether they were part of the interactive program guide (IPG) or separate software modules cooperating with the IPG. This functionality was evident from the term "*PVR extension*" itself and the "wherein" clause of claim 1 of the main request.
- (c) The PVR extensions cooperated with the IPG to provide the claimed result. Claim 1 technically specified the PVR extensions such that a person skilled in the art could implement extensions which provided the claimed functionality. It would not be fair to require further technical details in the claim.
- (d) By specifying PVR extensions, embodiments in which the IPG on the set-top box was a "*full-port*" of the IPG on the PVR were excluded.
- (e) Claim 1 of the second auxiliary request clearly specified the purpose and functionalities of the PVR extensions.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request - clarity (Article 84 EPC 1973)*
 - 2.1 According to Article 84 EPC 1973, the claims "*shall be clear*" and supported by the description.

Vague terms can create a lack of clarity if they result in different but equally valid interpretations of the claims (see Case Law of the Boards of Appeal of the European Patent Office ("Case Law"), 9th edition 2019, II.A.3.1).

- 2.2 Claim 1 of the main request specifies "*software and hardware configured to implement personal video recorder extensions*" and "*a second interactive television program guide for recording television programming [... wherein] the first and second interactive television program guides each provide the same features and functionality*".
- 2.3 In contrast to the appellant (see point XII(a) above), the board is of the opinion that the multiple possible interpretations of the phrases quoted in point 2.2 above create a lack of clarity.
 - 2.3.1 According to the claim, software or hardware can be configured to implement PVR extensions.

(a) In its assessment of inventive step in point 5.3.1 of the decision under appeal, the examining division mapped the PVR extensions to the disclosure of document D5, page 11, lines 15 to 25, i.e. the division mapped the PVR extensions to the

interface for communicating IPG data between the set-top box and the digital video recorder.

- (b) Paragraphs [0059] and [0060] of the description disclose that PVR extensions may be implemented together with the IPG, as part of a single software component or as a separate software module working in conjunction with the IPG to "integrate" PVR functionality.
- (c) These technically completely different interpretations of the PVR extensions (communication interface or software component providing PVR functionality) are equally valid in the context of the claim. However, the description does not disclose details of hardware used in conjunction with the IPG to provide the claimed functionality. Moreover, according to the description, paragraph [0062], PVR application programming interfaces (APIs) facilitate the communication with the PVR device.

Therefore, the board is not convinced that it is clear how hardware can be configured to implement extensions providing the claimed functionality (see point XII(b) above).

2.3.2 According to paragraph [0059], PVR extensions may be implemented with the IPG, as part of a single software component, or may be implemented as a separate software module working in conjunction with the IPG.

- (a) Since neither the claim nor the description specifies a pre-existing version of the IPG software into which extensions are to be integrated, implementing PVR extensions as an

integral part of the IPG does not go beyond a mere re-labelling of (part of) the existing IPG software.

The board is not convinced that the reference to extensions excludes "*full-port*" embodiments (see point XII(c) above). Both the single software implementation specified in paragraph [0059] and the "*full-port*" IPG specified in paragraph [0015] ("*A full-port of the IPG may be implemented in both the PVR equipment and the set-top box [...and] the integrated IPG may be used to provide PVR features and functionality*") provide PVR functionality. In both cases a single software component IPG provides PVR functionality.

(b) The board has not been persuaded that claim 1 technically specifies the PVR extensions such that a person skilled in the art can implement extensions which provide the claimed functionality (see point XII (c) above). In particular, it is not clear which additional functionality should be provided by the extensions because this depends on the functionality provided by the "*original*" guides.

(i) If the second IPG (that on the PVR) provides PVR functionality, then the first IPG (which provides the same functionality as the second IPG) already provides PVR functionality and need not cooperate with extensions to provide PVR functionality.

(ii) If the second IPG does not provide PVR functionality, then the extensions (of the first IPG on the compliant device) would be

purposeless because the first guide would not have to be extended to provide PVR functionality.

(iii) Thus, in the examples set out in (i) and (ii) above, the extensions seem to be purposeless.

(c) Therefore, the board is not convinced that claim 1 technically specifies the PVR extensions such that a person skilled in the art can implement extensions which provide the claimed functionality (see point XII(c) above).

2.3.3 In summary, claim 1 is ambiguous because the term "*personal video recorder extensions*" does not specify which part of the hardware or software provides extensions enabling the claimed functionality.

2.4 In view of the above, claim 1 of the main request does not meet the requirements of Article 84 EPC 1973.

3. *First and third auxiliary requests - clarity*
(Article 84 EPC 1973)

3.1 According to the established case law of the boards of appeal, Article 84 EPC 1973 has to be interpreted as meaning not only that a claim must be comprehensible from a technical point of view, but also that it must define all the essential features of the invention. If an independent claim contains a feature defined by a result to be achieved which essentially corresponds to the problem underlying the application, the remaining features of the claim have to comprise all essential features necessary for achieving that result (see Case Law, 9th edition 2019, II.A.3.2).

3.2 Claim 1 of the first and third auxiliary requests specifies that *"the personal video recorder extensions enable the first (second) interactive television program guide to provide the same personal video recording functionality for recordings executed by the personal video recorder device as the second interactive television program guide"*.

Thus, the PVR extensions are defined by the result to be achieved, i.e. to enable the first IPG to provide the same recording functionality as the second IPG.

3.3 According to paragraph [0008] of the description it is an object of the application to provide an interactive television system having PVR functionality in which the user may use an IPG seamlessly with PVR functionality.

3.4 This problem corresponds to the result to be achieved identified in point 3.2 above.

3.5 However, the remaining features of the claim do not comprise all features necessary for providing PVR extensions which enable the first IPG to provide the same recording functionality as the second IPG.

(a) Claim 1 of the first and third auxiliary requests specifies neither the functionality of the first "original" IPG (see also point 2.3.2(b) above) nor any means for detecting the difference between the functionality provided by the first and second IPGs. Therefore, it is not clear which functionality is to be provided by the PVR extensions.

(b) The board has not been persuaded that the term *"PVR extensions"* by itself defines the technical

features of the extensions such that a person skilled in the art can implement extensions which provide the claimed functionality (see also point 2.3.2 above). Therefore, the claim does not define any technical features of the extensions necessary to provide the claimed functionality.

3.6 In view of the above, claim 1 of neither the first nor the third auxiliary request meets the requirements of Article 84 EPC 1973.

4. *Second auxiliary request - clarity (Article 84 EPC 1973)*

4.1 In comparison with claim 1 of the first auxiliary request, claim 1 of the second auxiliary request further specifies that personal video recording functionality includes a recording option on a display screen of the personal video recording compliant device for recordings to be executed by the personal video recorder device.

4.2 The board agrees with the appellant that claim 1 of the second auxiliary request specifies that the PVR extensions enable the first IPG to provide the claimed functionality (see point XII(d) above).

4.3 However, this functionality defines a result to be achieved which corresponds to the problem underlying the current application and claim 1 of the second auxiliary request does not specify all the features necessary for enabling the PVR extensions to provide the claimed functionality (see also points 2.3.2 and 3.5(b) above).

4.4 In view of the above, claim 1 of the second auxiliary request does not meet the requirements of Article 84 EPC 1973.

5. Since none of the appellant's requests is allowable, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

C. Kunzelmann

Decision electronically authenticated