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**Datasheet for the decision
of 5 October 2022**

Case Number: T 1638/18 - 3.5.04

Application Number: 14150696.4

Publication Number: 2793477

IPC: H04N21/262, H04H60/06,
H04H60/73, H04N21/81, H04N21/84

Language of the proceedings: EN

Title of invention:
Recipient specific lists for distribution of media content

Applicant:
Disney Enterprises, Inc.

Headword:

Relevant legal provisions:
EPC Art. 84, 123(2), 111(1)
EPC R. 111(2)
RPBA 2020 Art. 11
RPBA Art. 13(2)

Keyword:

Amendment after summons - exceptional circumstances (yes)
Appealed decision - sufficiently reasoned (no)
Remittal to the department of first instance - (yes)
Amendment to appeal case - amendment overcomes issues raised
(yes)
Claims - clarity after amendment (yes)

Decisions cited:

T 0070/02, G 0010/93, T 0316/05

Catchword:



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Case Number: T 1638/18 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 5 October 2022

Appellant: Disney Enterprises, Inc.
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Burbank, CA 91521 (US)

Representative: Dr. Weitzel & Partner
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 2 February 2018
refusing European patent application No.
14150696.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman B. Willems
Members: F. Sanahuja
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the examining division's decision to refuse European patent application No. 14 150 696.4.
- II. The documents cited in the decision under appeal included the following:
- D1 WO 2011/150389 A1
E1 US 2009/0106082 A1
- III. Further, the document US 2010/0178030 A1 was cited in the decision under appeal. In its statement of grounds of appeal, the appellant referred to this document as D7. The board has adhered to the appellant's designation.
- IV. The application was refused on the grounds that the subject-matter of claims 1 and 8 lacked inventive step over the disclosure of D1 or E1 combined with the common general knowledge of the person skilled in the art, and over the combined disclosures of E1 and D7 (Article 56 EPC). Dependent claims 2 to 7 also lacked inventive step.
- V. The applicant ("appellant") filed notice of appeal. With its statement of grounds of appeal, the appellant filed a main request and stated that the claims of the main request had been the basis of the appealed decision (see the statement of grounds of appeal, last paragraph on page 2). The appellant also filed auxiliary requests I and II. Moreover, it provided arguments as to why the subject-matter of all of the

claims of the main request and of auxiliary requests I and II was new and involved an inventive step.

VI. In its notice of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the application as originally filed. Subsequently, in its statement of grounds of appeal the appellant requested that a patent be granted on the basis of the following request:

(a) a main request comprising claims 1 to 8 filed in electronic form on 8 December 2017, the original description with a new page 2, filed with the statement of grounds of appeal, and the drawings as originally filed (see the statement of grounds of appeal, paragraph bridging pages 2 and 3),

or, alternatively, that a patent be granted on the basis of

(b) the claims of auxiliary request I or II filed with the statement of grounds of appeal (see the statement of grounds of appeal, page 12, section entitled "*Auxiliary Requests*").

VII. A summons to oral proceedings scheduled for 4 and 5 October 2022 was issued on 11 November 2021. In a communication under Article 15(1) RPBA 2020 (the "board's communication"), the board expressed the following preliminary view:

(a) The appellant's requests, and the ranking thereof, were not clear.

(b) Neither claim 1 of the main request nor that of auxiliary request I met the requirements of

Article 84. Furthermore, the subject-matter thereof failed to meet the requirements of Article 123(2) EPC.

- (c) The board was not in a position to assess whether the examining division's conclusion that claim 1 of the main request lacked inventive step was justified.
- (d) Should the appellant succeed in convincing the board that the claims of the main request and of auxiliary request I met the requirements of Article 84 and that the subject-matter thereof met those of Article 123(2) EPC, the board was inclined to exercise its discretion under Article 111(1) EPC in remitting the case to the department of first instance for further prosecution.
- (e) Should a decision be required on auxiliary request II, its admittance in view of Article 12(4) RPBA 2007 would need to be discussed during the oral proceedings.

VIII. With a letter of reply dated 29 August 2022, the appellant clarified that the claim requests submitted with the statement of grounds of appeal were to replace the request filed with the notice of appeal.

It also filed amended claims according to a main request and auxiliary requests I and II to replace the main request and auxiliary requests I and II filed with the statement of grounds of appeal. It indicated a basis in the application as filed for the amended claims, provided reasons why it was of the opinion that the claims of all of the requests met the requirements

of Articles 84 and 123(2) EPC and argued in favour of the requests' admittance.

The appellant stated that in the event the board did not intend to admit these requests, it should proceed with the main request and auxiliary requests I and II filed with the statement of grounds of appeal.

With the same letter, the appellant requested that the case be remitted to the department of first instance for further prosecution on the basis of the request that fulfilled the requirements of Articles 84 and 123(2) EPC.

- IX. By communication of the Registry dated 7 September 2022, the appellant was informed that the oral proceedings scheduled for 4 and 5 October 2022 were to be re-scheduled for 5 October 2022 and would be held by videoconference.
- X. During the oral proceedings, following a discussion on Articles 84 and 123(2) EPC, the appellant submitted amended claims according to a new main request labelled "12:00 hrs". All of the other requests on file were withdrawn.
- XI. The appellant's final request was that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the main request labelled "12:00 hours" as filed during the oral proceedings of 5 October 2022.

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

XII. Claim 1 of the **main request** reads as follows:

- A method for use by a system including a processor, the method comprising:
- obtaining, using the processor, a unique identifier (UID), wherein the UID identifies a first entertainment content, a name and location corresponding to a recipient of the first entertainment content, a first time schedule for the first entertainment content, and a prioritization metadata for the first entertainment content;
- generating, using the processor, a first recipient specific list (RSL) using the UID, wherein the first RSL identifies the first entertainment content and includes an identifier for the recipient of the first entertainment content including the name and the location corresponding to the recipient of the first entertainment content, the first time schedule for the first entertainment content and the prioritization metadata, wherein the identifier for the recipient of the first entertainment content includes information data corresponding to the recipient of the first entertainment content including a multichannel video programming distributor (MVPD); and
- transmitting, using the processor, the first RSL to a content transport stream creator for creation of a first encoded content transport stream including the first entertainment content and the prioritization metadata using the first RSL and the

first entertainment content;

- creating, at the content transport stream creator, the first encoded content transport stream including the first entertainment content and the prioritization metadata using the first RSL and the first entertainment content;
- wherein the content stream creator transmits the first encoded content transport stream to a network director for distribution to the MVPD;
- distributing, at the network director, the first encoded content transport stream to the MVPD;
- receiving by the MVPD a second encoded content transport stream created using a second RSL including an identifier for a second entertainment content, an identifier for a recipient of the second entertainment content, and a second time schedule for the second entertainment content,
- wherein the MVPD gives priority in decoding to the encoded content transport stream which contains the prioritization metadata into video content and/or audio content for distribution to a display.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request - admittance (Article 13(2) RPBA 2020)*

- 2.1 The claims of the main request were filed by the appellant during the oral proceedings, i.e. after notification of the summons to oral proceedings.
- 2.2 According to Article 13(2) RPBA 2020, "*[a]ny amendment to a party's appeal case made ... after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned*".
- 2.3 The amendments to the claims were made following objections under Articles 84 and 123(2) EPC raised for the first time in the board's communication and during the oral proceedings. The board accepts that this constitutes exceptional circumstances within the meaning of Article 13(2) RPBA 2022 and has admitted the request into the appeal proceedings.
3. *Main request - clarity (Article 84 EPC)*
 - 3.1 According to the established case law of the boards of appeal, Article 84 EPC is 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 the object of the invention clearly, that is to say it must indicate all the essential features thereof (see Case Law of the Boards of Appeal of the European Patent Office, 10th edition, 2022, "Case Law", II.A.3.2).
 - 3.2 In its communication, the board expressed its preliminary opinion that claim 1 of the version of the main request and of auxiliary request I pending at that time omitted steps contributing to delivering an encoded content transport stream to the MVPD. Hence, it failed to define features which appeared to be required

for a workable solution and were thus considered to be essential. These features included the following steps:

- creating an encoded content transport stream using the RSL including media content and "prioritization metadata" (see the description, page 15, line 21, to page 16, line 3, and page 16, lines 19 to 22)
- transmitting the encoded content transport stream to a network director (see page 14, line 20, to page 15, line 5, or page 16, lines 4 to 6)
- distributing the encoded content transport stream to a media distributor such as an MVPD (see page 14, line 20, to page 15, line 5, or page 16, lines 4 to 6)

3.2.1 Claim 1 of the main request as amended includes the following features:

- creating, at the content transport stream creator, the first encoded content transport stream including the first entertainment content and the prioritization metadata using the first RSL and the first entertainment content
- wherein the content stream creator transmits the first encoded content transport stream to a network director for distribution to the MVPD
- distributing, at the network director, the first encoded content transport stream to the MVPD

3.2.2 Hence, claim 1 defines all of the necessary steps to deliver the content transport stream to the MVPD.

- 3.3 Furthermore, the amendments to claim 1 of the main request removed the ambiguities associated with the "*identifier for the first entertainment content*" and the "*identifier for the recipient of the first entertainment content*" that were pointed out in the board's communication.
- 3.4 In view of the above, the amendments made to the claims of the main request overcome the objections under Article 84 EPC that were raised in the board's communication (see point VII.(b) above).
4. *Main request - added subject-matter (Article 123(2) EPC)*
- 4.1 The European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).
- 4.2 In its communication, the board cast doubt on whether the application as filed provided a clear and unambiguous basis for giving decoding priority based on first and second "*prioritization metadata*" included in respective encoded content transport streams.
- 4.2.1 The paragraph bridging pages 16 and 17 of the description as filed states that "*if encoded content transport stream 374 contains priority data, media distributor 380 may give priority in decoding encoded content transport stream 374 into video content and/or audio content for distribution to display 304*". According to the description (see page 15, lines 2 to 4), media distributor 380 may correspond to a multichannel video programming distributor (MVPD).

- 4.2.2 Claim 1 of the main request has been amended to specify the following method step:
- wherein the MVPD gives priority in decoding to the encoded content transport stream which contains the prioritization metadata into video content and/or audio content for distribution to a display.
- 4.2.3 The board considers this method step to be directly and unambiguously derivable from page 15, lines 2 to 4, and the paragraph bridging pages 16 and 17 of the description.
- 4.3 Claim 1 has also been amended to give priority in decoding an encoded content transport stream into specific data for a specific use, i.e. *"into video content and/or audio content for distribution to a display"*, in accordance with the disclosure on page 16, lines 19 to 22, of the description.
- 4.4 The board is of the opinion that the amended steps in claim 1 contributing to delivering the encoded content transport stream to the MVPD (see point 3.2.1 above) have a basis in the application as filed (see the description, page 14, line 20, to page 15, line 5, page 15, line 21, to page 16, line 6, and page 16, lines 19 to 22).
- 4.5 In addition, the amendments made to remove the ambiguities identified in the board's communication (see point 3.3 above) have a basis in page 11, lines 7 to 9 and 12 to 14, and page 13, lines 1 to 3, of the description.
- 4.6 For these reasons, the amendments made to the claims of the main request do not contain subject-matter which

extends beyond the content of the application as filed. Moreover, they overcome the objections under Article 123(2) EPC that were raised in the board's communication.

5. *Insufficient reasoning for inventive step; Rule 111(2) EPC*

5.1 According to Rule 111(2) EPC, decisions of the European Patent Office which are open to appeal shall be reasoned.

The reasoning given in a decision open to appeal has to enable the appellant and the board of appeal to examine whether or not the decision was justified. A decision should therefore discuss in detail the facts, evidence and arguments that are essential to the decision. It must contain the logical chain of reasoning which led to the relevant conclusion (see Case Law, III.K.3.4.3).

5.2 *Insufficient reasoning; inventive step based on D1*

5.2.1 In order to give an applicant a fair chance of challenging the findings of the examining division, the latter should, as a rule, identify at least once where in the closest prior-art document each of the features of the claim in suit is disclosed (see e.g. T 70/02, Reasons 6).

5.2.2 In the decision under appeal, the examining division mapped the feature "*wherein the identifier of the first recipient of the first entertainment content includes information data corresponding to the first recipient of the first entertainment content including a MVPD*" to the "broadcast transport network" in paragraph [0129] of document D1. This paragraph does not specify any

information that can be recognised as being technically equivalent to information data including an MVPD. Moreover, the examining division did not explain whether it mapped the information data including an MVPD to the broadcast transport network.

Therefore, the board also "*cannot follow*" how "*D1 discloses a first recipient specific list including information data corresponding to the recipient of the first entertainment content including a multichannel video programming distributor (MVPD)*" (see the statement of grounds of appeal, paragraph bridging pages 5 and 6).

- 5.2.3 Further, the examining division linked the first recipient specific list (RSL) to the Broadcast Schedule Message (BSM), and the first encoded content transport stream to a series of BSMs in an overhead message flow of D1 (see the decision under appeal, point 2.1.1, fourth and seventh paragraphs). The overhead message flow is a transport stream which does not include content (see D1, paragraph [0129]).

The examining division then merely stated that the following features were implicit (see the decision under appeal, page 5, second paragraph):

- (a) using the RSL and the first entertainment content for creation of the first encoded transport stream,
- (b) receiving, at the MVPD, a second encoded transport stream, and
- (c) determining, at the MVPD, whether to give priority to the first encoded transport stream based on the

first and second prioritization included in first and second encoded content transport streams

This perfunctory statement does not allow the board to determine which passages of D1 were considered to be relevant and to assess why the examining division was of the opinion that:

- using a first entertainment content to create a transport stream composed of a series of BSMS (item (a) above), and
- receiving, at an MVPD, a second encoded transport stream and giving priority to a transport stream including a series of BSMS without content (items (b) and (c) above)

were implicitly disclosed in those passages.

5.3 *Insufficient reasoning; inventive step based on E1*

5.3.1 When deciding upon inventive step, as in the present case, the logical chain of reasoning must be given, including identifying the features which delimit and distinguish the subject-matter claimed from the selected springboard. In order to identify the distinguishing features, the features of the claim to be examined need to be compared with those disclosed in the selected springboard (see e.g. T 0316/05, Reasons 2.1).

5.3.2 It is not clear from the decision which of the "*added features in the last version of the claims*" equated to an update mechanism of playlists (see the decision under appeal, point 2.2.1).

The examining division did not identify the features distinguishing claim 1 from prior-art document E1. Further, the decision under appeal does not contain a discussion using the problem-solution approach based on E1. Therefore, the distinguishing features cannot be implied by such a discussion. Hence, the reader of the contested decision is at a loss as to which features the examining division regarded as distinguishing features over E1.

- 5.3.3 In an additional line of reasoning (see point 2.2.3 of the decision under appeal), the examining division held that "*additional features concerning priority are considered obvious over combination of E1 and ... document US2010178030A1*" and cited paragraphs [0017] and [0039] of the latter document (D7). These paragraphs disclose prioritising content according to its source.

However, the examining division failed to identify the features distinguishing claim 1 from prior-art document E1 and, in particular, to single out which "*features concerning priority*" were considered obvious from the combined disclosure of documents E1 and D7, and why.

- 5.3.4 Since the examining division based its inventive-step objection on an insufficient identification of the distinguishing features of claim 1 from prior-art document E1, the board is unable to follow the logical chain of reasoning which led the examining division to its conclusion that the subject-matter of claim 1 lacked inventive step.

- 5.4 In summary, none of the objections raised by the examining division is formulated in such a manner that

the board can examine whether or not the decision is justified.

6. *Remittal*

6.1 According to Article 111(1) EPC, the board, in deciding upon the appeal, may exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

Article 11 RPBA 2020 stipulates that the board should not remit a case for further prosecution unless special reasons present themselves for doing so.

6.2 The board is not in a position to assess, on the basis of the examining division's reasoning, whether or not the examining division's conclusion that claim 1 of the main request lacked inventive step starting from either D1 or E1 is justified (see section 5. above).

6.3 Thus, if the board were to decide on the substance of the case itself and did not remit the case to the department of first instance, the board would have to carry out a full examination of the application as to the patentability requirements. This, however, is the task of the examining division (see decision G 10/93 of the Enlarged Board of Appeal, OJ EPO 1995, 172, Reasons 4).

6.4 The examining division's deficient examination of inventive step constitutes "special reasons" within the meaning of Article 11 RPBA 2020. Thus, the board has decided to exercise its discretion under Article 111(1) EPC in remitting the case to the department of first instance for further prosecution.

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 Chairwoman:



K. Boelicke

B. Willems

Decision electronically authenticated