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**Datasheet for the decision
of 28 July 2022**

Case Number: T 1640/18 - 3.5.04

Application Number: 13190518.4

Publication Number: 2750395

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

Language of the proceedings: EN

Title of invention:

Intelligent generation and distribution of an encoded content
transport stream according to metadata

Applicant:

Disney Enterprises, Inc.

Headword:

Relevant legal provisions:

EPC Art. 123(2), 111(1)
EPC R. 111(2)
RPBA 2020 Art. 11, 13(2)

Keyword:

Amendments - allowable (yes)

Appealed decision - sufficiently reasoned (no) - remittal to
the department of first instance (yes)

Amendment after summons - exceptional circumstances (yes)

Decisions cited:

T 0070/02, G 0010/93

Catchword:



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Case Number: T 1640/18 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 28 July 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.
13190518.4 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. 13 190 518.4.
- II. The documents cited in the decision under appeal included the following:

D1 WO 2011/150389 A1
- III. The application was refused on the grounds that the subject-matter of claims 1 and 10 of the sole request then on file lacked inventive step over the disclosure of D1 combined with the common general knowledge of the person skilled in the art (Article 56 EPC). Dependent claims 2 to 9 and 11 to 15 also lacked inventive step.
- IV. The applicant ("appellant") filed notice of appeal. With the statement of grounds of appeal, the appellant filed a main request and submitted that the claims of the main request corresponded to the claims which had formed the basis of the decision under appeal with a mistake remedied (see statement of grounds of appeal, the paragraph bridging pages 1 and 2). The appellant also filed auxiliary requests I and II. It provided arguments as to why the subject-matter of the claims of all requests was new and involved an inventive step.
- V. In the notice of appeal, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the application as originally filed. Subsequently, in the statement of grounds of appeal, the appellant requested that a patent be granted on the basis of the following requests:

(a) a main request with claims 1 to 15 filed with the statement of grounds of appeal, the description as filed with the letter of 12 December 2014 and the original drawings (see statement of grounds of appeal, the paragraph bridging pages 1 and 2),

or, alternatively, on the basis of

(b) the claims of auxiliary request I or II filed with the statement of grounds of appeal (see statement of grounds of appeal, the paragraph bridging pages 8 and 9, and page 11, last full paragraph).

The appellant did not request oral proceedings.

VI. 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 their ranking were not clear.

(b) The subject-matter of claim 1 of the main request and auxiliary request I did not 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

auxiliary request I met the requirements 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.

VII. With a letter of reply dated 15 July 2022, the appellant clarified that the claim requests submitted with the statement of grounds of appeal substituted its request filed with the notice of appeal.

It also filed amended claims according to a main request and auxiliary requests I and II which should substitute the previously filed main request and auxiliary requests I and II. It indicated a basis in the application as filed for the amended claims and argued in favour of the requests' admittance.

The appellant stated that, should the board not admit these requests, it maintained the previously filed main request and auxiliary requests I and II.

With the same letter, the appellant stated that it *"would be pleased to receive a further advise [sic] from the Board if with the amendments the case [would] be remitted to the first instance for further prosecution and in view thereof oral proceedings [could] be cancelled"*.

VIII. By communication of the Registry dated 28 July 2022 the appellant was informed that, in view of the amendments,

the case would be remitted to the department of first instance and the oral proceedings scheduled for 4 and 5 October 2022 were cancelled.

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

"A method for use by a system including a processor and a memory, the memory having at least one unique identifier (UID) identifying a corresponding at least one content elements, for generation and distribution of at least one encoded content transport stream, the method comprising:

obtaining, using the processor, metadata and the at least one UID from the memory, the at least one UID identifying a corresponding at least one content element;

generating, using the processor, a recipient specific list (RSL) using the metadata and the at least one UID, wherein the RSL is a playlist of media content, and wherein the RSL includes at least a commercial scheduling metadata corresponding to at least a commercial content;

creating, using the processor, at least one content transport stream using the RSL, the at least one content transport stream including the metadata and the corresponding at least one content element, wherein the metadata includes at least one of a name and a location of an affiliate that receives the at least one encoded transport stream;

encoding, using the processor, the at least one content transport stream to generate the at least one encoded content transport stream; and

distributing, using the processor, the at least one encoded content transport stream through at least one network path to the affiliate for decoding into video content and/or audio content and further distribution by the affiliate to consumers of the affiliate."

- X. The appellant's arguments, in so far as relevant to the present decision, may be summarised as follows:

The claim requests enclosed with the letter dated 15 July 2022 were filed in response to an objection under Article 123(2) EPC raised for the first time in appeal proceedings. Hence, the requests should be admitted into the proceedings.

Reasons for the Decision

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

In response to the board's objection under Article 123(2) EPC raised for the first time in the communication under Article 15(1) RPBA 2020, the appellant filed *inter alia* a new main request aiming to overcome this objection. The board accepts that this constituted "exceptional circumstances" within the meaning of Article 13(2) RPBA 2020, and takes the main request into account.

3. *Main request, added subject-matter (Article 123(2) EPC)*

3.1 The amendments made to the claims of the main request overcome the objection under Article 123(2) EPC raised in the board's communication (see point VI.(b) above).

4. *Insufficient reasoning for inventive step, Rule 111(2) EPC*

4.1 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 the decision was justified or not. A decision should discuss the facts, evidence and arguments which are essential to the decision in detail. It has to contain the logical chain of reasoning which led to the relevant conclusion (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, "Case Law", III.K.3.4.3).

In order to give an applicant a fair chance to challenge the findings of the examining division, the latter should, as a rule, at least once identify 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).

4.2 In the decision under appeal (see point 2.1 of the "Grounds for the decision", page 5, second and third paragraphs), the examining division mapped the encoded content transport stream of claim 1 to a series of BSMS in an overhead message flow.

They also mapped the feature "*creating, using the processor, at least one content transport stream using*

the RSL, the at least one content transport stream including the metadata and the corresponding at least one content element" to the provision of BSMS between entities (see D1, paragraph [0120]), using a transport stream format at a certain stage (see D1, paragraph [0208]). These paragraphs of D1 do not specify any transport stream including, in addition to BSMS, a content element as specified in claim 1. The examining division did not explain why they were of the opinion that the transport stream of BSMS included at least one content element.

- 4.3 Claim 1 specifies that *"the metadata includes at least one of a name and a location of an affiliate that receives the at least one encoded transport streams"*.

The examining division identified an affiliate in the forward link only (FLO) service node (FSN) of D1 (paragraph [0120]) and concluded that an *"'affiliate' is necessarily identified in the metadata of the transport stream, with a name or location for transmission purposes"* (see decision under appeal, point 2.1 of the "Grounds for the decision", page 5, second paragraph).

However, claim 1 specifies that the metadata obtained and used to generate an RSL (in addition to being included in the content transport stream) is the metadata that includes "at least one of a name and a location" of the affiliate. The fact that an "affiliate" is necessarily included in a transport stream as metadata for transmission purposes does not imply that metadata defined in the "obtaining" step already includes a name or a location of an "affiliate". Therefore, the question arises whether the

examining division identified a name or a location of an affiliate in the obtained metadata.

The examining division referred to paragraphs [0003], [0111], [0125] and [0129] of D1 when discussing metadata (see decision under appeal, point 2.1 of the "Grounds for the decision", page 4, last paragraph, and page 5, first paragraph). None of these paragraphs specify any information that may be recognised as technically equivalent to a name or a location of an affiliate. Moreover, the examining division did not elaborate on whether the metadata in the "obtaining" step already included a name or a location of an affiliate.

4.4 Further, distributing the encoded content transport stream to the affiliate (identified as the FSN) was mapped to broadcasting a series of BSMS in a broadcast transport network (see decision under appeal, point 2.1 of the "Grounds for the decision", page 5, fourth paragraph). However, cited paragraph [0129] of D1 is concerned with the delivery of BSMS to a broadcast receiver instead of to the FSN. Thus, it is unclear whether the examining division considered that the cited paragraph disclosed the claimed distribution to the FSN or whether they remapped the affiliate to a broadcast receiver.

4.5 In the decision under appeal (see point 2.2 of the "Grounds for the decision"), the examining division identified the following "additional features to the disclosure of D1":

- (i) content is commercial;

- (ii) *"content further decoded by affiliate and distributed to consumers of the affiliate" (sic)*

Thus, the examining division identified decoding and distributing content as features of claim 1.

Then the examining division stated that *"[t]hese feature [sic] do not make any contribution ... to the technical character of the invention ... and is [sic] thus not relevant for assessing inventive step"*.

From the previous statement it is not clear to the board which of the features ((i), (ii) or both) were considered by the examining division not to make a technical contribution.

- 4.6 With respect to feature (ii) the examining division held that it was *"not limiting when assessing the contribution to the prior art"*. Nevertheless, they did not explain why they arrived at the conclusion that the steps of decoding and distributing, which had been identified as features of the claimed method (see point 4.5 above), were not limiting.
- 4.7 Besides, in spite of assessing feature (ii) as not limiting, the examining division stated that *"one could consider that the subscriber of D1 with device 10 is 'affiliates' and that he can decode and forward to peers, who are then consumers of the affiliate. In which case the additional features could also be read to be anticipated by D1"* (see decision under appeal, point 2.2 of the "Grounds for the decision").
 - 4.7.1 Thus, in this part of the decision the examining division equated the "affiliate" to "device 10" and

consumers to peers. However, the examining division omitted to identify the passages of document D1 which "anticipated" decoding and distributing from a consumer to peers. Under these conditions the board is unable to determine which passages of D1 were considered to be relevant and to assess whether they indeed disclose feature (ii).

- 4.7.2 In addition, the decision does not consistently identify the "affiliate" in document D1. The "affiliate" in claim 1 was remapped from the FSN to the "device 10" of D1 (see decision under appeal, point 2.2 of the "Grounds for the decision", page 6, paragraph starting with "First"). For this mapping, the examining division did not explain whether they maintained the previous assertions regarding the FSN. In particular, they did not indicate whether they considered that, in the context of a broadcast transmission, the content transport stream still necessarily identified "device 10" in the same manner as argued for the "affiliate" FSN (see decision under appeal, point 2.1 of the "Grounds for the decision", page 5, second and fourth paragraphs).

- 4.8 The decision further reads that "*[e]ven if the additional features of claim 1 would now be considered to describe a different part of the method in time and space (between affiliate and final user) ... the new features adding decoding and distributing to consumers are standard features, therefore obvious to add*" (see point 2.2 of the "Grounds for the decision", last paragraph).

The perfunctory statement that standard features would be "obvious to add" does not allow the board to assess why the examining division was of the opinion that the

person skilled in the art would have been motivated to modify the "affiliate" FSN to distribute decoded data.

- 4.9 Since the examining division did not identify where each of the features of claim 1 was disclosed in document D1, the board is unable to establish the passages of D1 relied on and thus to examine whether the decision was justified or not.

Further, since the inventive-step objection is based on contradictory statements (e.g., features not contributing to the technical character or not limiting, but nevertheless found obvious) and assertions with no supporting evidence, the board cannot follow the logical chain of reasoning which led the examining division to the conclusion that the subject-matter of claim 1 lacked inventive step.

5. *Remittal*

- 5.1 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 appealed decision or remit the case to that department for further prosecution.

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

- 5.2 The board is not in a position to assess, on the basis of the examining division's reasoning, whether the examining division's conclusion that the subject-matter of claim 1 of the main request lacked inventive step was justified (see section 4. above).

5.3 Thus, if the board were to decide on the substance of the case itself and not to 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 is the task of the examining division (see decision G 10/93 of the Enlarged Board of Appeal, OJ EPO 1995, 172, point 4 of the Reasons).

5.4 The examining division's deficient examination of inventive step constitutes "special reasons" within the meaning of Article 11 RPBA 2020. Thus, the board decides 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 examining division for further prosecution.

The Registrar:

The Chairwoman:



K. Boelicke

B. Willems

Decision electronically authenticated