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**D E C I S I O N**  
of 11 March 1996

**Case Number:** T 0673/93 - 3.5.1

**Application Number:** 88201504.3

**Publication Number:** 0300562

**IPC:** H04N 7/08

**Language of the proceedings:** EN

**Title of invention:**  
Television transmission system

**Applicant:**  
PHILIPS ELECTRONICS UK LIMITED, et al

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 123(2), 111(1)

**Keyword:**

"Amendments (main request - inadmissible) - no basis in the application as filed for deletion of feature"

"Re-amendments (auxiliary request - admissible) - deleted feature re-introduced and undisclosed added feature replaced by feature originally disclosed"

"Remittal - patentability not examined yet"

**Decisions cited:**  
T 0331/87

**Catchword:**  
-



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Boards of Appeal

Chambres de recours

Case Number: T 0673/93 - 3.5.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.1  
of 11 March 1996

**Appellant 01:** PHILIPS ELECTRONICS UK LIMITED  
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**Appellant 02:** PHILIPS ELECTRONICS N.V.  
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**Representative:** Boxall, Robin John  
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**Decision under appeal:** Decision of the Examining Division of the European  
Patent Office posted 2 February 1993 refusing  
European patent application No. 88 201 504.3  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** P. K. J. van den Berg  
**Members:** W. B. Oettinger  
C. Holtz

## Summary of Facts and Submissions

I. The appeal contests the Examining Division's decision to refuse the European patent application No. 88 201 504.3 filed jointly by a British and a Dutch company on 13 July 1988 (publication No. 0 300 562), the British company having designated GB and the Dutch company having designated DE, ES, FR, IT and SE.

The reason given for the refusal was added subject-matter (Article 123(2) EPC).

II. In preceding Communications, the Primary Examiner had raised an objection of lack of inventive step based on prior art documents

D1: EP-A-0 191 149

D2: GB-A-2 146 878 (originally incorrectly cited as GB-A-1 146 878)

against the claims then on file. Those claims were directed respectively to:

- (Claim 1) "a television transmission system" comprising, inter alia, a television receiver having a video recorder connected therewith,
- (Claim 2) "a teletext data transmitting means" and
- (Claim 4) "a video recorder",

(the transmitting means and video recorder both being "suitable for use in a system as claimed in Claim 1").

III. The claims were amended on 14 December 1992 to the effect of defining respectively:

- (Claim 1) a "television transmission system" (without any reference to a video recorder being connected to the receiver),
- (Claim 3) a "teletext data transmitting means" and
- (Claim 5) a "television signal receiver".

In its decision, the Examining Division considered that in Claim 1:

- the deletion of the feature of the video recorder from the preamble and
- the addition of the feature "marking on the display page the programme details associated with the programming information"

were inadmissible because they would extend beyond the content of the application as originally filed.

The independent Claims 3 and 5 were held to be inadmissible for the same reasons.

The independent Claims 1, 3 and 5 of the Subsidiary Request made on the same date were held to be inadmissible for the reason that the same feature of "marking ..." using a cursor was added.

IV. The decision to refuse, announced in oral proceedings, was issued with full reasons on 2 February 1993. The appeal was lodged jointly by both applicants on 27 March 1993.

The notice of appeal was written in Dutch, and it was accompanied by a translation in English. One appeal fee, reduced by 20%, was paid on the same day.

The notice contained requests that the decision under appeal be set aside and a patent be granted. This latter request was later corrected to the effect that the case be remitted to the first instance for further prosecution.

On 8 June 1993, the Appellants filed a Statement of Grounds.

- V. In the Statement of Grounds, they filed, whilst expressly not admitting the correctness of the appealed decision, new Claims 1 to 8 partly reinstating the deleted feature and modifying the feature that had been added (cf. III).
- VI. In response to a Communication from the Board pointing out that the amendments made would not appear to be sufficient to meet the objection of added subject-matter, the Appellants filed, on 21 December 1994, re-amended Claims 1 and 2.
- VII. At the same time the Appellants submitted a subsidiary request involving amendments to Claims 4 and 5 and the cancellation of Claims 6 to 8. In response to a further Communication from the Board pointing out manifest objections to Claims 4 and 5 as amended, the Appellants filed new versions of these claims for the subsidiary request on 10 October 1995.
- VIII. In a further submission, the Appellants referred to the Boards' case law (T 331/87, OJ EPO 1991, 22) and to the case law of British Courts.

IX. In oral proceedings, held at the Appellants' request, the Appellants filed new subsidiary request Claims 4 and 5.

X. With these amendments, the claims read as follows:

**Both requests**

"1. A television transmission system comprising, a transmitter station including teletext data transmitting means, and at least one television receiver having interconnected therewith a video recorder, and wherein said teletext data transmitting means is arranged to transmit teletext pages containing both teletext display data representing displayable programme details and teletext non-display data representing programming information which is associated with the programme details and which can be used for video recorder programming; which system is characterised in that said programming information is contained in at least one extension packet which is in addition to and does not replace data packets of a teletext page containing the displayable programme details and that addressing information is contained in said extension packet(s) which indicates an allocated cursor position on a display page, said cursor position being associated within the extension packet with programming information relating to the displayed programme details referred to by the cursor position.

2. A teletext data transmitting means arranged to transmit a teletext page containing both teletext display data representing displayable programme details and teletext non-display data representing associated programming information, characterised in that said teletext non-display data is contained in one or more extension packets and includes addressing information

which indicates an allocated cursor position on a display page, said cursor position being associated within the extension packet with programming information relating to the displayed programme details referred to by the cursor position."

Claim 3 is dependent, by virtue of a reference to "a ... system as claimed in Claim 1 or a ... means as claimed in Claim 2", alternatively upon Claim 1 or Claim 2.

**Main request**

"4. A television signal receiver suitable for use in a system as claimed in Claim 1, comprising a teletext decoder for selecting, receiving, and storing a teletext page containing data packets representing displayable programme details and one or more extension packets containing teletext non-display data representing associated receiver programming information and addressing information which indicates an allocated cursor position on a display page, said cursor position being associated within the extension packet with programming information relating to the displayed programme details referred to by the cursor position and means for automatically programming the receiver in accordance with said programming information for recording and/or displaying a selected programme, said automatic programming means comprising means for selecting the programme to be recorded and/or displayed and means for reading said programming information from locations of the storage means within the teletext decoder which are associated with the addressing information indicated by said allocated cursor position in respect of the selected programme details."

Claims 5 is dependent, by virtue of a reference to "a ... receiver as claimed in Claim 4", upon that claim, stating in addition that this receiver is "suitable for use in a system as claimed in Claim 3". Claims 6 to 8 are dependent, by similar references, alternatively upon Claim 4 or Claim 5.

**Subsidiary request**

"4. A television signal receiver suitable for use in a system as claimed in Claim 1, comprising a teletext decoder for selecting, receiving, and storing a teletext page containing data packets representing displayable programme details and one or more extension packets containing teletext non-display data representing associated video recorder programming information and addressing information which indicates an allocated cursor position on a display page, said cursor position being associated within the extension packet with programming information relating to the displayed programme details referred to by the cursor position and means for automatically programming the video recorder in accordance with said programming information for recording a selected programme, said automatic programming means comprising means for selecting the programme to be recorded and means for reading said programming information from locations of the storage means within the teletext decoder which are associated with addressing information indicated by said allocated cursor position in respect of the selected programme details."

Claims 5 is dependent, by virtue of a reference to "a ... receiver as claimed in Claim 4", upon that claim, stating in addition that this receiver is "suitable for use in a system as claimed in Claim 3".



XI. The Appellants request that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of Claims 1 and 2 filed on 21 December 1994, Claim 3 filed on 8 June 1993, and either Claims 4 to 8 filed on 8 June 1993 (main request) or Claims 4 and 5 as filed in the oral proceedings (subsidiary request).

XII. In the light of the Board's preliminary Communications, the Appellants' arguments in the oral proceedings were directed primarily to the admissibility of Claim 4 of the main request. They were essentially as follows:

The requirement of Article 123(2) is that there should be no amendments which would cause new matter to be introduced. This article does not prohibit the broadening of claims as such. It was indicated in the original description in various places that the original disclosure was not limited to the programming of a video recorder. The object of the invention was to lessen editorial restrictions in the layout of teletext data. This object was not related to the operation of a video recorder as such. Thus it was clear that video recording was not part of the invention, it was merely an application of it.

In addition, the video recorder described in the application had all the essential circuits of a television signal receiver, so that the replacement of the term "video recorder" in the claims by "television signal receiver" was an allowable generalisation of the application of the invention given in the description. The further use of the expressions "receiver" and "recording and/or display" in Claims 4 onwards was merely the consequence of this allowable generalisation.

The "video recorder" feature satisfied the three-part test put forward in T 331/87 for removal from a claim. Even if the Board considered that the recorder was consistently mentioned as part of the invention, which the Appellants disputed, this did not mean that it was essential to the invention.

According to decisions in the British Courts, claim broadening was in some cases permissible, as long as the claim was directed to the invention disclosed in the application. Inessential integers might be removed from a claim. In particular, the purpose of a claim was to identify the scope of protection; it did not follow that everything which a claim covered was necessarily also disclosed by that claim. The Appellants therefore contended that the deletion from Claim 4 was admissible.

### Reasons for the Decision

#### 1. *Admissibility of the appeal*

The appeal (cf. IV) is admissible (Articles 14(4), 59, 106 to 108, 118; Rules 6(3), 52, 64 EPC; Article 12(1) RFees).

#### 2. *The issue in this appeal*

- 2.1 The reason given for the refusal of the application being lack of compliance of amendments with Article 123(2) EPC, the issue to be decided by the Board will be whether the claims as re-amended in the appeal (cf. points V, VI and IX) do, or (still) do not, comply with that Article.

2.2 That issue has two aspects (cf. III), viz.:

- whether the deletion of a feature (concerning the "video recorder") and related amendments are admissible;
- whether a feature (concerning the "marking ...") has been inadmissibly added.

2.3 The Board will now deal with these two aspects for all the independent claims in turn.

3. *Claim 1 - deleted feature*

The deleted reference to a video recorder having been re-introduced in Claim 1, this (re-)amendment made to Claim 1 is admissible.

4. *Claim 1 - added feature*

4.1 The feature ("marking ...") found, in the decision under appeal, to have been inadmissibly added to Claim 1 (cf. III), has been replaced, in Claim 1 on file, by the feature "which (addressing information) indicates an allocated cursor position on a display page, said cursor position being associated within the extension packet with programming information relating to the displayed programme details referred to by the cursor position".

4.2 For support of this replacement, the Appellants referred to page 5 lines 4 to 16 (in particular lines 10 to 14) of the description as originally filed.

The Board agrees that the feature as now claimed is disclosed there.

4.3 Thus, this amendment removes the Examining Division's reason for considering the added feature to be inadmissible. In effect, it replaces the feature found to be inadmissible by a feature which was earlier in Claim 1 and which in the decision under appeal (paragraph 2.2) was mentioned to be allowable.

It is therefore admissible.

5. *Claim 2 - deleted feature*

5.1 The original Claim 2 sought, and Claim 2 on file still seeks, protection for a "teletext data transmitting means", i.e. the transmitter side of a teletext TV transmission system, without defining any particular features of the receiver side.

The original reference to the claimed means being "suitable for use in a system as claimed in Claim 1" was deleted; but this deletion is admissible because the said reference had no restricting effect on the scope of Claim 2.

5.2 Even though reference was made, in the original Claim 2, to "video recorder" programming, this reference is understood as relating to an intended purpose for the transmitted programming information without, however, defining any technical feature of the transmitter side of the system that would render the transmitted information suitable, on the receiver side, **exclusively** for this kind of programmable apparatus.

The said original reference to a "video recorder" was deleted; but, contrary to the situation found in Claim 4, in the context of Claim 2 this deletion is considered to be admissible because, as follows from the facts just mentioned, the said reference had no

restricting effect on the technical features of the transmitting means claimed.

5.3 The amendments made to Claim 2 in form of the omission of references are, therefore, admissible.

6. *Claim 2 - added feature*

6.1 The feature ("marking ...") found, in the decision under appeal, to have been inadmissibly added to Claim 3 (cf. III), has been replaced, in Claim 2 on file, by the same feature as in Claim 1 (cf. 4.1).

6.2 Support for this replacement is found in the description (cf. 4.2).

6.3 This removes the reason for regarding the "marking ..." feature as inadmissible (cf. 4.3).

The amendment made to claim 2 is therefore admissible.

7. *Main request Claim 4 - deleted feature*

7.1 Claim 4 is clearly broader in scope than the original Claim 4.

As is made very clear by the replacement of the originally used term "video recorder" by the expression "television signal receiver", and by the replacement of "recording" by "recording and/or displaying", the receiver now claimed may be either the receiving part of a video recorder or that of a TV set, and it may either only display or record, or both display and record, a television signal. This is in clear contrast to a "video recorder" as originally claimed which, by definition, must inevitably have the ability to record such a signal.

7.2 In contrast to the situation when a patent has been granted (Article 123(3) EPC), claim broadening is not always inadmissible in the examination stage of an application before grant. However, in order to be admissible, the new claim must not add subject-matter to the application as filed, i.e. it must not convey technical information to the skilled reader which that reader would not have derived from the original application documents (Article 123(2) EPC).

7.3 The Board takes the view that "means for automatically programming the receiver ... for ... displaying a selected programme" is added subject-matter. This phrase clearly conveys to the reader the idea of presetting a television receiver to display a particular programme, thus relieving the user of the tasks of keeping an eye on the time and switching to the desired programme when it is due to begin, and also compensating for possible delays in the broadcasting time. This idea was not disclosed in the application as filed. In the view of the Board the application documents as filed consistently describe the programming information as being used to set a video recorder to record a desired programme. No other potential use for the programming information is conveyed by the original application; in particular, the use now disclosed in Claim 4 was not originally disclosed. The Board comes to this conclusion for the following reasons.

7.4 The first sentence on page 1, lines 3 to 4, incidentally relating to the system (claimed in Claim 1) and not to its receiver or recorder (subject of Claim 4), is too vague to allow any conclusion to the effect that the term "receivers" should be understood as specifically covering receivers **without** a video recorder connected thereto. The second sentence, lines 4 to 7, can only be understood as meaning that the claimed invention relates

to a system adapted for **video recorder** programming. From there on, where reference is made to the apparatus to be programmed, consistently a video recorder is mentioned. This is in particular the case for

- the background art acknowledged (pages 1 and 2),
- the stated object of the invention (page 2 lines 20 to 23),
- the general description of the invention (pages 2 to 4),
- the specific description of a way of carrying out the invention (pages 5 ff.).

It is noted that the last paragraph on page 13, lines 6 to 23, is again too vague to allow any other conclusion. The statements made there are partly inadmissible for the reason that they can be interpreted as an attempt to extend the "matter for which protection is sought", which must be defined in the claims (Article 84 EPC), to **unspecified** other matter; for the rest they are inadmissible for the reason that, having regard to Article 69 (and the Protocol on its Interpretation) EPC, they are obviously irrelevant or unnecessary under the circumstances (Rule 34(1)(c) EPC).

7.5 Thus there is no explicit disclosure in the application documents as filed of the feature identified above as being conveyed to the skilled reader by the current Claim 4 of the main request. Nor would a person skilled in the art of video recorder programming by teletext signals, when reading the original application documents, see **immediately**, on the basis of his general knowledge of this art, without any specific considerations, that the teaching of the application was

intended to be applicable, or was applicable, to program a television signal receiver other than that of, or connected to, a video recorder.

This in particular because, whereas video recorder programming was (at the priority date) widely known to the public, the Appellant has not offered, or established, any evidence that programming a TV set receiver belonged (at that time) to the skilled person's common general knowledge.

- 7.6 For the question of admissibility of an amendment it would be irrelevant if the amended subject-matter was, although new (in the sense of Article 54) against the original teaching, obvious (in the sense of Article 56 EPC) from specific prior art.

It would, of course, also be irrelevant whether the applicants had realised only after the application date that the disclosed invention could be applied more generally than they had originally conceived.

What counts is whether the reader would have derived the wider or further application of the invention from the original documents in the light only of the common knowledge of the person skilled in the art, at the priority date of the patent application. In the view of the Board in the current case the skilled reader would not have derived the new use for the programming information disclosed by the current Claim 4 from the original application documents.

- 7.7 The amendment made to Claim 4 of the main request generalising the original "video recorder" to a "television signal receiver" and replacing "recording" by "recording and/or displaying" is, therefore, inadmissible.



7.8 The Appellant has argued that the feature of displaying a programme rather than recording it is merely a consequence of the generalisation of the "video recorder" to a "television signal receiver". This is taken to be an argument that the alternative use of the programming information now disclosed in Claim 4 was implicit in the application documents as filed. However, the Board cannot follow this argumentation, for the reasons given above. The Appellant's further arguments relating to the test set out in T 331/87 also fail to convince the Board because that test relates strictly to the admissibility of the removal of a feature from an independent claim. In the current case a feature has not only been removed but a further feature has been added. The test is therefore not applicable. Finally, the Board sees no reason to disagree with the general principles drawn by the Appellant from British cases. The Board does not see any contradiction between those principles and the conclusions it has come to in the current particular case.

7.9 For these reasons the main request must be refused.

8. *Subsidiary request Claim 4 - deleted feature*

8.1 In the original description page 3, lines 15 to 17, it is stated that "Alternatively, a television receiver provided with a teletext decoder could be provided with a suitable control interface to a video recorder". Thus the application documents as filed disclosed that the receiver need not be the video recorder itself, as long as the programming information is nonetheless used to programme a video recorder. Therefore, the amendment, in the introductory phrase of Claim 4, of "video recorder" to "television signal receiver" is considered admissible by the Board. This claim does not contain any reference to a use of the programming information other than for

"recording", so that its subject-matter does not extend beyond the content of the application as filed in the way that Claim 4 of the main request does.

8.2 This amendment made to Claim 4 is therefore admissible with respect to Article 123(2) EPC.

9. *Main and subsidiary request Claim 4 - added feature*

9.1 The feature ("marking ...") found, in the decision under appeal, to have been inadmissibly added to Claim 5 (cf. III), has been replaced, in both versions (main and subsidiary request) of Claim 4 on file. With this amendment, the "automatic programming means" is now defined as comprising "means for selecting the programme ..." and "means for reading said programming information from locations of the storage means ...".

9.2 Support for this re-amendment can be found on page 12, lines 13 to 27 of the original description.

9.3 This replacement removes the Examining Division's reason for considering the "marking ..." feature as inadmissible (cf. also 4.3).

9.4 The amendment made to the feature added to Claim 4 is therefore admissible.

10. *Conclusions*

10.1 The Appellants' main request is unallowable for the reason that the amendments made to Claim 4 are inadmissible (cf. point 7.7).

10.2 The Appellants' subsidiary request that the decision under appeal be set aside is allowable because the independent claims as re-amended are admissible

(points 3, 4.3, 5.3, 6.3, 8.2, 9.4) and the dependent claims correspond to dependent Claims 3 and 5 of the original application documents.

- 10.3 The Appellants' request for remittal of the case to the Examining Division is also allowable because the substantive examination has not, so far, been completed in respect of the question of patentability (Article 52(1) EPC).

It is noted, in this context, that amended pages 2 and 3 were filed on 8 June 1993, but not adapted to the subsidiary request claims now on file.

### Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The main request is refused.
3. The case is remitted to the first instance for further prosecution on the basis of the Appellant's subsidiary request.

The Registrar:



M. Kiehl

The Chairman:



P.K.J. van den Berg



