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**D E C I S I O N**  
**of 9 April 1998**

**Case Number:** T 0726/96 - 3.5.1

**Application Number:** 88307370.2

**Publication Number:** 0303450

**IPC:** H04N 7/04

**Language of the proceedings:** EN

**Title of invention:**  
Digital signal transmission apparatus

**Patentee:**  
Canon Kabushiki Kaisha

**Opponent:**  
Philips Electronics N.V.

**Headword:**  
Digital signal transmission/CANON

**Relevant legal provisions:**  
EPC Art. 111(1)  
EPC R. 86(3)

**Keyword:**  
"Remittal to the first instance"

**Decisions cited:**  
-

**Catchword:**  
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Boards of Appeal

Chambres de recours

Case Number: T 0726/96 - 3.5.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.1**  
**of 9 April 1998**

**Appellant:** Canon Kabushiki Kaisha  
(Proprietor of the patent) 30-2, 3-chome, Shimomaruko  
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**Representative:** Beresford, Keith Denis Lewis  
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**Respondent:** Philips Electronics N.V.  
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**Representative:** van der Kruk, Willem Leonardus  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 5 June 1996  
revoking European patent No. 0 303 450 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. K. J. van den Berg  
**Members:** R. Randes  
V. Di Cerbo

## Summary of Facts and Submissions

I. In a decision, dated 5 June 1996, the opposition division revoked the European patent No. 0 303 450, granted on the basis of European application No. 88 307 370.2.

II. Claim 1 of the patent, refused by the opposition division, was amended in relation to the patent as granted and read as follows :

"Digital signal transmitting or recording apparatus comprising: first means (14, 26, 28, 30, 101-110) operable (a) to form a first error check code using digital video data, (b) to form a second error check code using digital audio data, and (c) to form video blocks and audio blocks having the same block length as each other, < > the video blocks containing the said digital video data, the said first error check code and synchronisation data, and < > the audio blocks containing the said audio data, the said second error check code and synchronisation data; and second means (32-36, 112, 113) operable to transmit or operable to record the said video blocks and the said audio blocks time division multiplexed with each other,

[said second means (32-36, 112, 113) being operable to time division multiplex groups of the video blocks and groups of the audio blocks to sequentially record the time division multiplexed video and audio blocks on the tracks of a recording medium so that the synchronisation data recorded on adjacent tracks are not adjoining to each other in any direction]."

The last part of the claim has been separated from the rest of the claim and has been put within square brackets by the Board. Also the angled brackets < > in the claim have been introduced by the Board in order to facilitate referring to certain parts of the claim later on in the decision.

- III. The opposition division revoked the patent on the ground that amended claim 1 did not meet the requirements of Article 123(2) EPC. It was held that the last sentence of claim 1, "...so that the synchronisation data recorded on adjacent tracks are not adjoining to each other in any direction", was new subject-matter not disclosed in the original patent application.
- IV. The proprietor lodged a notice of appeal against this decision on 5 August 1996 and paid the prescribed fee. The statement of the grounds of appeal was filed on 14 October 1996.
- V. With the statement of the grounds of appeal an amended claim 1 was filed. This claim is distinguished from the refused claim 1 in that the specification "each of" has been introduced within the angled brackets (< >) introduced by the Board in the claim cited above. Moreover, the last paragraph of refused claim 1 put within square brackets by the Board has been deleted and replaced by the following paragraph:

"characterized by means for dividing a two dimensional sample matrix representing each field of video data horizontally and vertically to form a plurality of divided matrices of luminance samples and colour samples, the digital video data included in each video block corresponding to a plurality of luminance samples

in a two dimensional sample matrix and a plurality of colour samples in a two-dimensional sample matrix, each sample matrix being derived from a respective one of said divided matrices."

The appellants have stated that a basis for the new subject-matter introduced into the amended claim 1 (and the corresponding independent method claim 6) exists in Figures 2 and 8, together with the associated description on column 3, lines 16 to 43, and column 5, line 25 to column 6, line 2 of the published patent specification.

The appellants requested that the decision be set aside and the patent be maintained on the basis of the set of claims 1 to 19 filed with the statement of the grounds of appeal. As an auxiliary request, they requested oral proceedings.

VI. With a letter, dated 22 October 1996, the registry of the boards of appeal communicated the said statement of the grounds of appeal to the respondents. In the letter it was stated that "any submission in answer hereupon must be filed within four months".

VII. The respondents on 17 March 1997 filed a reply to the said letter dispatched by the registry and filed an additional letter on 10 April 1997. In their letters they argued that document

D1: EBU Tech. 3252-E 1986, Brussels "Standard for recording digital television signals on magnetic tape in cassettes", pages 1 to 101,

used in their argumentation before the opposition division, also anticipated the measure now claimed in the characterizing part of claim 1. Moreover, they raised an objection in accordance with Article 123(2).

Also they requested an apportionment of costs to be paid by the appellants, since "the patent proprietor filed a completely new main claim, which follows a line completely different from the line followed by the claims on file during the opposition proceedings". The respondents argued that their situation in the present case should be compared with a patent proprietor's situation in a case when a relevant document is filed for the first time during a late stage in appeal proceedings. In such a case it was considered (cf. T 705/92) that such late filing "would inevitably increase the costs to be incurred by the patent proprietor" and that the patent proprietor was clearly entitled, as a matter of equity, to be compensated for such additional costs.

#### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. According to Article 110(2) "the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from another party or issued by itself". The Board notes that the respondent's reply to the communication of the boards of appeal under the provision was filed late (see under VI and VII above), to wit after the expiry of the time limit fixed in the communication itself. For this reason the respondent's argumentations and requests should not be taken into account in dealing with this appeal. However, since the independent claims have been

radically changed, which apparently influences the further proceedings, it is inevitable in the present decision that the Board on its own motion has to consider the issues mentioned by the respondent.

3. The appealed decision was based on the objection that claim 1 then on file did not meet the requirements of Article 123(2) EPC.

The amendments made to claim 1 (and to the corresponding independent method claim 6) filed together with the statement of the grounds of appeal are intended to meet this objection.

However, the Board notes that the core of the invention as now claimed (cf. the characterising part of claim 1) has been completely changed, since the time division multiplexing aspect according to the refused claim 1 has been dropped and replaced by the aspect of treatment of two-dimensional digital sample data. The new matter which has been introduced into claim 1 has, apparently, been taken from the description and has, therefore, not been examined in the context of claims.

The admission at a late stage of a new set of claims substantially different from the old ones is discretionary (Rule 86(3) EPC, second sentence) and the Board, normally, refers such a question of admissibility to the first instance (cf. T 609/88, unpublished).

4. Thus, since the invention as now claimed has not at all been examined with regard to the EPC, the Board, in accordance with Article 111(1) EPC, deems it appropriate to remit the case to the first instance.

5. Since the appeal is not being dismissed (cf. under V above), there is no need to hold oral proceedings.

The respondent's request for an apportionment of costs (cf. Article 104(1) EPC) has to be considered as inadmissible since it was made, for the first time, with one of the said late filed letters (see under VII above).

### **Order**

#### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg