



BL O/191/06

14 July 2006

## PATENTS ACT 1977

BETWEEN

Pace Micro Technology Plc

Opponent  
(Claimant)

and

Koninklijke Philips Electronics NV

Proprietor  
(Defendant)

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PROCEEDINGS

Opposition to an application under section 27 to amend patent  
no EP(UK) 0755604

HEARING OFFICER

R C Kennell

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## DECISION

### Introduction

- 1 Koninklijke Philips Electronics NV ("Philips") filed a request to amend patent number EP 0755604 under section 27 on 16 July 2004 in order to avoid anticipation by specification EP 0694242 A1 (published as WO 95/15646 A1). Correspondence with the Patent Office resulted in some changes to the proposed amendments which were filed on 20 April 2005. These did not satisfy the examiner, but were advertised on 10 August 2005.
- 2 Pace Micro Technology Plc ("Pace") had filed a notice of opposition to the originally proposed amendments under section 27(5) of the Patents Act on 15 February 2005. They amended the accompanying statement on 7 October 2005 in consequence of the changes to the amendments. On 8 November 2005, Philips filed a counter-statement, on 12 December 2005 Pace filed a translation of the European patent EP 0694242 B1, and on 19 December 2005 Philips filed a letter with further argument, which was treated as a supplementary counter-statement. Neither side has filed any evidence.
- 3 Pace indicated that they would like the issues to be decided on the basis of the arguments on file, and that they would not be attending any hearing. However Philips requested a hearing, at which they would attend. The matter duly came before me at a hearing on 15 May 2006. Philips were represented by their

Agent, Mr. Steve Townsend, assisted by Mr. Darren Murley. As had been foreshadowed, Pace did not attend.

### The patent

- 4 The invention in the patent under consideration is fairly simple in principle, although more complex in its detail. Basically, the idea is to give a TV viewer a screen showing small sample images (or “thumbnails” or sub-images) from the channels on offer, arranged in a mosaic (or array or matrix). By selecting one of these the viewer can obtain the channel of their choice.
- 5 In the patent as granted, the invention was stated to reside in the transmission of channel identification data along with the mosaic image, so that viewers could simply “point and click” at their preferred sub-image and get up the channel automatically, rather than having to enter the channel identity manually. However, EP 0694242 was drawn to Philips’ attention after grant during licensing negotiations; they accept that it appears to anticipate the independent granted claims (at least) and have applied to amend by including in the independent claims a further feature, namely transmission of the number of rows and columns of sub-images in the mosaic image.
- 6 The patent has five independent claims, claims 1, 7, 11, 13 and 14, which are as follows:-

“1. A television transmitter for transmitting a plurality of video signals, each video signal having a program number, the transmitter comprising mixing means (6) for transmitting the video signals via a common channel, and composing means (1) for generating a mosaic video signal comprising a plurality of sub-pictures [in a horizontal and vertical array](#), each sub-picture representing one of said plurality of video signals, ~~characterized in that~~ the transmitter further comprises linking means (14) for generating [linking data specifying both the number of horizontal sub-pictures and vertical sub-pictures forming the array](#) [and](#) linking the position of each sub-picture on a display screen with the program number of the associated video signal, the mixing means (6) being adapted to transmit said mosaic video signal and linking data through said common channel.

7. A television receiver for receiving and displaying a plurality of video signals and a mosaic video signal representing a mosaic picture comprising a plurality of sub-pictures [in a horizontal and vertical array](#), each sub-picture representing one of said plurality of video signals, each video signal having a program number, the television receiver comprising a display screen (44), ~~characterized in that~~ the television receiver further comprises user-controlled pointing means (46) for selecting a selected sub-picture from the mosaic picture, and control means (45) for receiving and decoding [linking data specifying both the number of horizontal sub-pictures and vertical sub-pictures forming the array](#) [and](#) linking the position of each sub-picture of the mosaic picture with the program number of the associated video signal, and adapted to select a selected video signal represented by the selected sub- picture for display.

11. A method of transmitting a plurality of video signals via a common channel, each video signal having a program number, the method comprising [the steps](#) of:

- generating a mosaic video signal comprising a plurality of sub-pictures in a horizontal and vertical array, each sub-picture representing one of said plurality of video signals, ~~characterized in that the method further comprises a step of~~
- generating linking data specifying both the number of horizontal sub-pictures and vertical sub-pictures forming the array and linking the position of each sub-picture on a display screen with the program number of the corresponding video signal, ~~and a step of~~
- transmitting said mosaic video signal and linking data through said common channel.

13. A method of receiving and displaying a plurality of video signals and a mosaic video signal representing a mosaic picture comprising a plurality of sub-pictures in a horizontal and vertical array, each sub-picture representing one of said plurality of video signals, each video signal having a program number, ~~characterized in that the method comprises a~~ the steps of:

- receiving linking data specifying both the number of horizontal sub-pictures and vertical sub-pictures forming the array and linking the position of each sub-picture on screen with the program number of the associated video signal, ~~and a step of~~
- decoding the program number of a video signal represented by the position of the sub-picture being displayed and pointed at by a pointing device, and
- selecting said video signal for display.

14. A television signal including a plurality of video signals, each signal having a program number, a mosaic video signal representing a mosaic picture comprising a plurality of sub-pictures in a horizontal and vertical array, each sub-picture representing one of said plurality of video signals, ~~characterized in that the television signal further includes~~ linking data specifying both the number of horizontal sub-pictures and vertical sub-pictures forming the array and linking the position of each sub-picture on a display screen with the program number of the corresponding video signal.”

- 7 The requested amendments in their latest form (as filed on 20 April 2005) are indicated by underlined and struck through text (additions and deletions respectively).
- 8 Philips also request a number of consequential amendments to the description, but I do not need to recite these in detail for the purposes of this decision.

### **The issues**

- 9 Pace oppose the amendments on the grounds that
- A. The amendments do not meet the requirements of section 76 of the Patents Act 1977
  - B. Discretion to amend should be refused, and

C. The proposed amendments leave the patent invalid.

- 10 In more detail, as regards (A), they allege that the amendments are broader than there is basis for in the description. In particular, they allege that the description in paragraph [0031] refers to the linking means being in the form of a descriptor in a programme map table with the parameter descriptors for horizontal and vertical partitioning indicating how many sub-pictures are accommodated in the mosaic picture. They contend that the amendment sought is too broad in the light of this, since it does not mention the programme map table or the descriptor tag or descriptor tag length.
- 11 As regards (B), the opponents argue that discretion should be refused because Philips “must have appreciated that the proposed amendments do not put the claim in a valid form”, and that they were therefore acting in bad faith and employing covetous claiming.
- 12 Finally, with respect to (C), the opponents are of the view that the new features that are introduced by the proposed amendments are all shown in EP 0694242, and thus do not overcome the doubt about the validity of the patent.
- 13 In relation to (B) Pace give no reasons for their assertion that Philips “must have appreciated” the breadth of the claim. No ground of bad faith or covetousness apart from the breadth of the claim is put forward and in fact Pace argue grounds (B) and (C) together purely as a matter of whether the amendments were sufficient to cure the invalidity of the claims.
- 14 The Patent Office’s objections to the amendments also remain outstanding, since the examiner did not consider that the changes made on 20 April 2005 met her objections.

**The law**

- 15 The relevant parts of section 27 read:-

“27(1) Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.

...

(5) A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application”.

- 16 Also relevant are sections 2(1) – (3) and 76(3), which read:-

“2(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise

all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say -

(a) that matter was contained in the application for that other patent both as filed and as published; and

(b) the priority date of that matter is earlier than that of the invention.”

“76(3) No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it -

(a) results in the specification disclosing additional matter, or

(b) extends the protection conferred by the patent.”

- 17 EP 0694242 was published as WO 95/15646 A1 on 8 June 1995. As this is after the filing date of the patent (10 April 1995), it can form part of the state of the art only by virtue of section 2(3), and inventive step is not in issue. It is not disputed that conditions (a) and (b) of section 2(3) are met, and I will proceed on the basis that this is the case. The argument before me on ground (C) is therefore one of whether the amendments will cure lack of novelty over EP 0694242, and I will deal with this first.

### **Novelty – section 2(3)**

- 18 There are two slightly different issues to be dealt with here. First, there is the outstanding official action, in which the examiner alleged that the proposed independent claims were still anticipated by EP 0694242. Secondly, there is the opposition of Pace, which used slightly different arguments to arrive at the same conclusion.
- 19 The WO publication of EP 0694242 A1 is in French. An unverified translation has been provided of the European patent EP 0694242 B1, but it is the application which is in issue. However, both sides have agreed that the description of the corresponding US patent 5822014 wholly corresponds to the description of the WO specification and both have relied on it for reference. I am content to do likewise (and refer to it hereinafter as “US”), but I should make clear that US 5822014 does not itself form part of the state of the art.
- 20 Mr. Townsend treated the two objections separately at the hearing. However, they are sufficiently similar for me to treat them together in this decision.
- 21 EP 0694242 relates to a method for selecting programs in a digital video reception system. The system receives information corresponding to programme identification elements and information describing the location of each identified programme, displays the identification elements in the form of a

mosaic, and selects a programme by selecting an identifier element. The arranging of identification elements can be performed at the level of the transmitter, or dynamically at the level of the receiver device (see US col 2 lines 1-3). The Office's objection is that if the picture elements are arranged at the transmitter, then the transmitter must know how many rows and columns of sub-pictures are used.

- 22 Pace's statement explains that each image of the mosaic has an associated correspondence table, each table having an order number which could be compared to a maximum number of tables stored in memory, the tables being ordered in the same order as the images in the mosaic. The order number of the table and image is therefore representative of the horizontal and vertical position of the image in the mosaic, and the maximum number of tables stored in memory is, in effect, specifying the total number of horizontal and vertical sub-pictures in the mosaic. Thus, Pace says, linking means are necessarily present to generate data specifying the number of horizontal and vertical sub-pictures forming the array.
- 23 Philips take the view that there is no disclosure either explicit or implicit of the transmission of linking data specifying both the number of horizontal sub-pictures and vertical sub-pictures forming the array. At the hearing, Mr Townsend particularly addressed the issue of implicit disclosure, having regard to paragraph 2.07 of the Manual of Patent Practice which states (emphasis added):
- "While it is generally necessary, for a finding of lack of novelty, for all the features of the claim under consideration to have been explicitly disclosed, the teaching implicit in a document may also be taken into account. If a person skilled in the art would conclude that an earlier invention would, as a matter of normal practice, necessarily be performed in a way which would fall within the scope of the claim under consideration, then the matter defined by the claim is not new. ...."
- 24 Mr Townsend accordingly argued that the total number of entries in the table of correspondence with a particular total number of parameters describing relationships between mosaic sub-picture and a broadcast channels did not implicitly disclose the numbers of both horizontal and vertical sub-pictures. Thus, taking examples from the counter-statement, a 12-element matrix could be arranged 3x4, 4x3, 2x6 or 6x2, and a 7-element matrix could be arranged 7x1, or incompletely as 3x3, 4x2 or 2x4.
- 25 Mr. Townsend also pointed out that in the specific embodiments shown in EP 0694242 the arrangement of sub-images is associated with the layout of buttons on the user's remote control. It is thus fixed; and because it is fixed, he argued that there would be no need to transmit information relating to the number of rows and columns, even if the transmitter knows this information. The device would work perfectly well without this information being transmitted, since the receiver does not need to know where in the mosaic each sub-picture actually appears in order to implement the arrangement of EP 0694242.

- 26 Having read the specification carefully, I can find nothing which explicitly says that data specifying both the number of horizontal and vertical sub-pictures is transmitted, and for the reasons explained by Mr Townsend, neither do I think there is anything to suggest that this would necessarily occur as a matter of normal practice. Both the Office's objection and the opponent's arguments are based, in my opinion, on a non sequitur.
- 27 I therefore conclude that the proposed amendments would render the claims of the patent novel over EP 0694242.

**Added matter – section 76(3)**

- 28 However, that is not the end of the matter. Pace have argued that the introduction into claim 1 of linking means for generating data specifying both the number of horizontal sub-pictures and vertical sub-pictures forming the array introduces additional subject-matter in contravention of section 76(3)(a). It is not disputed that the only basis in the description for the amendment lies in paragraphs [0030] and [0031], which read:-

[0030] A method of accommodating the linking data in the transport stream from the transmitter will now be given. As disclosed in the MPEG2 systems standard, transport packets are labelled with a packet identifier (PID), which identifies the elementary stream the packet belongs to. One or more elementary streams make up a program having a program number. A typical program may contain three elementary streams: audio, visual and data. The joining of several elementary streams into a program is performed by generating an entry in a program association table which is transmitted in transport packets having a predetermined PID. The program association table contains, for each program, its program number and the PID of transport packets carrying a program map table. The program map table includes a list of the elementary streams making up the program, and their respective PIDs. The program map table may further contain other information about each elementary stream. Said information is transmitted in the form of so-called descriptors.

[0031] In an embodiment of the invention, the mosaic picture is transmitted as a program comprising the elementary stream Em and, if desired, an audio elementary stream as well. The associated linking data is transmitted by using a descriptor in the program table as mentioned above. The descriptor is designated mosaic\_picture\_descriptor. An example of relevant syntax in the program map table is shown in the following Table I:

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mosaic_picture_descriptor

descriptor_tag           8      uimsbf
descriptor_length       8      uimsbf
horizontal_partitioning  4      uimsbf
vertical_partitioning   4      uimsbf
for (i=0;i<n;i++){program_number}  16    uimsbf

}

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Table I

Herein, the parameters descriptor\_tag and descriptor\_length specify the type and length, respectively, of the descriptor. The parameters horizontal\_partitioning and vertical\_partitioning indicate how many sub-pictures are accommodated in the mosaic picture. The for-clause in the syntax indicates which program number is assigned to each sub-picture, the sub-pictures being ordered, for example, from left to right and from top to bottom.”

- 29 It will be seen that these paragraphs describe the transmission of linking data specifying both the number of horizontal sub-pictures and vertical sub-pictures forming the array, but as part of a picture descriptor including other data – a descriptor tag and a descriptor length in particular.
- 30 Pace have argued that, because the wording of the proposed claim is broader than that of the description, it should not be allowed in a post-grant amendment. No argument is made that the protection is being extended in contravention of section 76(3)(b), and clearly that is not the case. In effect, Pace are arguing that this is an “intermediate generalisation” (although they do not use the term) which, although narrower in scope than the granted claim, is still not allowable under section 76(3)(a).
- 31 The patentees reject this argument as unsustainable. In their counterstatement, as I understand it, they argue that claim 1 as granted included the feature “linking means for generating data linking the position of each sub-picture on a display screen with the program number of the associated video signal” which was specifically illustrated with reference to the mosaic picture descriptor which specified the programme number. Thus the generalization of the linking means was validly present in the patent as granted. Since the descriptor also included horizontal and vertical positioning parameters which served no purpose other than to specify the number of horizontal and vertical sub-pictures forming the mosaic, the incorporation of this further limitation could not be an impermissible generalisation.
- 32 At the hearing, Mr. Townsend developed his argument further, although with only passing reference (at my prompting) to precedent cases on intermediate generalization. It appeared that a request which I had intended to be sent to the parties to address me on the precedents cited in the Manual of Patent Practice, particularly those at paragraphs 76.15 and 76.16, had either not been sent or had gone astray. After the hearing, on 18 May 2006, the Office therefore wrote to both parties, again offering them an opportunity to comment



on these precedents, but neither party took advantage of this offer.

33 Mr Townsend made a number of points at the hearing, which I think I can summarise as follows:-

(a) Objections to intermediate generalizations are common in the chemical field, but practically unheard of in the mechanical and electronic fields.

(b) The Patent Office did not raise this issue when they considered the request to amend.

(c) In the present patent, there is a complete mapping between the features of the embodiment and the claims.

(d) Objection to intermediate generalization would be tenable only if a useful function could not be provided with the horizontal and vertical parameters, and that was not the case here. There was no functional inter-relationship between any other parameters and the number of horizontal and vertical sub-pictures in the array. Mr Townsend accepted that it might not be allowable to restrict to just one of the horizontal and vertical parameters because one was no use without the other.

34 Before considering these arguments, I think that I should first set them in the context of the three precedents quoted in the Manual of Patent Practice and specifically mentioned in the Office's letter of 18 May 2006, as best I can in the absence of evidence or even much argument on the point from the parties. Two of the cases, *AC Edwards v Acme Signs & Displays Ltd* ([1990] RPC 621 and [1992] RPC 131) and *Southco Inc v Dzus Fastener Europe* ([1990] RPC 587 and [1992] RPC 299), are concerned with whether pre-grant amendment to broaden claims is allowable under section 76(2). *A C Edwards* shows that amendment to a claim which introduces further features in generalized terms does not necessarily add subject matter, whilst *Southco* points out that the claims should not be altered in a way that claims a different invention. Subject to section 76(3)(b) about not extending the protection conferred, these principles would seem equally applicable to post-grant amendments.

35 *A C Edwards* related to a display device for petrol station forecourts in which elements making up a digit were covered or exposed by means of a hinged flap. It was held permissible by the Court of Appeal to introduce into the claims features of "a stud" and "means for retaining said stud within the aperture in the baseboard; and wherein spring means on the stud retains its associated flap in the first or second position", despite the fact that in the embodiment two studs were used and each was retained by a coil spring and cotter arrangement which also retained the flap in an open or closed position. I do not think I need to consider the facts of *Southco* in any detail.

36 However, in *Palmaz's European Patents (UK)* [1999] RPC 47 the Patents Court explicitly considered the issue of intermediate generalization, and held that under section 76(3)(a) the proposed amendment was not permissible post-grant. As explained by Pumfrey J (page 71 lines 1-7), where a specification discloses distinct sub-classes of the overall inventive concept,

then it should be possible to amend down to one or other of them, whether or not they were presented as inventively distinct in the unamended specification; the difficulty would come when it was sought to take features disclosed only in a specific context and not disclosed as having any inventive significance and introduce them in the claim devoid of that context.

- 37 In *Palmaz*, the amendment sought after grant was the incorporation of a feature that the claimed stent (a form of expandable tubular “scaffolding” to hold open a body passageway such as an artery) should comprise two series of intersecting thin bars with the second bars perpendicular to the longitudinal axis of the stent. In the granted patent there was no disclosure of the significance of second bars having such a position in the stent. The feature was disclosed only in the context of a construction in which the first bars were parallel to that axis, and it was nowhere suggested that it formed any part of the inventive concept. The amendment represented the selection of a particular feature, whose significance was nowhere disclosed, and its incorporation into the inventive concept shorn of its original context. This was held to constitute added matter (page 71 lines 16 to 27).
- 38 Turning now to the points raised by Mr. Townsend, on point (a) I am unconvinced that such a distinction should be drawn between chemical cases and other cases – although care may of course be needed when seeking analogies with a case in a different technical field. There is not one Patents Act for chemistry, and another Patents Act for other technology. The same law applies to both. In any case, as I pointed out at the hearing, *Palmaz* relates to non-chemical technology.
- 39 As regards point (b), it is true that the Office did not raise this issue when considering the amendments originally. However I do not think that should bar me from considering Pace’s arguments on their merits.
- 40 Points (c) and (d) go closer to the heart of the matter. With reference to point (c), I think that the problem, which Pace have identified, is that there is *not* a complete mapping between the features of the embodiment and the proposed claims. The embodiments have features such as a descriptor tag and a descriptor length which have no counterpart in the independent claims. Thus I do not see how this part of Mr. Townsend’s argument helps his case; indeed, it seems to hinder it.
- 41 I am mindful of the arguments advanced in the counter-statement (see paragraph 31 above) and of Mr Townsend’s argument in point (d) that that the horizontal and vertical parameters are not dependent on any other parameters to make a workable embodiment. That may well be the case, but I don’t think it is decisive of whether additional matter has been introduced after grant. Even if it were to be accepted that the descriptor tag and length parameters have nothing to do with the relationship between the sub-picture and the programme number, there is no suggestion in the patent that the other parameters can be transmitted without the descriptor tag and length information, and in the absence of evidence I am not convinced that the skilled man would necessarily read it that way. On the contrary, the description is of a system in which all the information is transmitted, without any suggestion that

the different pieces of information can be treated differently, and in my view this is significant in view of the case law.

- 42 Returning to that case law, if there is a conflict between *A C Edwards* and *Southco* on the one hand and *Palmaz* on the other, then the former as decisions of the Court of Appeal are of course of higher authority. (It was not necessary for the Court of Appeal in *Palmaz* at [2000] RPC 631 to consider whether matter had been added, even though the European Patent Office had taken a different view from the Patents Court on this point.) However, it seems to me that, whereas *AC Edwards* and *Southco* are in essence directed to whether specific features in an embodiment could be claimed in more general terms, *Palmaz* is more to do with whether it is permissible to lift specific features out of their context and place on them a greater significance than they were originally afforded.
- 43 The present case seems to me to be on all fours with *Palmaz*. As in *Palmaz*, the granted patent did not indicate that any or all of the features of paragraph [0031] were in any way inventive. In my view Philips have simply selected some, but not all, of these features (the number of rows and columns of “thumbnails”), and put them into the independent claims, thereby incorporating them into the inventive concept shorn of their original context (which included a descriptor tag and a descriptor length). Following *Palmaz*, therefore, I find that the present application to amend introduces matter, contrary to section 76(3)(a).
- 44 Although Pace have made a case only against claim 1, the same considerations would seem to apply, *mutatis mutandis*, to the other independent claims 7, 11, 13 and 14. I therefore find that the amendments to these claims also introduce added matter.

### **Conclusion and next steps**

- 45 In conclusion I find that the proposed amendments, whilst resulting in claims that are novel over the prior art, introduce matter in contravention of section 76(3). For that reason I refuse to allow the amendment in its present form.
- 46 It seems to me that there may well be alternative amendments which would cure the lack of novelty in the independent claims whilst avoiding the addition of matter. No ground of bad faith or covetousness having been made out, I am prepared to allow Philips an opportunity to submit fresh amendments. If Philips wish to do this, then they should submit them within 6 weeks. If they do, I will allow the opponents a period to file any comments, and then decide what further steps are appropriate.
- 47 If Philips do not submit alternative amendments within this time-scale, I shall refuse the application to amend.
- 48 There is one further minor issue that I raised at the hearing. The deletion of “characterized in that” in claims 1, 7, 13 and 14 renders them grammatically incorrect. This should be attended to if the application proceeds.

**Costs**

- 49 Neither side has asked for costs, but I will consider any submissions that they wish to make on this in the light of my decision within 6 weeks.

**Appeal**

- 50 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

**R C KENNEL**

Deputy Director acting for the Comptroller