

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 5 December 2003

Case Number: T 0413/00 - 3.5.1

Application Number: 93300043.2

Publication Number: 0551178

IPC: H04N 17/04

Language of the proceedings: EN

Title of invention:

Signal generator for television set with on-screen display
signal

Patentee:

SONY CORPORATION

Opponent:

Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG

Headword:

On-screen display/SONY

Relevant legal provisions:

EPC Art. 100(a), 56

Keyword:

"Inventive step (no)"

Decisions cited:

G 0007/95

Catchword:

-



Case Number: T 0413/00 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 5 December 2003

Appellant: Interessengemeinschaft für
(Opponent) Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG
Bahnstrasse 62
D-40210 Düsseldorf (DE)

Representative: Eichstädt, Alfred, Dipl.-Ing.
Maryniok & Partner
Kuhbergstrasse 23
96317 Kronach (DE)

Respondent: SONY CORPORATION
(Proprietor of the patent) 7-35, Kitashinagawa 6-chome
Shinagawa-ku
Tokyo (JP)

Representative: Nicholls, Michael John
J.A. KEMP & CO.
14, South Square
Gray's Inn
London WC1R 5JJ (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
21 March 2000 concerning maintenance of
European patent No. 0551178 in amended form.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. R. K. Zimmermann
B. J. Schachenmann

Summary of Facts and Submissions

- I. European patent number 0 551 178, claiming a priority date from 1992 and taking effect on 18 June 1997, was granted for an on-screen display (OSD) apparatus for use in picture adjustments on a TV monitor.

- II. The European patent application on which the patent was based claimed protection essentially for storing, retrieving and displaying, on the monitor during such adjustments, messages which signify the procedure of picture adjustments. In respect of such an OSD apparatus the European search report cited the UK patent application GB-A-2 155 714 (published in 1985) as a category X document, meaning that this UK document was particularly relevant even if taken alone.

- III. In the following EPO grant procedure, the examining division objected lack of novelty, citing the UK document, but waived the objection when the feature "during picture adjustment one of a plurality of test patterns is displayed on said display" was introduced into claim 1. This document, however, was then acknowledged in the patent specification, actually as the only prior art which was expressly cited.

- IV. The patent was contested by opposition solely on the grounds of lack of inventive step, arguing obviousness of the claimed invention *inter alia* in respect of the said UK document. In an interlocutory decision announced in oral proceedings, the written reasons of the decision posted on 21 March 2000, the opposition division found that the patent as amended during the opposition proceedings and the invention to which it

related met the requirements of the European Patent Convention. With reference to the UK document the decision contains one sentence only, namely that this document "only disclose(d) the preamble of claim 1".

V. Against the finding of the opposition division, a notice of appeal was filed by the opponent (the appellant) on 18 April 2000, including a debit order effecting payment of the appeal fee the same day, and followed by a written statement setting out the grounds of appeal on 25 July 2000.

VI. Concerning lack of inventive step, the appellant produced various chains of reasoning, among others arguments on the basis of the UK document as starting point of the assessment of inventive step. According to the appellant the subject-matter of claim 1 was distinguished therefrom only by the use of test patterns in place of a "normal image" as indicated in the UK document, a feature which was considered obvious, in particular if operation under a normal service mode was envisaged.

VII. The respondent (the patent proprietor) filed, as main and auxiliary requests, respectively, two sets of claims corresponding to the claims already filed in first instance, the respective claims 1 of these requests reading as follows:

Claim 1, main request: "An on-screen display apparatus for use in adjustments of picture qualities of chroma, hue, brightness and contrast on a television monitor (6), comprising:

a memory means (3) for storing messages which signify the procedure of adjustments of said picture qualities; and

a control means (1) for controlling the operation in such a manner as to retrieve the messages from said memory means (3) and to display the messages on said monitor (6),

characterised in that the on-screen display apparatus is arranged to display one of a plurality of test patterns on said display during adjustment of said picture qualities."

Claim 1, auxiliary request: "An on-screen display apparatus for use in adjustments of picture qualities on a television monitor (6), comprising:

a memory means (3) for storing messages which signify the procedure of adjustments of picture qualities; and a control means (1) for controlling the operation in such a manner as to retrieve the messages from said memory means (3) and to display the messages on said monitor (6),

characterised in that the on-screen display apparatus is arranged to display on said monitor, during adjustment of picture qualities, one of a plurality of test patterns and, overlaid thereon, messages which explain the proper manipulation for adjustment of the picture quality with reference to the test pattern."

VIII. Both parties to the appeal proceedings requested oral proceedings on an auxiliary basis.

IX. The respondent acknowledged the UK document as the closest piece of prior art, submitting that the problem solved by the present invention was to improve the

adjustment of the picture quality for the user. Novelty in respect of the UK document was present for the reason that this prior art document did not teach that the on-screen display apparatus caused the test patterns to be displayed during picture quality adjustment. It was rather stated expressly in this document that a "normal image" should be displayed during picture adjustment to allow the user to adjust the picture without having to interrupt the viewing programme. There was no reason for the skilled person to contravene this teaching.

- X. In an annex to the summons to oral proceedings issued in September 2003 the Board expressed, in the light of the UK document, doubts regarding the presence of novelty and inventive step, considering that a TV station might transmit, as a normal image, a test pattern or a plurality of test patterns at particular times or periods.

In two subsequent letters dated 23 October 2003 and 12 November 2003 the respondent withdrew its request for oral proceedings and stated that it will not be attending the oral proceedings to which it was summoned before the Board. However, a decision was requested on the basis of respondent's written submissions as at the time on file.

At the oral proceedings held as scheduled on 5 December 2003, the respondent was not present. The matter, therefore, was then discussed only with the representative of the appellant, who requested that the decision under appeal be set aside and the contested patent be revoked.

Reasons for the Decision

1. The appeal is admissible.
2. The appeal is allowable since taking the UK document into consideration, the amended patent in respect of the claimed subject-matter cannot be maintained for lack of inventive step, neither on the basis of the main request nor on the basis of the auxiliary request (Article 100(a) in combination with Article 56 EPC).
3. Lack of inventive step inevitably results from lack of novelty if the closest prior art document destroys novelty of the claimed subject-matter (see decision G 7/95-Fresh grounds for opposition / ETHICON, OJ EPO 1996, 626, point 7.2 of the Reasons for the Decision).
4. In the present case, it is undisputed that the UK document is the closest prior art document.

The Board has no reasons to deviate from such an evaluation of the prior art on file. Indeed, the UK document discloses an on-screen display apparatus (TV system with on-screen character generator 65; see figure 1) for use in adjustments of picture qualities (including colour level, colour tint, brightness, contrast and sharpness; see page 2, lines 100 to 104) on a television monitor (screen 27), comprising a memory means (ROM 71; see figure 2) for storing messages which signify the procedure of adjustments for said picture qualities (see for example step 020 in figure 4e), and a control means (CPU 69) for

controlling the operation in such a manner as to retrieve the messages from said memory means and to display the messages on said monitor , wherein the on-screen display apparatus is arranged to display a "normal image" on said display during adjustment of said picture qualities (see page 2, lines 84 to 107).

On this image, messages are overlaid which explain the proper manipulation for adjustment of the picture quality with reference to the test pattern, as follows from page 2, lines 94 to 100 in connection with the content of the "control instructions" displayed, for example the scale shown in 020, figure 4e. Under such circumstances it is thus not necessary to decide, although it may be convenient to note the issue, whether the content of messages as claimed in accordance with claim 1 of the auxiliary request provides any relevant technical contribution to the prior art at all.

5. It follows in respect of both requests that the only difference to the UK document may reside in the wording of the respective claims 1 that "the on-screen display apparatus is arranged to display one of a plurality of test patterns".

The respondent argued that these words explicitly required that the OSD apparatus itself caused the test pattern to be displayed during adjustment of picture quality.

This claim interpretation, however, is not supported by the normal meaning the terms of this definition has to be given. The expression "arranged to display" does not

imply more than that the apparatus is suitable or capable to display. A TV set, for example, which can clearly be said to be "arranged to display one of a plurality of" normal TV programmes, does usually not generate the pictures itself but receives the pictures, for example, on a TV channel or from another external video source. No other meaning can be given to such terms if used to define the display of test patterns.

In this respect, the claim wording is actually clear and does thus in so far not require the description and drawings to be taken into consideration for defining the claimed subject-matter.

Moreover, the Board does not infer from the description or drawings that the patent relates to an invention requiring an internal signal generator for generating the test patterns. Although the block diagram of figure 1 and the accompanying parts of the description indeed indicate such an internal solution these parts of the specification clearly relate to an embodiment only. Even for achieving the objects and advantages explicitly mentioned in the patent specification, an internal solution seems not to be a *sine qua non*. Therefore, there is no basis allowing a claim interpretation as fostered by the respondent.

On the other hand, the indication in the UK document that the (normal) user of a TV system should not have to interrupt viewing a programme during the control of other functions is relevant only in so far as the TV system must be arranged to display adjustment information and a selected TV programme at the same time, by overlay as indicated in this UK document. The

kind and content of the information displayed, as far as it is an issue in the present case, has no technical implications for the TV system itself.

Neither would the reference to the normal user hinder the skilled reader from considering the use of the same or the implementation of analogous features for a service mode involving well known test pattern-based test procedures. A TV service technician, for example, reading the UK document would certainly consider the synchronous display of additional adjustment information an obvious advantage for performing such kind of test procedures.

It follows that the claim definition in question includes a TV system which is suitable selectively to display a "normal image" transmitted from a plurality of external sources (TV programme channels, external video sources, etc.). The closest prior art, the UK document, therefore anticipates completely the claimed subject-matter, of the respective claims 1 of both requests, which again inevitably results in lack of inventive step according to the cited case law of the Enlarged Board of Appeal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener