BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

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 30 July 2003

Case Number: T 0367/01 - 3.5.1

Application Number: 92105772.5

Publication Number: 0507314

IPC: H04N 5/445

Language of the proceedings: EN

Title of invention:
Television set with improved remote control unit

Patentee:
EDICO S.R.L.

Opponents:
Koninklijke Philips Electronics N.V.
Interessengemeinschaft für Rundfunkschutzrechte GmbH Schutzrechtsverwertung & Co. KG

Headword:
Improved remote control/EDICO

Relevant legal provisions:
EPC Art. 56, 112(1), 114(1), 116(1)
EPC R. 71A
RPBA Art. 11(1)

Keyword:
"Inventive step - main and first auxiliary requests (no)"
"Late filed amendments - second and third auxiliary requests (not admitted)"
"Referral to the Enlarged Board of Appeal (not allowed)"

Decisions cited:
G 0006/95, T 0755/96, T 0633/97

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0367/01 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 30 July 2003

Appellant: (Opponent 02)	Interessengemeinschaft für Rundfunkschutzrechte GmbH Schutzrechtsverwertung & Co. KG Bahnstrasse 62 D-40210 Düsseldorf (DE)
Representative:	Eichstädt, Alfred, Dipl.-Ing. Maryniok & Eichstädt Kuhbergstrasse 23 D-96317 Kronach (DE)
Respondent: (Proprietor of the patent)	EDICO S.r.l. Via Kircher, 7 I-00197 Roma (IT)
Representative:	Eisenführ, Speiser & Partner Marinistrasse 24 D-28195 Bremen (DE)
Other Party: (Opponent 01)	Koninklijke Philips Electronics N.V. Groenewoudseweg 1 NL-5621 BA Eindhoven (NL)
Representative:	Schmitz, Herman Jan Renier Philips Intellectual Property & Standards P.O. Box 220 NL-5600 AE Eindhoven (NL)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted 22 January 2001 concerning maintenance of European patent No. 0507314 in amended form.**

Composition of the Board:

Chairman: S. V. Steinbrenner
Members: R. S. Wibergh
M. J. Vogel

Summary of Facts and Submissions

I. This decision concerns the appeal filed by Opponent 02 against the decision of the Opposition Division finding European patent No. 0 507 314 in amended form to meet the requirements of the EPC.

II. There were two oppositions against the grant, both based on Article 100(a) EPC. It was argued that the invention was not new or did not involve an inventive step. The following documents in particular were relied on:

D1: G. Zeisel et al., "An interactive menu-driven remote control unit for TV-receivers and VC-recorders", IEEE Transactions on Consumer Electronics, Vol.34, No.8, 1988, pp.814-818,

D2: GB-A-2 155 714.

III. The opposition division decided that the subject-matter of claim 1 of the then second auxiliary request out of a set of six auxiliary requests - which claim corresponded to claim 1 with claim 19 as granted - was not obvious for a skilled person.

IV. Claim 1 in the form considered allowable by the opposition division reads as follows (with misprints corrected):

Television receiver, supplied with a remote control unit comprising numerical keys and a reduced number of command keys for controlling functions in a plurality of functional modes among which a first operating mode

dedicated to controlling the normal television reception (TV) and/or a second operating mode for controlling the teletext reception (TXT) and/or a third operating mode for controlling the functionality of an auxiliary device (VTR) connected to the television receiver,
the television receiver comprising a logic control unit controlling a character and symbol generator for generating an on-screen display,
whereby one of the command keys (DISP) of the remote control unit is provided for activation /of/ the display on the television screen of at least one sequence for controlling said functions, corresponding to said functional modes and that each sequence provides for the control of all said functions of the selected operating mode,
the sequence consisting of alpha-numerical and/or graphic symbols representative of the function to be performed and said symbol generator being adapted to display said sequence on a part of the screen in such a way so as not to substantially disturb the viewing of the image reproduced on the television screen, even though being clearly visible,
characterized in that
the television receiver is further provided with means (50, 51) for moving an indicator on said symbols and means (53) adapted for activating the operating mode (TV, TXT, VTR) corresponding to the symbol (TV, TXT, VTR) selected with said indicator on said part of the screen and that said command keys comprise two keys (54, 55) on said remote control unit, for the volume control when said symbols are not displayed.

V. Claim 1 according to the then auxiliary request 3 - which the opposition division thus did not have to consider - additionally contained the features of claim 20 as granted, meaning that the following paragraph was added to claim 1:

"… said two keys (54, 55) have the purpose of controlling the volume in the teletext mode (TXT) even when said symbols are displayed".

Furthermore, the "or" in the first "and/or" combination (see paragraph 1 of claim 1) was deleted.

VI. Both opponents appealed against this decision, referring to additional prior art in the respective statement of grounds, inter alia to document

D10: EP-A-0 103 707.

In a communication from the Board dated 10 March 2003 the opinion was expressed that it was doubtful if the invention involved an inventive step. A deadline for filing amendments to the patent documents or evidence was set to two months before the date scheduled for the oral proceedings, which was 10 July 2003.

VII. With letter dated 12 May 2003 the respondent (patent proprietor) announced that "the patent proprietor will defend his patent on the basis of the auxiliary requests which were already filed with the Opposition Division and if required by limiting the independent claim with features as disclosed in the patent specification, in particular in the claims as granted".

VIII. With letter dated 8 July 2003 Opponent 01 withdrew its opposition against the patent.

IX. Oral proceedings before the Board were held on 10 July 2003. The respondent presented new sets of claims according to first to third auxiliary requests as well as five questions to be referred to the Enlarged Board of Appeal in case the new claims were not admitted for consideration.

Claim 1 according to the first auxiliary request corresponded to claim 1 of the third auxiliary request before the opposition division, ie in substance including claims 1, 19 and 20 as granted.

Claim 1 according to the second auxiliary request corresponded to claim 1 of the first auxiliary request plus dependent claims 3, 8 and 9 as granted, however without claim 20 as granted.

Claim 1 according to the third auxiliary request corresponded to claim 1 of the first auxiliary request plus dependent claims 3, 8 and 9 as granted.

The questions intended for the Enlarged Board of Appeal were (in the original German followed by the Board's translation):

"Die Große Beschwerdekammer möge entscheiden:
1) Ist Art 114(2) EPÜ vereinbar mit Regel 71(2) Satz… und der entsprechenden Regel für die Beschwerdekammern?
2) Kann ein während der mündlichen Verhandlung einer
a) Prüfungsabteilung / Einspruchsabteilung
b) Beschwerdekammer

vorgelegter Antrag des Anmelders / Patentinhabers wegen zu späten Vorbringens zurückgewiesen werden, insbesondere wenn der Antrag eine Kombination eines geltenden unabhängigen Anspruchs mit a) einem oder mehreren bereits eingereichten unselbständigen Ansprüchen enthält?
3) Wie 2 + sprachliche Verbesserung.
4) Wie 2 bis a) + b) einem oder mehreren Merkmalen aus der Offenbarung der Anmeldung / Patentschrift, wobei diese Merkmale bis dahin keinen Niederschlag in einem Anspruch gefunden haben.
5) Wie 2) + 4)".

[The Enlarged Board of Appeal is asked to decide:
1) Is Article 114(2) EPC compatible with Rule 71(2)… sentence and the corresponding rule for the boards of appeal?
2) Can a request submitted by the applicant / patent proprietor in oral proceedings before
a) an examining division / opposition division
b) a board of appeal
be rejected as late filed, in particular if the request concerns a combination of a current independent claim with a) one or more dependent claims on file?
3) As 2) + correction of the language.
4) As 2 until a) + b) one or more features of the disclosure of the application / patent specification, these features not yet having been the subject of a claim.
5) As 2) + 4).]

X. The appellant (opponent 02) requested that the decision under appeal be set aside and that the patent be revoked.

XI. The respondent (patent proprietor) requested that the appeal be dismissed (main request);
or that the decision under appeal be set aside and the patent be maintained in amended form on the basis of:

– the "third auxiliary request" as submitted before the opposition division on 4 December 2000 (first auxiliary request),

– the second auxiliary request, as clarified in the oral proceedings of 10 July 2003 (second auxiliary request),

– the third auxiliary request, as clarified in the oral proceedings of 10 July 2003 (third auxiliary request);
or that the questions submitted at the oral proceedings of 10 July 2003 be referred to the Enlarged Board of Appeal (fourth auxiliary request);
or that the proceedings be continued in writing (fifth auxiliary request);
or that second oral proceedings be arranged (sixth auxiliary request).

XII. At the end of the oral proceedings the Chairman of the Board closed the debate and announced that the decision would be given in writing.

Reasons for the Decision

The respondent's main request

1. According to the respondent's main request the appeal should be dismissed and the patent be maintained in the amended form found acceptable by the opposition division. The Board has thus to decide whether the invention according to claim 1 involves an inventive step.

2. *Prior art*

2.1 D1 describes a television receiver supplied with a remote control unit comprising a single command key for controlling functions in a plurality of functional modes, namely TV, teletext (VT) and video cassette recorder (VCR) control. The receiver is capable of generating an on-screen display (OSD) when the command key of the remote control unit is pressed. There is a display sequence at least in the TV mode (Figure 3) and the VCR mode (Figure 5) and each sequence provides for the control of all said functions of the selected operating mode. The sequence consisting of alpha-numerical and graphic symbols is representative of the function to be performed and displayed on a part of the screen in such a way so as not to substantially disturb the viewing of the image reproduced on the television screen (namely at the periphery), even though being clearly visible. The key of the remote control causes an indicator to move over the symbols and may activate the operating mode corresponding to the symbol selected. There are no numerical keys and no volume control keys: all selections are made on-screen.

2.2 D2 describes a TV receiver where most, but not all, functions are controlled on-screen. If for example the brightness is to be adjusted the "brightness" function is called up on the screen and two buttons on the remote control (ADJ+ and ADJ-) are used to set the desired level (page 4, lines 65 to 73). Certain functions, including the volume, are controlled by keys on the remote control and can be unconditionally controlled during the function control mode.

2.3 D10 describes a TV receiver capable of displaying teletext (page 10, top) and controlling a video recorder (page 5, second paragraph). Many functions are controlled on-screen but the most important functions, and above all the volume control, should be controllable at all times and are therefore attributed to dedicated keys on the remote control (page 10, second paragraph).

3. The Board chooses to start from D1 since this document is regarded by the respondent as the closest prior art. The difference between the invention and D1 is that the remote control is equipped with numerical keys and two keys controlling the volume "when said symbols are not displayed". "Said symbols" refers to the "alpha-numeric and/or graphic symbols representative of the function to be performed", ie the OSD indications. It is not in dispute that, since in D2 and D10 the volume is always controlled by keys, and there are also numerical keys, the distinguishing features are known as such from these documents. The question is therefore if D1 can be combined with D2 or D10.

4. The opposition division held (cf paragraph 49) of the decision under appeal) that the invention was non-obvious because there was no suggestion in D1 to use anything else than the cursor for controlling the volume and because a combination with the teaching of D2 was based on undue hindsight in view of the fact that changing the volume via a menu was not at all foreseen in D2.

The respondent has argued that the remote control in D1 was a "monster" since no user would accept such an inconvenient way of control. D1 and D2 were incompatible since they represented two completely different control concepts, one aiming at a maximal reduction of the number of keys and the other at quick control of important functions.

5. The Board finds that the invention is obvious for the following reasons. The skilled person was aware that not all TV functions can be controlled by individual buttons on a remote control (see D1, page 814, left-hand column, first paragraph; D2, page 1, lines 35 to 47; D10, page 2, lines 18 to 26). The OSD concept was developed to allow the number of keys to be reduced (see D1, page 814, left-hand column, last paragraph; D2, page 1, lines 48 to 65; D10, page 3, last paragraph and claim 1). At the same time it was clear that OSD will be slower than the direct control offered by the keys (cf. also D10, page 10, lines 9 to 25). There was thus a trade-off: a remote control with few keys was convenient to handle but offered relatively slow control whereas a remote control with many keys was difficult to handle.

In this known trade-off situation there are naturally an almost unlimited number of combinations of functions controlled by keys and functions controlled by OSD. It was within the capabilities of the skilled person to choose particular key/OSD configurations which could be assumed to appeal to users. This seems to be particularly the case for numerical keys and separate volume keys (see D2, page 3, lines 39 to 47; D10, page 10, lines 9 to 25).

It may be true that D1 *seen in isolation* suggests nothing else than a one-key remote control. The skilled person, however, was able to place D1 in its technical context and realised that it merely represented an extreme choice. He was still free to pick another configuration which he considered would facilitate the operation for typical users. This can in fact be regarded as the technical problem in this case, as argued by the appellant. Since innumerable remote controls are equipped with numerical keys and separate volume keys (eg D2, D10), the solution to the problem was not in any way an original choice. Thus D1 and D2/D10 can indeed be combined since their teachings are not incompatible - they merely represent different choices between alternatives whose advantages and disadvantages are well known.

6. The respondent has pointed out that D1 does not disclose a proper TV receiver with a screen but rather a complex set-up involving a PC (Figure 7) and that it is not disclosed that there is an OSD function in the teletext mode. The Board however agrees with the appellant that these differences are minor. Even if D1 is an experimental setup it is clearly intended as a TV

receiver, and even if it is not described that there is an OSD function in the teletext mode this technique was used in the other modes and would be used in the teletext mode as well if the number of functions to control required this. It is noted that there is in D1 an OSD button "VT" for entering the teletext mode, just as there is a "VCR" button for entering the VCR mode (cf Figure 3), and it appears to be a matter of simple analogy if OSD is used in the teletext mode as it is in the VCR mode (cf Figure 5).

It follows that in the Board's view the skilled person, starting out from D1, would have taken the teaching of D2 or D10 into consideration to arrive at the invention as claimed.

7. The appellant has additionally argued that it would be possible to start out from D2 instead of D1. Compared with the prior art known from D2 the invention is mainly distinguished by the presence of a plurality of operating modes and the OSD being in the form of sequences of symbols for controlling functions, an indicator being movable over the symbols to select a function to be adjusted. Since multi-mode receivers were known (eg from D1), as was this particular kind of cursor-controlled OSD (also from D1), no inventive step can be seen in these differences. The respondent has objected that the skilled person had no reason for substituting the OSD known from D1 for the one used in D2. But it is generally accepted that it is obvious merely to replace one technique by another which is functionally more or less equivalent and known from the same technical area. Moreover, the technique shown in

D1 may well be the more convenient one, as maintained by the appellant.

8. Thus the invention does not involve an inventive step (Article 56 EPC).

The respondent's first auxiliary request

9. Claim 1 differs from claim 1 of the main request mainly in that the volume keys have the purpose of controlling the volume in the teletext mode even when the symbols representative of the functions to be performed are displayed.

10. Above it was found that the skilled person would have combined the teachings of D1 and D2 (or D10) to arrive at a TV receiver with a remote control capable of OSD but, for the volume control, equipped with dedicated keys. The reason for having keys was that the volume should always be easily adjustable. Clearly this applies to any mode the TV receiver happens to be in and whether or not function symbols are displayed. Thus the reasoning above necessarily implies that the volume keys control the volume in particular in the teletext mode, and in particular if function symbols are displayed. Thus the subject-matter of claim 1 does not involve an inventive step (Article 56 EPC).

The respondent's second auxiliary request

11. The respondent's second auxiliary request adds to claim 1 of the main request the subject-matter of dependent claims 3, 8 and 9 as granted.

12. The respondent introduced this request for the first time at the oral proceedings before the Board. It is not identical with any one of the six auxiliary requests before the opposition division, the subject-matter of claims 3, 8 or 9 not having been contained in any of them. In the respondent's view the request was announced in good time, namely with the letter dated 12 May 2003, filed in response to the Board's communication setting a dead-line for filing amendments to the patent documents. Claim 1 was merely a clarification of this previously expressed intention to defend the patent "on the basis of the auxiliary requests which were already filed with the Opposition Division and if required by limiting the independent claim with features as disclosed in the patent specification, in particular in the claims as granted". An opponent should be prepared to deal with any new combination of dependent claims at the oral proceedings. If he was not, that was his problem.

The appellant requested that the claim not be admitted since a completely new and complex situation had been surprisingly created by the respondent's late request.

13. The Board finds that claim 1 has been presented much too late and that it would be inequitable to oblige the appellant to consider it during the last few hours of the opposition appeal proceedings. In preparation for the oral proceedings the Board had written a four-page communication warning the respondent that, in the Board's preliminary view, "the decision under appeal was not necessarily the right one". Amendments to the patent should be made *two months* before the oral proceedings. In reply, the respondent made no specific

request but merely announced that it might file amendments, in particular in accordance with the auxiliary requests before the opposition division. It should be clear that in such circumstances it would be exceptional if the Board, at the oral proceedings, were to admit a claim for consideration which was in fact *not* in accordance with the requests before the opposition division. The respondent's vague indication that amendments would possibly be presented at the oral proceedings cannot be equated with, or replace, the actual filing of specific claims. No reason for the lateness of the request has been offered. The respondent's view that the appellant should be prepared to deal with any combination of various dependent claims (the granted patent contains 20 claims) which the respondent cared to indicate at the oral proceedings goes against the established case-law according to which the admission of late filed requests is a matter of discretion for the Board (see decisions cited in "Case Law of the Boards of Appeal of the European Patent Office", 4th edition, European Patent Office 2002, page 324 ff and page 545 ff). In the Board's view, two important principles governing the exercise of this discretion are the fairness and the efficiency of the proceedings, taking account of their current state. Applying these principles, it must be expected that requests which have been considerably changed and for the first time submitted during an oral hearing normally ending the proceedings will no longer be admitted (see T 633/97 - Optical members/HERAEUS, not published in OJ EPO).

Nor does the fact that the appellant had argued against all claims in the notice of opposition (filed in 1998) give the respondent a right to make such amendments in the last minute. Parties must be aware that if they do not present their case as early and completely as possible, let alone if they do not keep the dead-lines given by the Board for filing amendments (or evidence), they do so at their own risk, depending on the Board's evaluation of the situation on a case-by-case basis. In the present proceedings the Board comes to the conclusion that, for the reasons given above, the new request was filed too late to be considered.

The respondent's second auxiliary request is therefore rejected as inadmissible.

The respondent's third auxiliary request

14. Claim 1 of the respondent's third auxiliary request corresponds to a combination of claims 1, 3, 8, 9, 19 and 20 as granted. Also this claim combination is new and the appellant has requested that it not be admitted.

15. The Board decides to reject this request as inadmissible for the reasons indicated in connection with the previous request.

The respondent's fourth auxiliary request

16. The respondent requests the Board to remit five questions to the Enlarged Board of Appeal (cf paragraph IX above).

According to Article 112(1) EPC a board shall, in order to ensure uniform application of the law, or if an important point of law arises, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for these purposes. To be admissible, the points of law must have a causal relationship with the legal situation of the appeal case (cf eg Moser, Europäisches Patentübereinkommen, 20. Lieferung, Munich 1997, chapter on Article 112 EPC, page 9, No. 18; G 6/95, point 6, EPO OJ 1996,649).

17. All five question concern the late filing of amendments to the patent (cf the respondent's auxiliary requests 2 and 3).

The first question is understood as an inquiry whether Rule 71a(2) EPC (rather than Rule 71(2) EPC, as stated by the respondent) and Article 11(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2000, 316) are compatible with Article 114(2) EPC.

Rule 71a(2) EPC states, in conjunction with the first paragraph of the same rule, in particular that if a patent proprietor has been notified of the grounds prejudicing the maintenance of the patent, he may be invited to submit, by a date fixed by the EPO, documents which meet the requirements of the Convention. If the documents are presented after that date they need not be considered, unless admitted on the grounds that the subject of the proceedings has changed.

Article 11(1) RPBA (in the version of the rules in force when the Board sent its communication) states that if oral proceedings are to take place, the Board concerned shall endeavour to ensure that the parties have provided all relevant information and documents before the hearing.

Article 114(2) EPC states that the EPO may disregard facts or evidence which are not submitted in due time by the parties concerned.

18. The Board first notes that whereas Article 114(2) EPC concerns facts or evidence, Rule 71a(2) EPC concerns amendments to the patent documents. If the view is taken that Article 114(2) EPC does not at all relate to amendments (cf T 755/96, point 3.3, OJ EPO 2000,174), a view which the respondent appeared to share in the oral proceedings, the two stipulations deal with different issues and cannot conceivably be contradictory. The same applies to the relationship between Article 114(2) EPC and Article 11(1) RPBA when applied to the patent proprietor. But even if Article 114(2) EPC were relevant by implication also for the issue of amendments the rules mentioned do not contradict it: they give discretionary power to reject late filed requests, something which Article 114(2) EPC spells out explicitly. The answer to question 1) thus appears straightforward so that a referral to the Enlarged Board of Appeal is not necessary.

19. The second to fifth questions relate in part to first instance proceedings and ex parte proceedings. Such aspects have no causal relationship with the legal situation of the present appeal case and can thus not

be considered. In respect of opposition appeal proceedings the issue is basically whether a request by the patent proprietor for amendment of the patent made during oral proceedings before a board of appeal can (at all) be rejected as having been presented too late. This question could in principle be relevant for the present case since two of the respondent's requests for amendment were not admitted. It is however established jurisprudence that the decision to admit or not to admit amendments is a matter of discretion for a board to be exercised on a case-by-case basis inter alia applying those principles referred to above. There has thus never been any real doubt that a board *may* in principle refuse late filed amendments. The second to fifth questions therefore also need not be referred since the law is uniformly applied on the point of law to which these questions are limited.

20. For these reasons the respondent's request for referral of questions to the Enlarged Board of Appeal is refused.

The respondent's fifth auxiliary request

21. The respondent furthermore requests that the proceedings be continued in writing, implicitly without closing the debate in order to allow a discussion of the respondent's second and third auxiliary requests. The Board sees however no reason for continuing the debate since these requests were not admitted, inter alia for reasons of procedural economy, and otherwise no issue seems to need clarification. The request is therefore refused.

The respondent's sixth auxiliary request

22. The respondent requests further oral proceedings before the Board to be held since, as a consequence of the filing of new claims according to the respondent's second and third auxiliary requests, the subject of the proceedings has changed (cf Article 116(1) EPC). The Board notes however that the amendments requested were not admitted and therefore the subject of the proceedings remains the same. Thus this request is also refused.

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