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D E C I S I O N
of 16 November 2004

Case Number: T 1011/01 - 3.5.1

Application Number: 95110997.4

Publication Number: 0679038

IPC: H04N 17/04

Language of the proceedings: EN

Title of invention:
Television receiver

Patentee:
MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.

Opponent:
Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG

Headword:
Television receiver/MATSUSHITA

Relevant legal provisions:
EPC Art. 54, 56, 83

Keyword:
"Disclosure - sufficiency (main request - no)"
"Novelty, inventive step (first auxiliary request - yes)"

Decisions cited:
T 0226/85, T 0229/99

Catchword:
-



Case Number: T 1011/01 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 16 November 2004

Appellant:
(Opponent)

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Representative:

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Respondent:
(Proprietor of the patent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 16 July 2001
rejecting the opposition filed against European
patent No. 0679038 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. S. Wibergh
G. E. Weiss

Summary of Facts and Submissions

I. This is an appeal against the decision of the opposition division to reject the opposition against European Patent No. 0 679 038.

II. The patent as granted contained five claims. Claims 1, 4 and 5 read as follows:

"1. A television receiver comprising:
a receiving circuit (5, 11);
a nonvolatile memory (15);
means (13) for reading out data from the nonvolatile memory;
adjustment sections for adjusting variable parameters of said receiving circuit such as sound volume or brightness of the television receiver operating in at least two different adjustment conditions;
controlled changing means (13) for changing said adjustment conditions of said adjustment sections of the television receiver between first and second adjustment conditions;
a power supply;
characterized by
means for turning on the power supply in response to the data of the nonvolatile memory (15) representing one of said first and second adjustment conditions."

"4. The television receiver of claim 1 further comprising a CRT (17) and means for automatically changing the CRT (17) into an ageing state when data of the nonvolatile memory (15) represents one of the first and second adjustment conditions and the power supply is turned on."

- "5. The television receiver according to claim 1 further comprising means (15, 13) for automatically setting the receiving circuit (11) and a CRT (17) into ageing states when the power supply is turned on and means for setting the receiving circuit (11) and the CRT (17) out of the ageing states in response to a mode change signal."
- III. According to the decision under appeal, the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (cf Article 100(b) EPC), and the invention was new and involved an inventive step over the closest prior art as represented by D1 (US-A-4 858 006) (cf Article 100(a) EPC).
- IV. The opponent appealed this decision, requesting that it be set aside and the patent revoked. In the statement of grounds it was argued that the invention as defined in claim 1 was not new over D1, or at least did not involve an inventive step. In the context of the objection based on Article 100(b) EPC it was furthermore argued for the first time that the invention according to claims 4 and 5 was not sufficiently disclosed since the patent did not define what an "ageing state" was or how this mode differed from the "normal mode" also mentioned in the description.
- V. On 12 August 2004 the Board issued an invitation to oral proceedings. In the Board's preliminary opinion the reasoning in the decision with respect to novelty and inventive step was convincing. However, the

respondent (patent proprietor) was informed that unless it could be shown, eg by reference to a handbook reflecting general knowledge, that the skilled person knew what was meant by "ageing state", the patent might not fulfil the requirements of Article 83 EPC.

VI. By letter of 8 October 2004, the respondent requested that the appeal be dismissed or, as first and second auxiliary requests, that the patent be maintained as amended in accordance with claims filed with the same letter. The claims of the first auxiliary request were identical with claims 1 to 3 as granted. The only claim of the second auxiliary request corresponded to claim 2 as granted.

VII. Oral proceedings were held on 16 November 2004.

The appellant argued that the term "ageing state" employed in claims 4 and 5 was not explained in the opposed patent and that it was not known whether it had any generally accepted conventional meaning. The appellant had failed to furnish evidence on this point although this should have been easy if the expression was well known. The invention according to claim 1 was either not new over D1 or did not involve an inventive step. This view was supported by the fact that the patent (EP-B-0 468 356) corresponding to the parent application of the patent-in-suit had been revoked by the EPO (cf T 229/99). The appellant referred in particular to the eighth auxiliary request in that case.

The respondent argued that the skilled person would know what was meant by "ageing state" and that the invention in any case did not concern this feature,

which only appeared in dependent claims. The subject-matter of claim 1 was new and involved an inventive step since the automatic activation of the main power supply in response to stored data according to the invention was not at all known from D1.

- VIII. The appellant requested that the decision under appeal be set aside and that the European patent be revoked.
- IX. The respondent requested that the appeal be dismissed and that the patent be maintained as granted (main request), or in the alternative, in amended form on the basis of claims 1 to 3 (first auxiliary request) or of claim 1 (second auxiliary request) submitted with the letter dated 8 October 2004, the description and drawings as granted.
- X. At the end of the oral proceedings the Board announced its decision.

Reasons for the Decision

1. The appeal meets the requirements referred to in Rule 65(1) EPC and is therefore admissible.

The respondent's main request

2. *Sufficiency of disclosure*

- 2.1 In the appeal proceedings, the appellant has argued that the invention as defined in dependent claims 4 and 5 of the patent as granted was not disclosed in the patent in a manner sufficiently complete for it to be

carried out by a person skilled in the art (cf Article 100(b) EPC). These claims referred to an "ageing state" which was nowhere explained. From the patent specification it was only clear that the ageing state (or "ageing mode") was different from the "normal" and "factory" modes, but not in what way it was different. Factory ageing could also be achieved by normal operation of the apparatus, but apparently something different and undefined must be added to the normal use. Competitors had to be informed what was meant by the term since otherwise they might inadvertently infringe the patent.

2.2 The respondent, referring to paragraph [0024] of the patent specification, has argued that in the ageing mode all sections of the receiver were put under greater strain and a reference image was displayed on the cathode ray tube. The skilled person was generally well aware of ageing techniques, and anyway the invention was not about this mode but about the way the power supply could be automatically turned on as set out in claim 1. Since the expression was not present in claim 1 the scope of protection conferred by the patent was not influenced by its meaning.

2.3 It follows from Article 100(b) EPC that a European patent must disclose an invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. According to T 226/85 (OJ EPO 1988,336, point 2 of the reasons), "substantially any embodiment of the invention, as defined in the broadest claim, must be capable of being realised on the basis of the disclosure". This implies in particular that an objection of insufficiency can be

raised against the subject-matter of any claim, independent or dependent (cf Rule 29(3) EPC). From a legal point of view, therefore, it is irrelevant whether or not the feature objected to is essential or to what degree the scope of protection conferred by the patent depends on the claim in question. In the present case it must thus be examined whether the skilled person is able to work the invention according to claims 4 and 5.

2.4 All what a skilled person learns from the application documents about the ageing mode is that in this mode all receiver sections are active and a "reference image" is displayed (cf paragraph [0024] of the patent specification and column 7, lines 6 to 15 of the corresponding A-publication). This, however, is not a fundamental difference from the other modes, especially considering that the image displayed is not specified. In the invitation to oral proceedings the Board warned the respondent that it might be necessary to demonstrate, eg by reference to a handbook reflecting general knowledge, what a skilled person would understand by this expression. The respondent however merely referred to the passages in the specification indicated above and stated that the skilled person would know what was meant by "ageing mode". The appellant, on the other hand, does not admit that this is common knowledge.

2.5 In principle, the burden of proof for an objection under Article 100(b) EPC falls on the opponent (see eg Singer/Stauder, The European Patent Convention, Third edition, Volume I, Cologne 2003, Commentary on Article 83, note 8). On the other hand, only the

applicant is responsible for the contents of a patent application (cf Article 113(2) EPC) and therefore only the applicant can ensure that what is claimed is also explained. In the present case the appellant can be regarded as having relieved himself of the burden of proof by pointing out the incomplete definition of the "ageing mode" in the patent-in-suit. It must then be expected of the respondent to try to demonstrate that the expression has a conventional meaning fitting the present context. This is all the more so since it would be virtually impossible for the appellant to prove that such a meaning does *not* exist. If the respondent fails to contribute to the clarification of the issue it must bear the consequences.

- 2.6 The Board thus concludes that a skilled person would not know what is meant by the expression "ageing state" in claims 4 and 5, or how it is distinguished from the other two operation modes. It follows that the main request must be refused.

The respondent's first auxiliary request

3. According to this request, claims 4 and 5 are deleted. Consequently, there is no objection against the patent under Article 100(b) EPC since the invention as now claimed is sufficiently disclosed.

4. *Construction of claim 1, novelty*

- 4.1 A main issue at the oral proceedings before the Board was whether the wording of claim 1 encompasses the receiver known from D1, the sole piece of prior art the appellant has relied on in connection with this claim.

The issues of claim construction and novelty will therefore be treated together.

- 4.2 D1 discloses a television receiver operative in two modes, the normal mode and the servicing mode. In the servicing mode, standardised values for contrast, hue, balance etc can be entered into nonvolatile memory. A user selects the servicing mode by giving in a code and then, within a predetermined time window, actuating the main power supply switch. If the code is correct, which is checked against a "secret number" stored in non-volatile memory, and the switch is actuated in time, the apparatus goes into servicing mode. Otherwise it enters the normal mode (cf for example the abstract).
- 4.3 Claim 1 further contains a "power supply" without however specifying to what circuits it provides power. The description suggests that the feature corresponds to the main power supply, which serves all sections of the receiver (cf paragraph [0024]). Even with such a limited reading the feature is known from D1 (cf switch 16 in Figure 1). Hence, the pre-characterising features of claim 1 are all known from D1.
- 4.4 According to the characterising feature of claim 1, means are provided "for turning on the power supply in response to the data of the non-volatile memory (15) representing one of said first and second adjustment conditions". In the appellant's opinion, this covers the situation in D1 where the code is entered by the user and compared with the stored secret number.
- 4.5 This crucial question was already considered by the opposition division, which concluded that the secret

number in D1 was not data representing a first or second adjustment condition, and that there was in D1 no mechanism for turning on the power supply "in response to" such data (cf point 5 of the appealed decision). The Board agrees with this opinion for the reasons set out below.

- 4.6 If an event B happens "in response to" another event A, this usually means in everyday language that the event A may occur or not, and only if it does, B occurs (cf one of the definitions of "response" in Webster's Third New International Dictionary, principal copyright 1961: "the output of a transducer or detecting device resulting from a given input"). According to claim 1 the power supply is turned on "in response to the data... representing" a certain condition. This wording is not ideally clear since the response is not to an event but to a state. The description, however, reveals that an event is in fact intended. According to the flow diagram in Figure 3 the mode data are read (step 31) after which it is decided (step 32) "whether or not the 1-bit mode data represents a factory mode" (cf paragraphs [0022] and [0024]). The meaning is thus that the power supply is turned on in response to the detection of the value of the data. The Board is of the opinion that the skilled person would interpret the claim as referring to such an event since this corresponds to the normal meaning of "in response to" and is supported by the description. Furthermore, since "in response to" only makes sense if the triggering event might also not occur, the "data" in claim 1 must be variable, ie capable of assuming different values. The description supports also this reading since, during the life-time of the receiver, the 1-bit data

initially represents the factory mode and, after shipping, the normal mode, and only in the factory mode is the main power supply turned on by the claimed means (cf Figure 3). This is also confirmed by claim 1 itself which attributes to the two possible values different "adjustment conditions".

4.7 In D1, however, the data allegedly corresponding to the "data" in claim 1 are the secret number stored in non-volatile memory. This number is predetermined and therefore nothing can happen *in response to* it. The variable data in D1 are instead the code entered by the user and used for comparison with the secret number. This code is never stored in non-volatile memory, as required by claim 1. Thus, D1 does not disclose means for turning on the power supply in response to (the detection of the value of) the data stored in the non-volatile memory. The difference is fundamental since the entire password procedure in D1 has no correspondence in the patent-in-suit, nor has the automatic detection of different operation modes according to the invention any correspondence in D1.

4.8 In this connection the appellant has referred to decision T 229/99 concerning the parent application of the patent-in-suit and by which the Board (in a different composition) upheld the opposition division's decision to revoke the patent, and in particular to the Board's rejection of the patent proprietor's eighth auxiliary request for lack of inventive step. Claim 1 of this request defines the television receiver in the way that it comprises a main power supply switch which is changed to an on position for activating all the sections of the television receiver "when the control-

mode determining data represents an ageing mode of operation". The Board concluded that this switch could simply be "the normal relay switch which causes the television receiver to change from stand-by operation to normal operation" (point 5.6). It should however be noted that claim 1 in this case did not contain the expression "in response to", found above to imply a limitation on the subject-matter claimed in the patent-in-suit.

4.9 It follows that the subject-matter of claim 1 is new (Article 54 EPC).

5. *Inventive step*

5.1 The appellant has suggested that even if the subject-matter of claim 1 were new it followed in a straightforward way from D1 since it was a mere matter of automatisisation. In other words, the skilled person would see that after the code had been successfully entered the power supply could be activated automatically.

5.2 The Board agrees on the general principle that normally no inventive step is involved in performing automatically what was previously done manually. The present case is however not such a straight-forward automatisisation. First, it is in fact an essential feature of D1 that *the user* activates the main power switch 16 (within a certain time window) since this serves to confirm his intention to select the service mode (see column 7, lines 30 to 42). Second, and more important, even if the power were automatically applied this would still not be in response to the data in the

nonvolatile memory (the secret number) but to the code entered, as explained above.

- 5.3 The appellant has not suggested any other credible problem which the skilled person would recognise from D1 and solve in an obvious manner to arrive at the present invention as claimed, nor can the Board see that such an argument exists. Thus, the subject-matter of claim 1 involves an inventive step (Article 56 EPC).
6. The respondent's first auxiliary request being allowable, there is no need to consider the second auxiliary request.

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 with the order to maintain the patent as amended in the following version:
 - description: columns 1 to 5 of the patent specification;
 - claims 1 to 3 filed with the letter of 8 October 2004 ("first auxiliary request");
 - drawings: Figures 1 to 6 of the patent specification.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener