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D E C I S I O N
of 13 September 2005

Case Number: T 0388/03 - 3.5.2

Application Number: 98300993.7

Publication Number: 0881611

IPC: G08C 23/04

Language of the proceedings: EN

Title of invention:

Remote control apparatus with a cleaning mechanism

Applicant:

Mitsubishi Denki Kabushiki Kaisha

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 84, 113(2)

RPBA Art. 11(3)

Keyword:

"Claims - clarity of combination (no)"

"Appellant not present at oral proceedings - decision taken on basis of claims submitted in written procedure"

Decisions cited:

-

Catchword:

-



Case Number: T 0388/03 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 13 September 2005

Appellant: Mitsubishi Denki Kabushiki Kaisha
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 21 November 2002
refusing European application No. 98300993.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. Wheeler
Members: F. Edlinger
C. Holtz

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 98 300 993.7.
- II. The following documents are referred to below:
- D1: US-4 611 365 A,
- D4: US-4 214 340 A and
- D5: US-5 436 625 A.
- III. The decision under appeal held that the subject-matter of claim 1 was not allowable for the reasons given in the communication dated 7 August 2002 (summons to attend oral proceedings). These reasons were not challenged by the applicant when the request for oral proceedings was withdrawn. Essentially, the grounds for refusing the application were based on lack of novelty with respect to the prior art disclosed in D1, and lack of inventive step in view of the prior art disclosed in D4 (referred to as US-4 214 "430") and D5. In view of the Guidelines for Examination (in particular the Annex to chapter C-IV) and the Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, I.D.6.4.1 and 6.4.2, the subject-matter of claim 1 was considered as a mere aggregation of features with no combinative effect, and no inventive combination which would require mutually supporting features to achieve a new technical result.

The decision under appeal further contained remarks on prior art found in a James Bond movie, which were said not to form part of the decision under appeal but relevant for considerations of inventive step.

IV. With the statement of grounds of appeal, the appellant filed two new pages 16 proposing to change the wording of claim 1 on the basis of first and second auxiliary requests. Oral proceedings were requested.

V. Claim 1 on which the decision under appeal is based (main request) has the following wording:

"An electronic remote control apparatus especially designed to control an electrical appliance such as a television receiver or VCR, the remote control apparatus comprising cleaning means (8, 50, 21, 31) for cleaning the electrical appliance."

Claims 2 to 11 are dependent on claim 1.

VI. Claim 1 of the first auxiliary request is worded as follows:

"An electronic remote control apparatus especially designed to control an electrical appliance which is a television receiver or VCR or similar, the remote control apparatus comprising cleaning means (8, 50, 21, 31) for cleaning the electrical appliance."

VII. Claim 1 of the second auxiliary request is worded as follows:

"An electronic remote control apparatus especially designed to control a television receiver or VCR, the remote control apparatus comprising cleaning means (8, 50, 21, 31) for cleaning the electrical appliance."

VIII. The appellant essentially argued as follows:

The invention was concerned with remote controls for television receivers or VCRs or similar types of devices. The wording "such as a television receiver or VCR" used in claim 1 (main request) was a limitation of the claimed apparatus which should not have been simply ignored. The vacuum cleaner of D1 was not a television receiver or VCR or similar, and not suitable for cleaning an electric appliance of the type addressed by the present invention (cf the paragraph bridging pages 1 and 2 of the application as filed). Thus the subject matter of claim 1 was novel over D1.

Contrary to what might be said of examples in the Guidelines for Examination (in particular C-IV, 9.8, 9.9 and C-IV, Annex), in the present case, the combination itself, that of a remote control with cleaning means for cleaning the controlled device, was not obvious. The argument of the examining division was clearly a hindsight analysis, with knowledge of the invention, not based on a real-life assessment. The simplicity of the present invention should not negate the fact that a technical contribution had been made. The invention amounted to something new and useful, and the applicants should not be denied protection as a

result of an academic, rigid and distorted application of an example in an Annex in the Guidelines, rather than a real-life assessment of what constituted an invention, as reflected by Article 56 EPC.

In any case, there was a synergism between the remote control and the cleaning means in that the size of cleaning means integrated with a remote control was ideal for cleaning a device controlled by the remote control, for example, the screen and buttons of the controlled device. If one saw a product corresponding to claim 1 in a shop, the reaction would be "oh, that's a good idea". This was much more persuasive that an inventive step was involved than the approach adopted by the examining division (see also the reference in the decision to a gimmick in a scene from a Bond movie). Despite searches by at least the search examiner and the primary examiner, nothing remotely similar to the present invention had been found. This was an indication that the subject-matter of claim 1 was not obvious.

IX. With the summons to oral proceedings dated 24 February 2005, the Board sent a communication under Article 11(1) Rules of procedure of the Boards of Appeal (RPBA). Two matters of special significance were mentioned therein.

Firstly, it was not clear what was implied in general by the remote control and cleaning functions, because that would vary depending on the type of electrical appliance, on the kind of remote control (simple on/off or more complex) and on the cleaning functions (to remove dirt, dust, stains, etc). Claim 1 of the main request and first auxiliary request, respectively,

specified much broader classes of electrical appliances ("such as", "or similar") than claim 1 of the second auxiliary request (and even the latter did not specify any features of the remote control or of the cleaning means, or of the manner in which they were held together).

Secondly, concerning inventive step of the subject-matter at the level of generality specified in claim 1 of all three requests, the question whether the recited features had to be seen as an obvious aggregation of known elements, or as their non-obvious combination, would depend on the embodiments which might be reasonably said to be covered by the claims. Claim 1 of all the requests would cover any known remote control apparatus which was especially designed to control a television receiver or VCR (see eg D5) and which was arranged in any manner together with a known cleaning means, suitable for cleaning the controlled television receiver or VCR (eg generally known cleaning means, such as a brush or a sheet of cloth). The arrangement of the apparatus might be such that the cleaning means was only loosely attached to the remote control apparatus.

The appellant's arguments as to the combination and the synergistic effect seemed to be based on particular embodiments as shown in Figures 1 to 10 of the present application, where the person would be influenced by the size, form and function of the familiar remote control and the specific cleaning means which was integrated in the casing in a particular way. A synergistic effect could not be attributable to any arbitrary arrangement of the known elements.

- X. With a letter dated 10 June 2005, the appellant announced he would not attend the oral proceedings and withdrew the request for oral proceedings.
- XI. Oral proceedings were held on 13 September 2005 in the absence of the appellant. The Board noted that the appellant implicitly requested that the decision under appeal be set aside and that a patent be granted on the basis of the application documents on file (main request), or claim 1 as amended according to the first or second auxiliary request filed with the statement of grounds of appeal received on 27 March 2003, with the remaining application documents unchanged.

Reasons for the Decision

1. The appeal is admissible.
2. Claim 1 (all requests) specifies an electronic remote control apparatus comprising cleaning means. It is not in dispute that such remote control apparatus *per se* are generally known, eg those which are especially designed to control a television receiver or VCR. The same can be said of cleaning means for cleaning an electrical appliance in general, or a television receiver or VCR in particular. The appellant argues that the present invention resides in the combination of these features. The decision under appeal considered the subject-matter of claim 1 (main request) as a mere aggregation of features with no combinative effect.

3. It is established jurisprudence of the Boards of Appeal (cf Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, I.D.6.4.1 and similarly in the Guidelines for Examination, in particular C-IV, 9.5 and Annex to chapter C-IV) that a combination of known elements may be patentable. This has been accepted for combination inventions where the subject-matter as claimed produces a technical effect which goes beyond the sum of the individual (and known) effects of a mere aggregation, showing a combinative effect in a non-obvious combination.

4. When individually known entities are specified as elements of a claimed apparatus as in the present case, the character of the combination is particularly important for deciding what the claimed invention is, a mere aggregation or a non-obvious combination. Since a particular technical effect has to be present over the whole range of the claimed invention, it is not sufficient if such an effect is apparent only in embodiments which combine specific ones of the groups of known entities in a specific way.

5. Claim 1 (all requests) specifies apparatus "comprising" cleaning means. Nothing more is said about the combination as such. For example, claim 1 does not specify any technical features relating to the combination, such as specific cleaning means which are part of the casing of the remote control as in the embodiments of Figures 1 to 10 of the present application. Nor do the individual entities implicitly characterize the combination in a clear manner because they specify very broad classes of remote control apparatus and cleaning means. Even the narrowest

definition of the remote control, as in claim 1 of the second auxiliary request, merely specifies that it is especially designed to control a television or VCR, without specifying any remote control functions or physical characteristics of the remote control. The cleaning means merely has to be suitable for any cleaning of (parts of) the electrical appliance which is a television or VCR or similar according to claim 1 of the first auxiliary request, and probably meant to be the controlled television or VCR, although not specified as such, according to claim 1 of the second auxiliary request.

6. At this level of generality of a combination of two known entities, it is not clear which technical effect is produced by the combination and what, on a technically meaningful construction, may be reasonably said to be covered by the claims. The terms "apparatus comprising cleaning means" leave the boundaries of the matter for which protection is sought unclear. Therefore, claim 1 of the main request and that of the first and second auxiliary requests do not clearly define the matter for which protection is sought, contrary to what it is required by Article 84 EPC.
7. The Board had drawn attention to this lack of clarity in the communication accompanying the summons to oral proceedings (see point IX above). The appellant did not file any amendments or observations and did not attend the oral proceedings. The Board thus had to decide on the submitted text of the claims (Article 113(2) EPC) and had no obligation to delay its decision by reason only of the absence of the appellant at the oral proceedings (see Article 11(3) RPBA).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Sauter

W. J. L. Wheeler