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**Datasheet for the decision
of 19 January 2007**

Case Number: T 0805/03 - 3.5.04

Application Number: 96104764.4

Publication Number: 0737006

IPC: H04N 5/445

Language of the proceedings: EN

Title of invention:

Customizable menu for a television receiver accessed via a remote control keyboard

Patentee:

THOMSON CONSUMER ELECTRONICS, INC.

Opponent:

IGR GmbH & Co. KG.

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56, 101(2), 113(1)

EPC R. 57(3), 67

Keyword:

"Novelty and inventive step (yes) after amendment"

"Examination of opposition - no need for a communication by the opposition division"

"Substantial procedural violation (no)"

Decisions cited:

-

Catchword:

No general obligation for the opposition division to issue a communication despite a request by a party (see points 5.1 and 5.2)



Case Number: T 0805/03 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 19 January 2007

Appellant:
(Opponent)

IGR GmbH & Co. KG.
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D-40210 Düsseldorf (DE)

Representative:

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Respondent:
(Patent Proprietor)

THOMSON CONSUMER ELECTRONICS, INC.
10330 North Meridian St.
Indianapolis, IN 46206 (US)

Representative:

Lindemann, Robert
Thomson Holding Germany GmbH & Co. OHG
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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 11 June 2003
rejecting the opposition filed against European
patent No. 0737006 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: F. Edlinger
Members: A. Dumont
B. Müller

Summary of Facts and Submissions

- I. The opponent lodged an appeal against the decision of the opposition division to reject the opposition against the European patent EP 0 737 006.

- II. The opposition had been filed based on Article 100(a) EPC on the ground that the subject-matter of the patent was neither new nor did it involve an inventive step in view of the following prior art:

D1: DE 42 01 031 C2;

D2: EP 0 476 842 A2;

D3: SCHNELL H-F, "Die DOS-SHELL individuell anpassen" in CHIP TOOL, September 1989, pages 74 to 79.

- III. The patent proprietor filed observations in reply to the notice of opposition.

- IV. The opposition division communicated the proprietor's observations with a brief communication dated 4 March 2003 without setting a time limit and issued the decision under appeal, which is dated 11 June 2003, without having previously issued a communication pursuant to Article 101(2) EPC.

- V. With its statement setting out the grounds of appeal, the appellant referred to the following additional prior art document, acknowledged in the introductory part of the patent specification:

D4: "User Interface Shortcut" in IBM Technical Disclosure Bulletin, Vol. 33, No. 3A, pages 413 and 414, August 1990.

VI. Oral proceedings took place on 19 January 2007 in the absence of the appellant, who had informed the board that he would not attend them. The respondent (patent proprietor) submitted a new set of claims 1 to 5 in the oral proceedings.

VII. Claim 1 reads as follows (features added with respect to claim 1 as granted have been set in italics and features deleted have been struck through):

"A method for programming a user definable menu for a television apparatus comprising the steps of:
selecting (640) one user controllable function from a list of user controllable functions *affecting the processing of the television signal*;
selecting (655) one of a limited number of programmable locations defined in said user definable menu; and
assigning (655) said selected user controllable function to said selected ~~slot~~ location,
wherein selecting and assigning is performed by means of remote control keys, and wherein the functions assigned to the user definable menu can be accessed for execution by recalling the user definable menu."

Claims 2 to 5 are dependent claims.

VIII. The appellant requested in writing that the decision under appeal be set aside and that the European patent No. 0 737 006 be revoked. Furthermore the appellant requested that the appeal fee be reimbursed.

IX. The respondent requested that the decision under appeal be set aside and that the patent be maintained in the following version:

- claims 1 to 5 submitted in the oral proceedings and
- description and figures of the patent specification.

X. The arguments of the appellant (opponent) relate to claim 1 as granted and may be summarised as follows.

- D1 discloses a method for programming an on-screen menu for a television set. The user may interactively determine a profile reflecting its interests, using a remote control unit. The profile effects a preselection of information items for TV programs of interest and therefore corresponds to the first selection step of claim 1. Thereafter the user may select and edit particular information items in the menu and mark them for various control functions ("Steuerfunktionen"), thereby assigning a function to a selected location. Although the user-controllable nature of the menu items and functions involved may play a role when the menu is actually used as taught in the opposed patent, it is immaterial for the claimed method of menu programming, which consists only in the selection and assignment of icons or labels in a list. Thus the subject-matter of claim 1 as granted is not new or at least not inventive.

- D2 discloses a method for programming a user definable menu in which the user may choose whether menu items associated with user definable functions (e.g. sound mode) should be displayed or hidden on the television screen. The items selected for display are assigned a fixed location on the screen. Since claim 1 as granted does not exclude this possibility, its subject-matter is not new or at least not inventive.

- D3 discloses an interactive configuration of a user interface comprising DOS shell menus according to individual preferences of the user. It relates to computer menus, not to menus for a television apparatus. However, in view of the fact that the skilled person designing menus for a television apparatus resorts to a computer for doing so and is therefore acquainted with the principle of user definable menus and in view of the fact that the principle of user definable menus for television receivers is already known from D2, the teaching of D3 is transferable to television menus without involving an inventive step.

- D4 discloses the programming by the user of a list of shortcuts pointing to functions, rendering obvious the selection of menu functions from a hierarchical tree structure.

- Reimbursement of the appeal fee by reason of a substantial procedural violation, namely not respecting the right to be heard, should be ordered. The opponent internally registered, as usual, a time limit of four months for replying to the

communication of 4 March 2003. However, the opposition division issued its decision prior to expiry of four months even though it had granted a period of six months to the proprietor for a reply and despite the appellant's request for an official communication, thereby depriving the opponent of the possibility to present his comments.

XI. The arguments of the respondent (patent proprietor) may be summarised as follows.

- Claim 1 defines a method for obtaining a simplified menu out of the full list of existing user controllable functions affecting the processing of the television signal. D1 merely presents the user with a complete list of preselected TV programs and does not allow the user to obtain a reduced list, or menu, of particular control functions assignable to selected locations in the menu.
- D2 is concerned with opting out items not to be displayed on the TV screen. It leaves the underlying menu structure unchanged and does not allow the user to change the location on the display. It is therefore not relevant to the invention.
- D3 relates to a method for programming a user definable menu for a computer. Adding a menu item requires knowledge of the exact syntax for the corresponding program and its parameters. Similarly, D4 relates to a method for programming a shortcut list requiring the definition of the destination menu and contextual information for each shortcut. These computer-specific techniques require complex

data entry which is a priori not transferable to a television system operated with remote control keys by a non-technical user.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

Claim 1 has been limited by the features set in italics in the claim reproduced in point VII above. User controllable functions affecting the processing of the television signal can be found in claims 1 and 6 as originally filed. The selecting and assigning of such functions by means of remote control keys is directly derivable from the use of the remote control shown in figure 4. The feature specifying that the functions assigned to the user definable menu can be accessed for execution by recalling the user definable menu is directly derivable from the application as filed (see the corresponding passage in column 2, lines 5 to 9 of the patent specification). The feature "selected slot" in claim 1 as granted was replaced by "selected location". In the judgment of the board, this amendment is merely of a declaratory nature. A person skilled in the art would have understood from the context of claim 1 in the patent specification that the expression "selected slot" actually meant selected location as referred to in the preceding step of "selecting (655) one of a limited number of programmable locations". This is confirmed by the original text of claim 1 on the basis of which the patent was granted, where the

term "slots" had been replaced in handwriting by the term "locations" (a term used throughout the application) in the selecting step, but retained in the following assigning step. The amendments therefore comply with Articles 123(2) and (3) EPC.

3. *Novelty*

3.1 Claim 1 now sets out that the method steps result in a user definable menu which, when recalled by the user, allows the functions to be accessed for execution, i.e. that a particular function may be executed by accessing the (limited) user definable menu of (favourite) functions in addition to the (full) list of available functions. Functions within the meaning of claim 1 are those "affecting the processing of the television signal", typically brightness, contrast and colour, etc (see for instance paragraphs [0003] and [0014] and figures 1 to 4 and 7 of the patent specification). One of these functions is selected from a list and assigned to a selected one of a limited number of locations. In other words, a favourite function is assigned to a particular location in the user definable menu (see for example paragraphs [0005] and [0008] of the patent specification).

3.2 D1 discloses a television receiver in which a selector preselects the TV programs matching categories (e.g. information, classical music, entertainment, ...) of interest for the user which are stored in a profile ("Interessenprofil"), in order to allow quicker menu editing; see column 1, lines 46 to 51 and column 3, lines 27 to 54. The user may manually process the list of items ("Informationsitems") corresponding to the

preselected programs using on-screen menu techniques, in particular he may mark particular TV programs for particular control functions ("Steuerfunktionen"), such as automatic recording ("Mitschnitt"); see column 4, lines 14 to 25.

Even if marking TV programs in a menu for particular control functions were construed as an assigning step in D1, nothing hints at making the particular functions accessible for execution by recalling the menu of TV programs. D1 therefore does not disclose a method resulting in a user definable menu of accessible functions in the meaning of present claim 1.

3.3 D2 is concerned with selectively erasing unwanted menu items in a standard menu in order to produce a simplified menu to be displayed on a television screen; see column 1, lines 49 to 54 and column 5, lines 20 to 27. The simplified menu can therefore be regarded as a user definable menu. However nothing in D2 hints at the possibility of assigning the functions to (particular user) selected locations in the menu or on the screen, or at the possibility of accessing a function for execution by recalling the on screen menu.

3.4 D3 and D4 are concerned with the design of user definable menus for a computer, not for a television apparatus. Therefore they do not disclose selecting and assigning functions which affect the processing of the television signal. Furthermore the use of remote control keys is not disclosed in these documents.

3.5 In conclusion the subject-matter of the claims is considered to be new with respect to the prior art cited in the proceedings (Article 54(1, 2) EPC).

4. *Inventive step*

4.1 Menus for television apparatus control have become increasingly complicated. The claimed invention allows a user to program a user definable menu of functions as set out above (see point 3.1) so as to allow quicker access to a favourite function by recalling the (simplified) user definable menu (see paragraphs [0001], [0002] and [0005] of the patent specification).

4.2 This technical problem had not been addressed in the field of television at the priority date, but it had been addressed in the field of computers according to D3 (see page 75, left-hand column: "...Menüsystem je nach Wunsch auszubauen und umzugestalten.") and D4 (see page 413: "...a computer software technique that allows a user to define a single step function to navigate directly to the function they wish to perform rather than repeating multiple user interactions"). In D3 the DOS shell may be freely adapted to individual preferences, allowing the user to program a menu by selecting one or more functions from the available DOS functions and assigning them to locations of a drop-down menu. The technique of D3 is directed to a user showing enough interest to fill in the exact syntax of the DOS function, and possibly its parameters if required (see page 74, left-hand column ("bietet sich dem engagierten DOS-Benutzer") and page 79, left-hand column, lines 10 to 19). In D4 the user may freely design a shortcut list (figure 2) pointing to

application programs arranged in a hierarchical tree structure (figure 1). Defining a shortcut requires entering both a destination in the tree structure and further contextual information or data to be used to execute the destination function (see last paragraph on page 414). Both documents therefore imply the use of a computer keyboard for alphanumerical data entry by a proficient user (command line interface).

4.3 The board notes that menus of control functions were already generally known, as attested in paragraph [0002] of the patent specification, and that the need for a simplification had been recognised in a television apparatus according to D1 or D2. The board accepts that a remote control may have constituted an alternative to an alphanumerical keyboard as an input device in a television apparatus, at least for graphical menu-driven data entry (see D1, column 3, lines 27 to 54). It is also recognised that the person skilled in the field of designing interfaces for television system, as opposed to the normal end user, may be conversant with menu and command line techniques typical for the computer field.

4.4 However, selecting and assigning of user controllable functions by means of remote control keys, that is entering the alphanumerical data necessary to create a user definable menu or shortcuts in accordance with the teaching of the prior art, would render the programming excessively complex for the end user, which is precisely what the method of the present invention, directed to programming by the layman, seeks to prevent. As a result, the board is not convinced that a person skilled in the art of designing television interfaces

would, at the priority date of the opposed patent, have contemplated making the menu programming technique known for computers available to end users of television systems.

4.5 As a result the subject-matter of claim 1 and of dependent claims 2 to 5 is considered as involving an inventive step (Article 56 EPC).

5. *Reimbursement of the appeal fee*

5.1 Article 101(2) EPC provides that, "in the examination of the opposition, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Opposition Division shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Opposition Division, on communications from another party or issued by itself". Rule 57(3) EPC implements this requirement for the proprietor's reply to the notice of opposition and provides that the "observations and any amendments filed by the proprietor of the patent shall be communicated to the other parties concerned who shall be invited by the Opposition Division, if it considers it expedient, to reply within a period to be fixed by the Opposition Division". The opposition division therefore has no general obligation to issue a communication inviting the opponent to reply within a fixed period, but has to exercise its discretion as to whether this is "necessary" and "expedient" in the given circumstances (see also Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, page 451, VII.C.2.2.1 and VII.C.2.2.2).

5.2 In the present case the patent proprietor filed observations in reply to the notice of opposition, which observations only contained arguments as to the relevance of the prior art cited by the opponent against his invention. The appellant alleges a violation of the right to be heard provided for in Article 113(1) EPC but does not assert that the appealed decision is based on new grounds or evidence on which he has not had an opportunity to present comments. Rather, he objects that his request for a communication has not been satisfied. However, the request was made in the notice of opposition in a standardised manner and was not accompanied by reasons as to why a communication was necessary. Since the opposition division has no general obligation to issue a communication setting out its preliminary opinion in advance, it was entitled to exercise its discretion to refuse the appellant's request in the present case. The fact that the appellant had internally set a time limit of four month for replying to the observations by the patent proprietor is irrelevant in this respect because it is based on an incorrect interpretation of the relevant procedural rules and the opposition division was not informed of this situation.

5.3 The board thus comes to the conclusion that the opposition division has not exercised its discretion in an unreasonable way and has not exceeded the proper limits of its discretion by not issuing a communication and taking a decision roughly three months after communicating the patent proprietor's observations. Reimbursement of the appeal fee in application of Rule 67 EPC would not therefore be equitable.

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:
 - claims 1 to 5 submitted in the oral proceedings and
 - description and figures of the patent specification.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

D. Sauter

F. Edlinger