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**Datasheet for the decision
of 17 July 2014**

Case Number: T 0579/10 - 3.5.04

Application Number: 99921072.7

Publication Number: 1038394

IPC: H04N5/63

Language of the proceedings: EN

Title of invention:

SYSTEM OF APPARATUS AND PERIPHERALS

Applicant:

Koninklijke Philips N.V.

Headword:

Relevant legal provisions:

EPC 1973 Art. 54(1), 84, 111(1)

Keyword:

Claims - clarity (no)

Novelty - auxiliary request (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



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Chambres de recours**

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Case Number: T 0579/10 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 17 July 2014

Appellant: Koninklijke Philips N.V.
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Representative: Verweij, Petronella Danielle
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 6 November 2009
refusing European patent application
No. 99921072.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman F. Edlinger
Members: C. Kunzelmann
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 99 921 072.7 under Article 97(2) of the European Patent Convention (EPC).
- II. The decision under appeal referred to the following prior-art documents
 - D1: EP 0 785 679 A2,
 - D2: US 4 912 463 A, and
 - D3: US 5 473 305 A.
- III. The application was refused on the grounds that the subject-matter of the independent claims of the main request was not new (Article 54(1) EPC) over document D1, and that the subject-matter of the independent claims of the auxiliary request then on file did not involve an inventive step (Article 56 EPC) in view of D1, D2 and D3.
- IV. The applicant appealed and requested that the decision be set aside.
- V. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to a summons to oral proceedings dated 13 February 2014. In this communication the board *inter alia* expressed doubts as to whether claim 1 of the main request was clear (Article 84 EPC 1973).
- VI. The appellant replied with a letter dated 9 April 2014. In this letter the appellant submitted arguments concerning the board's objections. With the letter the

appellant also filed claims according to a new auxiliary request replacing those of the auxiliary request underlying the decision under appeal.

- VII. In a further letter dated 21 May 2014 the appellant informed the board that it would not be attending the oral proceedings and requested a decision according to the state of the file.
- VIII. Oral proceedings were held by the board on 22 May 2014, in the appellant's absence, in application of Rule 71(2) EPC 1973 and Article 15(3) RPBA. The chairman noted that the appellant had requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request underlying the decision under appeal, or on the basis of the claims of the auxiliary request filed with the letter dated 9 April 2014.
- IX. Claim 1 of the main request reads as follows:
- "An apparatus comprising control means for controlling a function of the apparatus in response to a user command, the apparatus being connectable to a peripheral and the control means being adapted to send a control command to the peripheral in response to said user command for controlling a similar function of the peripheral, the control means further comprising user operable means for assuming a first state and a second state, the control means being adapted to send the control command to the peripheral in response to said user command in the second state, characterized in that the control means is further adapted to refrain from sending the control command in response to said user command and to control the function of the apparatus corresponding to said user command in the first state."

X. Claim 1 of the auxiliary request reads as follows:

"An apparatus comprising control means for controlling a function of the apparatus in response to a user command, the apparatus being connectable to a peripheral and the control means being adapted to send a control command to the peripheral in response to said user command for controlling a similar function of the peripheral, the control means further comprising user operable means for assuming a first state and a second state, the control means being adapted to send the control command to the peripheral in response to said user command in the second state, characterized in that the control means is further adapted to refrain from sending the control command in response to said user command and to control the function of the apparatus corresponding to said user command in the first state, wherein the control means assume the first state by default and said user command comprises pressing a button, and the control means is further adapted to assume the second state when a user holds the button down for a predetermined period of time after pressing of the button and/or is further adapted to assume the second state when a user presses the button a second time within a predetermined period of time after pressing of the button."

XI. Claim 4 of the auxiliary request reads as follows:

"A system comprising an apparatus and a peripheral, the apparatus comprising control means for controlling a function of the apparatus in response to a user command, the apparatus being connectable to the peripheral and the control means being adapted to send a control command to the peripheral in response to said user command for controlling a similar function of the

peripheral, the control means further comprising user-operable means for assuming a first state and a second state, the control means being adapted to send the control command to the peripheral in response to said user command in the second state characterized in that the control means is further adapted to refrain from sending the control command in response to said user command and to control the function of the apparatus corresponding to said user command in the first state, wherein the control means assume the first state by default and said user command comprises pressing a button, and the control means is further adapted to assume the second state when a user holds the button down for a predetermined period of time after pressing of the button and/or is further adapted to assume the second state when a user presses the button a second time within a predetermined period of time after pressing of the button."

XIII. Claim 9 of the auxiliary request reads as follows:

"A method of controlling an apparatus and a peripheral, comprising the steps of controlling a function of the apparatus in response to a user command and sending a control command to the peripheral in response to said user command for controlling a similar function of the peripheral, the method further comprising the step of assuming either a first or a second state, the control command being sent to the peripheral in response to said user command in the second state, characterized in that in the first state the control command is not sent to the peripheral in response to said user command and the function of the apparatus is controlled corresponding to said user command, wherein the method comprises assuming the first state by default and said user command comprises pressing a button, and the

method further comprises the step of assuming the second state when a user holds the button down for a predetermined period of time after pressing of the button and/or the step of assuming the second state when a user presses the button a second time within a predetermined period of time after pressing of the button."

XIII. The reasons for the decision under appeal may be summarised as follows:

Lack of novelty (main request)

D1 (figure 1 and the corresponding description) disclosed a television apparatus comprising control means for controlling a function of the apparatus in response to a user command, the television apparatus being connectable to a peripheral (such as a video recorder) and the control means being adapted to send a control command to the peripheral in response to said user command for controlling a similar function of the peripheral. This mode of operation corresponded to the apparatus having assumed a second state specified in claim 1 of the main request. D1 also disclosed a standby condition in which the data connection between the television apparatus and the peripheral was deactivated. In this state a relay of commands was not possible. This mode of operation constituted a first state as specified in claim 1 of the main request. Furthermore, the television apparatus or the peripheral could be individually reactivated from the standby condition, without necessarily reactivating the data connection and the connected devices. Hence the apparatus of D1 had all the features specified in claim 1 of the main request, even if the ambiguous

wording of claim 1 was given the specific interpretation suggested by the applicant.

The other independent claims were found not to be allowable for the same reasons.

Lack of inventive step (auxiliary request)

D1 disclosed that a transition to a first state in accordance with claim 1 of the auxiliary request could be brought about by depressing an appropriate combination of buttons on a remote control. D1 did not disclose the particular button depression mechanisms resulting in the transition to a second state. But there was a vast repertoire of translating control button operations into transmitted messages and subsequent operating state transitions of the receiving apparatus. The particular button allocations lay within the normal competence of a person skilled in the art. Button depression time of more than two seconds resulting in a different signal was known from D2. Depressing a button twice within a predetermined period of time resulting in a different signal was known from D3. Hence the apparatus of claim 1 of the auxiliary request lacked an inventive step.

The other independent claims were found not to be allowable for the same reasons.

XIV. The appellant's arguments may be summarised as follows:

Lack of novelty (main request)

The reasons for the decision were based on a claim interpretation in which the two states specified in claim 1 were states of the (television) apparatus. In

particular, the first state was equated to a standby state. This interpretation was at odds with the language of claim 1. The first state and the second state were assumed by the control means (and in particular the user operable means comprised therein), not by the apparatus itself. The first state and the second state of the control means determined the effect of the user command (such as a standby command). Depending on the state assumed by the control means, only the apparatus or the apparatus and the peripherals assumed the standby state. The invention solved the problem of enabling a user to easily control whether a function was invoked either on the apparatus only or simultaneously on the apparatus and one or more of its peripherals, without the need for a duplicate control for each function.

D1 aimed at solving a different problem, namely maximising power saving by putting both the main device and the peripheral devices into a standby mode. In D1 it was not possible to influence whether the standby button on the remote control resulted in the peripheral entering the standby mode or not. In the case of reactivation of an apparatus which had gone into a standby mode, D1 did not disclose that the reactivation signal was not relayed to a peripheral, either. Hence D1 did not disclose the features of the characterising portion of claim 1 of the main request.

Auxiliary request

The objection of incorrect claim interpretation raised in the context of the main request applied to the auxiliary request as well. Moreover, even if a person skilled in the art had modified the system of D1 such that it would be possible for a user to choose whether

a standby command was also sent to a peripheral, he/she would simply have added a second standby button in the same way as in the prior-art system described on page 1, lines 23 to 29 of the description as filed. The use of a single button was more intuitive for a single function (e.g. the standby function).

Reasons for the Decision

1. *Main request:*

Clarity of claim 1 (Article 84 EPC 1973)

1.1 Claim 1 refers to a "user command". A number of features of the apparatus of claim 1 are defined by a reference to this user command.

First, the control means are arranged for controlling a function of the apparatus in response to the user command.

Second, the control means (when in a second state) are adapted to send a control command to the peripheral in response to said user command, for controlling a similar function of the peripheral.

Third, the control means (when in a first state) are adapted to refrain from sending the control command in response to said user command and to control the function of the apparatus corresponding to the user command.

Thus the "user command" relates to the controlling of a function of an apparatus and also to the controlling of a similar function of the peripheral.

1.2 However, in the present application one and the same user command cannot have the effect of the control

means **controlling a function of the apparatus** only (by refraining from sending the control command to the peripheral) and of the control means sending a control command to the peripheral, for **controlling a similar function of the peripheral**. In the context of the present application, the user may choose both the apparatus ultimately responding to his/her user command (such as either a television apparatus and/or a peripheral) and the function to be performed by the chosen apparatus (such as a standby function or a power-on function). Thus a user command putting only the apparatus in a standby state is different from a user command putting the apparatus and the peripherals in a standby state. The distinct user commands are made distinguishable to the control means by issuing different signals from one button or by using an additional button (see page 5, lines 2 to 8 and lines 30 to 32).

1.3 This is confirmed by the wording of claim 1 which specifies that there is "a function of the apparatus" and "a **similar** function of the peripheral" (emphasis by the board) and also by dependent claims 3 and 4, which specify examples of how the user may select between two such user commands (and thus, ultimately between only the function of the apparatus and the function of the apparatus together with the similar function of the peripheral). Thus the reference to "said user command" in claim 1 is incorrect and leads to a lack of clarity of the claim.

1.4 The appellant's argument that a user command was, for instance, a standby command (and thus specified only a function) whereas the first state and the second state of the control means determined the effect of the user

command (i.e. the relevant apparatus) did not convince the board for the following reasons.

- 1.4.1 It is correct that claim 1 specifies that the control means comprises "user operable means for assuming a first state and a second state".
- 1.4.2 The board construes this feature to mean, in favour of the appellant, that it is the user (see "user-operable") who may put the control means (more particularly, the user operable means thereof) into the first or the second state. But even so, this user command of putting the control means into one of the first or second states necessitates user command signals which are distinguishable for the control means. However, the relationship of this user command to the user command discussed in points 1.1 to 1.3 above is not clear from the claim.
- 1.5 In view of the above, the board finds that claim 1 of the main request is not clear (Article 84 EPC 1973).

2. *Auxiliary request:*
Clarity (Article 84 EPC 1973)

- 2.1 The above objection does not apply to claims 1 and 4 of the auxiliary request. These claims specify that the control means assumes the first state by default and the user command comprises pressing a button. This user command results in the control means controlling the function (of the apparatus) corresponding to the user command. These claims also specify ways in which the user (using the same button) may switch the control means from the default state into the second (non-default) state. Thus the claims specify two different commands. The first one (pressing a button) in the

context of the application implies the selection of a particular button which corresponds to a function and also to a similar function. The second one (holding the button down for a predetermined period of time after pressing the button and/or pressing the button a second time within a predetermined period of time) causes the control means to assume the second state and thereby allows the selection of whether the control command is sent to the peripheral (for controlling the similar function of the peripheral).

- 2.2 Moreover, the above objection does not apply to claim 9 of the auxiliary request, even though claim 9 does not include the feature of control means and does not specify the element which may assume the first state and the second state. The claim nevertheless specifies two different commands as discussed in point 2.1 above and specifies the same ways in which the user may switch from the default state to the second (non-default) state.

3. *Auxiliary request:*
Novelty (Article 54(1) EPC 1973)

It is uncontested that D1 does not disclose the particular button depression mechanisms specified in the independent claims of the auxiliary request resulting in the transition to a second state. Documents D2 and D3 do not concern apparatus connectable to a peripheral. Thus the board finds that the subject-matter of independent claims 1, 4 and 9 is new (Article 54(1) EPC 1973).

4. *Auxiliary request:*

Inventive step (Article 56 EPC 1973)

4.1 The disclosure of D1

4.1.1 The embodiment illustrated in figure 1 of D1 discloses a method of controlling a television apparatus (TV set 1) and a peripheral (video recorder VCR 2, SAT receiver 3). The method comprises the steps of controlling a standby function of the television apparatus in response to a user command (see column 4, lines 34 to 39). It also comprises sending a control command (by changing the value of a status signal) to the peripheral (VCR 2 or SAT receiver 3) in response to said user command for controlling a standby function of the peripheral (see column 4, lines 39 to column 5, line 10). The method further comprises the step of assuming either a first or second state (the first state being the state in which the data connection between the television and the peripheral is deactivated, the second state being the state in which this data connection is activated, see column 2, lines 10 to 23). The control command (i.e. the value change of the status signal) invoking a standby function is sent to the peripheral in response to said user command in the second state.

4.1.2 Thus D1 discloses a method with the features of the pre-characterising portion of claim 9.

4.1.3 According to D1, if the television apparatus is put into standby mode the peripherals so too are (D1, column 4, lines 34 to 57). There is no disclosure that only the apparatus but not its peripherals are put into standby mode. Indeed, as convincingly argued by the appellant, the underlying problem in D1 (i.e.

maximising power saving) suggests that all the peripherals should be put into standby mode. If the user reactivates the television apparatus from the standby mode, the peripheral(s) may be reactivated as well if necessary ("ggfs. notwendige Aktivierung der benötigten Peripheriegeräte"; see D1, column 4, line 57 to column 5, line 6).

- 4.2 However, D1 does not disclose under which circumstances reactivation of a peripheral is necessary. It is clear that the configuration of the entire system would need to be considered. There is no disclosure of the user actively choosing (by means of a remote control, for instance) whether (or which) peripherals are reactivated from standby mode upon reactivating the television apparatus. Thus the problem underlying the present application (see page 2, lines 5 to 8 of the application as filed) is not addressed in D1.
- 4.3 Moreover, D1 does not disclose that in the first state (standby) the apparatus would refrain from sending any control command (standby command or other) in response to the user command.
- 4.4 In this respect the reasons for the decision under appeal (referring to D1, column 4, line 57 to column 5, line 6) refer to the possibility that individual devices may be reactivated, and that reactivation of a device need not cause reactivation of the data connection. However, in D1 the communication channel for sending a control command (by changing the value of the status signal) is permanently available, also in the case of a reactivation (see for instance column 2, lines 21 to 47 and column 4, line 57 to column 5, line 6). Depending on the system configuration, a value change of the status signal may result in activation of

the data connection between individual devices, but the status signal is not itself the control command. As discussed in point 4.1.3 above, this embodiment of D1 remains silent as to any user selection of the apparatus alone or the apparatus and individual devices between which the data connection should be activated.

4.5 The board notes that D1 discloses device identification in the context of a variation of the status signal illustrated in figure 6. However, this variation is not concerned with allowing the user to invoke a function either on a (television) apparatus only or simultaneously on the apparatus and its peripherals. Instead, this variation is concerned with selecting an individual (television) apparatus from a multitude of apparatuses (such as in a hotel).

4.6 In view of the above, the reasons given in the decision under appeal did not convince the board that the method of claim 9 lacked an inventive step. The same applies *a fortiori* to the subject-matter of claims 1 and 4, which each comprise the feature of control means comprising user operable means for assuming a first state and a second state.

4.7 Documents D2 and D3 are referred to in the decision under appeal only as disclosing, in isolation, certain button depression mechanisms. Thus they do not affect the above assessment.

5. *Remittal (Article 111(1) EPC 1973)*

5.1 The documents of the present auxiliary request are not yet ready for the grant of a patent. For instance, the description comprises embodiments, such as an embodiment with an additional button for invoking the

second state, which are not covered by the independent claims.

- 5.2 The board also notes that the problem of invoking functions either on the apparatus only or simultaneously on the apparatus and its peripherals is acknowledged to be known as background of the invention (see page 1, lines 22 to 29 of the application as filed), the known solution comprising two buttons on a remote control (for example, one for each of two standby functions).
- 5.3 In view of the above, the board decided to exercise its discretion in remitting the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated