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**Datasheet for the decision  
of 12 January 2017**

**Case Number:** T 1353/11 - 3.5.04

**Application Number:** 00992086.9

**Publication Number:** 1203492

**IPC:** H04N7/16, H04N7/173, G06F9/06,  
G06F9/44, G06F9/445, H04L29/06

**Language of the proceedings:** EN

**Title of invention:**

METHOD OF CONFIGURING A CONSUMER ELECTRONICS APPARATUS

**Applicant:**

Koninklijke Philips N.V.

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

Amendments - added subject-matter (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1353/11 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 12 January 2017**

**Appellant:**  
(Applicant)

Koninklijke Philips N.V.  
High Tech Campus 5  
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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted on 16 February  
2011 refusing European patent application  
No. 00992086.9 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** C. Kunzelmann  
**Members:** M. Paci  
B. Müller

## Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 00992086.9 published as international patent application WO 01/54406 A1.
- II. The decision under appeal was based on the grounds that claims 1 and 4 of the sole request did not meet the requirements of Article 123(2) EPC (added subject-matter) because of the expression "is absent from" in those claims. In the Reasons for the decision, the following prior-art document was referred to as evidence:  
  
D6: "Pronto intelligent remote control User Guide", Philips Electronics North America Corporation, 1998, pages i-iii and 6-105, XP001544617.
- III. With the statement of grounds of appeal the appellant filed amended claims according to a main request and first to third auxiliary requests, replacing all claims previously on file. The appellant also filed amended pages 1 to 15 of the description, replacing all the pages of the description previously on file.
- IV. In a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536), annexed to the summons to oral proceedings, the board informed the appellant *inter alia* that claims 1 and 4 of all the requests filed with the statement of grounds of appeal did not meet the requirements of Article 123(2) EPC.
- V. By a letter dated 23 December 2016, the appellant withdrew its request for oral proceedings, informed the

board that it would not attend the oral proceedings and requested a decision according to the state of the file. It did not submit any observations on the issues raised in the board's communication.

VI. The board held oral proceedings on 12 January 2017. As announced, the duly summoned appellant did not attend. The Chairman noted that the appellant had requested that the decision under appeal be set aside and that a European patent be granted with the claims of the main or the first to third auxiliary requests and the description pages filed with the statement of grounds of appeal. At the end of the oral proceedings, the Chairman announced the board's decision.

VII. Claim 1 according to the appellant's **main request** and **second auxiliary request** reads as follows:

"A method of enabling a consumer to program a handheld remote control device for control of a consumer electronics apparatus at run-time according to a preference of the consumer, wherein the handheld remote control device has a user-interface for control of the consumer electronics apparatus by the consumer at run-time, characterized in that

a configuration user-interface, operative to enable the consumer to configure the remote control device in advance for control of the consumer electronics system at run-time, is absent from the handheld remote control device;

the handheld remote control device has a data input for receiving control data as generated by interaction of the consumer with the server from a source external to the handheld remote control device;

the method comprises:

providing access to the server via a network for enabling the consumer to interact via the network with an application on the server via a further user-interface of another consumer electronics apparatus for generating the control data for programming the handheld remote control device according to the preference; and

providing the generated control data via the network to the other consumer electronics apparatus for transfer of the control data to the handheld remote control device."

- VIII. Claim 1 according to the appellant's **first** and **third auxiliary requests** reads as follows (additions to claim 1 of the main request are underlined, deletions are ~~struck through~~, long identical text portions are replaced by "[...]"):

"A method of [...], characterized in that a configuration user-interface, operative to enable the consumer to configure the remote control device in advance for control of the consumer electronics system at run-time is provided by a server rather than, ~~is absent from~~ the handheld remote control device; [...]."

- IX. The examining division's reasons for the decision under appeal may be summarised as follows:

Claims 1 and 4 specified that "a configuration user-interface, operative to enable the consumer to configure the remote control device in advance for control the consumer electronics system at run-time, is absent from the handheld remote control device".

The applicant cited as support for this amendment the passages on page 8, lines 11 and 12; page 4, lines 14 to 17; page 9, line 30, to page 10, line 9 and page 11, lines 28 to 30.

However, these passages did not allow to clearly and unambiguously derive this particular negative limitation ("a configuration user-interface [...] **is absent** from the handheld remote control device") for the following reasons:

These passages only provided support for first devices/systems (given examples were: A/V system, PVR, audio jukebox, high-end television) which were to be configured by second systems (given examples were: set-top box, PC, digital phone) (see page 10). The sentence bridging pages 9 and 10 mentioned that the first devices might **not** need a user-programming interface; however, the given device list for "first devices" did **not** include a remote control device.

The description also mentioned that once a first device was properly set up, all further operations could be performed with a "simple remote control" (page 8 [erroneously referred to as page 10 in the decision], lines 18 to 20). However, it remained open what features a simple remote control encompassed.

In a further example, an advanced remote control device (like the "Philips Pronto") was mentioned as a kind of mediator between "first" and "second" systems, wherein all the necessary procedures were uploaded into such an advanced remote control (page 8 [erroneously referred to as page 10 in the decision], lines 21-24). However, these advanced remote devices were able to be

configured by a user and were also able to configure other devices via macro functions (see D6, Chapter 4).

- X. The appellant's argumentation in the statement of grounds of appeal may be summarised as follows:

*Main and second auxiliary requests - Article 123(2) EPC*

The application as filed addressed the problems encountered by an end-user (consumer) of consumer electronics (CE) equipment when the CE equipment needed to be configured by the consumer for operational use. The problem resided in the fact that the user-interface (UI) of the CE equipment was typically not designed for efficiently configuring or setting up the CE equipment: see the application as filed, e.g. page 2, lines 1 to 19, page 6, line 15, to page 7, line 2, in conjunction with page 7, lines 21 to 23.

The application as filed proposed to solve this problem by enabling the user to configure a first CE equipment via a server, using the UI of a second CE equipment having a more suitable UI for entering text and navigating among menu options: see page 4, lines 6 to 17, and page 11, lines 24 to 30. As a result, the first CE equipment did not need a UI designed for setting up its configuration, e.g. an alphanumeric keyboard for entering text: see page 2, lines 20 to 24, page 9, line 30, to page 10, line 9, and page 11, lines 28 to 30.

The first CE equipment could thus be a simple box with a simple remote control that could be easily used: see page 2, lines 20 to 24.



Moreover, as stated on page 8, lines 12 and 13, of the application as filed, the setup UI was presented to the user and/or was developed at the server side, rather than on the end device side. The wording "rather than", as used in this portion of the application, had the meaning of "instead of", thus indicating that the setup UI was "absent from" the end device, and was provided on the server instead.

It was not disputed that the application as filed also mentioned an advanced remote control, such as the "Pronto". However, this advanced remote control was not used for setting up the configuration of a first CE equipment, because according to the invention as formulated on page 8, lines 11 to 23, the setup UI was implemented on the server, not on the end device. A remote control, be it simple or advanced, was generally regarded as forming part of the end device it controlled.

For the above reasons, the feature of claim 1 stating that "a configuration user-interface, operative to enable the consumer to configure the remote control device in advance for control of the consumer electronics system at run-time, **is absent from** the handheld remote control device" (bold added) was directly and unambiguously derivable from the application as filed.

Hence, claim 1 according to the **main request** and the **second auxiliary request** met the requirements of Article 123(2) EPC.

*First and third auxiliary requests - Article 123(2) EPC*

Claim 1 of the first auxiliary request only differed from claim 1 of the main request in that the expression "is absent from the handheld remote control device" had been replaced by "is provided by a server rather than the handheld remote control device".

The requirements of Article 123(2) EPC were met because the expression "rather than" was explicitly used in this context on page 8, lines 12 and 13, of the application as filed.

## **Reasons for the Decision**

1. The appeal is admissible.

*Main request and second auxiliary request - Article 123(2) EPC*

2. The board concurs with the examining division that it is **not** directly and unambiguously derivable from the application as filed that "a configuration user-interface, operative to enable the consumer to configure the remote control device in advance for control of the consumer electronics system at run-time, **is absent from** the handheld remote control device" (emphasis by the board), for the reasons set out below.

According to claim 1, the handheld remote control device is **programmable** by the consumer, i.e. the end user (see first line of the claim).

As pointed out under point 1 of the Reasons for the decision (summarised under point IX *supra*), the

application as filed mentions two types of remote control, simple ones and sophisticated ones (see e.g. page 7, lines 27 to 30). However, only the sophisticated ones, also referred to using expressions such as "advanced remote control", "universal programmable remote control" or "universal intelligent remote control" (see, for instance, page 8, line 21, page 5, lines 25 and 26 or page 7, lines 12 and 13), are said to be **programmable**. The disclosure relating to programmable remote controls in the application as filed is essentially based on the "Pronto" remote control marketed by the appellant before the earlier priority date of the present application (see page 7, lines 12 and 13). A "User Guide" for the "Pronto intelligent remote control" can be found in prior-art document D6 cited in the decision under appeal.

The most detailed disclosure as to the interaction between an advanced remote control and the setup process on a server is on page 8, line 11, to page 9, line 17, of the application as filed. It discloses that

- the setup process user interface (UI), for example for configuring the user's Personal TV recording system (PVR) preferences, is presented to the user and/or developed at the server side, rather than on the end device side (see page 8, lines 12 to 16);
- the server can host a variety of applications/interfaces that allow interface devices such as computers, web terminals, cellular phones, PDA's, high-end touch-screen universal remotes, etc., to interact with the setup process (see page 8, lines 16 to 18);
- the server or a computer can develop an adequate setup UI for an advanced remote control, such as Pronto. All the necessary procedures with GUI and corresponding IR commands can be loaded into the remote control as a \*.ccf file (see page 8, lines 20 to 23).

In the board's view, it cannot be derived directly and unambiguously from the above disclosure that a configuration user-interface (for configuring the remote control) **is absent from** the programmable remote control because

- (1) it is not clear at which stage the \*.ccf file is "loaded" into the remote control; it may be loaded at the factory; and
- (2) even assuming that the "adequate setup UI" is downloaded from the server (as a \*.ccf file), it still does not imply that the advanced remote control did not already contain a basic UI which could also be used during a setup process on the server. Indeed, according to D6 (Pronto's user guide), the Pronto remote control includes by default a touch screen (see page 7) and a virtual keyboard (see pages 36 and 37). In the board's view, these should be sufficient to allow a user to set up its preferences on a server.
- (3) Page 8, line 11 to page 9, line 17 concerns the configuration (set-up) of the CE apparatus, not of the remote control.

As to the appellant's argument that the expression "does not need" (used on page 10, line 1, of the application as filed) provides support for the negative feature, the board concurs with the examining division that it does not, because this expression refers to "first devices", but the given list of "first devices" does not include a remote control device.

The appellant also referred to page 13, lines 6 to 16, of the application as filed. However, this passage is one of several summaries of related patent applications filed earlier by the appellant. The present application as filed introduces these other applications by the

sentence "Reference is made to the following patent documents:" (see page 11, line 31). In the board's view, it is not directly and unambiguously derivable from the application as filed that these summaries describe features of the present invention.

For the above reasons, the board thus concurs with the examining division that claim 1 of the main and second auxiliary requests does not comply with the requirements of Article 123(2) EPC.

*First and third auxiliary requests - Article 123(2) EPC*

3. Claim 1 of the first and third auxiliary requests differs from claim 1 of the main (and second auxiliary) request in that the expression "is absent from the handheld remote control device" has been replaced by "is provided by a server rather than the handheld remote control device".
4. According to the appellant, the new expression is based on page 8, lines 12 and 13, of the application as filed reading "A setup process UI is presented to the user and/or developed at the server side, rather than on the end device side". The appellant further argued that the expression "rather than" had the meaning of "instead of".
5. The board notes that said passage on page 8, lines 12 and 13, of the application as filed relates only to the situation in which the UI of the setup process (for the CE apparatus) is presented to the user. The whole user-interface however must also include input means for the user to input its preferences. The board cannot find any disclosure in the passage cited by the appellant implying that not a single component of the

"configuration user-interface" - i.e. not even input means - is present in the remote control device.

Hence, claim 1 according to the first and third auxiliary requests does not meet the requirements of Article 123(2) EPC.

## Order

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

C. Kunzelmann

Decision electronically authenticated