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Datasheet for the decision of 29 September 2020

Case Number: T 0890/15 - 3.5.04

Application Number: 09807081.6

Publication Number: 2314068

IPC: H04N5/44, H04N5/445

Language of the proceedings: EN

Title of invention:
USING A/V DEVICE TO SEND CONTROLLED DEVICE COMMUNICATION-RELATED PARAMETERS TO PROGRAM REMOTE CONTROL

Applicant:
Saturn Licensing LLC

Headword:

Relevant legal provisions:
EPC Art. 56

Keyword:
main request and auxiliary request - inventive step (no)

Decisions cited:

Catchword:

Europäisches Patentamt
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Office européen des brevets

Beschwerdekammern

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Case Number: T 0890/15 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 29 September 2020

Appellant: (Applicant)	Saturn Licensing LLC 25 Madison Avenue New York, NY (US)
Representative:	D Young & Co LLP 120 Holborn London EC1N 2DY (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 11 December 2014 refusing European patent application No. 09807081.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	M. Paci
Members:	B. Le Guen
	B. Müller

Summary of Facts and Submissions

I. The appeal is against the decision to refuse European patent application No. 09 807 081.6, published as international application WO 2010/019421 A2.

II. The documents cited in the decision under appeal included the following:

D1: US 2001/0005197 A1

1.1 The decision was based on the grounds that:

(a) claim 1 of the two requests then on file related to unsearched subject-matter which did not combine with the originally claimed invention to form a single general inventive concept (Rule 137(5) EPC)

(b) the subject-matter of claim 1 of both requests lacked inventive step (Article 56 EPC) in view of the disclosure of document D1 combined with the common general knowledge of the person skilled in the art

(c) claim 7 of the main request (erroneously referred to as claim 14) lacked clarity (Article 84 EPC)

III. The applicant filed notice of appeal. With the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of a main request or an auxiliary request, both filed with the statement of grounds of appeal. The main request comprised claims 1 to 8 corresponding to the claims of the auxiliary request forming the basis for the decision under appeal. The auxiliary request comprised

amended claims 1 to 8. The appellant indicated a basis for the amendments in the application as filed and provided arguments as to why the claimed subject-matter combined with the originally claimed invention to form a single general inventive concept and why it involved an inventive step.

IV. The board issued a summons to oral proceedings. In a communication under Article 15(1) RPBA 2007 (Rules of Procedure of the Boards of Appeal in the version of 2007, OJ EPO 2007, 536), annexed to the summons, the board introduced the following document cited in the European search report into the appeal proceedings:

D5: US2007/0052547 A1

The board gave its preliminary opinion that the subject-matter of claim 1 of both requests then on file lacked inventive step (Article 56 EPC) in view of the disclosure of document D1 combined either with the common general knowledge of the person skilled in the art or with the disclosure of document D5. With respect to the auxiliary request then on file, the board expressed its provisional opinion that the additional feature of claim 1 "*wherein the audio-video device (24) is configured to display on a display (26) a mode currently selected on the remote control (10)*" related to a non-technical aspect which could not contribute to an inventive step and that, moreover, this additional feature, even if considered technical, was in any case obvious because it was known from document D5.

V. By letter dated 19 March 2020, the appellant filed amended claims 1 to 8 of an auxiliary request replacing the auxiliary request on file and provided arguments as to why the subject-matter of claim 1 of the main

request filed with the statement of grounds of appeal and the subject-matter of claim 1 of the auxiliary request involved an inventive step. With respect to claim 1 of the auxiliary request, the appellant submitted that the display of the mode currently selected on the remote control was of a technical nature (see letter of 19 March 2019, page 5, first to fifth paragraphs).

VI. As a precautionary measure against the spread of the coronavirus (COVID-19), the board cancelled the oral proceedings originally scheduled for 21 April 2020 and issued a new summons to oral proceedings. In a communication under Article 15(1) RPBA 2020 annexed to the new summons, the board drew the appellant's attention to the fact that should the display of the mode currently selected on the remote control be considered to be of a technical nature and should it be considered to not be (explicitly or implicitly) disclosed in document D1, document D5 may constitute the most promising starting point for an obvious development leading to the claimed solution.

VII. By letters dated 17 September 2020 and 24 September 2020, the appellant indicated that it would not attend the oral proceedings scheduled for 29 September 2020 but requested that oral proceedings take place in its absence.

VIII. In view of the above, the appellant's final requests are that the decision under appeal be set aside and that a European patent be granted on the basis of the claims of the main request filed with the statement of grounds of appeal or, alternatively, on the basis of the claims of the auxiliary request filed by letter dated 19 March 2020.

IX. Claim 1 of the main request reads as follows:

"An audio-video device (24) configured to present, in response to navigation signals wirelessly received from a remote control (10), a series of graphical user interfaces through which a user can navigate to select a component (38) to be controlled, the audio-video device in response transmitting to the remote control (10) communication-related information to enable the remote control to communicate with the component (38), the audio-video device comprising a storage medium bearing communication-related information loaded into the storage medium during manufacture, and the audio-video device further configured to periodically update the communication-related information from a network."

X. Claim 1 of the first auxiliary request reads as follows (the text added in comparison with claim 1 of the main request has been highlighted in italics):

"An audio-video device (24) configured to present, in response to navigation signals wirelessly received from a remote control (10), a series of graphical user interfaces through which a user can navigate to select a component (38) to be controlled, the audio-video device in response transmitting to the remote control (10) communication-related information to enable the remote control to communicate with the component (38), the audio-video device comprising a storage medium bearing communication-related information loaded into the storage medium during manufacture, and the audio-video device further configured to periodically update the communication-related information from a network,

wherein the audio-video device (24) is configured in response to signals wirelessly received from the remote control (10) to display on a video display (26) a mode currently selected on the remote control (10), the mode being a component type to be controlled, the component type being one of television, video disk player, video disk recorder, personal video recorder, music player, and games console."

XI. The arguments submitted by the appellant, as far as relevant to the present decision, may be summarised as follows.

Periodically updating, from a network, communication-relating information stored on the storage medium of an audio-video device has the effect that no network check is required when such information is requested by a user (statement of grounds of appeal, page 4, second paragraph; letter dated 19 March 2020, page 3, seventh and eighth full paragraphs). Starting from document D1, the objective technical problem is to improve the capabilities of the system (letter dated 19 March 2020, page 3, last full paragraph).

While it may be true that periodically updating communication-related information was well-known in the field of computer systems and computing devices before the priority date of the application, there was "*no suggestion or hint or indeed reason*" to do this with respect to configuring a remote control to receive periodic updates of communication-related information (statement of grounds of appeal, page 4, fifth paragraph).

The information downloaded periodically from the network in the system of document D5 is of a

fundamentally different nature than the codes disclosed in document D1 because it merely comprises "*device type / brand / code information, the codes being for display on a screen and manual entry into a remote control unit*". Thus, the "*skilled person would consider D5 as incompatible with D1*" (letter dated 19 March 2020, page 4, third full paragraph). Moreover, document D5 also discloses the option of downloading the codes on demand. Thus, even if the person skilled in the art had considered document D5 as relevant in light of the objective technical problem, they would have selected this option as it is more compatible with the teaching of document D1 (letter dated 19 March 2020, page 4, fourth full paragraph).

Reasons for the Decision

1. The appeal is admissible.

2. *The invention*

A programmable remote control is able to control electronic components of different types (personal video recorder, display player, music player, television, etc.), manufacturers and models. To control a component, communication-related information specific to the component must be previously stored on the remote control. The claims of the main and auxiliary requests relate to an audio-video device (claims 1 to 4) and a method (claims 5 to 8) facilitating the installation of communication-related information on a remote control. After selection of a component by a user on a graphical user interface presented by the audio-video device, communication-related information

specific to the selected component is transmitted to the remote control by the audio-video device. The communication-related information stored on the audio-video device is periodically updated from a network (main request, claim 1). Additionally, once the communication-related information has been installed on the remote control, the user may control the device by selecting a mode displayed on a video display (auxiliary request, claim 1).

3. *Both requests, claim interpretation*

3.1 The audio-video device defined in claim 1 enables a user to select a component to be controlled through a series of graphical user interfaces. It also comprises a storage medium bearing communication-related information periodically updated from a network.

3.2 In its reply dated 19 March 2020 (page 3, seventh full paragraph), the appellant submitted that the technical effect of this periodical update was that it permitted the provision of codes for devices not initially selectable by the user.

In the statement of grounds of appeal (page 4, second paragraph), the appellant submitted that the periodic update of the database had the effect that the database always contained the correct communication-related information for any component. This was in contrast with the system of document D1 in which the programming of a new component required a delay while the system found and downloaded the correct information from the network.

3.3 In view of this, the board deduces that, in the appellant's opinion, claim 1 should be construed as meaning that:

(a) only communication-related information corresponding to not yet selectable components is periodically downloaded from the network

(b) only components for which communication-related information has previously been loaded onto the storage medium of the audio-video device are selectable by the user when navigating through the series of graphical user interfaces

3.4 The board cannot accept this narrow interpretation of the claim. The aim of the periodical update of the communication-related information from the network is specified neither by the claim nor the description of the application as filed (page 4, lines 6 to 9). Thus, the periodical update may comprise the downloading of a communication-related information corresponding to already selectable devices (as well as communication-related information corresponding to not yet selectable devices). Moreover, the claim does not require that a component be only selectable if the communication-related information necessary to control it is already present in the storage medium of the audio-video device.

4. *Main request, inventive step (Article 56 EPC)*

4.1 According to Article 56 EPC, an invention is to be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

4.2 In the following, the board applies the established "problem and solution approach" for assessing whether

the invention claimed in claim 1 involves an inventive step (Case Law of the Boards of Appeal of the European Patent Office ("Case Law"), 9th edition 2019, I.D.2).

4.3 Document D1 may be considered the closest state of the art in the context of this approach.

4.4 Document D1 discloses a system made of a set-top computer and a television receiver (Figure 1, reference signs 12 and 14) enabling a user to navigate through a series of graphical user interfaces to select a component to be controlled by a remote control (paragraphs [0028] to [0031] and Figures 4a to 4c). In response to this selection, communication-related information is transmitted by the set-top computer to the remote control to enable the remote control to communicate with the component (paragraph [0034]). If the user selects a component for which no communication-related information is available in the storage medium of the set-top computer, it is downloaded from a network (paragraph [0035]).

4.5 It is common ground that the device of claim 1 differs from the device disclosed in document D1 in that it is configured to periodically update the communication-related information stored on the storage medium on the audio-video device from the network (see impugned decision, page 4, first full paragraph; statement of grounds of appeal, page 4, first indent; appellant's letter of reply dated 19 March 2020, page 2, lines 3 to 6).

4.6 In its letter dated 19 March 2020 (page 3, eighth full paragraph), the appellant submitted that this difference had the effect that no network check was required immediately following the user selection.

4.7 This argument is based on the appellant's view that claim 1 should be construed as meaning that only components for which communication-related information has previously been loaded onto the storage medium of the audio-video device are selectable by the user when navigating through the series of graphical user interfaces. However, the board does not accept this interpretation of the claim (see point 3.4 above).

4.8 Moreover, the board considers that the formulation of the problem proposed by the appellant in its letter dated 19 March 2020 (last full paragraph) ("*to improve the capabilities of the system of D1*") is too broad and does not reflect the actual contribution of the claimed invention to the state of the art.

4.9 For the board, the difference identified in point 4.5 above has the technical effect that communication-related information stored on the storage medium of the audio-video device is automatically updated instead of (or in addition to) being updated on demand. The problem to be solved starting from the disclosure of document D1 is therefore to find an alternative (or additional) way of obtaining communication-related information corresponding to components not yet covered by the database stored in the audio-video device.

4.10 The board shares the examining division's view that periodically updating communication-related information was well-known in the field of information technology before the priority date of the application (12 August 2008) (see impugned decision, page 4, first full paragraph).

4.10.1 In its statement of grounds of appeal (page 4, fifth paragraph), the appellant argued that while this may be true generally for computer systems and computing devices, there was "*no suggestion or hint or indeed reason*" to do this with respect to configuring a remote control unit to receive periodic updates of communication-related information. In its reply dated 19 March 2020 (page 3, sixth full paragraph), the appellant further argued that "*at the effective date of document D1, it may have been impractical (slow) to use a modem to update an entire database within an interactive procedure*".

4.10.2 The board does not find these arguments persuasive. The person skilled in the art starting from document D1 would have realised that if the communication-related information of a selectable component was already stored in the audio-video device at the time the component was selected, the communication-related information would have been more quickly transmitted to the remote control. This would have been a sufficient reason for querying the network periodically for communication-related information of selectable components for which no database entries existed in the storage medium of the audio-device. Moreover, the alleged impracticality of this solution on the "effective date" of document D1 is irrelevant since compliance of the subject-matter of claim 1 with the requirement of inventive step must be assessed taking into account the development made in the state of the art up to (but not including) the priority date of the application (12 August 2008).

4.11 In any case, the difference identified in point 4.5 above is disclosed by document D5.

4.11.1 Document D5 discloses a simplified system and method for manually setting up and configuring a universal remote control (paragraphs [0006] and [0007]). A user selects, via a graphical user interface presented on the screen of a television, the type and the brand of the device for which a code, to be manually entered into the remote control, is requested (paragraphs [0031] and [0032]). The code is fetched from a database stored, for example, on a set-top box (reference number 404 in paragraphs [0031]-[0032] and Figure 4). The database may be periodically updated from a network (paragraph [0023]) as an alternative to an on-demand update (paragraph [0042]).

4.11.2 The person skilled in the art, starting from D1 and faced with the problem of finding an alternative (or additional) way of obtaining communication-related information corresponding to components not yet covered by the database stored in the audio-video device, would have applied the solution taught in document D5 and would, in doing so, have arrived at the device of claim 1.

4.11.3 The appellant argued that the information downloaded periodically in the system of document D5 was of a fundamentally different nature than the codes disclosed in document D1 because it merely comprised "*device type / brand / code information, the codes being for display on a screen and manual entry into a remote control unit*". Thus, the "*skilled person would consider D5 as incompatible with D1*" (letter dated 19 March 2020, page 4, third full paragraph). Moreover, document D5 also disclosed the option of downloading the codes on demand. Thus, even if the person skilled in the art had considered document D5 as relevant in

light of the objective technical problem, they would have selected this option as it is more compatible with the teaching of document D1 (letter dated 19 March 2020, page 4, fourth full paragraph).

4.11.4 The board does not find these arguments persuasive.

The codes manually entered into the remote control in the system of document D5 and the codes automatically transmitted to the remote control in the system of document D1 are of the same nature in that they are used by the remote control to control specific components. The nature of the installation in the remote control - whether manual or automatic - has no bearing on the function of these codes once installed in the remote control.

In document D1, communication-related information is downloaded on demand. Thus, the person skilled in the art searching for alternative ways of obtaining codes would have considered other solutions disclosed in the state of the art, for example, the option of downloading this information periodically from the network (document D5, paragraph [0023]).

4.12 In view of the above, the board arrives at the conclusion that the subject-matter of claim 1 lacks inventive step in view of the disclosure of document D1 combined either with the common general knowledge of the person skilled in the art or the disclosure of document D5.

5. *Auxiliary request, inventive step (Article 56 EPC)*

5.1 The audio-video device of claim 1 of the auxiliary request differs from the audio-device of claim 1 of the

main request in that it is configured in response to signals wirelessly received from the remote control to display on a video display a mode currently selected on the remote control, the mode being a component type to be controlled, the component type being a television, video disk player, video disk recorder, personal video recorder, music player or games console.

5.2 In the system of document D1, the remote control communicates with the audio-video device using wireless communication (paragraph [0018]) and can be set up for controlling, among others, a television and a video disk player (paragraph [0002], Figure 4A).

5.3 Document D1 does not disclose displaying the mode currently selected on the remote control.

5.4 In its letter of reply dated 19 March 2020 (page 5, fourth paragraph), the appellant submitted that this feature allowed the user to determine whether the lack of response to an input by the device was due to an error in (or an absence of) the communication-related information or an incorrect mode selection by the user.

5.5 The board considers that the only technical effect of this feature is that the user gets a visual confirmation of their action (the selected mode). The subsequent determination of whether the lack of response to an input by the device is due to an error in (or an absence of) the communication-related information or an incorrect mode selection happens in the user's mind.

5.6 Visually confirming, on a video display, a selection made by a user on an input device (keyboard, mouse, joystick, remote control, etc.) would have been an

obvious way of ensuring that the user's actions correspond to their intention.

5.7 Therefore, displaying a visual confirmation of a mode selected by a user on a remote control would have been obvious.

5.8 In view of the above, the board arrives at the conclusion that the subject-matter of claim 1 of the auxiliary request does not involve an inventive step within the meaning of Article 56 EPC.

6. Since neither of the appellant's requests is allowable, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

K. Boelicke M. Paci

Decision electronically authenticated