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Datasheet for the decision of 24 August 2018

Case Number: T 2164/15 - 3.5.05

Application Number: 11175838.9

Publication Number: 2405350

IPC: G06F3/14, G06F3/048, H04N5/445, H04N21/478

Language of the proceedings: EN

Title of invention:
Input method and input apparatus

Applicant:
Saturn Licensing LLC

Headword:
Changing display images/SATURN

Relevant legal provisions:
EPC Art. 84, 111(1)

Keyword:
Support by the description - main request (no), auxiliary request (yes)
Remittal to the first instance for further prosecution - (yes)

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Case Number: T 2164/15 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 24 August 2018

Appellant: (Applicant)	Saturn Licensing LLC 25 Madison Avenue New York, NY 10022-3211 (US)
Representative:	Witte, Weller & Partner Patentanwälte mbB Postfach 10 54 62 70047 Stuttgart (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 5 June 2015 refusing European patent application No. 11175838.9 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair	A. Ritzka
Members:	K. Bengi-Akyuerek
	G. Weiss

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division to refuse the present European patent application, divided from its parent application EP 04736702.4, for lack of support by the description (Article 84 EPC) with respect to claim 1 of a main request and added subject-matter (Article 76(1) EPC) in respect of claim 1 of an auxiliary request.

II. With its statement setting out the grounds of appeal, the appellant filed amended sets of claims according to a main request and eight auxiliary requests. It requested that the examining division's decision be set aside and that a patent be granted on the basis of one of those claim requests.

III. In a communication annexed to the summons to oral proceedings pursuant to Article 15(1) RPBA, the board gave its preliminary opinion on the appeal. In particular, it raised objections under Articles 84, 123(2), 76(1) EPC and Rule 43(2) EPC. It also indicated that the case could be remitted to the examining division for further prosecution if those objections were overcome, since the questions of novelty and inventive step had not been decided in the decision under appeal.

IV. With a letter of reply dated 23 July 2018, the appellant submitted amended claims according to a new main request and new first, second, fourth, fifth, seventh and eighth auxiliary requests, along with counter-arguments to the objections raised in the board's communication under Article 15(1) RPBA, and requested that the appealed decision be set aside and

that the case be remitted to the examining division.

V. Oral proceedings were held on 24 August 2018, during which the appellant filed a new auxiliary request ("New Auxiliary Request 2"), replacing the former auxiliary requests on file.

The appellant's final request was that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the claims according to the main request filed with letter dated 23 July 2018 or to the "New Auxiliary Request 2" filed at the oral proceedings before the board.

At the end of the oral proceedings, the board's decision was announced.

VI. Claim 1 of the **main request** on file reads as follows:

"A controller operable to communicate with a first display (2) and a second display (3),

wherein said controller is operable according to a user instruction to perform:

a first process for exchanging the display image of said first display for the display image of said second display;

a second process for displaying the same image as that displayed on said first display onto said second display; and

a third process for displaying the same image as that displayed on said second display onto said first display."

Claim 1 of the sole **auxiliary request** on file ("New Auxiliary Request 2") reads as follows (amendments

compared with claim 1 of the main request underlined by the board):

"A controller of a media receiver operable to communicate with a first display (2) and a second display (3),

wherein said controller is operable according to a user instruction to perform:

a first process for exchanging the display image of said first display for the display image of said second display;

a second process for displaying the same image as that displayed on said first display onto said second display; and

a third process for displaying the same image as that displayed on said second display onto said first display."

Reasons for the Decision

1. MAIN REQUEST

Claim 1 of the main request comprises the following limiting features, as labelled by the board (the amendments compared with claim 1 of the main request underlying the appealed decision underlined by the board):

A) A controller operable to communicate with a first display and a second display, wherein said controller is operable according to a user instruction to perform:

B) a first process for exchanging the display image of said first display for the display image of said second display;

C) a second process for displaying the same image as that displayed on said first display onto said second display;
D) a third process for displaying the same image as that displayed on said second display onto said first display.

1.1 *Support by the description (Article 84 EPC)*

1.1.1 The examining division found that claim 1 then on file was not supported by the present description, since it did not indicate that the process steps B) to D) were performed in response to a user input action (see Reasons 6).

1.1.2 Following the amendment made in feature A), the board finds that the above objection under Article 84 EPC no longer applies.

1.1.3 However, it is apparent to the board that feature A) still implies that *any* controller of *any* system device could communicate with the two displays claimed and could perform the process steps B) to D). By contrast, the present description as originally filed teaches consistently and exclusively that it is the controller, i.e. "system controller 28", located within "media receiver 5" that controls the process steps B) to D) for changing the display image (see in particular page 19, lines 12-16 of the description as filed: "*... Such a changing process of the display image can be realized by transmitting the commands from the secondary display 3 to the primary display 2 side and controlling the main tuner 22a and the subtuner 22b by the system controller 28 ...*", in conjunction with page 8, lines 16-22, page 9, lines 18-22 and Fig. 2 as filed). This conclusion was also fully endorsed by the

appellant (see appellant's letter of 23 July 2018, section 1.1).

1.1.4 At the oral proceedings before the board, the appellant submitted that it was clear for the skilled person from the present application that the "controller" must be a controller external to the first and second displays claimed and that therefore it was not necessary that it is a controller of "media receiver 5".

The board is not convinced. The present application divulges neither explicitly nor implicitly that the controller as claimed could indeed be part of any *other* device of the system under consideration according to Figure 1 as filed, such as "PC 8", "access point 11", "switch 7" or "ADSL modem". Rather, it relies only on the use of the controller of a media receiver for communicating with a first and a second display and for performing steps B) to D).

1.2 Hence, the board concludes that present claim 1 is not supported by the present description and that, consequently, the main request is not allowable under Article 84 EPC.

2. AUXILIARY REQUEST

2.1 Claim 1 of this auxiliary request now specifies that it is the "controller of a media receiver" that communicates with both displays and performs the first to third process steps according to features B) to D).

2.2 This amendment finds its basis e.g. on page 19, lines 12-16, of the description as filed (see also point 1.1.3 above) and thus complies with Articles 123(2) and 76(1) EPC. As a consequence of that

amendment, present claim 1 also complies now with Article 84 EPC.

3. *Remittal of the case for further prosecution*

3.1 Following the amendments made to claim 1 of the present auxiliary request in these appeal proceedings, the grounds for refusal no longer apply. Thus, the decision under appeal has to be set aside.

3.2 However, it is evident from the file that compliance of the present application with the requirements of Article 52 EPC, in particular novelty and inventive step, was not decided in the appealed decision but only discussed for a speculatively clarified version of claim 1 of the former main request by way of an *obiter dictum* (cf. appealed decision, section 8).

3.3 In view of the fact that the present claims according to the auxiliary request were filed for the very first time in the appeal proceedings in order to overcome the formal objections under Articles 84 and 76(1) EPC raised in the first- and second-instance proceedings, the board concludes that under the present circumstances it is not appropriate to take a final decision on the matters of novelty and inventive step for the first time in the appeal proceedings.

Accordingly, the board has decided, in the exercise of its discretion conferred by Article 111(1) EPC and in accordance with the appellant's request (cf. point IV above), to remit the case to the department of first instance for further prosecution with regard to all other outstanding matters, on the basis of claims 1 to 9 submitted as "New Auxiliary Request 2" at the oral

proceedings before the board.

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 Chair:

K. Götz-Wein A. Ritzka

Decision electronically authenticated