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**Datasheet for the decision
of 8 November 2022**

Case Number: T 0462/18 - 3.5.04

Application Number: 13766102.1

Publication Number: 2912853

IPC: H04N21/41, H04N21/422,
H04N21/4227, H04N21/436,
H04N21/4363, H04N21/485,
H04L12/28, H04N5/44, H04N21/431

Language of the proceedings: EN

Title of invention:
HDMI DEVICE CONTROL VIA IP

Applicant:
Sony Group Corporation

Headword:

Relevant legal provisions:
EPC R. 111(2)
EPC Art. 111(1)
RPBA 2020 Art. 11

Keyword:
Appealed decision - sufficiently reasoned (no) - remittal to
the department of first instance (yes)

Decisions cited:

T 0070/02, G 0010/93

Catchword:



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Case Number: T 0462/18 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 8 November 2022

Appellant: Sony Group Corporation
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Minato-ku
Tokyo 108-0075 (JP)

Representative: Witte, Weller & Partner Patentanwälte mbB
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on
13 September 2017 to refuse European patent
application No. 13 766 102.1 under
Article 97(2) EPC.**

Composition of the Board:

Chair B. Willems
Members: A. Seeger
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the examining division's decision to refuse European patent application No. 13 766 102.1, published as international patent application WO 2014/063886 A1.
- II. The documents cited in the decision under appeal included the following:
- D1: US 2011/126116 A1
- D6: Hitachi et al.: "High-Definition Multimedia Interface Specification Version 1.3", 10 November 2006 (retrieved on 15 December 2011), retrieved from: www.evernew.com.tw/HDMISpecification13a.pdf, XP008146560
- III. The application was refused on the grounds that the subject-matter of claim 1 of the main request and the first auxiliary request was not new in view of the disclosure of document D1 (Article 54 EPC) and that the subject-matter of claim 1 of the second to fifth auxiliary requests lacked inventive step in view of the disclosure of document D1 combined with the disclosure of document D6 (Article 56 EPC).
- IV. The applicant (appellant) filed notice of appeal. With the statement of grounds of appeal, the appellant filed claims according to a main request and first to fifth auxiliary requests. According to the appellant, the claims of these requests were identical to those of the requests on which the decision under appeal was based. The appellant requested 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 or, alternatively, on the basis of the claims of one of the first to fifth auxiliary requests. It provided arguments to support its opinion that the claims met the requirements of Articles 54 and 56 EPC.

- V. The board issued a summons to oral proceedings and a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal in the 2020 version (RPBA 2020, see OJ EPO 2019, A63). In that communication, the board expressed the preliminary opinion that the examining division's reasoning as to why the main request was refused was insufficient to such an extent that the board could not examine whether or not the decision was justified. Hence, the requirements of Rule 111(2) EPC were not met. The board was minded to exercise its discretion under Article 111(1) EPC in remitting the case to the department of first instance for further prosecution. The appellant was invited to comment on the preliminary opinion and to inform the board whether the auxiliary request for oral proceedings would be maintained, since oral proceedings did not appear to be expedient under the circumstances outlined above.
- VI. By letter of reply dated 6 October 2022 (electronic filing of 7 October 2022), the appellant withdrew the auxiliary request for oral proceedings. The appellant agreed that the case could be remitted to the examining division for further prosecution.
- VII. Claim 1 of the main request reads as follows:

"Method comprising

transmitting information about network devices of an HDMI, high definition multimedia interface, network by an HDMI network device,
receiving this information by a remote control device,
presenting said network devices of said HDMI network on a display of said control device as selectable by a user,
presenting a set of control command softkeys on the display in response to a selection of a network device, the set being selected dependent on the type of network device,
generating control command data on the basis of a selected control command softkey,
transmitting said control command data to said HDMI network device, and
providing a CEC command in response to the received control command data."

Reasons for the Decision

1. The appeal is admissible.
2. Main request - insufficient reasoning for lack of novelty, Rule 111(2) EPC
 - 2.1 According to Rule 111(2) EPC, decisions of the European Patent Office which are open to appeal must be reasoned.

The reasoning given in a decision open to appeal has to enable the appellant and the board of appeal to examine whether the decision was justified or not (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019 ("Case Law"), III.K.3.4.1).

A decision should discuss in detail the facts, evidence and arguments which are essential to the decision. It must contain the logical chain of reasoning which led to the conclusion in the case (see Case Law, III.K. 3.4.3).

In order to give an applicant a fair chance to challenge the findings of the examining division, the latter should, as a rule, at least identify where in the closest prior-art document each of the features of a claim in suit is disclosed (see, e.g., T 70/02, Reasons 6).

- 2.2 In the decision under appeal, the examining division based its objection of lack of novelty against method claim 1 of the main request on the presence of elements in a network (see decision under appeal, page 5, lines 4 to 9) without arguing why the presence of these network elements disclosed or implied the claimed method steps. For the step of receiving network information, the examining division referred to 12 paragraphs of the description of document D1 without identifying a method step in these paragraphs (see decision under appeal, page 5, lines 7 to 9).

In particular, the examining division did not provide any reasons why the presence of HDMI network devices and a mobile phone controlling them meant that information about the network devices had to be transmitted by an HDMI network device to the mobile phone and could not be pre-stored on the mobile phone.

This lack of reasoning is all the more serious because this issue constituted a major point of discussion during the proceedings (see the minutes of oral proceedings before the examining division, page 3,

first paragraph, and the appellant's letter dated 2 May 2017, point 2.2).

- 2.3 In the decision under appeal, the examining division identified the selectable network devices as HDTV 412 and HIFI Audio 414 (see decision under appeal, page 5, lines 10 to 14). However, the control command softkeys for Ctrl and View were said to be associated with the network devices GAME PLAYER, PC and BDP (see decision under appeal, page 5, lines 15 to 19).

Hence, the identification of network devices was inconsistent in successive method steps.

In particular, it is unclear whether the examining division was of the opinion that softkeys for GAME PLAYER, PC and BDP were presented in response to selecting HDTV or whether softkeys for Ctrl and View were presented in response to selecting either GAME PLAYER, PC or BDP.

However, this mapping is crucial to assess the examining division's reasoning versus the applicant's counter-argument, according to which the Ctrl and View softkeys were already present in document D1 rather than being displayed in response to the selection of a BDP (see the appellant's letter dated 2 May 2017, point 2.1, third paragraph, and minutes of oral proceedings, page 1, fourth paragraph).

- 2.4 In the decision under appeal, the examining division did not indicate which disclosure it considered to anticipate the feature of "*transmitting said control command data to said HDMI network device*" (see decision under appeal, page 5, line 23).

Not providing any reference in respect of this feature is again a serious lack of reasoning, because whether this feature was disclosed by the prior art was under debate during the proceedings before the examining division.

In particular, it had been discussed whether a generated Ctrl and View command in document D1 was actually transmitted to an HDMI device or whether it only affected the mobile phone acting as a remote control device (see minutes of oral proceedings, page 1, penultimate paragraph, and the appellant's letter dated 2 May 2017, point 2.1, fourth paragraph).

- 2.5 In view of the above, the board finds that the decision under appeal did not sufficiently identify the passages of document D1 on which the examining division relied and that the mapping of claimed features to the passages of document D1 was inconsistent. Essential facts, evidence and arguments put forward by the applicant were not discussed. Therefore, the examining division's reasoning is insufficient to such an extent that the board cannot examine whether or not the decision was justified. Hence, the requirements of Rule 111(2) EPC are not met.
3. Remittal - Article 111(1) EPC and Article 11 RPBA 2020
 - 3.1 According to Article 111(1) EPC, in deciding upon the appeal, the board may either exercise any power within the competence of the department which was responsible for the appealed decision or remit the case to that department for further prosecution.
 - 3.2 The board is not in a position to assess, on the basis of the examining division's reasoning, whether the

examining division's conclusion that the subject-matter of claim 1 of the main request lacked novelty was justified (see point 2.5 above).

- 3.3 Thus, if the board itself were to decide on the substance of the case rather than remitting it to the department of first instance, the board would have to carry out a full examination of the application as to the patentability requirements. This, however, is the task of the examining division (see decision G 10/93, OJ EPO 1995, 172, point 4 of the Reasons).
- 3.4 The examining division's deficient examination of novelty of the main request constitutes "special reasons" within the meaning of Article 11 RPBA 2020. Therefore, the board exercises its discretion under Article 111(1) EPC in remitting the case to the department of first instance for further prosecution.
- 3.5 The appellant withdrew its auxiliary request for oral proceedings and agreed that the case should be remitted to the examining division for further prosecution. Therefore, the board is in a position to decide the case without holding oral proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chair:



K. Boelicke

B. Willems

Decision electronically authenticated