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**Datasheet for the decision
of 22 September 2022**

Case Number: T 1433/18 - 3.5.04

Application Number: 13734792.8

Publication Number: 3020205

IPC: H04N21/422, G06F3/0354,
H04N5/44

Language of the proceedings: EN

Title of invention:

REMOTE CONTROL FOR REMOTELY CONTROLLING AN APPARATUS FOR
RECEIVING TELEVISION SIGNALS, CONNECTING TO THE INTERNET AND
FUNCTIONING AS A MULTIMEDIA CENTER, AND RELATED SYSTEM THEREOF

Applicant:

Saronikos Trading and Services, Unipessoal Lda

Headword:

Relevant legal provisions:

EPC Art. 56
RPBA 2020 Art. 13(1), 13(2)

Keyword:

Main request, auxiliary requests I, III, IV - inventive step - (no)

New auxiliary request I - amendment to appeal case - amendment overcomes issues raised (no)

Auxiliary requests II, V, VI - amendment after summons - cogent reasons (no)

Decisions cited:

T 0989/15, T 0954/17

Catchword:



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Case Number: T 1433/18 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 22 September 2022

Appellant: Saronikos Trading and Services, Unipessoal Lda
(Applicant) Rua Nova de São Pedro, n. 38 A - 1. B
9000-48 Funchal, Madeira (PT)

Representative: Metroconsult Srl
Via Sestriere, 100
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 15 January 2018
refusing European patent application
No. 13734792.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair B. Willems
Members: A. Seeger
G. Decker

Summary of Facts and Submissions

I. The appeal is against the examining division's decision to refuse European patent application No. 13 734 792.8, published as international patent application WO 2015/003743 A1.

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

D1: WO 03/044625 A2

D3: WO 2008/130362 A1

D5: US 2007/0058047 A1

D6: US 5 638 061 A

III. The decision under appeal was based on the following grounds.

(a) The subject-matter of claim 1 of the main request was not new in view of the disclosure of document D6 (Article 54 EPC). The subject-matter of claims 1 and 13 to 15 of the main request lacked inventive step in view of the disclosure of document D1 combined with the disclosure of document D6 or common general knowledge (Article 56 EPC).

(b) The subject-matter of claim 1 of auxiliary request 1 lacked inventive step in view of the disclosure of document D1 combined with the disclosure of document D6 or common general knowledge (Article 56 EPC).

(c) The subject-matter of claim 1 of auxiliary requests 2 and 3 was not new in view of the disclosure of document D6 (Article 54 EPC). The subject-matter of claim 1 of auxiliary requests 2 and 3 lacked inventive step in view of the disclosure of document D1 combined with the disclosure of document D6 (Article 56 EPC).

(d) The subject-matter of claim 1 of auxiliary request 4 lacked inventive step in view of the disclosure of document D1 combined with the disclosure of documents D5 and D6 or combined with the disclosure of document D5 and common general knowledge (Article 56 EPC).

(e) The subject-matter of claim 1 of auxiliary request 5 lacked inventive step in view of the disclosure of document D1 combined with the disclosure of documents D5 and D6.

IV. The applicant (appellant) filed notice of appeal. With the statement of grounds of appeal, the appellant maintained the main request and auxiliary requests 1 to 5 on which the decision under appeal was based. It provided arguments to support its opinion that the claims met the requirements of Articles 54 and 56 EPC.

V. The board issued 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 this communication, the board submitted the following.

(a) Claim 1 of none of the requests then on file met the requirements of Article 84 EPC.

- (b) For the examination of novelty and inventive step, the board interpreted the claims in a manner consistent with the description, page 4, line 25 to page 5, line 3; page 8, lines 18 to 24 and page 14, lines 2 to 12.
- (c) The subject-matter of claim 1 of the main request and auxiliary requests 2 and 3 lacked novelty in view of the disclosure of document D6 (Article 54 EPC).
- (d) Document D3 was an appropriate starting point for the assessment of inventive step of the subject-matter of claim 1 of auxiliary request 1. The subject-matter of claim 1 of auxiliary request 1 lacked inventive step over the combined disclosure of documents D3, D5 and D6 (Article 56 EPC).
- (e) The subject-matter of claim 1 of auxiliary requests 4 and 5 lacked inventive step over the combined disclosure of documents D6 and D5 (Article 56 EPC).

VI. By letter of reply dated 22 August 2022, the appellant filed amended claims of a main request and auxiliary requests I to VI. The appellant indicated a basis in the application as filed for the amendments and submitted reasons why, in its opinion, the claims met the requirements of Articles 54, 56 and 84 EPC.

VII. On 22 September 2022, oral proceedings took place before the board.

The appellant's final requests were 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 auxiliary request I, both requests filed by letter of 22 August 2022, or on the basis of the claims of "New Auxiliary request 1" filed during oral proceedings on 22 September 2022, or on the basis of the claims of one of auxiliary requests II to VI filed by letter of 22 August 2022.

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

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

"System for remotely controlling a television apparatus capable of working in different operative modes, namely receiving broadcasted signals, connecting to the Internet and functioning as a multimedia center, said system comprising said television apparatus and a remote control (1) being able to cooperate with said television apparatus and comprises rotary means (2) comprising a sphere and actuating means (3A,3B,3C,3D,6) for an execution, said remote control (1) being configured to carry out different functions depending on which of said operative modes of the television apparatus has been selected by accessing a menu of said television apparatus and in reply to said execution of said rotary means (2) and said actuating means (3A,3B,3C,3D,6) of said remote control (1)."

IX. Claim 1 of auxiliary request I reads as follows:

"System for remotely controlling a television apparatus capable of operating in different operative modes, namely receiving broadcasted signals, connecting to the Internet and functioning as a multimedia center, said

system comprising said television apparatus and a remote control (1) able to cooperate with said television apparatus, said remote control (1) comprises rotary means (2) comprising a sphere and actuating means (3A,3B,3C,3D,6) for an execution, said remote control (1) being configured to carry out different functions depending on which of said operative modes of the television apparatus has been selected by accessing a menu of said television apparatus and in reply to said execution of said rotary means (2) and said actuating means (3A,3B,3C,3D,6) of said remote control,

wherein if said television apparatus is operating in a 'TV mode', a displacement of said rotary means (2) along a longitudinal axis (Y) of the same in a manner concordant with a first direction (V) increases by one position in a list of channels, the service to be tuned in relation to the previous one, likewise a displacement of said rotary means (2) along said longitudinal axis (Y) in an opposite manner to said first direction (V) decreases by one position in a list of channels, the service to be tuned in relation to the previous one and

wherein a displacement of said rotary means (2) along a transversal axis (X) of the same in a manner concordant with a second direction (P) increases the volume value in relation to the actual value, likewise a displacement of said rotary means (2) along said transversal axis (X) in an opposite manner to said second direction (P) decreases the volume value in relation to the actual value,

wherein in said 'internet mode' the actuating means (3A,3B,3C,3D) and rotary means (2) perform different functions compared to the 'TV mode' and wherein in said

'internet mode' said rotary means (2) are configured to perform the function of controlling a pointing device."

- X. Claim 1 of "New Auxiliary request I" differs from claim 1 of auxiliary request I in that the operation in a "TV mode" and an "internet mode" is further defined as follows (amendments relative to claim 1 of auxiliary request I are underlined):

"wherein, if said television apparatus is operating in a 'TV mode', it allows for the viewing of a broadcasted program and a displacement of said rotary means (2) ...

wherein, in a [sic] 'internet mode', said television apparatus allows the display of a browser and the actuating means ..."

- XI. Claim 1 of auxiliary request II differs from claim 1 of auxiliary request I in that the following text is added before the full stop:

", wherein said actuating means (3A,3B,3C,3D) comprise four keys (3A,3B,3C,3D) arranged in proximity to said sphere, in which a first key (3A) and a second key (3B) are arranged on the upper part of the remote control (1), and in which a third key (3C) and a fourth key (3D) are arranged on the lower part of the remote control (1)"

- XII. Claim 1 of auxiliary request III and auxiliary request IV differs from claim 1 of the main request and auxiliary request I, respectively, in that the following text is inserted before the full stop:

", wherein an 'ENTER' function is obtained by way of pressing down said rotary means (2), in particular said sphere"

XIII. Claim 1 of auxiliary request V differs from claim 1 of the main request in that the following text is inserted before the full stop:

", wherein said actuator means (3A,3B,3C,3D,6) comprise means for adjusting the sensitivity (6) of the rotary means (2), in particular a wheel,

wherein, when said means for adjusting the sensitivity (6) are set to the maximum possible value, the rotary means (2) enable additional operations according to the operative mode selected, in particular at least one of the following additional operations:

- when said television apparatus is operating in a 'TV mode', at that time a displacement of said rotary means (2) along a longitudinal axis (Y) of the same in a manner concordant with a first direction (V) increases by a plurality of positions in a list of channels, the service to be tuned in relation to the previous one, in particular ten units, likewise a displacement of said rotary means (2) along said longitudinal axis (Y) in an opposite manner to said first direction (V) decreases by a plurality of positions in a list of channels, the service to be tuned in relation to the previous one, in particular ten units;
- when said television apparatus is operating in an 'Internet mode' or in a 'Smart TV mode', a displacement of said rotary means (2) along a longitudinal axis (Y) of the same allows for carrying out a scrolling function of a current page on said screen;

- when said television apparatus operates as a multimedia center managing image files, a displacement of said rotary means (2) allows for scrolling groups of images, in particular ten images"

XIV. Claim 1 of auxiliary request VI differs from claim 1 of auxiliary request I in that the following text is inserted before the full stop:

", wherein an 'ENTER' function is obtained by way of pressing down said rotary means (2), in particular said sphere,

wherein said actuator means (3A, 3B, 3C, 3D, 6) comprise means for adjusting the sensitivity (6) of the rotary means (2), in particular a wheel,

wherein, when said means for adjusting the sensitivity (6) are set to the maximum possible value, the rotary means (2) enable additional operations according to the operative mode selected, in particular at least one of the following additional operations:

- when said television apparatus is operating in a 'TV mode', at that time a displacement of said rotary means (2) along a longitudinal axis (Y) of the same in a manner concordant with a first direction (V) increases by a plurality of positions in a list of channels, the service to be tuned in relation to the previous one, in particular ten units, likewise a displacement of said rotary means (2) along said longitudinal axis (Y) in an opposite manner to said first direction (V) decreases by a plurality of positions in a list of channels, the service to be tuned in relation to the previous one, in particular ten units;

- when said television apparatus is operating in an 'Internet mode' or in a 'Smart TV mode', a displacement of said rotary means (2) along a longitudinal axis (Y) of the same allows for carrying out a scrolling function of a current page on said screen;
- when said television apparatus operates as a multimedia center managing image files, a displacement of said rotary means (2) allows for scrolling groups of images, in particular ten images"

XV. The appellant's arguments relevant to the present decision may be summarised as follows.

Main request and auxiliary requests I, III and IV

- (a) Document D3 taught different operative modes of a remote control but not of a television apparatus (see D3, page 9, lines 1 to 4). Changing the channel, adjusting the volume or navigating a menu were not different operative modes of a television apparatus.
- (b) The distinguishing features were functionally interdependent because accessing the internet, i.e. a browser, required higher precision in the navigation provided by the remote control, and a trackball was thus of particular advantage.
- (c) Document D5 taught away from using a trackball in a remote control.

"New Auxiliary request I"

(d) During the oral proceedings, the board interpreted an operative mode of a television connecting to the internet for the first time as merely receiving a television programme via the internet. This was an exceptional circumstance to which the appellant could not have reacted earlier than by filing "New Auxiliary request I" during the oral proceedings. This request was thus to be admitted into the appeal proceedings.

Auxiliary requests II, V, VI

(e) Starting from a different document cited in the decision under appeal as the closest prior art in an inventive-step objection was a new objection in the communication of the board. This was an exceptional circumstance within the meaning of Article 13(2) RPBA 2020 and thus allowed amending the claim.

Reasons for the Decision

1. The appeal is admissible.
2. Main request and auxiliary requests I, III and IV - admittance (Article 13(2) RPBA 2020)
 - 2.1 The main request and auxiliary requests I, III and IV were filed after the notification of the summons to oral proceedings. These requests are therefore amendments within the meaning of Article 13(2) RPBA 2020.
 - 2.2 The board raised for the first time objections of lack of clarity in the communication under Article 15(1) RPBA 2020. In response to this communication, the

appellant filed the main request and auxiliary requests I, III and IV with the aim of overcoming these new objections. This represents an exceptional circumstance within the meaning of Article 13(2) RPBA 2020. Exercising its discretion under this provision, the board thus decided to admit the main request and auxiliary requests I, III and IV into the appeal proceedings.

3. Main request - inventive step (Article 56 EPC)

3.1 Document D3 may be considered the closest prior art for the assessment of inventive step of the subject-matter of claim 1.

3.2 Document D3 discloses a system (see Figure 1: 100) for remotely controlling a television apparatus (see Figure 1: 102) capable of working in different operative modes (see page 9, lines 1 to 5 and page 10, line 20, according to which one operative mode of the television may be a mode in which menu navigation takes place and another operative mode of the television may be a mode in which broadcasted signals are received and television commands such as channel changing or volume adjustment occur), namely receiving broadcasted signals, this system comprising the television apparatus and a remote control (see Figure 1: 104) being able to cooperate with the television apparatus (see page 4, lines 13 to 15: "*The television system 100 includes a television 102 and a remote control 104 that cooperate to facilitate operation of the television 102 by a user*") and which comprises a rotary means (see Figure 4: 400 and page 7, lines 2 to 4: "*the control element 106 may include a tiltable scroll wheel that can be activated by tilting it to the left or right to activate certain features*") and an actuating means for

an execution (see page 8, lines 12 to 17: "*if the control element 106 is a ... scroll wheel, it may be activated by pushing directly down on a central portion of the ... scroll wheel. In some embodiments, multiple buttons may be arranged beneath the control element 106 such that they are activated based on what manner and/or in what direction the control element 106 is activated*"), the remote control being configured to carry out different functions depending on which operative mode of the television apparatus has been selected and in reply to the execution of the rotary means and the actuating means of the remote control (see page 9, lines 2 to 5: "*Manipulation or activation of the control element 106 may facilitate initiation of television commands, navigation of menu*").

3.3 The appellant argued that document D3 taught different operative modes of a remote control but not of a television apparatus. Changing the channel, adjusting the volume or navigating a menu were not different operative modes of a television apparatus (see point XV.(a) above).

The board is not convinced by these arguments and finds that an operative mode is a broad term encompassing a set of different parameters which put a television apparatus into a particular way of working. For example, page 1 of document D3 sets out such different ways of working, namely channel changing, volume adjustment, manipulation of viewing settings, video recording and display of closed captions.

3.4 The subject-matter of claim 1 thus differs from the disclosure of document D3 in that the former specifies that:

- (a) the rotary means comprises a sphere
- (b) the television apparatus is capable of connecting to the internet and functioning as a multimedia centre wherein these different operative modes are selected by accessing a menu of the television apparatus

3.5 The board finds that these distinguishing features are a mere aggregation and not functionally interdependent. The mechanical implementation of the rotary means has no bearing on the use of these means in different operating modes of the television apparatus. Whether a television apparatus receives a programme via broadcast or the internet does not change the presentation of this programme on the television apparatus. Hence, it has to be established whether each of the distinguishing features a) and b) is separately obvious in light of the prior art (see Case Law of the Boards of Appeal of the European Patent Office, 10th edition 2022 ("Case Law"), I.D.9.3.2, corresponding to section I.D.9.2.2 of the 9th edition 2019 of the Case Law referred to in the board's communication under Article 15(1) RPBA 2020).

3.6 The appellant argued that the distinguishing features were functionally interdependent because accessing the internet, i.e. a browser, required higher precision in the navigation provided by remote control, and a trackball was thus of particular advantage (see point XV.(b) above).

The board is not convinced by these arguments because the same programme can be obtained from a terrestrial television station or via the internet. Operating a pointing device with more precision helps navigating

any kind of menu, regardless of whether that menu is received via a terrestrial broadcast or the internet. Claim 1 only specifies that the television apparatus is capable of connecting to the internet and does not require the use of a browser.

- 3.7 The partial objective technical problem related to feature a) may be regarded as providing alternative mechanical means to create left/right and up/down commands.
- 3.8 A track ball, as disclosed in document D6, is a known alternative to the tiltable scroll wheel on the remote control according to document D3 for creating left/right and up/down commands in the context of a television receiver (see D6, column 1, lines 17 to 20: "*Track ball mechanisms ... are finding increased use in television receivers having on-screen menus*").
- 3.9 It is established case law that applying one of the possible solutions available to the person skilled in the art requires no particular skill and hence does not involve an inventive step (see Case Law, I.D.9.21.9 a)). Therefore, the board finds that substituting the tiltable scroll wheel known from document D3 with a track ball cannot contribute to inventive step.
- 3.10 The appellant argued that document D5 taught away from using a trackball in a remote control (see point XV.(c) above).

The board is not convinced by this argument. Paragraph [0006] of document D5 reads "*wireless keyboards may include an integrated trackball or other pointing device to provide mouse type control of the PC or Internet functions. These types of multi-directional*

controls are less natural and convenient to use than a separate mouse controller. Also, such systems require both hands to use making simple one handed navigation of a GUI TV interface impossible". Document D5 thus states that simple one-handed navigation of a TV GUI is impossible only in combination with a wireless keyboard. This does not teach away from using a trackball.

- 3.11 The partial objective technical problem related to distinguishing feature b) may be regarded as how to extend the operative modes of the television.
- 3.12 Extending the functionality of a television to include an internet operative mode had become common place, as set out in the background section of document D5. There it is stated that "*set top Internet access devices have been introduced which integrate Internet access capabilities with conventional televisions*" (see D5, paragraph [0005]). Furthermore, document D5 discloses that different modes of a television apparatus, including a "TV" mode, a "WEB" mode and a "DVR" mode, can be selected by accessing a menu of the television apparatus (see D5, Figure 9A).
- 3.13 Therefore, given the partial objective technical problem set out under point 3.11, the person skilled in the art would have incorporated these features of document D5 into a system according to document D3, thus arriving at the distinguishing feature b) indicated under point 3.4 above.
- 3.14 In view of the findings under points 3.5, 3.9 and 3.13, the board concludes that the subject-matter of claim 1 according to the main request does not involve an inventive step within the meaning of Article 56 EPC.

4. Auxiliary request I - inventive step (Article 56 EPC)

4.1 The subject-matter of claim 1 of auxiliary request I differs from claim 1 of the main request in that the former specifies the following additional features:

- (a) wherein if said television apparatus is operating in a "TV mode", a displacement of said rotary means along a longitudinal axis of the same in a manner concordant with a first direction increases by one position in a list of channels, the service to be tuned in relation to the previous one, likewise a displacement of said rotary means along said longitudinal axis in an opposite manner to said first direction decreases by one position in a list of channels, the service to be tuned in relation to the previous one
- (b) wherein a displacement of said rotary means along a transversal axis of the same in a manner concordant with a second direction increases the volume value in relation to the actual value, likewise a displacement of said rotary means along said transversal axis in an opposite manner to said second direction decreases the volume value in relation to the actual value
- (c) wherein in said "internet mode" the actuating means and rotary means perform different functions compared to the "TV mode" and wherein in said "internet mode" said rotary means are configured to perform the function of controlling a pointing device

- 4.2 The additional features a) and b) are known from document D3, Figure 4: "Content+", "Previous Content" and "Vol-", "Vol+".
- 4.3 Hence, the subject-matter of claim 1 of auxiliary request I differs from the disclosure of document D3 in that the former specifies that:
- (a) the rotary means comprises a sphere
 - (b) the television apparatus is capable of connecting to the internet and functioning as a multimedia centre, wherein these different operative modes are selected by accessing a menu of the television apparatus, where in the "internet mode" the actuating means and rotary means perform different functions compared to the "TV mode" and where in the "internet mode" the rotary means are configured to perform the function of controlling a pointing device
- 4.4 The board is of the opinion that these distinguishing features relate to different partial objective technical problems for the reasons set out under point 3.5 above.
- 4.5 The partial objective technical problem related to distinguishing feature a) and its solution cannot contribute to inventive step for the reasons set out under points 3.7 to 3.9 above.
- 4.6 The partial objective technical problem related to distinguishing feature b) may be regarded as how to extend the operative modes of the television and adapt the use of the rotary and actuating means accordingly.

- 4.7 Extending the functionality of a television to include internet operative modes had become common place as set out in the background section of document D5. There it is stated that *"set top Internet access devices have been introduced which integrate Internet access capabilities with conventional televisions"* (see D5, paragraph [0005]). The same background section of document D5 indicates *"convenient control of PC type functions also requires an ability to interface with a Graphical User Interface (GUI)"* and the need for *"an up-down-left-right control to move around in a limited GUI interface"* (see D5, paragraph [0006]). Furthermore, document D5 discloses that different modes of a television apparatus, including a "TV" mode, a "WEB" mode and a "DVR" mode are selected by accessing a menu of the television apparatus (see D5, Figure 9A).
- 4.8 In view of the above, the board finds that the person skilled in the art would have extended the operative modes of the television apparatus according to document D3 to include an "internet mode" and so it functioned as a multimedia centre. Moreover, it would have been obvious to use the rotary and actuating means already available in the television apparatus according to document D3 (see D3, page 9, lines 2 to 5: *"Manipulation or activation of the control element 106 may facilitate ... navigation of menu"*) to fulfil the need of *"an up-down-left-right control to move around in a limited GUI interface"* in an "internet mode".
- 4.9 Therefore, the person skilled in the art would have arrived at the distinguishing feature b) indicated under point 4.3 above in a straightforward manner.
- 4.10 In view of the findings under points 4.4, 4.5 and 4.9, the board concludes that the subject-matter of claim 1

according to auxiliary request I does not involve an inventive step within the meaning of Article 56 EPC.

5. "New Auxiliary request I" - admittance (Article 13(2) and (1) RPBA 2020)
 - 5.1 "New Auxiliary request I" was filed during the oral proceedings before the board, i.e. after the notification of the summons to oral proceedings. "New Auxiliary request I" is therefore an amendment within the meaning of Article 13(2) RPBA 2020.
 - 5.2 Under Article 13(2) RPBA 2020, any amendment to a party's appeal case after notification of a summons to oral proceedings is, in principle, not to be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
 - 5.3 The explanatory remarks on Article 13(2) RPBA 2020 contain the following guidance: "*At the third level of the convergent approach, the Board may also rely on criteria applicable at the second level of the convergent approach, i.e. as set out in proposed new paragraph 1 of Article 13*" (see Document CA/3/19, section VI, explanatory remarks on Article 13(2), fourth paragraph). The board takes the view that, at the third level of the convergent approach, the boards are free to use or not use the criteria set out in Article 13(1) RPBA 2020 when deciding, in exercising their discretion in accordance with Article 13(2) RPBA 2020, whether to admit an amendment made at this stage of the proceedings (see also decisions T 989/15, point 16.2 of the Reasons, and T 954/17, point 3.10 of the Reasons).

Under Article 13(1) RPBA 2020, the onus is on the appellant to demonstrate that any amendment overcomes, *prima facie*, the issues raised by the board and does not give rise to new objections (see Document CA/3/19, section VI, explanatory remarks on Article 13(1), third paragraph).

5.4 Claim 1 of "New Auxiliary request I" differs from claim 1 of auxiliary request I in that the former further specifies:

(a) if said television apparatus is operating in a "TV mode", it allows for the viewing of a broadcasted programme

(b) in an "internet mode", said television apparatus allows the display of a browser

5.5 The board finds that the term "TV mode" had already been interpreted in the sense of feature a). Thus, adding feature a) cannot overcome the objection of lack of inventive step raised by the board.

Concerning feature b), the board finds that the already cited paragraph [0005] of document D5 mentions an "Internet browser" (see D5, paragraph [0005], fifth sentence). Therefore, the board finds that the display of a browser in an "internet mode" cannot overcome the objection of lack of inventive step raised by the board either.

5.6 Therefore, the board finds that the appellant did not demonstrate that the amendments quoted under point 5.4 above overcome, *prima facie*, the objection of lack of inventive step raised by the board.

Whether the board's interpretation of an operative mode of a television connecting to the internet created an exceptional circumstance (see point XV.(d) above) is thus not decisive for the admittance of "New Auxiliary request I" and can be left open.

- 5.7 Hence, the board exercised its discretion under Article 13(2) RPBA 2020, using the criteria of Article 13(1) RPBA 2020, and did not admit "New Auxiliary request I" into the appeal proceedings.
6. Auxiliary request II - admittance (Article 13(2) RPBA 2020)
- 6.1 Auxiliary request II was filed after the notification of the summons to oral proceedings and is therefore an amendment within the meaning of Article 13(2) RPBA 2020.
- 6.2 Under Article 13(2) RPBA 2020, any amendment to a party's appeal case after notification of a summons to oral proceedings is, in principle, not to be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
- 6.3 The explanatory remarks on Article 13(2) RPBA 2020 contain the following guidance: *"The basic principle of the third level of the convergent approach is that, at this stage of the appeal proceedings, amendments to a party's appeal case are not to be taken into consideration. However, a limited exception is provided for: it requires a party to present compelling reasons which justify clearly why the circumstances leading to the amendment are indeed exceptional in the particular appeal ('cogent reasons'). For example, if a party*

submits that the Board raised an objection for the first time in a communication, it must explain precisely why this objection is new and does not fall under objections previously raised by the Board or a party. The Board may decide to admit the amendment in the exercise of its discretion" (see document CA/3/19, section VI, explanatory remarks on Article 13(2), third paragraph).

6.4 Furthermore, when filing new submissions in the appeal phase specified in Article 13(2) RPBA 2020, a party, in providing "cogent reasons", should not only identify the circumstances invoked and explain why they should be regarded as exceptional but also explain why these circumstances had the direct result of preventing it from filing its requests at an earlier stage; in other words, there should be a causal link between the exceptional circumstances and the late filing (see Case Law, V.A.4.5.4 b)).

6.5 Claim 1 of auxiliary request II corresponds to claim 1 of auxiliary request 1 on which the decision under appeal was based except for:

(a) amendments made to resolve the clarity objections raised by the board

(b) additional features reading "*wherein said actuating means (3A, 3B, 3C, 3D) comprise four keys (3A, 3B, 3C, 3D) arranged in proximity to said sphere, in which a first key (3A) and a second key (3B) are arranged on the upper part of the remote control (1), and in which a third key (3C) and a fourth key (3D) are arranged on the lower part of the remote control (1)*"

- 6.6 In the decision under appeal, the examining division held that the subject-matter of claim 1 of auxiliary request 1 lacked inventive step in view of document D1 combined with document D6 or in view of document D1 combined with common general knowledge (see decision under appeal, page 4, last paragraph).
- 6.7 In the communication under Article 15(1) RPBA 2020, the board also expressed the preliminary opinion that the subject-matter of claim 1 of auxiliary request 1 lacked inventive step, but in view of document D3 combined with documents D6 and D5 (see point V. above). The new aspect that the board introduced in its communication was thus not the inventive-step objection but its reasoning starting from a different document cited in the decision under appeal as the closest prior art.
- 6.8 The appellant argued that changing the closest prior art in an inventive-step objection created a new objection in the communication of the board. This was an exceptional circumstance within the meaning of Article 13(2) RPBA 2020 and thus allowed amending the claim (see point XV.(e) above).
- 6.9 However, the additional features in b) quoted above, namely the specification of further buttons on the remote control, are not a reaction to starting from document D3 rather than document D1 as the closest prior art. These additional features also do not concern the main issue under debate, namely a potential synergistic effect between the rotary means comprising a sphere and the operation of a television apparatus in an "internet mode". Consequently, the amendment made by adding the features in b) is not causally linked to starting from document D3 as the closest prior art. The appellant merely used the opportunity to add features

unrelated to the difference in disclosure between document D1 and D3. Hence, the board finds that there is no causal link between the exceptional circumstances, i.e. the inventive-step objection raised by the board starting from document D3 rather than document D1, and the late filing of auxiliary request II.

6.10 Moreover, when exercising its discretion under Article 13(2) RPBA 2020, the board may also rely on the criteria set out in Article 13(1) RPBA 2020 (see point 5.3 above). The second sentence of Article 13(1) RPBA 2020 reads: "*Article 12, paragraphs 4 to 6, shall apply mutatis mutandis*". According to Article 12(6), second sentence, RPBA 2020, "*the board shall not admit requests ... which should have been submitted ... in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance*" (see also Case Law, V.A.4.5.10 f)). The board notes that the latter provision is identical in substance to the criterion set out in Article 12(4) RPBA 2007 in which requests which *could* have been presented in the first-instance proceedings are interpreted as requests which *should* have been presented in the first-instance proceedings (see Case Law, V.A.5.11.4 a)). The board further notes that it had already been recognised in the case law on the RPBA 2007 that the fact that requests could have been presented in the first-instance proceedings was another criterion potentially to be considered when exercising discretion under Article 13(1) RPBA 2007, i.e. at a later stage of the proceedings (see Case Law, V.A.5.11.2).

6.11 In the set of claims according to auxiliary request 1 underlying the impugned decision, the category of

claim 1 is the same as in the requests currently on file. This set of claims was discussed during the oral proceedings before the examining division (see minutes of the oral proceedings, page 2, last paragraph to page 3, fifth paragraph). In this discussion, it became apparent that the examining division held that the subject-matter of claim 1 lacked inventive step.

The board finds that at this time, the appellant should have filed amended claims containing the features which it now submitted at the appeal stage (see point 6.5 b) above) to overcome the examining division's inventive-step objection.

However, according to the minutes of the oral proceedings, the appellant neither made further submissions on this request nor filed amended claims (see minutes of the oral proceedings, page 3, penultimate paragraph to page 4, last paragraph).

The appellant's representative submitted that at the time of the oral proceedings before the examining division, he had not been the acting representative. He was thus not in a position to argue why corresponding amended claims were not filed at this stage.

The board does not accept this as a valid reason for the late filing of requests, a change of representative being at the party's own risk (see Case Law, V.A.5.8.2).

6.12 In view of the above, the board exercised its discretion under Article 13(2) RPBA 2020 and did not admit auxiliary request II into the appeal proceedings.

7. Auxiliary requests III and IV - inventive step (Article 56 EPC)
 - 7.1 Claim 1 of auxiliary requests III and IV differs from claim 1 of the main request and auxiliary request I, respectively, only in that the former further specifies that *"an 'ENTER' function is obtained by way of pressing down said rotary means (2)"*.
 - 7.2 This additional feature is disclosed in document D3, page 8, lines 22 to 24, reading *"pushing directly down on the control element 106 may initiate a 'select' function to enable a user to select menu options"*. Selecting a menu option is equivalent to an 'ENTER' function.
 - 7.3 Therefore, the subject-matter of claim 1 of auxiliary requests III and IV lacks inventive step within the meaning of Article 56 EPC for the same reasons as set out above for claim 1 of the main request and the first auxiliary request, respectively (see points 3. and 4.).
8. Auxiliary requests V and VI - admittance (Article 13(2) RPBA 2020)
 - 8.1 Auxiliary requests V and VI were filed after the notification of the summons to oral proceedings and are therefore amendments within the meaning of Article 13(2) RPBA 2020.
 - 8.2 Claim 1 of auxiliary requests V and VI differs from claim 1 of auxiliary request 4 and 5, respectively, by, *inter alia*, the following amended features:

"wherein, when said means for adjusting the sensitivity (6) are set to the maximum possible value, the rotary

means (2) enable additional operations according to the operative mode selected, in particular at least one of the following additional operations:

- when said television apparatus is operating in a "TV mode", at that time a displacement of said rotary means (2) along a longitudinal axis (Y) of the same in a manner concordant with a first direction (V) increases by a plurality of positions in a list of channels, the service to be tuned in relation to the previous one, in particular ten units, likewise a displacement of said rotary means (2) along said longitudinal axis (Y) in an opposite manner to said first direction (V) decreases by a plurality of positions in a list of channels, the service to be tuned in relation to the previous one, in particular ten units;*
- when said television apparatus is operating in an 'Internet mode' or in a 'Smart TV mode', a displacement of said rotary means (2) along a longitudinal axis (Y) of the same allows for carrying out a scrolling function of a current page on said screen;*
- when said television apparatus operates as a multimedia center managing image files, a displacement of said rotary means (2) allows for scrolling groups of images, in particular ten images"*

8.3 In the decision under appeal, the examining division held that the subject-matter of claim 1 of auxiliary requests 4 and 5 lacked inventive step in view of the disclosure of document D1 combined with the disclosure of documents D5 and D6 (see point III. above).

8.4 In the communication under Article 15(1) RPBA 2020, the board expressed the preliminary opinion that the

subject-matter of claim 1 of the then auxiliary requests 4 and 5 lacked inventive step in view of the disclosure of documents D5 and D6 (see point V. above) rather than the combined disclosure of document D1, D5 and D6 referred to by the examining division. The new aspect that the board introduced in its communication was thus not the inventive-step objection but its reasoning.

8.5 However, the additional features quoted under point 8.2 above, namely the specification of additional operations if the sensitivity is adjusted to a maximum possible value, are not related to identifying a different document cited in the decision under appeal as the closest prior art. The amendment made by the new features is not causally linked to the change of reasoning. The appellant merely used the opportunity to add features unrelated to the fact that document D1 was no longer identified as the closest prior art (see also points 6.4 to 6.9 above).

8.6 Moreover, the board is of the opinion that the appellant should have filed requests with independent claims containing the amended features during the first-instance proceedings for the same reasons as set out under points 6.10 and 6.11 above.

8.7 In view of the above, the board exercised its discretion under Article 13(2) RPBA 2020 and did not admit auxiliary requests V and VI into the appeal proceedings.

9. Conclusion

The main request and auxiliary requests I, III and IV are not allowable because claim 1 of each of these

requests does not meet the requirements of Article 56 EPC. "New Auxiliary request I" and auxiliary requests II, V and VI were not admitted into the appeal proceedings. Since none of the appellant's requests is allowable, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



K. Boelicke

B. Willems

Decision electronically authenticated