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**Datasheet for the decision
of 9 February 2023**

Case Number: T 1081/20 - 3.5.03

Application Number: 06016560.2

Publication Number: 1793570

IPC: H04M1/02, H04N21/422,
H04N21/4363, H04N21/472,
H04N5/44, H04N21/414, H04N7/173

Language of the proceedings: EN

Title of invention:
Phone with television remote control functionality

Patent Proprietor:
Broadcom Corporation

Opponent:
Netflix Inc.

Headword:
Dual display/BROADCOM vs. NETFLIX

Relevant legal provisions:
EPC Art. 54, 123(2)
RPBA 2020 Art. 12(6)

Keyword:

Novelty - main request and auxiliary requests XI, XII, XIV to XXI (no)

Admittance of requests filed on appeal - auxiliary requests I to IX, XXII and XXIII (no): should have been submitted in first-instance proceedings

Admittance of disregarded request - auxiliary request X (no): discretion correctly exercised by the opposition division

Added subject-matter - auxiliary request XIII (yes)

Decisions cited:

T 0966/17, T 0256/19



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Case Number: T 1081/20 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 9 February 2023

Appellant:
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 13 February
2020 revoking European patent No. 1793570
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chair

K. Bengi-Akyürek

Members:

J. Eraso Helguera

C. Heath

Summary of Facts and Submissions

- I. This case concerns the appeal filed by the proprietor against the decision of the opposition division revoking the opposed patent under Article 101(2) and (3) (b) EPC.
- II. The decision under appeal made reference *inter alia* to the following prior-art document:
- D13:** US 6,097,441.
- III. Oral proceedings before the board were held on 9 February 2023. The final requests of the parties were:
- The proprietor (appellant) requested, as a **main request**, that the decision under appeal be set aside and that the the opposition be rejected (i.e. that the patent be maintained in its granted form), or that the patent be maintained in amended form on the basis of the claims of one of twenty-three auxiliary requests: **auxiliary requests I to IX**, filed with the statement setting out the grounds of appeal, **auxiliary requests X to XXI**, subject to the decision under appeal as auxiliary requests 1a, 1 to 4, 6 to 9, 11, 12 and 1b, respectively, and re-submitted with the statement setting out the grounds of appeal and **auxiliary requests XXII and XXIII**, filed with the statement setting out the grounds of appeal.
 - The opponent (respondent) requested that the appeal be dismissed.

IV. Claim 1 as granted (**main request**) reads as follows:

"A phone (103, 203, 303, 403, 503, 603, 703, 803) that is adapted to interact with a television system (205, 305, 505, 605, 1057), the television system having a screen (125, 231, 325, 531), the phone comprising:

a communication interface (121, 223, 241, 420, 445);

a user input interface (117, 217, 319, 428, 451, 909) adapted to receive a user input identifying a video selection; and

processing circuitry (113, 213, 313, 417) adapted to:

retrieve from a media source (107) via the communication interface, a first video stream according to the video selection; and transmit a control signal via the communication interface, wherein the control signal is adapted to cause the display of a second video stream according to the video selection on the screen of the television system;

wherein

the first video stream is identified for a video display (111, 211, 311, 414, 521) of the phone and the second video stream is identified for the screen of the television system and delivered to the television from the media source (107)."

Claim 1 of **auxiliary request I** is identical to claim 1 as granted, except for the addition of:

", wherein the media source is a repository of a plurality of video streams"

right after "a first video stream according to the video selection", and the addition of:

" , and wherein the first and second video streams are two video streams of the plurality of video streams"

at the very end of the claim.

Claim 1 of **auxiliary request II** is identical to claim 1 of auxiliary request I, except for the deletion of "and" right before "wherein the first and second video streams" and the addition of:

" , wherein the first video stream is a video stream specifically adapted for the video display of the phone, and wherein the second video stream is a video stream specifically adapted for the screen of the television system"

at the very end of the claim.

Claim 1 of **auxiliary request III** is identical to claim 1 of auxiliary request I, except for the addition of:

"and supports media in phone format and media in television format"

right after "a repository of a plurality of video streams", the insertion of:

"in the phone format and"

right before "identified for a video display" and the insertion of

"in the television format and"

right before "identified for the screen of the television system".

Claim 1 of **auxiliary request IV** is identical to claim 1 of auxiliary request I, except for the deletion of "and" right before "wherein the first and second video streams" and the addition of:

", and wherein the phone is adapted to send a request to the media source seeking delivery of the first video stream stored in the media source"

at the very end of the claim.

Claim 1 of **auxiliary request V** is identical to claim 1 as granted, except for the addition of:

", wherein the phone is not adapted to perform a first media swapping request causing the media stream that was being displayed on the video display of the phone to be displayed on the screen of the television system"

at the very end of the claim.

Claim 1 of **auxiliary request VI** reads as follows:

"A system comprising a television system (205, 305, 505, 605, 1057), a media source (107) and a phone (103, 203, 303, 403, 503, 603, 703, 803) that is adapted to interact with the television system (205, 305, 505,

605, 1057), the television system having a screen (125, 231, 325, 531),
wherein the media source is a repository of a plurality of video streams,
the phone comprising:
a communication interface (121, 223, 241, 420, 445);
a user input interface (117, 217, 319, 428, 451, 909) adapted to receive a user input identifying a video selection; and
processing circuitry (113, 213, 313, 417) adapted to:
 retrieve from the media source (107) via the communication interface, a first video stream according to the video selection; and
 transmit a control signal via the communication interface, wherein the control signal is adapted to cause the display of a second video stream according to the video selection on the screen of the television system;
wherein the first video stream is identified for a video display (111, 211, 311, 414, 521) of the phone and the second video stream is identified for the screen of the television system and delivered to the television from the media source (107), and wherein the first and second video streams are two video streams of the plurality of video streams."

Claim 1 of **auxiliary request VII** is identical to claim 1 of auxiliary request VI, except for the deletion of "and" right before "wherein the first and second video streams" and the addition of:

" , wherein the first video stream is a video stream specifically adapted for the video display of the phone, and

wherein the second video stream is a video stream specifically adapted for the screen of the television system"

at the very end of the claim.

Claim 1 of **auxiliary request VIII** is identical to claim 1 of auxiliary request VI, except for the addition of:

"and supports media in phone format and media in television format"

right after "a repository of a plurality of video streams", the insertion of:

"in the phone format and"

right before "identified for a video display" and the insertion of

"in the television format and"

right before "identified for the screen of the television system".

Claim 1 of **auxiliary request IX** is identical to claim 1 of auxiliary request VI, except for the deletion of "and" right before "wherein the first and second video streams" and the addition of:

", and wherein the phone is adapted to send a request to the media source seeking delivery of the first video stream stored in the media source"

at the very end of the claim.

Claim 1 of **auxiliary request X** is identical to claim 1 as granted, except for the addition of:

" , wherein the first and second video streams are different video streams "

right after "on the screen of the television system".

Claim 1 of **auxiliary request XI** is identical to claim 1 as granted, except for the addition of:

"and a media source"

right after "a television system (205, 305, 505, 605, 1057)" and the replacement of "a" by "the" right before "media source (107) via the communication interface".

Claim 1 of **auxiliary request XII** is identical to claim 1 as granted, except for the insertion of:

"to the television system"

right before " , wherein the control signal".

Claim 1 of **auxiliary request XIII** is identical to claim 1 as granted, except for the addition of:

" , wherein the communication interface is adapted to receive media guide information, the media guide information identifying a plurality of media elements "

right after "a communication interface (121, 223, 241, 420, 445)", the insertion of:

"present the received media guide information to a user and "

right before "receive a user input identifying a video selection", and the addition of:

", wherein the video selection is performed using the presented media guide information"

right after "receive a user input identifying a video selection".

Claim 1 of **auxiliary request XIV** is identical to claim 1 as granted, except for the addition of:

", wherein the media source is an internet media server"

right after "a first video stream according to the video selection".

Claim 1 of **auxiliary request XV** is identical to claim 1 as granted, except for the addition of:

", wherein the video selection does not correspond to a media swapping request causing a video stream that was being displayed on the video display of the phone to be displayed on the screen of the television system and a video stream that was being displayed on the screen of the television system to be displayed on the video display of the phone."

at the very end of the claim.

Claim 1 of **auxiliary request XVI** is identical to claim 1 as granted, except for the addition of:

", wherein the video selection does not correspond to a media swapping request causing the phone to send a request to the media source for the second video stream that is currently being presented by the television system and to send a control signal to the media source that directs the media source to deliver the first video stream that is currently being presented by the phone to the television system"

at the very end of the claim.

Claim 1 of **auxiliary request XVII** is identical to claim 1 as granted, except for the insertion of:

"and specifically adapted"

right before "for a video display" and right before "for the screen of the television system".

Claim 1 of **auxiliary request XVIII** is identical to claim 1 as granted, except for the addition of:

"via a communication pathway comprising an Internet link"

at the very end of the claim.

Claim 1 of **auxiliary request XIX** is identical to claim 1 of auxiliary request XI, except for the insertion of:

"the media source is an internet media server,"

right before "the phone comprising:", and the addition of:

"via a communication pathway comprising an internet link"

at the very end of the claim.

Claim 1 of **auxiliary request XX** is identical to claim 1 of auxiliary request XIX, except for the insertion of:

"and specifically adapted"

right before "for a video display" and right before "for the screen of the television system".

Claim 1 of **auxiliary request XXI** reads as follows:

"A system comprising a television system (205, 305, 505, 605, 1057), a media source and a phone (103, 203, 303, 403, 503, 603, 703, 803) that is adapted to interact with the television system (205, 305, 505, 605, 1057), the television system having a screen (125, 231, 325, 531), the phone comprising:
a communication interface (121, 223, 241, 420, 445);
a user input interface (117, 217, 319, 428, 451, 909) adapted to receive a user input identifying a video selection; and
processing circuitry (113, 213, 313, 417) adapted to:
retrieve from the media source (107) via the communication interface, a first video stream according to the video selection; and
transmit a control signal via the communication interface, wherein the control signal is adapted to cause the display of a second video stream according to the video selection on the screen of the television system, wherein the first and second video streams are different video streams; wherein the first video stream is identified for a video

display (111, 211, 311, 414, 521) of the phone and the second video stream is identified for the screen of the television system and delivered to the television from the media source (107)."

Claim 1 of **auxiliary request XXII** reads as follows:

"A system comprising a television system (205, 305, 505, 605, 1057), a media source and a phone (103, 203, 303, 403, 503, 603, 703, 803) that is adapted to interact with the television system (205, 305, 505, 605, 1057), the television system having a screen (125, 231, 325, 531), the television system and the phone being located at a first premises, the phone comprising:

a communication interface (121, 223, 241, 420, 445);
a user input interface (117, 217, 319, 428, 451, 909) adapted to receive a user input identifying a video selection; and

processing circuitry (113, 213, 313, 417) adapted to:
retrieve from the media source (107) being located at a remote premises from the first premises via the communication interface, a first video stream according to the video selection; and
transmit a control signal via the communication interface, wherein the control signal is adapted to cause the display of a second video stream according to the video selection on the screen of the television system; wherein
the first video stream is identified for a video display (111, 211, 311, 414, 521) of the phone and the second video stream is identified for the screen of the television system and delivered to the television from the media source (107)."

Claim 1 of **auxiliary request XXIII** reads as follows:

"A system comprising a television system (205, 305, 505, 605, 1057), a media source and a phone (103, 203, 303, 403, 503, 603, 703, 803) that is adapted to interact with the television system (205, 305, 505, 605, 1057) and a media source (107), the television system having a screen (125, 231, 325, 531), the media source is an internet media server, the phone comprising:

a communication interface (121, 223, 241, 420, 445);
a user input interface (117, 217, 319, 428, 451, 909) adapted to receive a user input identifying a video selection; and

processing circuitry (113, 213, 313, 417) adapted to:

retrieve from the media source (107) via the communication interface, a first video stream according to the video selection; and

transmit a control signal via the communication interface, wherein the control signal is adapted to cause the display of a second video stream according to the video selection on the screen of the television system, wherein

the first video stream is identified for a video display (111, 211, 311, 414, 521) of the phone and the second video stream is identified for the screen of the television system and delivered to the television from the media source (107) via a communication pathway comprising an internet link."

Reasons for the Decision

1. MAIN REQUEST

1.1 Claim 1 - novelty over D13 (Articles 100(a) and 54 EPC)

1.1.1 Using the wording of claim 1, document **D13** discloses (outline as used in the decision under appeal):

1 A phone ("REMOTE CONTROL UNIT 10") that is adapted to interact with a television system ("TV 80"), the television system having a screen (col. 5, l. 11-15; col. 7, l. 1), the phone comprising:

1.1 a communication interface (Fig. 2: arrows "110", "115", "120"; Fig. 4: "RF ANTENNA 280", "CONTROL IR 355", "IrDA 360");

1.2 a user input interface ("TOUCH SCREEN 375") adapted to receive a user input (col. 9, l. 4: "... physical or touch screen actuating buttons ..."; col. 8, l. 20: "... by the press of a button ..."; col. 8, l. 22-23: "... a button may allow the user to execute a 'swap' ...") identifying a video selection (col. 8, l. 21: "... the desired program ..."; col. 8, l. 25: "... the program that was being played on the primary display ...");

1.3 processing circuitry (Fig. 4) adapted to:

1.3.1 retrieve from a media source (e.g. "broadcast TV", "cable TV", etc.) via the communication interface a first video stream ("desired program") according to the video selection (col. 8, l. 21; col. 8, l. 25: "... the program that was being played on the primary display ..."; col. 9, l. 48-50: "... The signals 85 may originate from broadcast TV, cable TV, satellite TV, ..."); Fig. 2: "VIDEO AND AUDIO

SIGNALS (MAY CONTAIN EMBEDDED DATA) 85", "DATA FROM OUTSIDE SOURCE (E.G. THE INTERNET));

- 1.3.2 transmit a control signal ("command") via the communication interface, wherein the control signal is adapted to cause the display of a second video stream according to the video selection on the screen of the television system (col. 10, l. 49-52: "... Typical commands from the remote control 10 to the base station 75 may be a request for a new channel to view on the display 15 (i.e., channel surfing), a request to swap displayed programs with the TV 80, ..."; col. 11, l. 39-42: "... a command is sent from the remote control 10 to the TV 80 to tune the TV tuner to that channel, i.e., the channel that the base station 75 was tuned to just prior to the swap ...");

- 1.3.3 the first video stream is identified for a video display of the phone (col. 8, l. 18-27: "the desired program that was found while surfing" is sent to the remote control's display 15 when the user presses the button in both the "channel surfing" and the "swap" embodiment, additionally, "the program that was being played on the primary display" is sent to the remote control's display in the "swap" embodiment after the user presses the button) and the second video stream is identified for the screen of the television system and delivered to the television from the media source (col. 8, l. 18-27: after the user presses the button, "the desired program that was found while surfing" is sent to the primary display 15 in both the "channel surfing" and the "swap" embodiment).

The subject-matter of claim 1 is therefore not new (Article 54 EPC) in view of document D13.

1.1.2 The appellant argued that document D13 did not disclose features 1, 1.3.1, 1.3.2 and 1.3.3:

(a) With respect to feature 1, the necessity of having to provide for additional microphones meant that the "remote control unit" of D13 did not have its own microphones, i.e. the additional microphones were not part of the remote controller. A remote controller without a microphone could not be a "phone". Already for this reason, the remote controller of D13 was not a phone. Furthermore, D13 did not disclose that a combination of the remote controller and microphones was a phone (i.e., had all necessary features of a phone), but only that this combination could form part of a "video phone system". In addition, the skilled person was used to distinguish between "devices" and "systems", wherein the skilled person used the term "system" in a more generic way so as to also encompass cases in which the technical problem could be solved by the contribution of more than one device. It was established case law that a generic disclosure did not destroy the novelty of a more specific feature. Thus, the "phone system" of D13 was not the same subject-matter as the "phone" of feature 1.

(b) With respect to features 1.3.1 to 1.3.3, the opposition division's view in the decision under appeal was entirely based on an incorrect claim interpretation. In D13, the same stream previously received at the remote controller was then received on the TV (and, in the case of a "swapping request" mentioned in column 8, lines 21-26 of D13, the

stream previously received at the TV was then received on the remote controller). The respective source 85 of the broadcast TV, cable TV or satellite TV provider was not involved in any way in this process. It merely constantly provided its data stream including an analog or digital TV broadcast signal, satellite TV signal or cable TV signal as an input to the base station. This was not in accordance with the requirements of features 1.3.1 to 1.3.3, according to which the first video stream and the second video stream must be *separate and different* data streams originating from the source. Further, due to a lack of communication of the remote controller with the source and of the base station with the source, there was no retrieval of a "first video stream" from the source, contrary to feature 1.3.1. In accordance with the common meaning of the term "retrieve", retrieving a stream from a media source was not a *passive* activity. Rather, it required a *direct communication* between the retrieving entity and the media source and a *retrieval request* for a video stream with *specific* characteristics in accordance with feature 1.3.3. Hence, according to claim 1, the claimed "phone" had to send two signals, i.e. a "retrieve signal" and a "control signal".

1.1.3 The appellant's arguments are not convincing:

- (a) As to **feature 1**, D13 discloses a "video phone system" of which the remote controller 10 and additional microphones form part. This "video phone system" should be the claimed "phone". The argument that "system" should be more generic than "device"

is moot because claim 1 merely refers to a "phone", which is even more generic than a "phone system".

- (b) As to **features 1.3.1 to 1.3.3**, the board endorses the opposition division's and the respondent's interpretation of these features. These features are disclosed by the embodiments according to column 8, lines 21-26 of D13, *with or without* the base station being an integrated part of the remote controller (see col. 9, l. 19-23). This is because, in both the "channel surfing" and the "swap" embodiment, the use of a button indubitably causes the media source to deliver a particular channel to the TV. Regardless of its content, this second end-to-end stream of information was not being delivered to the TV *before* the video selection. The resulting first and second streams are *separate and different* data streams, even if they may transport the same TV channel content. Furthermore, the "data streams" of D13 need not be broadcast TV channels only. Rather, they can originate from any other source: a VCR, a laser disc, a DVD or the internet (see e.g. D13, column 9, lines 48-53). A base station may switch those data streams. Yet, each data stream is "identified" (and processed) for video display at the corresponding receiver. Moreover, the board notes that feature 1.3.3 does not even appear to limit the scope of claim 1, since the indicated steps of "identification" and "delivery" of the two video streams are not necessarily performed by the claimed "phone".

- 1.2 In view of the above, the ground for opposition under Article 100(a) in conjunction with Article 54 EPC prejudices the maintenance of the granted patent.

2. AUXILIARY REQUESTS I to IX, XXII AND XXIII

Claim 1 of **auxiliary requests I to IX, XXII and XXIII** contains all the limiting features of claim 1 as granted and the following additional features (board's outline and highlighting):

- (i) the media source is a repository of a plurality of video streams (**auxiliary requests I to IV**)
- (ii) the first and second video streams are two video streams of the plurality of video streams (**auxiliary requests I to IV**)
- (j) the first video stream is a video stream specifically adapted for the video display of the phone (**auxiliary request II**)
- (k) the second video stream is a video stream specifically adapted for the screen of the TV system (**auxiliary request II**)
- (iii) the media source supports media in phone format and media in TV format (**auxiliary request III**)
- (iv) the first video stream is in the phone format (**auxiliary request III**)
- (v) the second video stream is in the TV format (**auxiliary request III**)
- (vi) the phone is adapted to send a request to the media source seeking delivery of the first video stream stored in the media source (**auxiliary request IV**)
- (vii) the phone is not adapted to perform a first media swapping request causing the media stream that was being displayed on the video display of the phone to be displayed on the screen of the TV system (**auxiliary request V**)

Claim 1 of **auxiliary requests VI, VII, VIII, IX** concerns a system comprising the "TV system", the

"media source" and the "phone" of claim 1 according to auxiliary request I, II, III and IV respectively.

Claim 1 of **auxiliary request XXII** concerns a system comprising the "TV system", the "media source" and the "phone" of granted claim 1 with the following additional features (board's outline and highlighting):

- (viii) the TV system and the phone being located at a first premises,
- (ix) the media source being located at a remote premises from the first premises.

Claim 1 of **auxiliary request XXIII** concerns a system comprising the TV system, the media source and the phone of granted claim 1 with the following additional features (board's outline and highlighting):

- (b) the phone also interacts with a media source,
- (g) the media source is an internet media server,
- (l) the second video stream is delivered to the TV from the media source via a communication pathway comprising an internet link.

2.1 *Admittance into the appeal proceedings (Article 12(6) RPBA, second sentence, 2020)*

2.1.1 The appealed decision was based on different claim requests, auxiliary requests I to X, XXII and XXIII having been submitted with the statement setting out the grounds of appeal. The appellant did not demonstrate that *this* part of the appeal case (i.e. the part relating to these auxiliary requests) was "admissibly raised and maintained" in the opposition proceedings, as required by Article 12(4) RPBA 2020. In consequence, it is an "amendment" which may be admitted

only at the discretion of the board, which shall exercise its discretion in view of, *inter alia*, the complexity of the amendment, the suitability of the amendment to address the issues which led to the appealed decision, and the need for procedural economy.

2.1.2 The appellant's case presented in the statement setting out the grounds of appeal with respect to the newly filed auxiliary requests was either:

- based on the presence of *additional limitations* which had been taken from the description of the application as filed, specifically:
 - paragraphs [43], [44], [45] and [47] for auxiliary request I,
 - paragraph [26] for auxiliary request II,
 - paragraph [29] for auxiliary request III,
 - paragraphs [60] and [64] for auxiliary request IV,
 - paragraphs [22] and [23] for auxiliary request VI,
 - paragraphs [22], [23] and [26] for auxiliary request VII,
 - paragraphs [22], [23] and [29] for auxiliary request VIII and
 - paragraphs [22], [23], [60] and [64] for auxiliary request IX)

or

- *disclaiming* in granted claim 1 the features of granted claim 9 (auxiliary request V). As to auxiliary requests I to IX and XXII, none of features (i) to (ix) was present in an independent claim before. Nor was the specific combination of

features of system claim 1 of auxiliary request XXIII.

- 2.1.3 The appellant turned to the board with eleven additional auxiliary requests which would require examination from the ground up and a re-assessment of the prior art on file in view of the additional features. In agreement with the respondent, the board considers that these requests *could and should* have already been filed before the opposition division, during the first-instance oral proceedings at the latest. The purpose of appeal proceedings is not to examine subject-matter which is substantially different from that considered by the department of first instance. Rather, the primary object of appeal proceedings is to review in a judicial manner the correctness of the appealed decision (cf. Article 12(2) RPBA 2020).
- 2.1.4 The appellant submitted that these claim requests, in particular those addressing a *system* comprising the media source, removed the outstanding issues with feature 1.3.3. Those issues were brought up during the first-instance oral proceedings for the first time and discussed at a rather late point of the day. Since the opposed patent was the subject of infringement proceedings in Germany, coordination with the corresponding attorneys-at-law was necessary. This was not possible during those oral proceedings. Further, the new claim requests did not introduce new discussion points.
- 2.1.5 These arguments are not persuasive. During the oral proceedings before the opposition division (cf. minutes, page 3, paragraphs 29-33), the appellant had the opportunity to file two further claim requests

after the chair closed the debate on novelty with respect to granted claim 1 and announced the opposition division's conclusions. Claim 1 of one of these auxiliary requests, i.e. "auxiliary request 1b", already addressed a "system". The minutes do not record any comments of the appellant about the time allocated for the preparation of the new filings either.

2.2 Thus, the board did not admit auxiliary requests I to IX, XXII and XXIII into the appeal proceedings (Article 12(6), second sentence, RPBA 2020).

3. AUXILIARY REQUEST X

Claim 1 of auxiliary request X contains all the limiting features of claim 1 as granted and the following additional feature (board's outline and highlighting):

(a) the first and second video streams are different video streams.

3.1 *Admittance into the appeal proceedings (Article 12(6), first sentence, RPBA 2020)*

3.1.1 This claim request was filed as "auxiliary request 1a" during the oral proceedings before the opposition division, which did not admit it into the opposition proceedings for *inter alia* not being *prima facie* compliant with the requirements of Articles 84 and 123(2) EPC.

3.1.2 In accordance with Article 12(6), first sentence, RPBA 2020, the board shall not admit *requests, facts, objections or evidence* which were not admitted in the proceedings leading to the decision under appeal,

unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

- 3.1.3 The admittance of this request was at the opposition division's discretion pursuant to Article 123(1) EPC in conjunction with Rules 79(1) and/or 81(3) EPC (rather than Rule 80 EPC; see **T 256/19**, Reasons 4.7). This discretion exists independently of the provisions of Rule 116 EPC (see **T 966/17**, Catchword 3). A board should overrule such a discretionary decision only if the wrong principles were applied or if the decision was taken in an unreasonable way.

This is not the case here. In respect of auxiliary request X, the opposition division assessed *inter alia* "*prima facie* allowability", which is an established criterion as regards admittance. As to the right to be heard, the appellant was additionally given the opportunity to refute the objections raised by the respondent under Articles 123(2) and 84 EPC (cf. minutes, page 5, paragraphs 35 and to 37).

- 3.1.4 The board sees therefore no reason to overrule the opposition's discretionary decision.
- 3.2 Consequently, the board did not admit auxiliary request X into the appeal proceedings (Article 12(6), first sentence, RPBA 2020).

4. AUXILIARY REQUESTS XI, XII, XIV to XXI

- 4.1 *Claim 1 - novelty (Article 54 EPC) in view of D13*

4.1.1 Document **D13** further discloses the additional features associated with auxiliary requests XI, XII and XIV to XXI (board's outline and highlighting):

- (b) the phone is adapted to interact with the media source (col. 10, l. 40-54: "... The remote control 10 may also send commands to other devices, such as a DVD player, VCR, etc., for the control thereof ...") [**auxiliary requests XI, XIX and XX**]
- (c) the control signal is sent to the TV system (col. 9, l. 21-22: "... the base station 75 may be implemented as an integrated part of ... the TV 80") [**auxiliary request XII**]
- (g) the media source is an internet media server (col. 9, l. 50-53: "... Other data 95 from an outside data source such as the internet may enter the base station 75 as indicated by arrow 100 ..."; col. 13, l. 27-31) [**auxiliary requests XIV, XIX and XX**]
- (h) the video selection does not correspond to a media swapping request causing a video stream that was being displayed on the video display of the phone to be displayed on the screen of the TV system and a video stream that was being displayed on the screen of the TV system to be displayed on the video display of the phone (col. 8, l. 20-21: "... the desired program that was found while channel surfing ...") [**auxiliary request XV**]
- (i) the video selection does not correspond to a media swapping request causing the phone to send a request to the media source for the second video stream that is currently being presented by the TV system and to send a control signal to the media

source that directs the media source to deliver the first video stream that is currently being presented by the phone to the TV system (col. 8, l. 20-21: "... the desired program that was found while channel surfing ...") [**auxiliary request XVI**]

(j) the first video stream is specifically adapted for a video display of the phone (col. 13, l. 17-32: "Analog data 85 to be sent to the remote control 10 ... passes through ... may be then processed ... Converted data 85 is sent ... Digital data 85 and/or 95, or portions thereof to be sent to the remote control 10 ...") [**auxiliary requests XVII and XX**]

(k) the second video stream is specifically adapted for the screen of the TV system (col. 13, l. 47 to col. 14, l. 8: "Data 85 and/or 95 or portions thereof to be sent to an analog TV input are treated differently ... Data 85 and/or 95 or portions thereof to be sent to a digital TV input are also treated differently ...") [**auxiliary requests XVII and XX**]

(l) the second video stream is delivered to the TV from the media source via a communication pathway comprising an Internet link (col. 9, l. 50-53: "... Other data 95 from an outside data source such as the internet may enter the base station 75 as indicated by arrow 100 ... ") [**auxiliary requests XVIII, XIX and XX**].

A system (Fig. 2) comprising the TV system, the media source and the phone of claim 1 as granted [**auxiliary request XXI**].

4.1.2 In summary, the board concurs with the opposition division and with the respondent in that the subject-matter of claim 1 of each of auxiliary requests XI, XII and XIV to XXI is not new in view of D13.

With respect to the appellant's arguments, the board has the following observations:

Auxiliary requests XI, XIX, XX

4.1.3 As regards feature (b), the appellant submitted that, in the context of the "channel surfing" embodiment of D13 relied upon by the opposition division for the question of novelty of the main request, there was no communication of the remote controller with the respective source, neither directly nor indirectly via the base station. Rather, the remote controller was "specifically adapted" to interact with the base station only. Thus, the remote controller was not adapted to interact directly or indirectly with the respective source.

The board disagrees. It is immediately apparent that the channel selection is done by the user via the phone, which means that the phone ultimately interacts with the media source, in particular when the media source is a DVD player or a VCR (see e.g. D13, col. 11, l. 51 to col. 12, l. 10).

Auxiliary request XII

4.1.4 As regards feature (c), the appellant submitted that the added requirement was not disclosed or rendered obvious by D13, because in D13 any control signals corresponding to the "swap command" necessarily must

have been transmitted to the base device rather than to the TV system. Also for this reason the swap command of D13 could not constitute the claimed user input identifying a video selection.

This argument is not convincing. When it comes to broadcast TV channels, the control signal of D13 must reach the component ultimately extracting the selected channel from the broadcast TV signal, be it the base station's tuner (cf. D13, col. 11, l. 29), the TV tuner (cf. D13, col. 11, l. 40), a home cable box or a satellite TV receiver (cf. D13, col. 9, l. 42). All of these components are in fact part of a "television system".

Auxiliary requests XIV, XIX, XX

- 4.1.5 As regards feature (g), the appellant submitted that the processing circuitry and the control signal must have been *specifically adapted* to retrieve the first video stream from an internet media server and to cause delivery of the second video stream from such an internet media server, i.e. a particular type of server. Any device to be used for retrieving data from or effecting control of an internet server had to be *specifically adapted* to do so. For example, a television merely having a cable TV input and a cable TV tuner was not able to access an internet server in this way. Rather, this required the circuitry of the TV to be adapted in a particular manner. Moreover, the text portion of column 13, lines 17 to 21 of D13 stated that "data such as text will not necessarily require MPEG compressing" and that therefore digital data or portions thereof to be sent to the remote control "may or may not pass through the MPEG A/V encoder 170". Consequently, this text portion actually disclosed that

non-video data might or might not require MPEG compressing and, thus, might or might not pass through the MPEG A/V encoder.

The board is not persuaded. Document D13 explicitly refers to "ATVs (advance TVs)" with "a two-way internet connection". Furthermore, digital data 95 from the Internet may also include video data, whether or not it requires further MPEG compressing. Consequently, its source is an internet media server.

Auxiliary requests XV and XVI

- 4.1.6 As regards features (h) and (i), the appellant submitted that, in claim 1 of these requests, it was explicitly specified now that the video selection did not correspond to a "media swapping request".

In the view of the board, the subject-matter of claim 1 is still not new in view of at least the "channel surfing" embodiment of D13, without a subsequent "swapping request".

Auxiliary requests XVII, XVIII, XIX and XX

- 4.1.7 As regards features (j) and (k), the appellant submitted that the board's interpretation of the claim wording seemed to be identical to a claim wording stating that "the first video stream is *suitable for* a video display of the phone". Already from this comparison, this interpretation was not correct. A specific adaptation for a specific type of display had to be more than just the ability to be displayed by that type of display. While e.g. a broadcast signal, such as the TV signal of D13, could be received by *different* devices having *different* display resolutions

and still be suitable to be displayed on the different devices, video streams "specifically adapted for" specific display types needed to differ in at least one property which was specific to the respective display type. In this regard, the skilled person understood that "specifically adapted for a video display of the phone" meant that at least one property of the first video stream was different from the corresponding property of the second video stream so that the second video stream was "specifically adapted for the screen of the TV system". Document D13 neither disclosed nor suggested such a difference in the video streams. In contrast, the relevant part of D13 dealt with TV signals of a broadcast nature and being thus provided with identical properties to all different recipients.

This argument is not persuasive. The claim does not specify what "specifically adapted for" should actually entail. As for feature 1.3.3 (see point 1.1.3 above), the board notes that features (j) and (k) do not appear to limit the scope of present claim 1, since also the added step of "specifically adapting" the two video streams is not necessarily performed by the claimed "phone". At any rate, it suffices that the first and second video streams are eventually displayed by the phone and the screen of the TV system, irrespective of the amount of processing that they need to undergo for this purpose and where the processing takes place. This is exactly the same in D13 (see e.g. col. 13, l. 16 to col. 14, l. 8), showing how data streams to be sent to the remote control and to the TV are *treated differently* at the base station.

Auxiliary request XXI

4.1.8 The appellant referred to the reasons presented with respect to the main request.

The board considers that D13 also discloses a "system" comprising all the claimed components (see e.g. Fig. 2).

4.2 It follows that none of auxiliary requests XI, XII, XIV to XXI is allowable under Article 54 EPC either.

5. AUXILIARY REQUEST XIII

Claim 1 of auxiliary request XIII contains all the limiting features of claim 1 as granted and the following additional features (board's outline and highlighting):

(d) the communication interface is adapted to receive media guide information, the media guide information identifying a plurality of media elements,

(e) the user input interface is adapted to present the received media guide information to the user,

(f) the video selection is performed using the presented media guide information.

5.1 *Claim 1 - added subject-matter (Article 123(2) EPC)*

5.1.1 The application as filed consistently differentiates between "user interface" to *present the received media guide information to a user and receive a user input identifying a selected media element, display a video portion of a second media element and receive a media swapping command* (cf. original claims 5 to 7 and paragraph [10]), on the one hand, and "user input interface" to *receive a user input*, on the other hand

(cf. e.g. paragraph [41]: "... The user input interface 428 may comprise one or more of: buttons 429, a touchpad 430, a pen 431, a thumbwheel 432, a mouse 433 and a voice interface 434."). Adapting the "user input interface" so as to *present the received media guide information* thus results in an extension beyond the content of the application as filed.

- 5.1.2 The appellant submitted that "user interface" and "user input interface" were used interchangeably throughout the application as filed.

The board disagrees. The "user input interface" as disclosed in the application as filed has no presentation capabilities and, as such, is univocally distinguishable from the "user interface" of the original claims and the corresponding text of paragraph [10] of the description as filed.

- 5.2 Thus, auxiliary request XIII is not allowable under Article 123(2) EPC.

6. Since there is no allowable claim request on file, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated