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**Datasheet for the decision  
of 7 November 2008**

**Case Number:** T 1355/04 - 3.5.04

**Application Number:** 96914340.3

**Publication Number:** 0827668

**IPC:** H04N 5/44

**Language of the proceedings:** EN

**Title of invention:**

Improvements in receivers for television signals

**Patentee:**

British Sky Broadcasting Ltd.

**Opponent:**

IGR GmbH & Co. KG.

**Headword:**

-

**Relevant legal provisions:**

EPC R. 100(2)

RPBA Art. 15(1), 17

**Relevant legal provisions (EPC 1973):**

EPC Art. 56

**Keyword:**

"Inventive step - yes"

**Decisions cited:**

G 0009/91

**Catchword:**

see reasons, point 7.



Case Number: T 1355/04 - 3.5.04

**DECISION**  
of the Technical Board of Appeal 3.5.04  
of 7 November 2008

**Appellant:** IGR GmbH & Co. KG  
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**Representative:** Eichstädt, Alfred  
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**Respondent:** British Sky Broadcasting Ltd.  
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**Representative:** Whitten, George Alan  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
7 October 2004 concerning maintenance of  
European patent No. 0827668 in amended form.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** A. Teale  
B. Müller

## Summary of Facts and Submissions

I. The opponent's appeal is against the interlocutory decision by the opposition division that, account being taken of the amendments according to the then first auxiliary request made by the patent proprietor, European patent No. 0 827 668 and the invention to which it related met the requirements of the EPC 1973. The patent results from an international patent application filed at WIPO and published as international patent application No. WO 9637996. The opposition was based on grounds of opposition under Article 100(a) EPC 1973 (novelty and inventive step). An objection under Article 123(2) EPC 1973 (added subject-matter) was introduced by the opposition division during opposition proceedings.

II. Claim 1 as maintained in the appealed decision reads as follows:

"A remote control device for controlling a television system including a plurality of independently controllable units, the device comprising plural user selectable keys and being arranged to respond to user selection of a first key by transmitting separate command signals to each of the independently controllable units to cause the television system to be configured in a first configuration and by entering a mode in which the command signals corresponding to a plurality of the keys change such that the remote control device thereafter responds to further user selection of the keys by transmitting command signals pertinent to the first configuration of the television system."

III. According to the reasons for the appealed decision, claim 1 of the first auxiliary request specified that when a first key was selected to set up a desired configuration of the units in the television system, the command signals corresponding to a plurality of the keys also changed, such that the keys on the remote control device could then be selected to control the units in the selected configuration. There was no disclosure or suggestion in either of the following documents:

D1: "Funkschau", vol. 2/95, 5 January 1995, pages 72 to 76,  
D2: DE 27 44 057 A1

that selecting one key to set up a configuration automatically changed the functions of several keys. In particular, it was not implicit in the passage in the left-hand column of page 76 of D1 that the function of a given key was automatically changed when a configuration was selected. The subject-matter of claim 1 of the first auxiliary request was therefore new and involved an inventive step.

Claim 1 according to the first auxiliary request was also found to comply with Article 123(2) EPC 1973, the opponent having disputed whether the application as originally filed disclosed changing the functions of a plurality of keys on the remote control device by the selection of a first key to set up a configuration of the television system. The proprietor had pointed to various passages in the description which made clear that several keys performed different functions in

different configurations of the system. The minutes of the oral proceedings (see page 2, lines 6 to 8) mention the following paragraphs of the published patent in this context: [0038], [0045], [0078] and [0055].

- IV. The opponent appealed, requesting that the decision be set aside and the patent revoked in its entirety. In a subsequently filed statement of grounds of appeal the appellant argued that claim 1 of the patent did not comply with Article 123(2) EPC 1973, since it did not disclose the selection of a first key having a "dual effect" of configuring the television system and changing the function of a plurality of keys on the remote control. The subject-matter of claim 1 of the patent also lacked inventive step, Article 56 EPC 1973, in view of D1 alone, D2 alone or D1 combined with D2.
- V. Within the period under Article 108 EPC 1973 for filing the statement of grounds of appeal the appellant also filed the following document:

D4: Grundig Technische Informationen, 4/5-1980, editorial and pages 171 to 182

as evidence that at the priority date the remote controls of televisions equipped with videotext (VT) decoders had keys whose function changed depending on whether the television was in "TV" or "VT" mode.

- VI. In a response to the statement of grounds of appeal the respondent (proprietor) requested that the appealed decision be upheld on the basis of the patent as maintained by the opposition division. The respondent argued that the dual effect was disclosed in the

- original application and stated that, although not objecting to D4 being introduced into the proceedings, he did request remittal of the case to the first instance if the board considered D4 to be prejudicial to inventive step.
- VII. In a letter dated 26 October 2006 the appellant submitted a change of name and filed a copy of the corresponding extract from the German commercial register.
- VIII. In an annex to a summons to oral proceedings the board expressed its preliminary opinion on the appeal.
- IX. With a letter dated 24 July 2008 the respondent filed a retyped version of the claims of the main request and a new first auxiliary request.
- X. At the oral proceedings held on 28 August 2008 the appellant requested that the decision under appeal be set aside and that the patent be revoked. The respondent requested that the appeal be dismissed and the patent maintained as upheld by the opposition division, or in the alternative, that the patent be maintained on the basis of claims 1 to 8 of the first auxiliary request filed with the letter dated 24 July 2008 and the description and drawings in the version upheld by the opposition division.
- XI. The appellant's arguments may be summarised as follows. The objective technical problem was to simplify the use of the remote control device known from D1. The subject-matter of claim 1 of the main request was obvious in view of D1 alone, in particular in view of

the macro programming mentioned on page 76, left column, and the mention on page 73 (right column, lines 32 to 38) of a universal remote control having means to select a mode appropriate to a particular device to be controlled. The paragraph bridging pages 73 and 74 mentioned a user being able to program a remote control to arrange its functions on different levels, it being possible to arrange commands for different devices on the same level. It would have been obvious to combine the selection of a macro with the selection of a level so that the user no longer had to select the right device. For instance, the macro for watching a video ("Videoschauen") mentioned on page 76, left column, lines 24 to 30, could be combined with the video function to simplify operation for the user. Moreover the reference to macro programming as an additional feature did not exclude the remote control having other functions. The claimed change of key command signals could cover disabling them, and it would be obvious in D1 to disable keys that could disturb a selected macro. As to the macro for recording an encoded satellite programme (see page 76, sentence bridging left and middle columns), the macro did not address the TV. It would have been obvious to leave the remote control in TV mode at the end of the macro to allow the user to set the sound volume.

D2 disclosed a remote control having a switch for selecting a system configuration, the remote control only transmitting commands relevant to that system configuration; see page 1, claim 1, characterising part. The claimed subject-matter lacked inventive step in view of D2 alone or D1 combined with D2.

D4 disclosed a remote control having number keys which served to select a channel in TV mode, but changed function to select page numbers and set the time in videotext (VT) mode. This avoided a change of page in VT mode also inadvertently causing a change of TV channel; see page 176, left column, lines 37 to 41. According to the paragraph on page 180 bridging the centre and right columns, the command signals received from the remote control differed depending on whether the remote control was in TV or VT mode. The claimed subject-matter consequently lacked inventive step in view of D4 alone.

The respondent's objection about the board investigating beyond the grounds of appeal was unfounded. Although the board had put questions about new passages in the patent and cited documents, and raised arguments that had not been addressed before, these all related to the grounds of appeal, namely added subject-matter and lack of inventive step.

XII. The respondent's arguments may be summarised as follows.

The parts of the published patent disclosing the television mode and the satellite mode provided the proper basis for the claimed subject-matter. The claimed change in the command signals corresponding to a plurality of remote control keys had a basis in the parts of the published patent relating to the "INFO" key and the four coloured keys in the two modes. According to paragraph [0033] of the description, the remote control comprised a memory 63 (see figure 4) which included codes for the "vast majority of televisions available in a given market". In this sense



the remote control was a "universal" remote control. Moreover the decoder, VCR and TV could be from different manufacturers and thus use different control codes. It was thus implicit that the command signals corresponding to the remote control keys changed and that the same memory contained the command signals for the decoder. Merely disabling a key did not amount to changing the corresponding command signal.

Claim 1 of the main request set out three groups of features: the configuration signal, key signal mode and the dual effect that both were caused by pressing a key. The result of the invention was that the user did not need to think about the configuration of the television system. The term "pertinent" in claim 1 of both requests excluded, for instance, the assignment of the up/down keys to the decoder when the remote control was in television mode, since this would deprive the user of control over the television channel.

D1 formed the closest prior art, since the macro programming mentioned in D1 disclosed the configuration signal. D1 also disclosed in the paragraph bridging pages 73 and 74 the programming of television system commands not only on different levels but also, in the case of the UMA device, all together on one level. None of the cited documents disclosed the combination of a configuration signal and a key signal mode resulting from pressing a single key. The disclosures on pages 73 and 76 of D1 were separate; there was no suggestion in D1 that a macro key could switch the mode of a universal remote. The reference in D1 to macro programming as an additional feature meant that the remote control could have other functions. Indeed the

table on page 76 showed that each of the four remote controls offering macro programming also had either pre-programmed or adaptive key signal modes. Although D2 disclosed separate key signal modes, there was no suggestion of a configuration signal. The disclosure in D4 on page 180 (see the paragraph bridging the middle and right columns) related to the decoder rather than to the remote control itself. Moreover in D4 the transmitted command signals did not change between TV and VT mode, they were simply ignored by the decoder in TV mode; see page 181, left column, lines 37 to 44.

The respondent objected that the board considered facts and arguments in the discussion in the oral proceedings which went beyond the grounds of appeal.

XIII. After deliberation by the board the chairman of the board declared the debate closed, announced that the decision would be given in writing and closed the oral proceedings.

### **Reasons for the Decision**

1. *Admissibility*

The appeal is admissible.

2. *The main request, amendments, Article 123(2) EPC*

Editorial amendments aside, claim 1 differs from that originally filed in the addition of the expression "by entering a mode in which the command signals corresponding to a plurality of the keys change such

that the remote control device ...". This expression has a basis in page 18, lines 1 to 20, of the application as originally filed and published as WO 9637996 (corresponding to paragraphs [0035] and [0036] of the published patent), concerning putting the television system in a television configuration and the processor of the remote control in a television mode, and page 20, line 2, to page 21, line 1 (corresponding to paragraphs [0040] and [0041] of the published patent), concerning putting the television system in a satellite configuration and the processor of the remote control in a satellite mode. In both cases pressing the TV key or SAT key, respectively, has what the parties have called the "dual effect" of transmitting separate command signals to each of the independently controllable units, for instance the television and the digital integrated receiver decoder (termed "decoder" in the description), to set up the system configuration as well as changing the mode of the processor of the remote control to thereafter (in the first configuration) transmit different command signals than before, for example changing the command signals corresponding to the "INFO" and four coloured keys; see original page 19, lines 6 to 16, and page 22, lines 10 to 23 (corresponding to paragraphs [0038], [0044] and [0045] of the published patent). These changes have the effect that the "INFO" key turns on teletext in the television mode and the IEPG (intelligent electronic programme guide) in the decoder in the satellite mode. Likewise the four coloured keys relate to teletext fast-text facilities in the television mode and to IEPG quick response commands in the satellite mode. In other words, by changing the mode of the remote control the "INFO" and coloured keys control a different device, be

it the television or the decoder. Since the codes for transmission by the transmitter are stored in the memory (63) of the remote control (see original page 17, lines 8 to 13, and paragraph [0033] of the published patent) it follows that in the remote control device as claimed the user may select keys which cause the device to transmit different command signals to a different device in said modes.

Apart from editorial amendments in claims 2 and 3, dependent claims 2 to 8 are the same as claims 2 to 8 as originally filed.

The board consequently agrees with the appealed decision (reasons, point 6) that the claims satisfied Article 123(2) EPC 1973 and also finds that the claims now satisfy Article 123(2) EPC.

3. *Construction of claim 1 of the main request*

The board understands the expression in claim 1 "independently controllable units" as meaning devices such as a television, a decoder or a VCR which may "each" be controlled by "separate command signals" (implying different command signals for different devices); see paragraphs [0005] and [0021], lines 18 to 22, of the published patent. The expression in claim 1 "command signals pertinent to the first configuration of the television system", understood in the light of the television and satellite modes of the remote control described in paragraphs [0036] and [0041] of the published patent, means command signals required by the user to control the available functions of the

first configuration, such as teletext in the television mode and the IEPG in the satellite mode.

4. *The prior art*

4.1 *Document D1*

D1 reviews the multi-function remote controls available shortly before the earlier of the two priority dates (22 May 1995) of the patent in suit, summarized in the table on page 76. According to page 75, lines 5 to 7 from the bottom, a universal remote control can typically control several independently controllable units, for instance a television, a satellite receiver and a HiFi system. D1 discusses several arrangements for allowing the user to access commands relevant to the various devices being controlled. According to page 73, right column, lines 32 to 54, in some multi-function remote controls the device to be controlled must first be selected before selecting the device functions. The paragraph bridging pages 73 and 74 discusses programmable remote controls where the user can arrange device functions on different levels, even mixing functions for several devices, for example television and video functions, on the same level. An example is also given where all device functions are available simultaneously on one level; see page 74, right column, lines 7 to 12. Some remote controls have the additional feature of macro programming ("Makros"); see page 76, left column, line 24 to middle column, line 7. This means that, as an additional feature of a remote control, a sequence of key presses can be stored under one key as a macro. For instance, a macro could allow a video to be watched or an encrypted satellite

programme to be recorded. In the case of watching a video, the television is turned on, the VCR is turned on, the television is switched to the AV channel and PLAY is selected on the video recorder; see page 76, left column, lines 25 to 30.

#### 4.2 *Document D2*

D2 concerns a remote control in which the effect of several keys or analogue controls varies depending on the setting of a function selector; see characterising part of claim 1. D2 contains no hint at, in response to user selection of a first key, transmitting separate command signals to a plurality of independently controllable units to configure a system.

#### 4.3 *Document D4*

D4 relates to a remote control (see figure 20, page 181) for controlling a television having a removable videotext module ("Cassette") (see figure 9, page 175), allowing the television to operate in a TV mode and a "VT" (videotext) mode. The number keys serve to select a channel in TV mode, but change function to select page numbers in VT mode; see page 176, left column, lines 37 to 41. The videotext decoder is controlled by signals received via an interface from the television; see page 174, right column, lines 38 to 56, and page 176, left column, lines 7 to 22. The decoder can distinguish between TV and VT commands by means of two bits in the data words it receives via the interface; see page 180, paragraph bridging middle and right columns. However this does not necessarily mean that the command signals corresponding to keys of the remote

control change between the TV and VT modes. It might be that, according to whether the television is in the TV or VT mode, it interprets the same command signals from the remote control differently and adapts the signals sent via the interface to the decoder accordingly. Hence it is not directly and unambiguously derivable from D4 that the command signals corresponding to keys of the remote control change between the TV and VT modes. Moreover the board does not consider the module and the television to be independently controllable units in the sense of claim 1, since it is also not directly and unambiguously derivable from D4 that the module can be controlled independently from the television. There is also no hint in D4 at, in response to user selection of a first key, transmitting separate command signals to a plurality of independently controllable units to configure a system.

5. *Main request, inventive step, Article 56 EPC 1973*

The closest prior art is the disclosure of macro programming in D1 (see page 76, left column, line 24, to middle column, line 7). According to this passage, as an additional feature of a remote control a sequence of key presses can be stored under one key as a macro. A macro is described which allows a video to be watched by turning on the television, turning on the VCR, switching the television to the AV channel and selecting PLAY on the video recorder. Hence D1 discloses a remote control device for controlling a television system including a plurality of independently controllable units (the television and the VCR), the device comprising plural user selectable keys and being arranged to respond to user selection of

a first key (the macro key) by transmitting separate command signals (the macro steps) to each of the independently controllable units to cause the television system to be configured in a first configuration.

The subject-matter of claim 1 differs from this disclosure in that the remote control device also responds to user selection of the first key by entering a mode in which the command signals corresponding to a plurality of the keys change such that the remote control device thereafter responds to further user selection of the keys by transmitting command signals pertinent to the first configuration of the television system. The effect of the difference features is that a plurality of keys address a different independently controllable unit in the television system in response to pressing the first key. In the case disclosed in the patent, the command signals corresponding to the "INFO" and four coloured keys of the remote control change between the television and satellite modes so that the decoder is addressed instead of the television.

The objective technical problem is seen as seeking to simplify user control of a television system, as may be derived from paragraph [0011], first sentence, of the published patent. This has also been argued by the appellant. The skilled person would consider such a problem as a matter of usual design.

However none of the documents relied upon by the appellant discloses the "dual effect" that user selection of a first key causes separate command signals to be transmitted to each of the independently



controllable units to configure the television system and also causes the remote control to enter a mode in which the command signals corresponding to a plurality of the keys change. Starting from the macros known from D1, which allow a video to be watched or an encrypted satellite programme to be recorded, the board is not convinced that it would then be obvious to change the command signals corresponding to a plurality of keys on the remote control, for instance by selecting the video or television modes (page 73, right column, lines 32 to 38). When running one of the macros the remote control would transmit signals corresponding to the recorded steps without there being a need to enter a mode where keys change signals, since the purpose of the macro is that the corresponding keys need not be pressed again. There is no indication in D1 that any of the keys will be redefined during or after running a macro. In the case of the macro for watching a video, the board is not convinced that it would be obvious to set the remote control to a particular mode, for instance TV mode, at the end of the macro, since the user would also typically wish to be able to pause the VCR. Equally it would also not be obvious to set the remote control to a video mode at the end of the macro, since the user would also typically wish to be able to control the sound volume of the television. Moreover D1 gives examples of remote controls where both the VCR and TV can be simultaneously controlled without a change in key command signals. In the case of the macro for recording an encrypted satellite programme, it seems unlikely that changes to the remote control would be needed once the system had been configured, since it follows from the steps of the macro itself that the programme is not being watched while it is being

recorded. The board is also not convinced that it would be obvious to disable keys which could interfere with a macro, since disabling keys would, in effect, disable certain parts of the system, having the undesirable result that the television system would be harder to control. Since there is no hint in D1 that a macro might set up a different mode in which keys transmit signals to different controllable units, there is no obvious reason for disabling any of the keys. Hence the board need not go into the question of whether disabling keys amounts to changing the corresponding command signals.

Turning to D2, although the command signals corresponding to the keys of the remote control can be changed using the function selector, there is no hint at one key press resulting in several devices being addressed to configure a television system. Hence even combining D1 with either D2 or D4 (see point 4.3 above) does not yield the subject-matter of claim 1.

The board consequently agrees with the appealed decision (reasons, point 5) that the subject-matter of claim 1 is considered to involve an inventive step, Article 56 EPC 1973. Hence the board also agrees with the finding of the opposition division that, account being taken of the amendments made by the patent proprietor, the patent and the invention to which it relates meet the requirements of the EPC.

6. *The first auxiliary request*

Since the respondent's main request is allowable, there is no need to consider the respondent's request for remittal or the first auxiliary request.

7. *Procedural matters*

The respondent has objected that the discussion in the oral proceedings went beyond the grounds of appeal. Although the respondent is not adversely affected by the present decision, the board wishes to comment on this objection.

The respondent has not contested that the same legal grounds and documents as were mentioned in the statement of grounds of appeal were also considered by the board in the oral proceedings when putting questions about the basis in the application for certain claimed features and the disclosure of D1, D2 and D4. The objection was rather that the board was too investigative in addressing issues in this context which had not been raised by the appellant. The board concurs with the respondent's argument that the appeal procedure is to be considered as a judicial procedure, which by its very nature is less investigative than an administrative procedure (see G 9/91, OJ EPO 1993, 408, point 18). However this does not mean that a board in examining the appeal within the framework of the legal grounds and facts submitted by the parties is limited to only considering passages in documents indicated and arguments submitted by the parties. Examination of the appeal may raise further relevant questions within this framework. Therefore a board may invite parties to file

observations on matters which are of significance (see Rule 100(2) EPC and Article 15(1) and Article 17 RPBA, OJ EPO 2007, 536).

Moreover, in the present case, amendments of the claims of the patent were made in the course of opposition proceedings. Such amendments are to be fully examined as to their compatibility with the requirements of the EPC (see G 9/91, *supra*, point 19). The questions by the board concerning the construction of the claims mainly related to these amendments. Hence, contrary to the respondent's objection, the discussion in the oral proceedings did not go beyond the grounds of appeal and the board's duty to examine the appeal.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

D. Sauter

F. Edlinger