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**Datasheet for the decision  
of 12 March 2018**

**Case Number:** T 0950/17 - 3.5.05

**Application Number:** 13168270.0

**Publication Number:** 2629191

**IPC:** G06F3/06, H04L12/40, G11B20/00

**Language of the proceedings:** EN

**Title of invention:**  
Apparatus and method for interfacing between A/V system and portable device

**Applicant:**  
Samsung Electronics Co., Ltd.

**Headword:**  
USB controller/SAMSUNG

**Relevant legal provisions:**  
EPC Art. 123(2), 111(1)

**Keyword:**  
Added subject-matter - main request (yes)  
Added subject-matter - auxiliary request (no, after amendment)  
Remittal for further prosecution - (yes)

**Decisions cited:**

T 0759/10



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0950/17 - 3.5.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.05**  
**of 12 March 2018**

**Appellant:** Samsung Electronics Co., Ltd.  
(Applicant) 129, Samsung-ro  
Yeongtong-gu  
Suwon-si  
Gyeonggi-do 443-742 (KR)

**Representative:** Grünecker Patent- und Rechtsanwälte  
PartG mbB  
Leopoldstraße 4  
80802 München (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 18 November  
2016 refusing European patent application  
No. 13168270.0 pursuant to Article 97(2) EPC**

**Composition of the Board:**

**Chair** A. Ritzka  
**Members:** K. Bengi-Akyuerek  
D. Prietzel-Funk

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the examining division to refuse the present European patent application, divided from its parent application EP 06124330.9, on the sole ground of added subject-matter (Article 123(2) EPC).
  
- II. With the statement setting out the grounds of appeal, the appellant filed amended sets of claims according to a main request and three auxiliary requests. It requested that, if the decision under appeal was not rectified by way of an interlocutory revision under Article 109 EPC, the appealed decision be set aside and that (1) the case be remitted to the department of first instance for further prosecution or (2) a patent be granted on the basis of one of the above claim requests. In addition, oral proceedings were requested as an auxiliary measure.
  
- III. In a communication annexed to the summons to oral proceedings pursuant to Article 15(1) RPBA, the board gave its preliminary opinion on the appeal. In particular, it indicated that, despite the amendments made, the present independent claims were not found to be allowable under Article 123(2) EPC. The board also informed the appellant that the case could be remitted to the examining division if the objections under Article 123(2) EPC were overcome.
  
- IV. With a letter of reply dated 28 February 2018, the appellant submitted an amended main request along with counter-arguments on the objections raised in the board's communication as regards the main request on file. It further stated that the "request for oral proceedings is maintained unless the case is remitted

to the first instance on the basis of the main request presently on file or on the basis of the replacement main request."

V. Claim 1 of the **main request** reads as follows:

"A digital data recording and/or reproducing apparatus (520), the apparatus comprising:

a storage unit (620) for storing digital data encoded in a predetermined format;

a decoder unit (650) for decoding digital data stored in the storage unit;

an interface unit (630) comprising a USB device controller for transmitting the decoded digital data to an audio/video system (510); and

a control unit (610) for controlling the storage unit, the decoder unit, and the interface unit, characterized in that:

the control unit controls the decoder unit to decode the stored digital data in units determined by the audio/video system according to a control signal requesting the stored digital data from the audio/video system, the units being determined by transferring information on the digital data from the digital data recording and/or reproducing apparatus to the audio/video system, and

the USB device controller comprises a streaming terminal transmitting the decoded digital data decoded in the determined units, and an interface terminal receiving the control signal requesting the stored

digital data from the audio/video system."

Claim 1 of the **amended main request** reads as follows (amendments to claim 1 of the main request indicated by the board):

"A digital data recording and/or reproducing apparatus (520), the apparatus comprising:

a storage unit (620) for storing digital data encoded in a predetermined format;

a decoder unit (650) for decoding digital data stored in the storage unit;

an interface unit (630) comprising a USB device controller for transmitting the decoded digital data to an audio/video system (510); and

a control unit (610) for controlling the storage unit, the decoder unit, and the interface unit, characterized in that:

the control unit controls the decoder unit to decode the stored digital data in units determined by the audio/video system according to a control signal requesting the stored digital data from the audio/video system, the units being determined by transferring information on the digital data from the digital data recording and/or reproducing apparatus to the audio/video system, and

the USB device controller comprises a streaming terminal transmitting the decoded digital data decoded in the determined units, and an interface terminal receiving the control signal requesting the stored

digital data from the audio/video system, and a setup terminal for transmitting and receiving information required to set the streaming and interface terminals."

The further independent claims 10, 14 and 20 of the amended main request are directed to a complementary audio/video system and corresponding methods respectively.

## **Reasons for the Decision**

### 1. MAIN REQUEST

This request was submitted in reaction to the objections raised under Article 123(2) EPC in the decision under appeal, according to which the interfaces recited in the independent claims on file were restricted to "USB device/host controllers" and "USB bulk, isochronous and control interfaces" (see Reasons 1).

#### 1.1 Claim 1 of the present main request comprises the following limiting features, as labelled by the board (relevant amendments to claim 1 underlying the appealed decision emphasised by the board):

A digital data recording and/or reproducing apparatus, the apparatus comprising:

- A) a storage unit for storing digital data encoded in a predetermined format;
- B) a decoder unit for decoding digital data stored in the storage unit;
- C) an interface unit comprising a USB device controller for transmitting the decoded digital data to an audio/video system;

- D) a control unit for controlling the storage unit, the decoder unit and the interface unit,
- E) wherein the control unit controls the decoder unit to decode the stored digital data in units determined by the audio/video system according to a control signal requesting the stored digital data from the audio/video system, the units being determined by transferring information on the digital data from the digital data recording and/or reproducing apparatus to the audio/video system,
- F) wherein the USB device controller comprises a streaming terminal transmitting the decoded digital data decoded in the determined units and an interface terminal receiving the control signal requesting the stored digital data from the audio/video system.

The further independent claims 10, 14 and 20 include corresponding amendments.

1.2 *Added subject-matter (Article 123(2) EPC)*

The board finds that, despite the amendments made, the present independent claims are still not allowable under Article 123(2) EPC, for the reasons set out below.

- 1.2.1 As to feature F) of claim 1, the application as originally filed consistently teaches that USB device controller 820 of apparatus 520 comprises, apart from "streaming terminal 1010, 1110" and "interface terminal 1012, 1112", also "setup terminal 1008, 1108" for transmitting and receiving information required to set the streaming and interface terminals (cf. paragraphs [0097] and [00102], in conjunction with



Figs. 10 to 12).

- 1.2.2 As to the corresponding feature of independent claim 10, referring to a "USB host controller (810)", the original application consistently teaches that USB host controller 810 of A/V system 510 comprises, besides "streaming terminal 1004, 1104" and "interface terminal 1006, 1106", also "setup terminal 1002, 1102" for transmitting and receiving information required to set the streaming and interface terminals (cf. paragraphs [0097] and [00102], in conjunction with Figs. 10 to 12).
- 1.2.3 Accordingly, the present independent claims amount to an intermediate generalisation of the present application's original content, contrary to Article 123(2) EPC.
- 1.2.4 The appellant argued in its letter of reply (cf. point IV) that the use of a "control interface" associated with a corresponding "setup terminal" was not always referred to in the original disclosure. As support, paragraphs [0021], [0022], [0031], [0032] and [0043], a list of embodiments set out at pages 31 to 40 of the present divisional application and claims of the parent application were provided. Furthermore, the appellant submitted that it was well known in the art that such a control interface between two setup terminals was typically present in USB connections using USB device/host controllers and thus was an implicit feature of the present invention.

The board is not convinced. It is apparent that all the passages quoted by the appellant use the language "may include" or "comprises" (see e.g. paragraph [0022]:  
*"... the USB device controller may include a first bulk*

*interface ..."*; paragraph [0031]: "*... the USB host controller may include a first bulk interface ..."*"; page 31, "Embodiment 3": "*... the USB device controller comprises a first bulk interface ..."*). This, however, does not provide a clear and unambiguous basis that the relevant USB devices exclusively consist of the corresponding specified sub-components (see also T 759/10, Reasons 3.4).

Rather, the relevant exemplary embodiment of the present invention explicitly demonstrates that the corresponding USB devices - along with the expressly mentioned streaming and interface terminals - also expressly comprise setup terminals which are supposed to set the corresponding streaming and interface terminals (see paragraphs [0096] to [00109], in conjunction with Figs. 10 to 12).

1.3 In conclusion, the main request is not allowable under Article 123(2) EPC.

2. AMENDED MAIN REQUEST

Independent claims 1, 10, 14 and 20 of the amended main request differ from the independent claims of the main request essentially in that they now specify that (emphasis added by the board)

G) said USB device and host controllers further comprise a setup terminal for transmitting and receiving information required to set the streaming and interface terminals.

2.1 Added feature G) is supported in particular by paragraphs [0097] and [00102] in conjunction with Figures 10 to 12 of the present application as

originally filed. The board therefore holds that this amendment overcomes the objections raised in point 1.2 above.

2.2 Hence, the amended main request is allowable under Article 123(2) EPC.

3. *Remittal of the case for further prosecution*

3.1 Given that the sole ground for refusal of the present application, i.e. added subject-matter, no longer applies to the claims of the amended main request, the decision under appeal is to be set aside.

3.2 However, the compliance of the present application with the requirements of Article 52 EPC, in particular novelty and inventive step, was neither discussed nor decided in the decision under appeal. Therefore, the board does not consider itself in a position to assess the correctness of any conclusion of the examining division as regards novelty and inventive step, nor to pass final judgment on that issue for the very first time in these appeal proceedings.

3.3 Rather, the board has decided, in the exercise of its discretion under Article 111(1) EPC, to remit the case to the examining division for further prosecution, on the basis of the claims of the amended main request submitted with letter of 28 February 2018.

4. *Request for oral proceedings*

Since the case is to be remitted to the examining division on the basis of the amended main request (see point IV above), the board considers that it can decide on the present appeal without holding oral proceedings.

## Order

### For these reasons it is decided that:

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

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated