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D E C I S I O N
of 23 April 1999

Case Number: T 0619/98 - 3.5.1

Application Number: 90111942.0

Publication Number: 0407791

IPC: H04N 5/44

Language of the proceedings: EN

Title of invention:

Television set

Patentee:

Edico S.r.l.

Opponent:

Koninklijke Philips Electronics N.V.
Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 54, 114(2)

Keyword:

"Novelty, late filed amendments - admitted (no)"

Decisions cited:

T 0115/85

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0619/98 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 23 April 1999

Appellant: Edico S.r.l.
(Proprietor of the patent) Via Atanasio Kircher, 7
00197 Roma (IT)

Representative: Eisenführ, Speiser & Partner
Martinistrasse 24
28195 Bremen (DE)

Respondent: Koninklijke Philips Electronics N.V.
(Opponent) Groenewoudseweg 1
5621 BA Eindhoven (NL)

Representative: Schmitz, Herman Jan Renier
Internationaal Octrooibureau B.V.
Prof. Holstlaan 6
5656 AA Eindhoven (NL)

Respondent: Interessengemeinschaft
(Opponent) für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG
Bahnstrasse 62
40210 Düsseldorf (DE)

Representative: Eichstädt, Alfred, Dipl.-Ing.
Maryniok & Partner
Kuhbergstrasse 23
96317 Kronach (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 14 April 1998
revoking European patent No. 0 407 791 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. S. Wibergh
 V. Di Cerbo

Summary of Facts and Submissions

I. This is an appeal by the proprietor of European Patent No. 0 407 791 against the decision of the Opposition Division to revoke the patent.

II. Claim 1 as granted reads as follows:

"Use of an apparatus comprising a guide to indicate a reason of a malfunction of a television receiver, in cases where the set is not really defective, but only incorrectly set by the user, whereby the receiver is provided with the guide to the user for fixing the apparent defects, said guide being contained in the receiver in such a way that it cannot be separated from the receiver, said apparatus comprising

- a source of prestored messages,
- a control circuit,
- a command device producing, when activated, a first determined command (00) or a second determined command (0) to said control circuit,
- incorporating in said control circuit a logic circuit which reacts to said first determined command (00) providing for
- reading from said source and displaying onto a screen coupled to the receiver a message in form of a question to the user ("The picture is available but the sound is missing?"), and/or of a correlated suggestion ("Check if the switch on the

back of the set is in the left position"),

- said logic circuit reacting to said second determined command (0) providing for reading from said source and displaying onto the screen a next message, and
- the control circuit incorporates a testing unit (11,18) which checks whether a command from the command device corresponds to the first or second determined command and which supports the display of a further message."

III. Respondent I and Respondent II had opposed the patent on the grounds that the invention was not new or did not involve an inventive step having regard to - among others - the documents

D1: EP-B-0 149 735 and

D2: EP-A-0 057 914.

Respondent I had submitted that claim 1 furthermore involved presentation of information.

IV. The Opposition Division held that the subject-matter of claim 1 was not inventive over a combination of the documents D2 and D1.

V. With the communication dated 15 February 1999 the parties were summoned to oral proceedings to be held before the Board on 23 April 1999, a date to which they had already agreed. On 10 March 1999 the appellant asked for postponement of the oral proceedings due to

illness of the inventor. This request was not granted by the Board in view of the administrative complexity of rearranging oral proceedings involving three parties and interpretation.

- VI. In a communication annexed to the summons the rapporteur indicated that the claims contained obscurities and therefore would have to be interpreted in the light of the description. As usual, a deadline was set for filing amendments (one month before the date of the oral proceedings) in accordance with the "Guidance for parties to appeal proceedings and their representatives" (OJ 1996,342).
- VII. On 19 April 1999 the appellant filed claims according to a new main request and four auxiliary requests. During the oral proceedings on 23 April 1999, however, the appellant reinstated his previous main request for maintenance of the patent as granted.
- VIII. The appellant argued that the subject-matter of claim 1 as granted was both new and inventive with respect to D1. The first auxiliary request had been filed to overcome the clarity objections raised in the Board's communication and involved only formal amendments to claim 1 as granted.

Respondent I submitted that the appellant should not be allowed to switch back to his original main request. In any case the subject-matter of claim 1 as granted was not new since any differences with respect to D1 would at most concern the content of the information presented to a user.

Respondent II argued that the appellant's auxiliary requests should be rejected as having been filed late. The subject-matter of claim 1 as granted was regarded as anticipated by D1.

- IX. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted. In the alternative it was requested that the patent be maintained according to the five requests submitted with letter of 19 April 1999.
- X. The respondents requested that the appeal be dismissed. As auxiliary request they requested that the procedure be continued in writing.

Reasons for the Decision

- 1. Four days prior to the oral proceedings before the Board, the appellant filed a new main request and four new auxiliary requests. At the oral proceedings the appellant reinstated the previous main request (the patent as granted) and retained the new claims as auxiliary requests. Respondent I has argued that the original main request had been dropped and should not be considered anymore in the proceedings. The Board finds however that if a party files new requests at such a late stage that it is uncertain whether they will be allowed into the proceedings, it would be unfair if he could not at least fall back on the previous request even if this was not explicitly asked for when the new requests were filed. The Board will therefore consider the appellant's main request.

The appellant's main request

2. *The invention*

The invention according to claim 1 as granted is the use of an apparatus, in particular a TV receiver. The apparatus comprises a guide (similar to an operating manual) which can be activated by the operator, for example by means of the remote control. This guide contains information which may be displayed on the screen as a sequence of messages. In case the apparatus is not in need of repair but has merely been incorrectly set, the operator - prompted by the displayed messages - will be able to adjust it himself. According to the description, typical problems which can be solved in this way are that switches are in the wrong position or that the antenna cable has not been properly attached.

3. *The closest prior art*

D1 describes a video tape recorder (VTR) in which service information has been stored in non-volatile memory. By activating a switch 22 a message is displayed on a connected TV screen. Another switch 23 is used to jump from message to message. The information displayed can consist of an instruction to the operator to perform a certain act, of a confirmation that an operator input has been understood, or of an indication that a certain setting is incorrect.

4. *Novelty*

- 4.1 Both respondents have submitted that the subject-matter of claim 1 is not new with respect to D1. According to Respondent II, the hardware in D1 is the same as the one indicated in claim 1, the instructions given to the operator according to D1 are a "suggestion" in the meaning of claim 1, and the mentioning of an incorrect setting ("Fehleinstellung") in D1 shows that also the situation to which the claimed use is limited - "in cases where the set is not really defective, but only incorrectly set by the user" - is covered by this prior art.
- 4.2 The appellant has argued that a number of features of claim 1 are not known from D1. The information displayed according to D1 was directed to a repairman, not to a user. The VTR would therefore in general not merely be incorrectly set, but defective. The guide would contain information aimed at a repairman and understandable only by him. Also the hardware was different: the switches in D1 were accessible only to a repairman whereas according to the invention the remote control was used; these switches were moreover not connected with the logic circuits (microprocessor) as required by claim 1 but only with a memory unit (10), and consequently there was also no test for determining which switch had been activated.
- 4.3 The Board first notes that the claimed use is defined by three different kinds of features: (a) those setting out the apparatus (hardware) as such of which use is made, (b) those setting out the particular state of this apparatus, and (c) those setting out the type of information shown to the user.

4.4 As to (a), the Board agrees with the respondents that no clear distinction can be made between the hardware set out in claim 1 and that described in D1. The switches 22 and 23 in D1 can be seen as a "command device", a clear term which cannot be construed to mean merely "remote control". It is true that in the figure of D1 no connection is shown between the switches and the microprocessor, but this is immaterial considering that the disclosure as a whole leaves no doubt that the data entered via the switches influence the way the microprocessor works (the processor is said to control the data flow) and thus that a connection of some kind must exist. It is also true that the actual wiring of the apparatus described in D1 would be different from the invention, as pointed out by the appellant, but such differences are not apparent on the claim level and therefore need not be considered. Finally D1 must contain means for checking which command has been entered if the commands are to be understood at all.

4.5 As to (b), claim 1 specifies that the apparatus "is not really defective, but only incorrectly set by the user". This is a limitation to the use of the apparatus if it is in a certain state. The wording excludes unambiguously some states, such as if the apparatus is working perfectly or if it is not working at all, but otherwise the borderline between an "incorrectly set" apparatus and a "really defective" one will be hard to draw. It may be that D1 concerns primarily serious errors which require the skills of a professional repairman, as the appellant has argued, but on the other hand the word "Fehleinstellung" does seem to suggest that the VTR may just be "incorrectly set". The passage at the top of column 2 of D1, which states that

the invention is applicable to every kind of service function which might occur, also makes it difficult to conclude that D1 does not aim at "incorrectly set" devices. Since in general novelty should not depend on features whose meaning is not fully clear, the Board takes the view that the above feature is not distinguishing.

It is furthermore noted that the feature "incorrectly set" may contain a subjective element since the correctness of in particular the brightness and contrast settings (an example mentioned in the description) will in some degree depend on the preferences of the individual user. This is seen as a further indication that too much weight should not be attributed to this feature.

4.6 As to (c), claim 1 contains one feature which bears directly on the information given by the messages displayed: that the messages are in the form of questions and/or suggestions. Another feature is intended to define the information indirectly: that the messages are aimed at a "user" (as opposed to a repairman), implying - it has been argued - that they may relate for example to possibly incorrect screen control settings but not, say, to the electronic components of the apparatus. The Board has some doubts that a particular kind of "user" can at all be assumed for a use claim but, to the benefit of the appellant, it is in the following taken for granted that the restriction mentioned is indeed implied by the claim.

4.7 *Prima facie* the features of the kind (c) seem non-technical, ie not serving to define the matter for

which protection is sought (Rule 29(1) EPC). Nevertheless, according to well-established jurisprudence of the Boards of appeal, a mix of (known) technical features and apparently non-technical features may still be patentable as long as the latter features contribute to an overall technical effect. It need therefore be examined whether the features of the kind (c) bring about a technical effect or whether they merely serve to present information, as Respondent I has argued.

- 4.8 In the Guidelines C-IV 2.3 it is pointed out that "the arrangement or manner of representation, as distinguished from the information content, may well constitute a patentable technical feature", a statement the Board fully agrees with. In the present case, however, whether a message is in the form of a "suggestion" or not is recognisable solely from the information conveyed by the message. It is thus not possible to separate this kind of "form" of a message from its "content", and therefore the claimed suggestion form is not a "manner of representation" in the meaning of the Guidelines. Furthermore, any effect the message has will be on the mind of the user only, ie the effect is not technical. Even if the user as a consequence of the displayed message "Check if the switch on the back of the set is in the left position!" (which is the example in claim 1) walks up to the TV set and connects its antenna cable properly, this personal reaction of his cannot be regarded as a technical effect. (If it were, the exclusion of presentations of information in Article 52(2) EPC would become largely meaningless). The present situation should be contrasted with the hypothetical one that the

apparatus itself is capable of interpreting and reacting to the messages, in which case a technical effect would be given due to the absence of a human link. The situation is also different from the one described in decision T 0115/85 (OJ 1990,030) in which the displayed messages indicated the actually detected state of a system.

The same reasoning applies to messages in the form of questions. Similarly, the kind of user for whom the messages are aimed determines at most the complexity of the information presented, ie its content and not the manner of its representation.

The Board therefore concludes that these features do not produce a technical effect of any kind. It follows that they are not "technical features" in the meaning of Rule 29(1) EPC and, consequently, that they cannot serve to distinguish the invention from the prior art.

The subject-matter of claim 1 must thus be regarded as not new.

The appellant's auxiliary requests

5. Respondent II has submitted that the claims according to the appellant's five auxiliary requests should not be admitted into the proceedings because of their having been filed late. This was all the more appropriate considering that the amendments were not based on the granted dependent claims and that their basis in the application as filed had not been indicated. Respondent I has announced that he would raise objections under Article 123(2) and (3) EPC against these claims if they were admitted.

The appellant has explained that the requests could not be filed earlier since, due to the inventor's illness, the necessary technical discussions had been delayed. The first auxiliary request had been amended in response to the communication of the Board and could therefore not be regarded as late filed. Claim 1 according to this request had merely been clarified. There was no intention to extend the scope of the claims, which was anyway not possible since no features had been deleted as compared with claim 1 as granted.

6. As to the first auxiliary request, the appellant admits that the amendments have been made in order to clarify the wording of the claims as granted. In view of Rule 57a EPC, however, such amendments are not normally admitted, and mere clarifications would in any case not overcome the novelty objection against the main request. Therefore the first auxiliary request will not be further considered.
7. According to the second to fifth auxiliary requests,

truly limiting features have been added to claim 1. Nevertheless, these features are not such that it is *prima facie* apparent that the claimed invention might be inventive with respect to D1. The Board in fact doubts strongly that there is any subject-matter at all in the patent-in-suit on which a clearly acceptable independent claim could be based. In these circumstances the Board finds it appropriate to disregard these auxiliary requests under Article 114(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg