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D E C I S I O N
of 20 December 2001

Case Number: T 0116/00 - 3.5.1

Application Number: 92116493.5

Publication Number: 0534478

IPC: H04M 1/72, H04M 1/274, H04M 1/02

Language of the proceedings: EN

Title of invention:
Portable telephone apparatus including electronic notebook function

Patentee:
Casio Computer Co. Ltd.

Opponent:
Interessengemeinschaft für Rundfunkschutzrechte GmbH Schutzrechtsverwertung & Co. KG

Headword:
Portable telephone apparatus/CASIO

Relevant legal provisions:
EPC Art. 54(3), 56, 108
EPC R. 87

Keyword:
"Form of appeal - time limit"
"Novelty - prior European application"
"Inventive step (yes)"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0116/00 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 20 December 2001

Appellant: (Opponent)
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Schutzrechtsverwertung & Co. KG
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Representative:
-

Respondent: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 3 November 1999 rejecting the opposition filed against European patent No. 0 534 478 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: S. V. Steinbrener
Members: A. S. Clelland
P. Muehlens

Summary of Facts and Submissions

I. This is an appeal against the decision of the Opposition Division dated 3 November 1999 to reject an opposition against European patent No. 0 534 478.

II. The opposition was on the grounds of lack of novelty and lack of inventive step, and was based *inter alia* on the following documents, the Board adopting the opponent's nomenclature:

E1: EP-A-0 472 361

E2: US-A-4 481 382

E8: Patent abstracts of Japan, vol. 15, no. 434 (E-1129) 6 November 1991 relating to JP-A-3 181 252,

E8": Certified English translation of JP-A-3 181 252, filed during the opposition proceedings.

E13: US-A-4 517 660.

III. An appeal was filed on 3 January 2000; subsequently the statement of grounds of appeal was filed by fax on 13 March 2000, the three-page fax bearing the time stamp "23.58" on page 1 and "23.59" on pages 2 and 3. The appellant (oppponent) focused on the argument that

granted claim 1 lacked novelty with respect to document E1. Furthermore, the presence of inventive step was summarily contested with respect to a combination of E8 with E13, particularly when also considering E2. Further prior art was referred to, without however, giving any reasons for referring to it.

IV. The patent claims the priority of Japanese filing JP 247282/91 (hereinafter referred to as the priority document) filed in Japan on 26 September 1991. In the course of the appeal proceedings the appellant disputed the right to priority of claims 1 and 7 of the patent.

V. The respondent (patentee) challenged the admissibility of the appeal, arguing that the statement of grounds was not filed in due time and that the appeal was not sufficiently substantiated, in particular because it relied on documents which were not filed within the time limit prescribed by Article 108 EPC and which were either not prior art or had no indication of a publication date.

VI. Both parties having made auxiliary requests for oral proceedings, the Board, together with a communication setting out the salient issues, issued a summons to oral proceedings.

VII. Prior to the oral proceedings the appellant drew attention to a further document which was said to assist in the interpretation of E1:

E11a: Recommendation GSM 02.17, version 3.2.0, released by ETSI, release date: March 1990, title: "Subscriber Identity Modules, functional characteristics", front page and pages 1 to 11.

VIII. The oral proceedings were held on 20 December 2001. The appellant requested that the decision under appeal be set aside and the patent revoked. The respondent in the course of the oral proceedings modified his requests and filed a revised claim 1. He requested that the decision be set aside and the patent be maintained as granted for the contracting state IT and on the basis of the revised claim 1 and claims 2 to 11 as granted, and a description to be adapted for the contracting states DE, FR and GB.

IX. Claim 1 as granted reads as follows:

"A portable telephone apparatus equipped with an electronic notebook function, characterized in that:

a plurality of telephone keys (3) are provided on an outer surface of an openable/closable member (2) mounted on a case body (1) in openable/closable states, and a plurality of electronic notebook keys (4:5) are provided on a rear surface of the openable/closable member (2) and also a region of a front surface of the case body (1), which is covered by the openable/closable member (2)."

X. Claim 1 as filed in the oral proceedings for the contracting states DE, FR and GB, reads as follows:

"A portable telephone apparatus equipped with an electronic notebook function wherein a plurality of telephone directory data is entered and registered, characterized in that:

a plurality of telephone keys (3) are provided on an outer surface of an openable/closable member (2)

mounted on a case body (1) in openable/closable states, and a plurality of electronic notebook keys (4:5) to enter data and to control the function of the electronic notebook are provided on a rear surface of the openable/closable member (2) and also a region of a front surface of the case body (1), which is covered by the openable/closable member (2)."

XI. At the end of the oral proceedings the Board announced its decision.

Reasons for the Decision

1. *Admissibility*

1.1 The respondent challenged the admissibility of the appeal, arguing both that the statement of grounds was late-filed and was insufficient to substantiate the appeal. The statement of grounds was three pages long and had been faxed to the EPO, but page 1 referred to a fax which was four pages long and a page thus appeared to be missing. Moreover, two of the three pages bore the time stamp "23.59" on the last day of the time limit under Article 108 EPC. Since fax time stamps were notoriously inaccurate it had not been proven that the statement had been filed in time. The burden of proof was on the appellant.

1.2 The appellant’s representative accepted that fax clocks were not always accurate but expressed certainty that the fax had been sent at the time recorded; as the representative sent the documents he was watching a radio-controlled clock and could confirm that the entire document was sent before midnight. The reference

to four pages was a clerical error.

1.3 The Board notes from a comparison of the faxes in the appeal file that the time stamp on the fax is that of the receiving, not the sending, machine, so that it was generated by the EPO. The respondent has given no convincing reason for doubting that the EPO time stamp is correct; the appellant's explicit statement that he could verify the sending time is moreover noted. On the facts of the case the Board therefore finds that the statement of grounds was received in due time.

1.4 The Board also finds that the contents of the statement of grounds are sufficient to substantiate the appeal. The statement of grounds contains in total almost two full pages of argument directed to the objection based on E1. Even though other issues are handled extremely briefly - the inventive step objection based on E8 and E13 rates a single sentence - the appellant's reasons for setting aside the opposition division's decision can be understood.

1.5 The appeal consequently fulfils the requirements set out in Rule 65(1) EPC and is admissible.

2. *Amendments*

The amendments to claim 1 for the contracting states DE, FR and GB additionally limit the claim by providing functional definitions of the "electronic notebook function" and the "electronic notebook keys". They are supported by the application as filed, see the published application at column 1, lines 4 to 6, column 1, line 56 to column 2, line 1 and column 3, lines 43 to 48. Articles 123(2) and (3) EPC are

accordingly satisfied.

3. *Priority*

3.1 In the oral proceedings the appellant argued that claim 1 for the contracting states DE, FR and GB was not entitled to the claimed priority date since the priority document did not disclose either a plurality of telephone directory data being entered and registered or the electronic notebook keys controlling the function of the electronic notebook.

3.2 Page 8, lines 11 and 12 of the translation of the priority document on file mentions data such as telephone numbers "used as the electronic notebook" being stored in memory; in the Board's view telephone numbers constitute "telephone directory data" in the claimed sense. Moreover Figure 5 shows at step "S2" that when the case is open, ie the switch (8) is OFF, the "data process" step (S5) is executed, thus controlling the function of the electronic notebook (see also page 9, lines 18 and 19 and page 11, lines 1 to 5 of the translation). Figure 3 of the priority document shows a large number of keys 2, 3b respectively situated on the front surface of the case body which is covered by the openable/closable member and on the inner surface of the member itself. These keys are referred to at page 5, lines 8 to 18 as "data input keys" and "data entry keys"; the latter are explicitly said to be "used for an electronic notebook function".

3.3 Claim 1 for the contracting states DE, FR and GB is consequently entitled to the claimed priority date.

4. *Novelty*

4.1 E1 is an earlier European application which *inter alia* designates three contracting states designated in the patent, namely DE, FR and GB, and which was published between the priority date and the filing date of the patent. It is therefore comprised in the state of the art as regards novelty but not inventive step, Articles 54(3), 54(4) and 56 EPC.

4.2 E1 (see Figures 1a to 3) discloses a portable telephone apparatus (column 1, lines 1 to 3) having a plurality of telephone keys (6) provided on an outer surface 2b of an openable/closable member (2) mounted on a case body (1) in openable/closable states, and a plurality of keys (4,5) provided on an inner or rear surface (2a) of the openable/closable member (2) and also a region of a front surface of the case body (3) which is covered by the openable/closable member (2). E1 also mentions (column 3, lines 24 to 28) that the mobile telephone part of the apparatus can use the GSM standard. Although disputed by the respondent, the Board considers that the prior art as represented by document E11a shows that an intrinsic part of any GSM telephone is a subscriber identity module (SIM). E11a moreover shows in section 3.4.2 that a basic function of a GSM SIM is to store short messages and abbreviated dialling codes such as alphanumeric codes, ie to provide a notebook function. The Board therefore takes the view that the implementation of the GSM standard in the apparatus of E1 would require a SIM and would consequently provide the portable telephone apparatus known from E1 with a notebook function.

4.3 Claim 1 for the contracting states DE, FR and GB

requires that the keys provided both on the rear surface of the openable/closable member and the region of the front surface of the case body which is covered by the openable/closable member be a plurality of electronic notebook keys to enter data and to control the function of the electronic notebook. In E1 the telephone keys 6, which also serve as notebook keys for information stored in the SIM, are provided on a rear or outer surface 2b of the openable/closable member 2. However, the keys 5 provided on the front or inner surface of the case body covered by the openable/closable member 2 are computer function keys rather than telephone keys. There is no suggestion in E1 that the computer and telephone functions are in any way interlinked; E1 does not therefore provide electronic notebook keys on the front surface of the case body in the same sense as the claim. The subject matter of claim 1 for the contracting states DE, FR and GB is accordingly novel, Articles 52(1) and 54(3) and (4) EPC, having regard to E1 interpreted in the light of E11a.

4.4 E1 does not designate IT and is therefore not prior art for claim 1 as granted for that contracting state, Article 54(4) EPC.

5. *Inventive Step*

5.1 The most relevant prior art as regards inventive step is in the Board’s view that represented by documents E8 and E8"; this is true for both versions of claim 1.

5.2 Turning first to claim 1 for the contracting state IT, the appellant has argued that it lacks an inventive step since E8/E8" discloses a mobile telephone with an

openable/closable member and a notebook function. E8/E8" gives rise to the problem that the unit has to be opened and closed when initiating and ending a call, since the exterior of the case lacks any keys. It was well known to place keyboards on the exterior of instrument cases, E13 exemplifying the prior art. The skilled person faced with the problem of continually opening and closing the case of the E8/E8" device would without the exercise of inventive skill find the solution in E13.

5.3 Referring to the certified translation of JP-A-3 181 252, E8" (see Figures 1 and 2), this discloses a portable telephone apparatus (see title) having an openable/closable member (20) mounted on a case body (10) in openable/closable states and a plurality of keys (21) provided on a rear surface of the openable/closable member (20) and also on a region (12) of a front surface of the case body (10), which is covered by the openable/closable member (20). The sentence bridging pages 9 and 10 states that when open the apparatus forms a "pocket-sized notebook". Although it was argued that this phrase is a mistranslation, other comparable passages in E8" referring to "like a pocket-sized notebook", the Board takes the view that the large number of keys on the rear surface of the openable/closable member and also on the region of the front surface of the case body covered by the openable/closable member would not be required unless a notebook function in the usual sense were provided.

5.4 The subject-matter of claim 1 consequently differs from the disclosure of E8/E8" in that a plurality of telephone keys is provided on an outer surface of the

openable/closable member, thus allowing a large number of keys and simple dialing by separating the notebook and telephone functions (see column 10, line 37 to column 11, line 3 of the patent in suit).

5.5 The Board is not convinced by the argument that the skilled person, starting from the E8/E8" device, would see the lack of keys on the exterior of the case as a problem requiring a solution. E8" teaches (page 10, lines 5 to 6 and 21 to 22) that the absence of external keys avoids inadvertent operation of the apparatus and enhances its appearance. No reason can be seen as to why, as asserted by the appellant, the need to open the case would annoy the user and lead to the provision of external keys.

5.6 The appellant drew attention to E13, which discloses a foldable electronic calculator having keys on its exterior as well as keys revealed by opening the device. It was argued by the appellant that the skilled person would be led to combine the E8/E8" device with that of E13 and in doing so would provide exterior telephone keys. Since however the E13 device is an electronic calculator the Board does not consider that the skilled person would have any reason to adapt an arrangement known from a calculator to a mobile phone and notebook. But even if the skilled person were for the sake of argument led by E13 to provide external keys on E8, the obvious keys to provide are calculator keys.

5.7 The appellant also made reference to document E2, which concerns a foldable cordless telephone (see Figure 1) having external keys (4, 18) as well as keys (3) revealed by opening the device. E2 does not appear to

the Board to add anything to E8; it merely provides an openable/closable member (7) with a different hinge axis to E8. There are no telephone keys on the outer surface of the openable/closable member. Nor is there a plausible combination of E2, E8 and E13 which would lead the skilled person without the exercise of inventive skill to the claimed subject-matter.

5.8 The remaining prior art referred to by the appellant in the appeal proceedings being less relevant, the Board finds that claim 1 for the contracting state IT involves an inventive step (Article 56 EPC).

5.9 Since claim 1 for the contracting states DE, FR and GB is more limited that that discussed above, it follows that the above conclusions on inventive step apply to this claim also.

6. *The description*

6.1 The description needs to be adapted to the amended claims for the contracting states DE, FR and GB in order to satisfy Rules 27(1)(b) and (c) EPC. Attention is directed in particular to the recitation of the independent claim at column 2, lines 13 to 22 of the published patent.

6.2 Under Rule 87 EPC the European Patent Office may decide that it is necessary for a patent to have different descriptions for different designated contracting states if, as in the present case, the content of an earlier European patent application forms part of the state of the art pursuant to Article 54(3) EPC in some of the designated contracting states.

6.3 In the present case the Board finds that retaining the description as granted for the contracting state IT and producing an adapted description for the contracting states DE, FR and GB would allow a clearer presentation of which subject matter is to be protected in the different contracting states (see also Guidelines for Examination in the European Patent Office, D VII, 4.2 and C III, 8.1).

6.4 The Board consequently remits the case to the first instance to permit an adapted description to be prepared for the contracting states DE, FR and GB.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to maintain the patent as granted for the contracting state IT and on the basis of claim 1 as filed in the oral proceedings and claims 2 to 11 as granted and a description to be adapted for the contracting states DE, FR and GB.

The Registrar: The Chairman:

M. Kiehl S. V. Steinbrener