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D E C I S I O N
of 19 June 2002

Case Number: T 0907/00 - 3.5.1

Application Number: 90907922.0

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Language of the proceedings: EN

Title of invention:
Radio and electronic card assembly

Patentee:
MOTOROLA, INC.

Opponent:
Telefonaktiebolaget L M. Ericsson
Alcatel N.V.

Headword:
Radio and card assembly/MOTOTOLA

Relevant legal provisions:
EPC Art. 56

Keyword:
"Late-filed amendments (accepted in part)"
"Inventive step (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0907/00 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 19 June 2002

Appellant: MOTOROLA, INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 13 June 2000
revoking European patent No. 0 489 013 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener

Members: R. S. Wibergh
E. Lachacinski

Summary of Facts and Submissions

- I. This is an appeal by the proprietor of European Patent No. 0 489 013 against the decision of the Opposition Division to revoke the patent.

- II. Respondent 1 and respondent 2 had opposed the patent on the grounds that the invention was not new or did not involve an inventive step. Among the documents cited was:

D4: JP-U-64 23140 and an English translation thereof.

- III. The Opposition Division held that the subject-matter of claim 1 was not inventive over D4. In addition it was found that the claims according to the patent proprietor's two auxiliary requests then on file were not allowable due to amendments extending beyond the content of the application as filed.

- IV. The patent proprietor (appellant) lodged an appeal against this decision. In the statement setting out the grounds of appeal it was argued that the subject-matter of claim 1 as granted involved an inventive step. The appellant requested that the decision be set aside and the patent be upheld as granted.

- V. In a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, the preliminary opinion was given that the invention lacked an inventive step.

- VI. Oral proceedings before the Board were held on 19 June 2002. At the beginning of the oral proceedings the appellant presented different versions of claim 1

according to a main request and three auxiliary requests.

Claim 1 of the *main request* read as follows:

"A portable radio (10) and electronic card (31) assembly comprising:
a radio portion (11); and
a battery portion (12);
the assembly characterized by:
latch means (22) removably attaching the battery portion (12) to the radio portion (11), the battery and radio portion (12 and 11) being coupled together to form the radio (10); and wherein
the radio portion (11) includes an opening for receiving the electronic card (31), the opening being inaccessible when the radio portion (11) and the battery portion (12) are interconnected and being accessible for insertion or removal of the electronic card (31) when the battery portion (12) is detached from the radio portion (11), in which the battery portion (12) includes together with the battery means (33) for retaining the electronic card (31)".

In claim 1 of *auxiliary request 1*, which corresponded to dependent claim 6 of the patent as granted, it was further specified that the means for retaining the electronic card was a groove:

"... the battery portion (12) includes a groove (33) for retaining the electronic card (31)"

Claim 1 according to the second and third auxiliary requests contained additional features based on the description and drawings.

- VII. The respondents requested that all modifications of the patent should be refused as having been presented too late. Moreover, if one or more of the appellant's requests were admitted the oral proceedings should be adjourned to a later date.

- VIII. The Board decided to admit the appellant's main and first auxiliary requests but not the second and third auxiliary requests. The respondents' requests for adjournment of the oral proceedings were rejected but the parties were given time to study the new claims.

- IX. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of amended claim 1 according to the main request, alternatively on the basis of amended claim 1 of the (only remaining) auxiliary request.

- X. The respondents requested that the appeal be dismissed.

- XI. At the end of the oral proceedings the Chairman announced the Board's decision.

Reasons for the Decision

- 1. *Late filed amendments*
 - 1.1 At the oral proceedings before the Board the appellant filed modified independent claims according to a main request and three auxiliary requests. The respondents requested that these claims should not be admitted, or if they were, that the oral proceedings should be adjourned to allow the respondents to analyse the new claim formulations in depth and also, if necessary, to

search for further relevant prior art.

- 1.2 The Board decided to admit only the appellant's main and first auxiliary requests. In reaching this decision the Board was guided by the principle that a patent proprietor may be allowed to file amendments to the patent even at a very late stage of the procedure *if* this is possible without confronting the opponents with a situation they cannot reasonably have foreseen and without substantially delaying the proceedings. In the present case claim 1 according to the appellant's auxiliary request 1 was identical with dependent claim 6 of the patent as granted. It is hardly surprising that an independent claim is limited to one of its dependent claims. The patent as granted contains only six, rather short, claims and the description is only two and a half columns long. It could therefore be expected by the opponents to deal with one of the dependent claims at the oral proceedings. The Board has thus decided to admit the appellant's auxiliary request 1 and main request, the latter being a generalisation of the former and in substance corresponding to claim 2 as granted. The second and third auxiliary requests, however, contained amendments taken from the description and drawings which the respondents could not possibly have foreseen. These requests were therefore rejected as having been presented to late.

Since the above considerations were based on the understanding that only those requests were to be admitted which could be examined without further preparation, the Board rejected the respondents' requests for postponement of the oral proceedings.

2. *Amendments, construction of claim 1 according to the*

appellant's main request

- 2.1 Amended claim 1 makes a distinction between a "battery" and a "battery portion". The respondents have pointed out - and the appellant has not denied - that such a difference between the terms does not exist in the patent as granted or in the application as filed. Here the words are used synonymously in the meaning of "battery pack", ie batteries in a housing. The respondents have therefore submitted that the present use of the word "battery" in a different sense - namely as part of the battery portion - infringes Article 123(2) EPC.

The Board disagrees with this view. It is immediately clear from the description and drawings that the "battery portion" will contain a "battery" in the normal sense of the word (else the radio would not work). Therefore the *feature* "battery" has been (at least implicitly) disclosed and can be included in claim 1 without infringing Article 123(2) EPC.

Another, albeit related, question is how this feature should be referred to in the claim, considering that the word "battery" in the patent as granted is used differently. This appears however to be a matter under Article 84 EPC (support by the description) rather than under Article 123(2), and the Board is convinced that it could easily be solved, eg by replacing all instances of "battery" in the description by "battery portion". It is true that the new claim has the effect of redefining the word "battery", but the Board cannot see that this is objectionable as long as the new definition does not introduce any undisclosed subject-matter.

2.2 The appellant declared at the oral proceedings before the Board that the last feature of claim 1 - which states that the battery portion includes together with the battery means for retaining the electronic card - should be understood in the sense that the battery portion comprises a battery and, *additionally*, means for retaining the electronic card. In other words, the claim excludes the possibility that the battery itself serves to retain the card. This interpretation was challenged by the respondents who found the claim obscure. The Board notes however that the interpretation proposed by the appellant is supported by the description and drawings (cf. column 3, lines 5 to 8 of the patent in suit: "The battery portion 12 is formed with a groove 33 for capturing the bottom of the electronic card 31, thereby providing additional mechanical protection"). Therefore, for the purposes of the present decision, the claim is understood in the way indicated by the appellant.

3. *The prior art*

D4 (Figure 5) discloses a portable radio comprising a radio portion and a battery portion, where the battery portion consists of a battery 20. Latch means attaching the battery to the radio portion are also disclosed (they would consist either of the lid 19 or the implicit battery contacts). An electronic card in the meaning of the patent in suit is present in the form of a ROM 23. This ROM is accessible through an opening in a wall when the battery is detached from the radio portion. Moreover, the battery covers this opening such that it retains the electronic card, ie prevents it from moving or being dislodged from its socket.

4. *Novelty*

The difference between the invention according to claim 1 and the radio in D4 is that in the invention *additional* means retain the electronic card, not the battery itself. Due to this difference the invention is new.

5. *Inventive step*

The advantage provided by the means for retaining the electronic card is "additional mechanical protection" (description column 3, line 7). Starting out from D4, the skilled person would as a matter of course want to ensure that all sensitive parts of the radio, including the ROM 23, are sufficiently protected against any kind of impact to which a portable device is likely to be subjected. Thus, posing the problem solved by the invention was obvious. The solution according to claim 1 consists in providing "means together with the battery for retaining the electronic card". In essence, this functional feature just states that the problem to be solved is indeed solved. If the skilled person considered that the battery shown in D4 might not retain the card effectively, he would add extra means for this purpose. This mere idea, which does not specify the way the protection should be improved, does not involve an inventive step since it follows directly from the formulation of the problem.

Thus the appellant's main request must be refused (Article 56 EPC).

6. *The appellant's auxiliary request*

- 6.1 According to claim 1 of the auxiliary request the means for retaining the electronic card is a groove in the battery portion.
- 6.2 Respondent 2 has argued that the skilled person, starting from the prior art shown in D4, would replace the battery with a battery pack of the rechargeable type, a kind which is conventionally used in portable devices. The battery pack itself would support the electronic card (ROM) in one direction. In order to support it in a perpendicular direction it would be obvious to provide the battery pack with a groove into which an edge of the card may be inserted. Such a groove was a well-known way of stabilising electronic cards such as printed circuit boards.
- 6.3 The appellant, while accepting that grooves are known to serve as guides for circuit boards, has argued that the prior art does not suggest to provide grooves *in the battery portion* for retaining an electronic card. In particular, as has already been pointed out above, in D4 the battery itself retains the card and it would not be feasible (or would be entirely impractical) to provide a battery with a groove. Only with hindsight could the skilled person arrive at a radio having the claimed feature.
- 6.4 The Board takes the view that the invention according to the auxiliary request does not involve an inventive step. The technical problem of stabilising the electronic card had to be addressed, and merely to provide a groove to achieve this aim is conventional since in many kinds of devices thin, flat parts are supported by means of a groove. The appellant's argument that it was not obvious to provide a retaining

groove in the battery portion is not regarded as convincing. A groove would have to be placed along the circumference of the card, and since in D4 the card (ROM) is adjacent to the battery, it would also be adjacent to the battery pack if a battery pack is used instead.

6.5 It may be noted that the above reasoning contains two stages: first it is assumed that the skilled person would replace the known battery with a battery pack, and then that he would adapt the battery pack for the purpose of stabilising the electronic card. In other words, the technical problem of stabilising the electronic card is not formulated with respect to the prior art actually described in D4 but with respect to what is regarded as an obvious modification of this prior art. It could be questioned whether the skilled person can at all be expected to address a problem which occurs in such a hypothetical piece of prior art. However, at least if the first modification is a very natural one, such as in this case the substitution of a battery pack for the single battery, the skilled person would hardly regard it as a separate mental step. The modified apparatus would rather have the character of an alternative starting point. Moreover, the technical problem of stabilisation of the electronic card is not a consequence of the modification but applies already to the radio as described in D4 (see point 5 above). Only the details of the solution would depend on the particulars of the battery portion. It follows that there is no inventive interrelationship between the measures of adding a battery pack and providing a groove in it.

6.6 Therefore the invention does not involve an inventive

step (Article 56 EPC) and the appellant's auxiliary request is also rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener