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D E C I S I O N
of 17 December 2003

Case Number: T 0624/01 - 3.5.1

Application Number: 92118888.4

Publication Number: 0542118

IPC: H04M 1/72, H04M 1/65

Language of the proceedings: EN

Title of invention:

Cordless telephone apparatus with recording-reproducing means

Patentee:

SONY CORPORATION

Opponent:

Siemens AG
ALCATEL

Headword:

Selective recording/SONY

Relevant legal provisions:

EPC Art. 100(c), 123(2)

Keyword:

"Opposition grounds - extension of subject matter (yes)"

Decisions cited:

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Catchword:

-



Case Number: T 0624/01 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 17 December 2003

Appellant: SONY CORPORATION
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 April 2001
revoking European patent No. 0542118 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. R. K. Zimmermann
E. Lachacinski

Summary of Facts and Submissions

I. European patent No. 0 542 118 was granted on European patent application No. 92 118 888.4 with effect from 23 September 1998.

II. Claim 1 of the patent reads as follows:

"A cordless telephone system comprising:

a master unit (2) connected to an outside telephone line (3); and

at least a first and second slave unit (11-15) each connected to said master unit (2) via a radio wave channel;

wherein said master unit (2) includes a recording/reproducing means (260) for recording an incoming message originated from a calling party through the telephone line (3) and reproducing the recorded message in response to a request performed by a key operation; said recording/reproducing means (260) having a recording medium to record and reproduce the message

said recording medium comprising a management area (265) for managing the message recorded on said recording medium;

characterized in that

means (264) are provided for selectively storing in an absence answering/recording mode an incoming message from the telephone line (3) such that the stored message is either reproduceable only by a selected one of the slave units (11-15) or by all of the slave units (11-15), and in that

means are provided for deciding the selection on the base of a selection signal through the telephone line (3)."

- III. In opposition proceedings, commenced by the opponents, *inter alia*, on grounds of Article 100(c) EPC, the patent was revoked for the sole reason of added subject-matter with decision dated 2 April 2001. In the opposition division's view, the scope of patent claim 1 included the embodiment that a "selection signal through the telephone line" caused the selection of all slave units, whereas according to the application as filed all slave units were selected only in the absence of a signal (the DTMF signal), which was the exact opposite.
- IV. Against the revocation decision, a notice of appeal was filed by the appellant (patentee) on 1 June 2001, effecting payment of the appeal fee the same day. A statement setting out the grounds of appeal was filed in writing on 18 July 2001.
- V. In oral proceedings, which took place before the Board in the presence of the representatives of the appellant and the respondents (opponents) on 17 December 2003, the issue of Article 100(c) EPC was discussed, considering in particular the claim amendments concerning the selection signal, the dial key operation, and the definition of "selectively storing ... an incoming message".
- VI. The appellant filed auxiliary requests I and II, each containing an amended claim 1 which differed from

claim 1 of the patent as granted only in the respective second, characterizing part.

These amended portions read as follows:

Auxiliary request I:

"1. ...

characterized in that

means (264) are provided for selectively storing in an absence answering/recording mode of the telephone system, an incoming message from the telephone line (3) such that the stored message is either reproduceable only by a selected one of the slave units (11-15) or by all of the slave units (11-15),

and in that

means (240) are provided for monitoring the telephone line (3) to decide the selection on the base of a selection signal through the telephone line (3)."

Auxiliary request II:

"1. ...

characterized in that

means (264) are provided for selectively storing in an absence answering/recording mode an incoming message from the telephone line (3) such that the stored message is either reproduceable only by a selected one of the slave units (11-15) or by all of the slave units (11-15), and in that

means (240) are provided for deciding the selection on the base of a selection signal through the telephone line (3), wherein it is decided to store the incoming message such that it is reproduceable by all slave units (11-15) in case no signal selecting a reproduction by a selected one of the slave units (11-

15) is transmitted over the telephone line (3) during a reproduction of a recorded outgoing message(OGM)."

VII. Referring to the objection that the application as filed disclosed the selection of all slave units only in absence of a selection signal, the appellant cited international telecommunication standards defining the term "signal" as "a physical phenomenon one or more of whose characteristics may vary to represent information". The DTMF components of a telephone signal was such a phenomenon; the characteristic amplitude zero thus defining a signal if to the receiver this signal state represented information, in the present case the information that the incoming message should be stored so as to be reproduceable by all slave units.

Moreover, the claim wording "on the base of a selection signal" clearly included the process deciding on the absence of an explicit selection signal, showing clearly that the claim was supported by the application as filed.

Regarding the further amendments, in particular the removal of features concerning the management area and the dial keys in the calling operation, the appellant was of the opinion that such amendments merely extended the scope of the claim, always allowable in the examination stage of the grant procedure. A mere extension of the scope of protection, however, did not extend the content of the application as filed.

Finally, the definition "selectively storing ... an incoming message" referred to the selective reproduction of the stored messages. As shown in

figures 5 and 6 of the original application, the incoming message was stored in combination with the administrative data which allowed either one or all slave units selectively to reproduce the stored message.

VIII. The appellant accordingly requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or alternatively in amended form on the basis of auxiliary request I or II filed during the oral proceedings.

IX. The respondents requested that the appeal be dismissed.

Dismissal of the appeal was justified already on the grounds of Article 100(c) EPC.

The absence of a signal was the opposite of a signal so that the wording of claim 1, in so far clear in all requests, did not have proper support in the application as filed.

Furthermore, the plain meaning of the expression "selectively storing" was that the storing process itself was characterized by a selection or, in a broader but still acceptable sense, enabled a selection. However, according to the application as filed, storing the incoming message was only a first step, still requiring in further process steps registration and managing of address data for the selective reproduction of slave units as shown in figure"6 of the application.

The present claim wording, however, encompassed embodiments which, contrary to the content of the application as filed, made the selective reproduction

possible without any such registration or address managing steps, for example by using separate memories allocated to and selectively readable by the individual slave units.

- X. At the end of the oral proceedings, the Board's decision was announced.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC and is thus admissible.
2. The appeal, however, is not allowable since the opposition ground Article 100(c) EPC, in connection with the requirement of Article 123(2) EPC, prejudices the maintenance of the patent on the base of any of the claims offered by the appellant for consideration.

According to Article 123(2) EPC, a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. For deciding this issue the case law and practice of the EPO applies the criterion of whether a skilled person would derive the amended subject-matter from the application as filed in a direct and unambiguous manner. An amendment deleting a definitional term of the invention or replacing it by a different or more generic definition is considered allowable only if the original teaching of the invention remains unchanged, i.e. if the technical features of the invention which the application as

filed presents to the skilled person as essential to the invention have not been deleted or changed, or in other words if the amendment does not shift the invention as presented in the application as filed to subject-matter not originally disclosed.

3. The present requests, however, result in such an inadmissible shift of the invention.

In fact, each claim 1 offered by the appellant for consideration comprises the feature that the incoming message from the telephone line is "selectively" stored "such that the stored message is either reproduceable only by a selected one of the slave units () or by all of the slave units". Furthermore, the claims do not define any registration of the message recording in a management area in response to a key operation as it had been the case for every single claim originally filed.

4. The application as filed started from a prior art cordless telephone system wherein a "master unit" was capable of handling, via RF-channels, a plurality of "slave units" and recording incoming messages (ICM) sent over an outside telephone line to a slave unit for the later reproduction by a person using the slave unit but momentarily absent (see the A2 publication, column 1, lines 14 to 32).

The inventor recognized as a problem that the message could be reproduced at other slave units, even though it should be kept secret. Accordingly, the application as filed presented, as the object of the invention, the safeguard of privacy in such kind of master-slave

systems connected to an outside telephone line (see column 1, lines 29 ff., 43 ff., and 53 ff., column 3, lines 4 ff., column 17, lines 36 ff.).

In the prior art the messages are recorded or stored, on a tape for example, sequentially in the random manner they arrive. This kind of message recording was not changed in the application; the application as filed only mentioned sequential recording (see, for example, figure 5 and the accompanying parts of the description, column 9, lines 48 to 51 and column 10, lines 25 to 32).

The solution to the said privacy problem resided rather in the idea to add the registration of recording data and address management for tracking the storage locations of the incoming messages on the sequential memory and linking the recorded message to the slave unit to which the calling party wished to address the message.

This solution led apparently to a division of the system memory into a memory for recording the incoming messages sequentially, like in the prior art, and into a dedicated management area for registration of the recording data, and simultaneously to a division of the data and signal processing, namely first receiving the DTMF signal, which identified the unit to which the message should be reproduceable, then the recording of the incoming message, and finally the registration of the recording data in the management area (see steps 413 and 423 in figure 3). It is noted that the recording or storing of the incoming message was to be

stopped before the recording data were registered in the management area (see steps 425 and 426).

5. This concept of a conventional, sequential recording of the incoming messages on the one hand and the inventive registration and address management on the other hand is imposed on the skilled reader by the application text itself, not only because it was the base of the only embodiment described but also because all original claims explicitly encompassed this concept. The whole technical disclosure of the application as filed would appear to be incompatible with a shift away from this concept.

Indeed, the application as filed does not give the skilled reader any idea how to generalize or to deviate from the disclosed embodiment. The only passage (column 11, lines 16 to 31 of application as filed) cited by the appellant in the examination stage as the support of the amendments then filed, is part of the description explaining the routine 400 shown in figure 3 and has thus to be read in the context of the registration of recording data and address management.

Although a skilled person reading the application as filed must infer therefrom that registering recording data in a memory separated from the sequential message memory as well as a proper address management on the basis of such data are essential features of the invention for solving the privacy problem addressed by the application as filed such features lack completely in claim 1 of all present requests.

6. To the contrary, the present claims comprise the feature "selectively storing ... an incoming message from the telephone line (3) such that the stored message is either reproduceable only by a selected one of the slave units (11-15) or by all of the slave units (11-15)", which links the selective reproducibility of messages to the storing of messages rather than to the registration of recording data and address management. The feature actually favours the interpretation that the incoming messages are stored, dependent on the received selection (DTMF) signal, in predetermined units of memory which are individually allocated to the slave units, dispensing thereby with all the overhead which the registration of recording data and address management entails in accordance with the original disclosure.

In summary, the Board is convinced, therefore, that the present requests result in a shift of the invention which is inadmissible in the light of the criteria provided by Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener