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D E C I S I O N
of 21 July 2004

Case Number: T 0823/01 - 3.5.3

Application Number: 89120988.4

Publication Number: 0378775

IPC: H04M 1/72

Language of the proceedings: EN

Title of invention:

Radiotelephone

Patentee:

MOTOROLA A/S

Opponent:

Nokia Mobile Phones Ltd.

Headword:

Radiotelephone/MOTOROLA

Relevant legal provisions:

EPC Art. 100(b), 54, 56

Keyword:

"Novelty (yes)"
"Inventive step (yes)"
"Disclosure - sufficiency - (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0823/01 - 3.5.3

D E C I S I O N
of the Technical Board of Appeal 3.5.3
of 21 July 2004

Appellant: Nokia Mobile Phones Ltd.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 21 May 2001
rejecting the opposition filed against European
patent No. 0378775 pursuant to Article 102(2)
EPC.**

Composition of the Board:

Chairman: A. S. Clelland
Members: D. H. Rees
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This is an appeal against the decision of the opposition division to reject the opposition against European Patent No. 0 378 775.

II. Claim 1 as granted reads as follows:

"A radiotelephone having means (18) for coupling to a second memory (20, 36), the radiotelephone comprising: a first memory (34) for storing first abbreviated dial information items including telephone numbers; memory receiving means (18) for temporarily receiving the second memory (20, 36) for storing second abbreviated dial information items including telephone numbers; user selective memory access means (42, 30, 44) for accessing the first memory (34), selecting an abbreviated dial information item in the first memory and automatically dialling the telephone number included therein, user selective memory access means (42, 30, 44) for accessing the second memory (36), selecting an abbreviated dial information item in the second memory and automatically dialling the telephone number included therein, and user selective transfer means (42, 30, 44) for user selectively identifying an abbreviated dial information item in one of the memories (34, 36) and causing it to be transferred to the other of the memories for user selective access and automatic dialling from the other of the memories."

- III. The opponent (appellant) had requested the revocation of the patent on the grounds (1) that it did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC), and (2) that the claimed subject-matter lacked novelty or did not involve an inventive step (Articles 100(a), 52, 54 and 56 EPC).
- IV. In oral proceedings held on 9 May 2001, the opposition division rejected the opposition. The written decision was dispatched on 21 May 2001.
- V. The following documents discussed in the opposition proceedings remain relevant to the present decision:
- D1: US-A-4 680 787
- D7: C. Andren et al, "Mobile radio system C600", Ericsson Review, volume 60 number 3, pages 151 to 158, 1983, Stockholm, SE.
- D8: EP-A-0 206 391
- D10: A.C. Downton, "Computers and Microprocessors," chapter 2 (pages 11 to 21), Van Nostrand Reinhold, Wokingham, England, 1984.
- VI. Notice of appeal was filed, with the appropriate fee, on 17 July 2001. A statement of grounds of appeal, maintaining all the grounds for opposition and requesting that the decision of the opposition division be cancelled and the patent revoked, was submitted on the 27 September 2001. A substantial procedural

violation by the opposition division was also alleged and a request therefore made for reimbursement of the appeal fee according to Rule 67 EPC.

- VII. In a response dated 12 February and received 13 February 2002, the respondent (proprietor) requested that the decision of the opposition division be upheld.
- VIII. In preparation for oral proceedings the respondent filed, on 21 June 2004, a further document and claim sets of two auxiliary requests.
- IX. At the oral proceedings the appellant maintained the requests made in the statement of grounds of appeal (see point VI above).

The respondent requested that the appeal be dismissed and that the patent be maintained as granted or alternatively on the basis of auxiliary requests 1 or 2 filed with the letter dated 21 June 2004.

The decision of the board was announced at the end of the oral proceedings.

Reasons for the Decision

- 1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
- 2. *The alleged substantial procedural violation*
 - 2.1 In its discussion of the question of whether the claimed subject-matter involved an inventive step, the

opposition division's decision contains at section 2.8 the following passage.

"With regard to inventive step, during the oral proceedings the opponent was of the opinion that as the difference between claim 1 and D1 lay in the selective transfer means, that the objective technical problem was the implementation of this means. In his view, it would be obvious to combine the separate recall and store functions into a single means.

The opposition division does not share this view. The opponent was not able to provide evidence which would suggest that this problem was disclosed in any of the available documents. It is pointed out that according to the Guidelines G-C-IV,9.4(i), an invention exists if a new problem is formulated. ..."

The appellant argued that the opposition division thus identified the claimed subject-matter as a "problem invention", that this was critical to the decision and that, since this had been done for the first time in the decision, there had been no opportunity to put counter-arguments. This constituted a substantial procedural violation.

- 2.2 In the board's view the reference to the Guidelines for Examination is, in the context, merely reinforcing a point which is basic to the determination of whether there is an inventive step using the problem and solution approach, namely that what is decisive is not what the skilled person could have done but what he or she **would** have done, so that the problem and solution have to be considered together for obviousness. The

opposition division was not making a new and unexpected argument, but rather pointing out a reason for finding the opponent's (appellant's) arguments unconvincing, namely that the opponent had not pointed out any motivation why the skilled person **would** implement a transfer means. This passage in the opposition decision does not establish a new ground for rejecting the opposition. The rejection of an argument on the basis of well-established principles related to the points under discussion cannot be considered surprising or otherwise a procedural violation.

2.3 Thus the request for reimbursement of the appeal fee does not meet the first condition set out in Rule 67 EPC and must therefore be refused.

3. *Insufficiency (Article 100(b))*

3.1 The contested patent gives no details of how the "user selective transfer means" is implemented; the only relevant passage in the description (column 3, lines 4 to 15 of the published patent) relates to the sequence of interactions which the user makes with the radiotelephone. In the opposition proceedings the respondent submitted D10 as evidence that how to transfer data from one memory to another was part of the skilled person's common general knowledge.

3.2 The appellant argued that this document merely showed one way of implementing a memory transfer, namely an indirect transfer via a register. Inasmuch as the claim also encompassed direct transfer the patent was deficient since it did not disclose how to carry out such a direct transfer, and an applicant was obliged to

disclose how to realise an invention in its full breadth.

3.3 However, in the present case the board considers that the skilled person, making use of common general knowledge, would have been able to implement the necessary transfer means in a variety of ways appropriate to the other elements in an embodiment, such as the types of memory used. It is noted that the appellant, in discussing the question of whether an inventive step is involved, elsewhere argued that memory transfers are common general knowledge in computer technology. The board considers it also to be common general knowledge that such memory transfers in computers can take a variety of forms.

3.4 For these reasons the board does not accept the appellant's argument that the contested patent should be revoked under Article 100(b) EPC.

4. *Novelty*

4.1 Novelty with respect to D1

4.1.1 This document discloses an adapter in a car which facilitates the use of a portable radiotelephone. The radiotelephone includes a so-called "repertory memory" for frequently used telephone numbers. When it is plugged into the adapter, which comprises a converter and a handset, it can take advantage of the car battery, an improved antenna, the handset and extra repertory memory. It was argued that the repertory memories in the radiotelephone and the converter satisfy the requirements for the claimed "first memory" and "second

memory" respectively. D1 further discloses "store" and "recall" means which can save telephone numbers to, and retrieve them from, both repertory memories, so that in the view of the appellant the store means and the recall means together constituted a "user selective transfer means" as specified in the claim.

4.1.2 However, the claimed subject-matter of the contested patent, while broadly formulated, does specify that all the various means specified - with the exception of the second memory - belong to the radiotelephone. In D1 the adapter, generally referred to as "converter and remote handset", comprises its own microprocessor and working memory (fig.7, 703 and 709 respectively). When attached, the remote handset is enabled and the radiotelephone keypad is disabled (D1, column 6, line 68, to column 7, line 4). When, for example, a recall command is entered by the user, the user interaction is controlled by the converter's microprocessor which is directly connected to the remote handset (fig.7, 703 and 713). D1 further discloses that the value of the location in the repertory memory which the user desires to access is held in the converter's working memory 709 (column 8, lines 28 to 33). The radiotelephone's role in recalling a telephone number from the "second memory" contained in the converter is confined to sending a single bit command to the converter (column 8, lines 25 to 28). This interpretation of the teaching of D1 is supported by elements 1031 and 1033 of the flow-chart in fig.10b, which are shown as converter actions. A similar analysis applies to the store command as applied to the second memory (e.g. fig.10b, 1017, 1019, 1021).

4.1.3 Thus the "user selective memory access means for accessing the second memory" of D1 does not form part of the radiotelephone, but is rather part of the converter and remote handset into which the radiotelephone is plugged. Hence the claimed subject-matter of claim 1 as granted is novel with respect to the disclosure of D1.

4.2 Novelty with respect to D7

4.2.1 D7 discloses a radiotelephone for installation in a vehicle (page 151, column 1, lines 1 to 4). It includes a working memory which may be used for holding at least two sorts of telephone numbers, "automatic call numbers" and "recently dialled numbers" (page 152, column 2, lines 29 to 37). In addition there is a "plug-in code memory" which consists of a PROM, which is "programmed at the factory" (page 152, column 2, lines 50 to 54). This code memory is intended to hold "data that are individual for each system", including up to eleven automatic call numbers (page 153, column 1, lines 1 to 7). The code memory is accessible on the front panel of the installation and is therefore easy to change (page 153, column 1, lines 23 to 26). Thus "the identity of the mobile radio station can be transferred simply by changing the code memory" (lines 28 to 30).

4.2.2 The appellant argued that this radiotelephone fell within the claimed subject-matter. As part of the argument it was asserted that the code memory corresponded to the claimed "second memory", and that if an automatic call number was accessed from the code memory, it became the most recently dialled number and

was therefore transferred to the working memory ("first memory"). This constituted the claimed "transfer means".

4.2.3 However, D7 does not explicitly disclose that an automatic dial number which is called up is stored as the most recently dialled number; while at first sight it might seem likely that this is the case, there are other possibilities. The writer of the document might have been referring only to numbers which have actually been input via the keypad by the user. Moreover this would be a technically credible option, since presumably the reason for retaining the recently dialled numbers in the working memory is to shorten the process for redialling them. However, a short procedure for dialling the automatic dial numbers already exists, and the designer of the system disclosed in D7 could therefore have opted not to store this special category of dialled numbers in the recently dialled numbers storage in order to maximise the number of numbers available to the user by short access.

4.2.4 Thus there is no clear and unambiguous disclosure in D7 of the claimed "transfer means". Whether the provision of such transfer means by the skilled person would be likely is an issue to be considered in the context of whether the claimed subject-matter involves an inventive step, not whether it is novel (see point 5.2.1 below). Hence the subject-matter of claim 1 as granted is novel with respect to the disclosure of D7. It may be added for clarity that in coming to this conclusion on novelty the board has not had to consider the question of whether such a transfer, if it were established that it took place, would constitute a

"user selective" transfer means as specified in the claim.

5. *Inventive step*

5.1 D1 as starting point.

5.1.1 The appellant argued firstly that whether the means for accessing the second memory was in the radiotelephone or in the converter was a mere design choice, so that the skilled person would as a matter of routine also consider putting it in the radiotelephone. However the board does not find this argument convincing: when the radiotelephone is plugged into the converter, the remote handset (including display - D1, column 6, lines 58 to 60, and column 6, line 68, to column 7, line 4) is enabled, and all input and output of data is carried out via this remote handset, the corresponding function of the radiotelephone being disabled. The handset is controlled by a microprocessor (fig.7, 703). There is always working memory associated with a microprocessor, and it is natural that this memory should be used for storing input from the remote handset. Thus in the case of, for example, a recall command specifying a number stored in the EEPROM 707 of the converter ("second memory"), the command is parsed by the converter's microprocessor and its parameters stored in the local working storage, RAM 709. The data to be retrieved is also in the converter. It would then be a step going well beyond routine design choice to decide not to process the command locally, i.e. using the microprocessor 703, but rather to pass the command and its parameters to the radiotelephone for execution and access of the converter memory. Indeed the skilled

person would have a specific motivation not to do this. An amendment to the architecture of the converter with respect to the memory addresses could be accommodated in the system as described in D1 by a corresponding amendment to the converter's microprocessor program. Making the radiotelephone responsible for accessing the converter memory would mean that in the event of changes to the converter, radiotelephones already in use would have to be reprogrammed if the clearly desirable compatibility were to be preserved.

Hence, the skilled person would not be led by the disclosure of D1 to provide simply as an alternative design choice the claimed feature that the radiotelephone has means for accessing the second memory.

- 5.1.2 As an alternative the appellant suggested that it would be obvious to the skilled person that it was superfluous to provide an extra handset with the converter, and that the keypad and display already in the radiotelephone could be used. This might be done in order to save space or reduce cost. If this were done there would be no need for the microprocessor in the converter and if this were removed it would follow that the converter memory access would have to be carried out by the radiotelephone logic unit. However, no good reason has been put forward why the skilled person would want to save space by eliminating a feature of the system which would be useful to the user, or would choose to save cost in this particular way. Indeed, if the microprocessor were removed from the converter with the aim of saving cost, the board considers that the

skilled person would be equally motivated to remove the EEPROM (i.e. the second memory) itself.

Thus the board concludes that this argument would not lead the skilled person, starting out from the teaching of D1, to provide a radiotelephone falling within the scope of claim 1 as granted.

5.1.3 An objection based on a combination of the teachings of D1 and D8 was also raised by the appellant. D8 discloses a "repertory dialler", a device which stores short-dial numbers for use by a telephone, and discusses the benefits of loading the memory of the dialler from an outside source, either as a whole or by the transfer of individual entries. However, there is no suggestion that the outside source should be accessible by the telephone or repertory dialler as an extension to the repertory memory, i.e. as a "second memory" as claimed. Hence applying the teachings of D8 to D1 would not lead the skilled person to construct a radiotelephone falling within the scope of the claim 1 as granted.

5.2 D7 as starting point.

5.2.1 The appellant argued that the code memory of D7 could be identified with the claimed "second memory", see point 4.2.2 above, and that even if D7 did not explicitly teach the transfer of automatic call numbers when called up, to the "recently dialled numbers" area of the working memory ("first memory"), it would be obvious to do so. Although this argument is plausible the board does not consider that such a transfer would satisfy the requirement of being "user selective" as

specified in the claim; such a transfer would take place each and every time an automatic dial number was called up, whether or not the user wanted it to. Hence such a transfer, even if obvious, would not fall within the terms of the claim.

5.2.2 The working memory of D7 may also contain automatic dial numbers input by the user (D7, page 152, column 2, lines 30 to 33). The appellant argued that it would also be obvious to include a transfer mechanism for transferring numbers from the code memory to the working memory or vice versa. Reference was made in this context to D8 and the skilled person's general knowledge of memory transfers in the computer field; it was argued that the skilled person, aware from D7 that a second memory can be transferred from one radiotelephone to another (page 153, column 1, lines 23 to 30), would anticipate a user desire to transfer numbers from the working memory of one radiotelephone to that of another. It would therefore be obvious for the skilled person to implement a transfer mechanism from the working memory to the code memory and vice versa. Alternatively the teaching of D8 or general knowledge from the computer field would provide motivation for such a feature.

5.2.3 However, the code memory of D7 is a PROM, programmed in the factory (page 152, column 2, lines 51 to 54). Hence such a transfer mechanism could not be implemented in D7 as described, since it would not be possible to write to the code memory. Moreover, if for some reason the skilled person were motivated to replace the code memory PROM by a writable form of memory, e.g. EEPROM, it appears to the board that rather than provide a

transfer mechanism the skilled person would be led to store all user-defined automatic call numbers in the EEPROM instead of in the working memory of the radiotelephone.

5.2.4 Thus the board concludes that the skilled person, starting out from D7 would not arrive at the subject-matter of claim 1 as granted.

5.3 The prior art mentioned in the patent

5.3.1 Finally, the appellant drew attention to the prior art mentioned in the introduction to the patent, see column 1, lines 10 to 23 of the published patent, which mentions a radiotelephone arranged to receive a memory carrier in the form of a magnetic card. The appellant argued that it would be obvious to implement a transfer function on the basis of general knowledge from the field of computers.

5.3.2 The board notes that this argument was not raised at any stage of the opposition or appeal proceedings but was mentioned for the first time in the oral proceedings. Since the appellant did not present a detailed analysis of the actual prior art, the board considers this argument speculative and unconvincing.

6. For these reasons the appellant's arguments that the contested patent should to be revoked under Article 100(a) EPC also failed to convince the board.

7. In view of the board's conclusions on the respondent's main request it has not proved necessary to consider the claims of the auxiliary requests.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland