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**Datasheet for the decision
of 14 January 2009**

Case Number: T 1827/06 - 3.4.01

Application Number: 03024238.2

Publication Number: 1418571

IPC: G10L 17/00

Language of the proceedings: EN

Title of invention:

Voice connection system between humans and animals

Applicant:

S.I.SV.EL.

Opponent:

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Headword:

-

Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC Art. 83

Keyword:

"Sufficiency of disclosure"
"Principle of legitimate expectations"
"Estoppel by rem judicatam"

Decisions cited:

G 0010/93, T 0167/93

Catchword:

-



Case Number: T 1827/06 - 3.4.01

DECISION
of the Technical Board of Appeal 3.4.01
of 14 January 2009

Applicant: S.I.SV.EL
Appellant: Società Italiana per lo Sviluppo
dell'Elettronica S.p.A.
Via Sestriere 100
I-10060 None (TO) (IT)

Representative: Dini, Roberto
Metroconsult S.r.l.
Via Sestriere 100
I-10060 None (TO) (IT)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 19 July 2006
refusing European application No. 03024238.2
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: B. Schachenmann
Members: P. Fontenay
G. Assi

Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse the European patent application No. 03 024 238.2, notified on 19 July 2006. The decision was based on the ground that the invention was not sufficiently disclosed (Article 83 EPC 1973).
- II. Independent claim 1, refused by the examining division, concerned a voice connection system between humans and animals. In the "Reasons" for its decision, the examining division objected to the characterising feature of the claim according to which the *"pulse generating means comprise a generator of radioelectric waves [...], said generator being operative for sending radioelectric waves having different frequencies and amplitudes which can be directly perceived by the animal's brain"*. The examining division held, more specifically, that the skilled person would not know, on the basis of the description, how to generate radioelectric waves which could be directly perceived by the animal's brain.
- III. The appellant (applicant) filed an appeal against the above decision by notice of appeal received on 28 September 2006 under simultaneous payment of the prescribed appeal fee. The written statement setting out the grounds of appeal was received on 27 November 2006; it included a modified set of claims 1 to 5 and a correspondingly amended version of the description which then constituted the only request of the appellant.

Independent claim 1 filed with the statement of grounds reads as follows:

"1. Voice connection system between humans and animals, in particular domestic animals, comprising:

- sensor means (2) designed to be positioned on an animal, in particular on its head and/or neck, for converting pulses detected on the animal's body into electric signals (4) indicating a status of said animal,

- processing means (3) operatively associated to the sensor means (2), comprising memory means (5) into which human voice messages corresponding to different statuses of the animal are recorded,

- loudspeaker means (6) operatively connected to the processing means (3), the latter being designed to receive the electric signals (4) coming from said sensor means (2) and for activating said loudspeaker means (6) in order to issue a voice message selected in said memory means (5), in function of the aforesaid electric signals received (4),

- speech recognition means (7) operative for sending to the processing means (3) signals (9) representing the content of voice messages uttered by a human user (8), and

- pulse-generating means (10), which receive from said processing means (3) said signals (9) representing the content of the voice messages uttered by the human user (8), and which send to the animal's brain corresponding pulses, wherein

- a neural network control system is implemented into said processing means (3),

- said sensor means (2) comprises electroencephalographic type sensors (2A), i.e.,

operating for detecting electric activity in the animal's brain, and electromyographic type sensors (2B), i.e., operating for detecting electric activity in the animal's muscles and/or nerves,

- at least first and second encephalographic type sensor means (2A) are placed close to a respective ear of the animal, or anyhow close to its occipital-temporal region, and electromyographic type sensors means (2B) are placed on the animal's neck,

characterized in that said pulse-generating means (10) comprise one of a generator of microwaves and a generator of ultrasound waves."

Said claim differed from claim 1 according to the impugned decision, essentially, in that the characterising feature objected to by the examining division, relating to a generator of radioelectric waves, had been replaced by alternative generator means for microwaves or ultrasound waves.

- IV. On 3 November 2008, the Board issued a communication in which it expressed its provisional view that the amended claims still appeared to offend the dispositions of Article 83 EPC 1973 despite the deletion in claim 1 of the feature objected to by the examining division. Particular reference was made to the functionality of the system to issue a voice message representing a status of the animal in function of electric signals received by the sensor means, which issue had not been addressed by the examining division. Doubts were in particular expressed as to the possibility for the skilled person, on the basis of the current description, possibly completed by common general knowledge, to identify in a reproducible manner

sets of signals actually representative of specific statuses of animals such as those corresponding, according to the description, to thoughts, desires or feelings of the animal. Sufficiency of disclosure was also questioned in view of the large ambit of the claim, which referred to animals in general, whereas all embodiments disclosed in the application concerned, more specifically, dogs.

A further issue raised by the Board in its communication concerned the analysing process carried out on the signals collected by the sensors in order to determine the statuses of the animal. It was observed, in this respect, that the description was completely silent as to the algorithm actually implemented by the neural network.

- V. The appellant filed on 15 December 2008 with its reply to the communication of the Board a new main request and three auxiliary requests in which the feature of the generator of radioelectric waves had been reinstated in independent claim 1 of each request. Each request included a second independent claim directed to a corresponding method. As a further auxiliary request, the appellant requested that the case be remitted to the examining division for further prosecution.
- VI. Oral proceedings before the Board took place on 14 January 2009 in presence of the appellant's representative. In view of the new amended requests that had been filed by the appellant, the Board first drew the attention of the appellant to the issues which, in its view, possibly contravened to the requirements set out in Article 83 EPC 1973. The rapporteur

therefore developed during oral proceedings the objections already raised in the communication of the Board as to the asserted ability for the claimed system to issue voice messages corresponding to statuses of the animal in function of signals detected by the sensor means. Concerning, more specifically, the reinstated feature of the generator of radioelectric waves, the appellant was informed that the Board tended to concur with the analysis put forward by the examining division in the reasons for its decision.

- VII. The appellant took issue with the arguments invoked by the Board of appeal seeking to demonstrate their unsoundness and consequently the lack of basis of the objection as to insufficiency of disclosure. Addressing the objection raised for the first time by the Board of Appeal as to the ability of the system to issue voice messages indicative of the status of a dog, the appellant's representative refuted the view that the invention was essentially speculative. He indicated not to have been able so far, despite of having repeatedly asked the appellant and the inventors, to provide evidence of a successful performance of the claimed invention, but that he still expected to obtain such evidence.

In addition, he also referred to the fact that the application corresponding to PCT application WO-A-03/079775 (D1), which related to substantially the same subject-matter, had led to a patent granted by the EPO without any objection being raised under Article 83 EPC 1973. In his view the principle of legitimate expectations, which governs the relationships between the EPO and the parties to proceedings, implied that

the examining division entrusted with an application, which was similar to a previous one already granted by another examining division, would reach the same conclusion; a different outcome of the proceedings would namely lead to a distortion of competition between two competitors owning such an application and patent, respectively.

Concerning the definition of the generator of radioelectric waves generating waves directly perceived by the animal's brain, although objecting to the provisional view of the Board, the appellant declared in the oral proceedings that he was prepared to file a new request limited to the embodiment of an ultrasound generator.

VIII. The appellant eventually filed in the oral proceedings a new set of claims 1-7 replacing all previous requests. He requested that the impugned decision be set aside and a patent be granted on the basis of this only request.

Independent claim 1 of this request reads as follows:

"1. Voice connection system between humans and dogs comprising:

- sensor means (2) designed to be positioned on a dog, in particular on its head and/or neck, for converting pulses detected on the dog's body into first electric signals (4) indicating a status of said dog,

- processing means (3) operatively associated to the sensor means (2), comprising memory means (5) into which human voice messages corresponding to different statuses of the dog are recorded,

- loudspeaker means (6) operatively connected to the processing means (3), the latter being designed to receive the first electric signals (4) coming from said sensor means (2) and for activating said loudspeaker means (6) in order to issue a voice message selected in said memory means (5), in function of the aforesaid electric signals received (4), thus simulating the possibility of speaking for the dog,

- speech recognition means (7) operative for sending to the processing means (3) second electric signals (9) representing the content of voice messages uttered by a human user (8), and

- pulse-generating means (10), which receive from said processing means (3) said second electric signals (9) representing the content of the voice messages uttered by the human user (8), and which send to the dog's brain corresponding pulses, wherein

- a neural network control system is implemented into said processing means (3),

- said sensor means (2) comprises electroencephalographic type sensors (2A), i.e. operating for detecting electric activity in the dog's brain, and electromyographic type sensors (2B), i.e. operating for detecting electric activity in the dog's muscles and/or nerves,

- at least first and second electroencephalographic type sensor means (2A) apt to be placed close to a respective ear of the dog, or anyhow close to its occipital-temporal region, and electromyographic type sensors means (2B) are placed on the dog's neck, and wherein

said pulse-generating means is constituted by an ultrasound generator (10), that converts said second

electric signals (9) into ultrasounds which are sent directly to the dog's brain."

New claim 1 differs from claim 1 filed with the statement of grounds and reproduced above essentially in that it is limited to a voice connection system between humans and dogs and in that the pulse generating means is limited to the alternative of an ultrasound generator. Independent claim 6 refers to a corresponding method for allowing vocal connection between humans and dogs. Claims 2-5 and 7 depend respectively on independent claims 1 and 6.

In addition, the appellant reiterated his auxiliary request for remittal of the case to the examining division for further prosecution in the event that the Board would not be prepared to grant a patent on this basis.

Reasons for the Decision

1. The appeal is admissible.
2. *The reasons for the decision of the examining division do not apply to the amended request.*

The ground of lack of sufficiency of the disclosure (Article 83 EPC 1973), relied upon by the examining division in its decision to refuse the patent application, rests on the feature of the generator of radioelectric waves for sending waves which should be directly perceived by the animal's brain. The deletion of this feature and its replacement in claim 1

according to the appellant's request by the ultrasound generator renders the analysis of the examining division, which does also not apply to new method claim 6, obsolete.

3. *Remittal to the first instance*

3.1 In its decision G 10/93 (OJ 1995, 172), the Enlarged Board of Appeal ruled that the boards of appeal are not restricted, in ex parte proceedings, to examination of the grounds on which the decision of the first instance was based. More specifically, the boards of appeal have the power to examine whether an application meets requirements of the EPC that have not been considered during the examination proceedings or have been regarded as fulfilled by the examining division. Although decision G 10/93 focuses on the introduction of new grounds in the appeal procedure, the principle developed in this decision also implies, *a fortiori*, that a board of appeal is not restricted to examination of those arguments relied on by the examining division. Consequently, new arguments supporting grounds previously addressed before the first instance may be introduced by the Board of Appeal of its own motion.

3.2 In the present case, the Board finds that investigations as to the question of sufficiency of disclosure should be extended to the claimed system's alleged functionality that voice messages representative of different statuses of the animal can be generated in function of received electric signals. As this objection was raised for the first time in the appeal phase the applicant is thereby given the

opportunity to submit convincing evidence, if any, supporting his allegations (cf. point VII supra).

- 3.3 The Board does not accept the argument put forward by the appellant that the principle of legitimate expectations, which governs relations between the EPO and parties to proceedings before it, implied that a department of the EPO would be forced to follow previous decisions of examining divisions relating to other applications concerning substantially the same subject-matter.

The argumentation produced by the appellant is *de facto* tantamount to implying that the departments of the EPO would be bound by precedents. This approach is, however, in contradiction with the practise actually existing before the EPO. In decision T 167/93 the board investigated under Article 125 EPC 1973 whether a basis existed, among the principles of procedural law generally recognised in the Contracting States, for a binding effect of decisions of boards of appeal and concluded that the principle of estoppel by *rem judicatam* was of extremely narrow scope for the Contracting States. In particular, the conditions identified under section 2.5 of this decision make such a binding effect dependent on that something has been a) judicially determined, b) in a final manner, c) by a tribunal of competent jurisdiction, d) where the issues of facts are the same, e) the parties (or their successors in title) are the same and f) the legal capacities of the parties are the same.

In the present case, taking account of the fact that the decision relied upon by the appellant concerns a

decision of an examining division, none of the conditions a), b) and c) are met, so that, in line with decision T 167/93, no right for the appellant can *a fortiori* be inferred from the fact that a patent was granted based on earlier application D1. Consequently, no legal bar exists in the case under consideration for this particular aspect of sufficiency of disclosure being newly examined and decided upon by the examining division or the Board of Appeal.

- 3.4 However, the Board considers, in line with decision G 10/93 (cf. point 5), that the relevant circumstances of the case justify a remittal to the first instance in order for it to decide on the matter of sufficiency of disclosure and pursue the examination of present application on the basis of the set of claims filed during oral proceedings. To reach its conclusion the Board noted that the particular new aspect referred to in point 3.2 *supra* concerning sufficiency of disclosure was raised by the Board for the first time during the appeal procedure and that the appellant might have been surprised, in view of the fact that an examining division granted a patent on the basis of D1, by the introduction of this new argument into the procedure. In addition, the Board took note of the fact that the representative indicated during oral proceedings that he still expected to obtain additional information as to the actual performance of the claimed invention from the appellant and/or inventors.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of claims 1 to 7 filed in the oral proceedings.

The Registrar

The Chairman

R. Schumacher

B. Schachenmann