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**Datasheet for the decision
of 26 October 2010**

Case Number: T 0264/09 - 3.5.03

Application Number: 01111429.5

Publication Number: 1124229

IPC: H04M 11/08

Language of the proceedings: EN

Title of invention:

Audio recording and reproducing system

Applicant:

Sony Corporation

Headword:

Audio recording and reproducing system/SONY

Relevant legal provisions:

EPC Art. 56, 111(1)

EPC Rule 137(5)

Relevant legal provisions (EPC 1973):

EPC Rule 86(4)

Keyword:

"Inventive step - main request and auxiliary requests I and II
(no)"

"Remittal - auxiliary request III (yes)"

Decisions cited:

T 0708/00, T 0274/03, T 0141/04

Catchword:

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Case Number: T 0264/09 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 26 October 2010

Appellant:

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Decision under appeal:

Decision of the examining division of the
European Patent Office posted 12 September 2008
refusing European patent application
No. 01111429.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
R. Moufang

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European patent application No. 01111429.5 (publication number EP 1 124 229), which claims a priority date of 24 January 1996 and which is a divisional application of European patent application 97101119.2 (publication number EP 0 786 774).

II. The refusal was based on the ground that the subject-matter of claim 1 of a main request and that of claim 1 of a second auxiliary request did not involve an inventive step (Articles 52(1) and 56 EPC) having regard to the disclosure of:

D1: EP 0 467 208 A.

Claim 1 of a first auxiliary request was held not to meet the requirements of Rule 137(4) EPC (as then in force) and the first auxiliary request was therefore not admitted.

III. With the statement of grounds of appeal the appellant filed new sets of claims and implicitly requested that the decision be set aside and a patent be granted on the basis of claims of a main request or, failing that, on the basis of claims of one of two auxiliary requests, all as filed with the statement of grounds. Oral proceedings were conditionally requested.

IV. In a communication annexed to a summons to oral proceedings the board raised, without prejudice to its final decision, objections against claim 1 of all requests under, *inter alia*, Article 52(1) EPC, both in

combination with Article 54 EPC (lack of novelty) and in combination with Article 56 EPC (lack of inventive step).

V. In preparation for the oral proceedings, the appellant filed, with a letter dated 24 September 2010, sets of claims of a main request and three auxiliary requests I to III, replacing all requests on file, and submitted arguments in support.

VI. Oral proceedings were held on 26 October 2010 in the course of which the appellant filed, by way of replacement, revised sets of claims of the main request and the auxiliary requests I and III. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 12 of the main request or, in the alternative, auxiliary request I, both requests as filed at the oral proceedings, or auxiliary request II as filed with the letter dated 24 September 2010, or auxiliary request III as filed at the oral proceedings.

At the end of the oral proceedings the board's decision was announced.

VII. Claim 1 of the main request reads as follows:

"An audio recording and reproducing system comprising:
- a portable handheld audio device (1) having
 receiving means (9, 47) for receiving audio data
supplied from an external source (21),
 storage means (45) for storing said audio data,
 reproducing means (15, 52) for reproducing said
stored audio data, and

control means (41, 42) for controlling at least said reproducing means (15, 52), and a base station (2) having

a cavity (3) for inserting said portable audio device (1) therein,

transmitting means (4, 7, 61) for transmitting said audio data supplied from said external source (21) to said receiving means (9, 47) of said portable audio device (1) inserted in said cavity (3), and

power supply means (62) for charging a battery (53) built-in said portable audio device (1), characterised in that

said receiving means (9, 47) is adapted to be connected to said external source (21) by said base station (2) and is adapted to be connected to said external source (21) by a modem or terminal adapter (33) for receiving compressed audio data from said external source (21) and said storage means (45) is adapted to store said compressed audio data, wherein said portable audio device (1) comprises

expanding means (46) for expanding said compressed audio data stored in said storage means (45) and outputting expanded audio data; and

input key means (51) for directing at least play, stop, fast forward and rewind, wherein

said control means (41, 42) is adapted to control, in response to user's operation of said input key means (51), said expanding means (46) to expand compressed audio data stored in said storage means (45) and said reproducing means (15, 52) to reproduce said expanded audio data."

Claim 1 of auxiliary request I differs from claim 1 of the main request in that it additionally includes the

following feature in the characterising portion of the claim:

"said portable audio device (1) is adapted to upload audio data from said portable audio device (1) to said external source (21);"

and in that "and is adapted to be connected to said external source (21) by a modem ..." is replaced by "and is adapted to be connected to a modem ...".

Claim 1 of auxiliary request II differs from claim 1 of the main request in that the first paragraph of the characterising portion is replaced by the following two paragraphs:

"said portable audio device (1) comprises an external device connector means (18) for connecting an external display (31);

said receiving means (9, 47) is adapted to receive compressed audio data from said external source (21) using said base station (2) or without using said base station (2) and said storage means (45) is adapted to store said compressed audio data, wherein said portable audio device (1) comprises".

Claim 1 of auxiliary request III differs from claim 1 of the main request in that in the preamble of the claim the following paragraph is inserted between the paragraphs concerning the storage means (45) and the reproducing means (15, 52), respectively:

"display means (11) for displaying a menu image"

and in that the first paragraph of the characterising portion is replaced by the following two paragraphs:

"said receiving means (9, 47) is adapted to be connected to said external source (21) by said base station (2) and is adapted to be connected to said external source (21) by a modem or a terminal adapter (33) for receiving said menu image, wherein said portable audio device (1) comprises

means (12, 13A, 13B) for selecting desired audio data from said menu image indicating a plurality of pieces of audio data stored in said external source (21), wherein said receiving means (9, 47) is adapted to be connected to said external source (21) by said base station (2) and is adapted to be connected to said external source (21) by a modem or a terminal adapter (33) for receiving compressed audio data from said external source (21) and said storage means (45) is adapted to store said compressed audio data;".

Reasons for the Decision

1. Main request

1.1 The examining division regarded D1 as representing the closest prior art and so did the appellant. The board sees no reason to question this.

1.2 More specifically, D1 discloses, using the language of claim 1 of the main request, an audio recording and reproducing system (D1, col. 2, lines 4 to 12 and 37 to 48) including:

a portable handheld audio device (player 101, Fig. 1) having:

receiving means (connector 804, Fig. 8, and col. 14, line 44, to col. 15, line 2) adapted to be connected to an external source ("original supplier", col. 9, lines 52 to 56) via a base station (terminal device 100, Figs 1 and 69, col. 16, lines 36 to 39, and col. 66, lines 4 to 10) for receiving audio data ("music") supplied from the external source;

storage means (memory circuit 701, Fig. 7, col. 11, lines 10 to 12) for storing the audio data;

reproducing means for reproducing the stored audio data ("playback circuit", col. 11, lines 12 to 15); and

control means (controller 704, Fig. 7) for controlling at least the reproducing means (col. 14, lines 9 to 13);

and

a base station (terminal device 100, Figs 1 and 69) having:

a cavity (Fig. 69) for inserting the portable handheld audio device 101 therein;

transmitting means for transmitting the audio data supplied from the external source to the receiving means of the portable handheld audio device when inserted in the cavity (output section 104, Figs 1 and 4, col. 7, lines 55 to 57, and col. 10, lines 22 to 24); and

power supply means for charging a battery built-in the portable handheld audio device (power supply 407, Fig. 4 and col. 11, lines 25 to 37).

The portable audio device 101 further includes means for expanding compressed audio data stored in the storage means 701 (abstract, col. 40, line 48, to col. 41, line 6) and for outputting expanded audio data (col. 43, lines 31 to 38). It also includes input key means for directing at least play and stop (switch 5101, col. 55, lines 6 to 27, and Figs 51 to 53). Hence, the control means 704 (col. 14, lines 9 to 13) are adapted to control, in response to user's operation of the input key means 5101, the expanding means to expand compressed audio data stored in the storage means and the reproducing means to reproduce the expanded audio data.

- 1.3 According to D1, the switch 5101 is suitable for directing a plurality of types of operations, for the purpose of which the control means either measures the on time T of the switch or counts the number of times the switch is turned on (col. 55, lines 6 to 36 and line 48 to col. 56, line 2). Hence, it is implicit that the switch 5101 is also suitable for directing operations such as fast forward and rewind, it being noted that the fact that D1 does not disclose these specific operations is, as far as the suitability of the switch 5101 for directing these operations is concerned, not decisive.

Further, the connector 804 is suitable for receiving digital data from the external source via the base station, i.e. irrespective of the data content (col. 9, lines 41 to 44, and col. 64, lines 15 to 18). Hence, it is implicit that the connector is also suitable for receiving digital data which represents compressed audio data, it being noted that even if D1 does not

disclose that the original supplier supplies compressed audio data to the portable audio device, this is, as far as the suitability of the connector 804 for receiving the compressed audio data is concerned, not decisive.

- 1.4 The subject-matter of claim 1 differs from the system of D1 in that, according to claim 1, the receiving means is also adapted to be connected to the external source by a modem or terminal adapter. For the sake of argument the claim will be interpreted in a narrow sense, the modem or terminal adapter being considered as being part of the claimed system.

- 1.5 In D1, the receiving means of the portable audio device 101, i.e. connector 804, is adapted to be connected to the base station (terminal device 100, Figs 8 and 69) for receiving audio data from the original supplier via a B-ISDN (broad band integrated services digital network) (col. 7, lines 39 to 44, col. 9, lines 52 to 56, and Figs 1 and 2). D1 does not disclose details of the B-ISDN and, in particular, its connection to the input section 102 (Fig. 2) of the base station 100.

- 1.6 It was however common general knowledge at the priority date of the application in suit to interface digital equipment to a telephone network by means of a terminal adapter, also known as a "TA" and in the case of an ISDN network usually referred to as an ISDN modem. Hence, when faced with the problem of implementing the system of D1 and in particular its connection to the original supplier, it would have been obvious for a person skilled in the art to include an ISDN modem or terminal adapter in the terminal device 100. The

connector 804 of the portable audio device 101 would thereby be adapted to be connected, via the terminal device 100, to a modem or terminal adapter and be suitable for receiving compressed audio data from the original supplier. Hence, the skilled person would thereby arrive at an audio recording and reproducing system which includes all the features of claim 1.

1.7 The board therefore concludes that the subject-matter of claim 1 of the main request does not involve an inventive step (Articles 52(1) and 56 EPC).

2. *Auxiliary request I*

2.1 Claim 1 of auxiliary request I essentially differs from claim 1 of the main request in that it additionally includes the feature that the portable audio device is adapted to upload audio data from the portable audio device to the external source, cf. point VII above.

2.2 D1 discloses that the contents recorded in the portable audio device (player 101) may be shared with other players 101, electronic notebooks or the like (col. 65, lines 4 to 6) and that, in a preferred embodiment, the connector 804 complies with the JEIDA (Japan Electronic Industry Development Association) standard in terms of its size and pin arrangement in order to be compatible with existing memory cards (col. 14, line 57, to col. 15, line 2, col. 16, lines 36 to 39, col. 70, lines 39 to 41, and Figs 64 and 65). It was not contested that the JEIDA connector is equivalent to the well-known PCMCIA connector.

In the board's view, particularly in the case in which the connector of the portable audio device is compatible with existing memory cards, the above passages suggest that the portable audio device 101, like any memory card, is not only capable of receiving digital data and storing it in its memory but also of being read by any other external device, e.g. another player, an electronic notebook, a computer, etc., as long as the external device is able to receive, either directly or indirectly, the JEIDA standard connector of the portable audio device. In Figs 4 and 7 the arrows in both directions in the path of data signal D (col. 11, lines 37 to 41) between the portable audio device 101 and the terminal device 100 also suggest a bidirectional data flow capability. Audio data would thus be transmitted from the portable audio device to the external device, and *vice versa*. It would therefore be obvious for the person skilled in the art that the portable audio device 101 provided with the JEIDA connector is adapted to transmit or upload audio data from the portable audio device to the external device. Whether or not the external device is the original supplier referred to in D1, which corresponds to the external source referred to in the claim, is not relevant when comparing this system with the claimed system, since the external source is not defined as being part of the claimed subject-matter.

- 2.3 The appellant argued that "transmitting" data cannot always be equated with "uploading" data, since "uploading" requires that the transmitter initiates the data transmission. In the board's view, however, the term "uploading" should be given the meaning and scope it normally has in the relevant art, namely that of

transferring data, etc., from one computer or device to another, especially to one which is larger or remote from the user, or is functioning as a server; it is not relevant which side initiated the transfer. Hence, by transmitting data from the portable audio device to the external device as referred to above, the data is uploaded. The argument is therefore not convincing.

2.4 For these reasons and the reasons set out above in respect of claim 1 of the main request, the board concludes that the subject-matter of claim 1 of auxiliary request I does not involve an inventive step (Articles 52(1) and 56 EPC).

3. *Auxiliary request II*

3.1 As to the additional feature of claim 1 of auxiliary request II, according to which the portable audio device comprises an external device connector means for connecting an external display, the board notes that the connector 804 of the portable audio device 101 of D1 is suitable for being connected to a base station (terminal device 100) which has a liquid crystal display 303 (col. 9, line 31, to col. 10, line 2, col. 14, line 44, to col. 15, line 2, col. 66, lines 4 to 19, and Figs 3, 8 and 69). If for the sake of argument "external" in "external device" and "external display" in claim 1 were understood as relating to a device or display which is not part of the claimed system and, in particular, not part of the base station, it would, particularly in the case of a standard JEIDA connector, at the priority date have been obvious to the skilled person that the portable audio device would be adapted to be connected to any other external

electronic device capable of receiving a standard JEIDA connector, e.g. an electronic notebook provided with a display and, hence, that this portable audio device be suitable for connecting an external display.

3.2 The remaining features of claim 1 of auxiliary request II, including at least the first alternative in the second paragraph of the characterising portion of claim 1, according to which the receiving means is adapted to receive compressed audio data from the external source using the base station, are known from D1, see points 1.2 and 1.3 above.

3.3 The subject-matter of claim 1 of auxiliary request II does not therefore involve an inventive step (Articles 52(1) and 56 EPC).

4. *Auxiliary request III*

4.1 The board notes that the examining division did not admit a first auxiliary request for the reasons that claim 1 of that request differed from claim 1 of a main request by the addition of a feature which was not present in the claims as originally filed, had not been searched, and did not combine with the originally claimed invention to form a single inventive concept. Consequently, the claim was held not to meet the requirements of Rule 137(4) EPC (as then in force). The feature in question related to the portable handheld audio device of the system according to claim 1 as originally filed and further specified that it was adapted to transmit audio data from the portable handheld audio device to the external source.

4.2 In the board's view, if a feature which has not been searched and which further defines an element which was already part of a claim which had been searched, is taken from the description and added to this claim in order to overcome an objection under the EPC, e.g. lack of inventive step, this does not result in a claim which has been amended such that it relates to unsearched subject-matter which does not combine with the originally claimed invention to form a single general inventive concept. The board thereby follows the well-established case law on the interpretation of Rule 86(4) EPC 1973 see, e.g., T 708/00 (OJ EPO 2004, 160), point 17, T 274/03 (not published in OJ EPO), points 5 and 6, and T 141/04 (not published in OJ EPO), point 5, it being noted that Rule 86(4) EPC 1973 has the same wording as Rule 137(4) EPC (as in force at the date the examining division took its decision), which, as from 1 April 2010, is included in Rule 137(5) EPC. The board notes that the Guidelines for Examination in the European Patent Office (April 2010) are drafted accordingly, cf. section C-VI 5.2(ii) which explicitly mentions the possibility of carrying out an additional search in connection with the examination of amended claims.

4.3 It follows that in respect of the then first auxiliary request referred to at point 4.1 above the examining division was wrong in raising an objection under Rule 137(4) EPC.

4.4 Turning to claim 1 of present auxiliary request III, this claim includes, *inter alia*, the additional features that the display means of the portable audio device is suitable for displaying a menu image and that

the portable audio device includes means for selecting desired audio data from a menu image which indicates a plurality of pieces of audio data which are stored in the external source.

The situation referred to at point 4.2 above applies to this claim in that it includes additional features which were not part of the claims as originally filed and which give rise to the question of whether or not an additional search as provided for in the Guidelines, B-II 4.2(i) and C-VI, 5.2(ii) and 8.2, is required in order to be able to examine the question of whether or not the claimed subject-matter meets the requirements of the EPC, in particular Article 52(1) EPC in combination with Articles 54 and 56 EPC.

- 4.5 Having regard to the considerations set out above at points 4.1 to 4.4, the board is of the view that, in the present case, the above-mentioned question of whether or not an additional search is required, is a matter to be considered by the examining division.
- 4.6 The board therefore judges that it be appropriate pursuant to Article 111(1) EPC to remit the case to the examining division for further prosecution on the basis of the claims of auxiliary request III.
- 4.7 With respect to the further prosecution, the board notes that it may be necessary to examine whether or not the claims comply with the requirements of Articles 76(1) and 123(2) EPC. Further, it may be necessary to consider the question of whether or not the additional feature "means for selecting desired audio data from said menu image indicating a plurality of pieces of

audio data stored in said external source" (underlining by the board) implicitly requires that the external source be defined as part of the claimed system, or that it will be necessary that the category of the claim be changed to a method, in order to comply with the requirement of Article 84 EPC that the claims shall be clear.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 12 of auxiliary request III as filed at the oral proceedings.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland