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**Datasheet for the decision  
of 18 September 2012**

**Case Number:** T 0905/09 - 3.5.06

**Application Number:** 02701727.6

**Publication Number:** 1367494

**IPC:** G06F 13/00, G06F 17/60,  
A63F 13/12

**Language of the proceedings:** EN

**Title of invention:**  
Method of communication by e-mail

**Applicant:**  
Kabushiki Kaisha Eighting

**Headword:**  
Anthropomorphized toy/EIGHTING

**Relevant legal provisions (EPC 1973):**  
EPC Art. 56

**Keyword:**  
"Inventive (no) - both requests"

**Decisions cited:**  
T 0641/00

**Catchword:**  
See reasons 8.3 and 9



Case Number: T 0905/09 - 3.5.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.06  
of 18 September 2012

**Appellant:** Kabushiki Kaisha Eighting  
(Applicant) 23-1, Ohi 1-Chome  
Shinagawa-ku  
Tokyo 140-0014 (JP)

**Representative:** Hoffmann Eitle  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 19 December 2008  
refusing European patent application  
No. 02701727.6 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** D. H. Rees  
**Members:** M. Müller  
C. Heath

## Summary of Facts and Submissions

- I. The appeal lies against the decision of the examining division, with written reasons dated 19 December 2008, to refuse European application no. 02701727.6 for lack of an inventive step.
  
- II. The decision argues that the claimed invention constitutes a straightforward implementation of a business idea with conventional hardware and software. Based on this argument, a declaration under Rule 45 EPC 1973 had been issued instead of a search report. On request by the applicant, the examining division had later introduced a document, D1=GB2349551, but only, as it argued, to illustrate what was considered notoriously known in the art (cf. summons to oral proceedings before the examining division, p. 4, last par. before point 5). Consistent with this position, the decision under appeal does not rely on D1 in its reasons.
  
- III. An appeal was filed on 27 January 2009 and the appeal fee was paid on the same day. A statement of grounds of appeal was filed on 3 April 2009. It was requested that the decision under appeal be set aside and that a patent be granted based on a main or first and second auxiliary requests as filed with the grounds of appeal.
  
- IV. With a summons to oral proceedings, the board raised clarity objections and expressed its preliminary opinion that, as regards inventive step, the decision would have to be confirmed.

V. In response to the summons, the appellant filed new claims according to a main and an auxiliary request which were amended in view of overcoming the board's clarity objections. The second auxiliary request was withdrawn.

VI. The oral proceedings took place as scheduled. During the oral proceedings the appellant filed amended claims according to the main request and requested that a patent be granted based on the following documents.

claims, no.

1-6 according to the main request, as filed during oral proceedings on 18 September 2012

1-4 according to the auxiliary request, as filed on 13 August 2012

description, pages

1, 2, 4, 8, 9 according to the main or auxiliary request, filed on 13 August 2012

3, 5-7 according to the main or auxiliary request, filed with the grounds of appeal

drawings, sheets

1/4-4/4 according to the main or auxiliary request, filed with the grounds of appeal.

VII. Independent claim 1 according to the main request reads as follows:

"An electronic mail communication method performed by a transmission control apparatus (30), the method comprising the steps of:

receiving a signal from a mobile telephone defining an ID code assigned to an anthropomorphized object comprising a stuffed animal toy and an electronic mail address for an owner of the anthropomorphized object, the ID code having been input by the owner via a display of the mobile telephone; and electronically generating a mail text related to said ID code and sending said mail text as an electronic mail purporting to be from the stuffed animal toy to the owner, wherein the mail text comprises a conversational text expressing feelings including characters, signs, graphics, voices or sounds."

Claim 1 according to the auxiliary request reads as follows:

"An electronic mail communication method performed by a transmission control apparatus (30), the method comprising the steps of:

receiving a signal from a mobile telephone defining an ID code assigned to an anthropomorphized object comprising a stuffed animal toy and an electronic mail address for an owner of the anthropomorphized object, the ID code having been input by the owner via a display of the mobile telephone; and electronically generating a mail text related to said ID code and sending said mail as an electronic mail to the owner, wherein the mail text comprises a conversational text including characters, signs, graphics, voices or sounds, and wherein the electronic mail is generated from stored data comprising:  
attribute information for the anthropomorphized object stored in an anthropomorphizing table (32);

attribute information for the owner of the anthropomorphized object stored in a user information table (33);

texts stored in a standard text table (34); and grammatical rules."

Both requests also comprise an independent apparatus claim (no. 4 in the main request, no. 3 in the auxiliary request) which corresponds closely in wording with the respective claim 1.

VIII. At the end of the oral proceedings, the chairman announced the decision of the board.

## **Reasons for the Decision**

### *The invention*

1. The invention is concerned with generating and sending an electronic mail (email) to the owner of a so-called "anthropomorphized" object, especially a stuffed animal toy, so that the email is perceived as having been sent by the object. To enable this the user enters - via a mobile telephone - an ID code "associated with" and thereby identifying the object of interest and an email address to which the email should be sent. According to the main request, the email "purport[s] to be from the stuffed animal toy", is "related to said ID code" and comprises "conversational text expressing feelings". According to the auxiliary request, the email is generated based on "attribute information" for the object and for its owner, stored in respective tables,

on predefined texts also stored in a table, and on grammar rules.

*Clarity*

2. The board has a number of reservations as to whether the independent claims are clear, all of which apply to both requests:
  - 2.1 There is doubt whether the reference in claim 1 to an ID code as "having been input by the owner via a display of the mobile telephone" defines a step of the claimed method or not: although the skilled person would normally take a step defined in a method claim to be part of the claimed method, even if, as is the case here, it is phrased in the perfect tense, this arguably contradicts the preamble of claim 1 which relates to a method performed by a "transmission control apparatus (30)" excluding the mobile telephone (cf. also claim 4 of the main request).
  - 2.2 The independent claims specify that the ID code is input "via a display" while the application appears to depict that the input should be "via a keyboard" in view of a display prompt (fig. 2). It is arguable that the skilled person would interpret the former claim language in the latter, intended manner, in view of the fact that data input into mobile telephones normally was, at the priority date, "via the keyboard" and not literally "via the display".
  - 2.3 It appears dubious to specify the claimed "anthropomorphized object" as "comprising" - rather than "being" - "a stuffed animal toy".

- 2.4 These issues were put to the appellant during the oral proceedings but then left open in favour of the debate about inventive step and in view of the board's understanding that clarification would be easily available if needed. For the purpose of assessing inventive step, the board interpreted the claims as intended, namely as specifying that the transmission control apparatus receives (or is set up to receive) from a mobile telephone a digital - rather than an audio - signal representing an ID code, that this ID is keyed in at the mobile telephone, and that the anthropomorphized object is a stuffed animal toy.
3. Anthropomorphism is the property of an entity to resemble a person. While the board deems this term to be rather vague, it accepts that "stuffed animal toys ... already have", in an intuitive sense, "a certain degree of anthropomorphism" (cf. submission of 13 August 2012, p. 3, lines 9-10). In the board's judgment, hence, the specification of the "stuffed animal toy" to be anthropomorphic merely explicates a feature implicit to the toy but does not limit the scope of the claims. During oral proceedings the appellant confirmed this view, further explaining that the explicit mention of "anthropomorphism" in the claims is meant to clarify the purpose of the invention, namely to enhance the already existing anthropomorphism of stuffed animal toys.

*Inventive step*

4. It is undisputed that the claimed invention consists of a mixture of so-called technical and non-technical features but has, as a whole, technical character, for



instance by virtue of requiring an email to be sent. For this situation, it is established jurisprudence of the boards of appeal that inventive step has to be assessed by taking account of all those, but only those features which contribute to the technical character of the invention, and that an aim in a non-technical field which the claimed invention aims to achieve may appear in the formulation of the technical problem to be solved according to the problem-solution-approach (see esp. T 641/00, headnotes).

5. Therefore, before the inventive merit of the claimed invention can be assessed, it must be determined in which technical field the invention makes a contribution and which technical problem the claimed invention solves.

*Technical field*

6. The appellant argues that the invention belongs to the field of stuffed animal toys or dolls. In this field, "talking dolls" are known which exhibit enhanced anthropomorphism over normal dolls by communicating electronically with their owners. Assessment of the inventive step of the invention should, so the appellant, start from such a doll and appreciate that the invention enhances its anthropomorphism further with technical means, and with a limited increase in development and production cost (cf. original description, p. 2, lines 2-5). To solve this problem, the skilled person in this field would modify the sound clips the doll is able to play back, for example by recording new sentences which purport to express the doll's feelings. However, it would not be obvious for the skilled person to switch to an entirely different communication medium such as email.

7. The board does not follow this argument.
- 7.1 The invention relates to the stuffed animal toy only by way of the ID code identifying it and the content of the generated email which "purport[s] to be from" the toy and to express its "feelings".
- 7.2 According to the claims, the ID code is "assigned to" the toy in an unspecified way. The description discloses that the ID code may be printed on the back of the price tag (see p. 5, lines 1-3; and fig. 2). Otherwise, the toy need not be modified at all to enable the claimed invention: The registration of the ID code is done by the owner, the email is generated in the "transmission control apparatus", and the illusion that the email is from the toy is created in the mind of the receiver of the email (cf. fig. 1, esp. item no. 15).
- 7.3 The board agrees with the appellant that talking dolls create an illusion, too, and that the owner of such a doll must also be willing to accept the sound clips as being spoken by the doll (or, in the case of small children, unable to notice that they are not). However, a talking doll requires the provision of constructional elements such as a recording device, a loudspeaker, batteries, and, possibly, sensors or timers.
- 7.4 In contrast, the claimed invention applies to any given stuffed animal toy alike and it does not change the toy's design or production at all. The development and production departments need not even be aware of the claimed registration or the sent emails.

7.5 The board therefore rejects the appellant's assertion that the invention makes a contribution in the field of physical toys and dolls.

*Technical and non-technical features*

8. In the board's view, the following features do not constitute or imply any technical limitations of the claimed subject matter.

8.1 It is of no technical relevance for the invention whether the email address belongs to the *owner* of the toy or any other person.

8.2 The *ID code* serves to select and/or generate the text to be sent to the user. Beyond that, it does not have any impact on the claimed invention that the ID code is "assigned to" a specific stuffed animal toy. As already argued above, the invention does not depend on the nature of the object. Hence, it is not a technical feature of the claim that the ID code is "assigned to" a physical toy.

8.3 If the alleged effect of enhanced anthropomorphism is actually achieved by the invention, then due to the fact that the generated email "purports to be from the stuffed animal toy", is held in a conversation tone and expresses "feelings". The extent to which this effect is achieved depends, on the one hand, on the receiver's mental disposition to accept the illusion and, on the other hand, on the specific content of the email, *i.e.* which words are used. A complete loss of content may render the communication meaningless for the receiver but does not affect the technical working of the claimed

invention. Thus, the content of the email constitutes mere "cognitive data" in the terms of T 1194/97 (OJ 2000, 525; reasons 3.3) and therefore does not contribute to the technical character of the claimed invention.

*Technical problem*

9. Accordingly, the board considers as the objective technical problem solved by the claimed invention how to communicate to the owner of a given stuffed animal toy customized information purporting to come from the toy and express its feelings. It is to be noted that this is not a problem of improving a toy in any way, so that the relevant skilled person is not a toy designer. Rather he or she is a communication engineer.
- 9.1 In the board's view, the motivation for addressing this problem may be a marketing idea for affective advertising ("Your cuddly bear is cold, get me a jacket." or "Barbie is lonely, buy me a Ken."). The description in fact discloses the option of using the invention for delivering news or advertisements to the users who, due to the conversational and emotional tone of the text, "can accept" them "without feeling any mental resistance" (cf. p. 9, last par.; also p. 6, lines 17-20).
- 9.2 The appellant argues that this perspective takes a distorted view on the invention because it must already have been made before the marketing department can "hijack" it for targeted advertising.
- 9.3 The board disagrees with this argument.

9.3.1 First, marketing is to a large degree a matter of psychology so that marketing experts can realistically be assumed to be familiar with affective concepts. Moreover, the idea of using conversational tone and emotionalised content for targeted advertisement, for which customers may have to register, is a rather well-known marketing scheme (imagine, say, a car dealer offering a new set of summer tyres at the first signs of spring). Considering the invention as the implementation of a given marketing concept is thus, in the board's view, a realistic perspective, beyond the fact that it is consistent with the description.

9.3.2 Second, and more importantly, the reference to marketing only serves to illustrate that the above objective technical problem is not a contrived one but can reasonably be assumed to arise. The board concedes that different perspectives could be taken on the invention, for example as a means for parents trying to increase the emotional bonds between their child and its teddy bear, but holds that the technical problem solved by the invention would remain the same.

*Main request*

10. The skilled person, in order to solve the above problem by implementing the given communication task, would have to choose a means of communication with the owners. *A priori*, several options exist, such as telephone, telefax, WWW, or email. All of them were well-established at the priority date so that the skilled person would have made his choice according to circumstances and after weighing the well-known advantages and disadvantages of these communication

means against each other. Specifically, the choice of email was obvious at the time.

- 10.1 Evidently, for email communication to be possible the email address of an owner must be made available to the information provider. Likewise, it appears to be a matter of necessity that the object of interest - the stuffed animal toy - must be identified to the information provider so that the information can be customized to the object.
- 10.2 The skilled person would also have to decide how that information should be made available. Again various alternatives exist, including the ones mentioned above, all of which were equally well-established and thus equally obvious.
- 10.3 The board considers that it was commonly known at the priority date that Internet users would register their interest to receive information - such as electronic newsletters - via a web browser. Document D1 reports that by its filing date in June 1999 it was known to use the wireless application protocol WAP to browse the Internet with a mobile phone (see p. 1, lines 7-24; esp. lines 9-12). In the board's view the desire to access the Internet via a mobile phone was common at the priority date of the present application and that also the use of WAP to achieve it was commonly known at the time. The use of a mobile telephone to register the relevant data would thus be an option that the skilled person would consider as a matter of course.
- 10.4 Finally, the skilled person would have to obtain the message text to be sent. It follows directly from the

problem that the text should relate to the registered toy and it would be obvious, for instance, to select the appropriate text for a given toy, identified by its ID code, from a list of predefined such texts, thereby "electronically generating a mail text" according to claims 1 and 4 of the main request.

- 10.5 In summary, the board concludes that the skilled person would have to make only routine choices - selecting technical means for the user to register the relevant data and for the information provider to obtain and communicate the information of interest - so as to arrive at the subject matter of claims 1 and 4 of the main request which, hence, lacks an inventive step over common knowledge in the art, Article 56 EPC 1973.

*Auxiliary Request*

11. The independent claims 1 and 3 of the auxiliary request additionally specify sources of stored data from which the electronic mail is generated, namely
- a) attribute information for the anthropomorphized object and the owner, both stored in respective tables, and
  - b) texts stored in a text table and grammatical rules.
- 11.1 As already pointed out above, the content of the electronic mail is a non-technical matter (point 8.3). This applies both to the topic of the mail - e.g. that it relates to "attribute information for" the object and its owner - and its form - e.g. that it contains certain texts and conforms with grammatical rules.

11.2 The board concedes that a specific implementation of the automatic text generation may involve technical considerations and solve a technical problem. The claims however - and the description - specify only little relevant detail in this respect. The features which the claims do specify would be obvious for the skilled person for the following reasons.

11.3 It is evident that different texts may have to be sent depending on circumstances, for example to provide topical information such as an invitation to the upcoming Barbie fashion show. Depending on how many different texts these are, the skilled person would consider it obvious - according to a well-known trade-off between required storage space and computation time - that these should not be individually predefined but automatically generated from text fragments (e.g. letter opening, letter body and complimentary close), for example with slots for the insertion of the relevant attribute information (e.g., "Dear <owner name>, my name is <name of toy> ..."; see also "Yuko!" in fig. 1). Using tables to store the attribute information and the texts appears to be an elementary and thus obvious choice for the skilled person.

11.4 Some languages require that the letter opening or closing phrases take into account the addressee's gender ("Cher Monsieur" or "Chère Madame", "Sehr geehrter Herr" or "Sehr geehrte Dame"). Already for linguistic reasons it would thus also be obvious that the mail text is generated in view of the pertinent grammatical rule.

11.5 In summary, the board considers that the additional features a) and b) do not contribute to the non-obvious



solution to a technical problem and are thus insufficient to establish an inventive step, Article 56 EPC 1973.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees