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**Datasheet for the decision  
of 20 October 2011**

**Case Number:** T 0470/10 - 3.5.03

**Application Number:** 00310119.3

**Publication Number:** 1102461

**IPC:** H04M 3/533

**Language of the proceedings:** EN

**Title of invention:**  
Bookmarking voice messages

**Applicant:**  
Avaya Inc.

**Opponent:**  
-

**Headword:**  
Bookmarking voice messages/AVAYA

**Relevant legal provisions:**  
EPC Art. 123(2)

**Relevant legal provisions (EPC 1973):**  
-

**Keyword:**  
"Added subject-matter - no (after amendment)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0470/10 - 3.5.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.03  
of 20 October 2011

**Appellant:** Avaya Inc.  
211 Mount Airy Road  
Basking Ridge, NJ 07920 (US)

**Representative:** Williams, David John  
Page White & Farrer  
Bedford House  
John Street  
London  
WC1N 2BF (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 13 October 2009  
refusing European patent application  
No. 00310119.3 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** B. Noll  
M.-B. Tardo-Dino

## Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division by which European patent application no. 00310119.3 was refused pursuant to Article 97(2) EPC on the ground that the subject-matter of claim 1 of each of a main and an auxiliary request as filed on 4 September 2009 extended beyond the content of the application as originally filed (Article 123(2) EPC).
- II. Together with the statement of grounds of appeal three sets of claims according to a main and two auxiliary requests were filed. It was requested, inter alia, that the case be remitted to the examining division with the order to grant a patent on any one of the main, first or second auxiliary requests.
- III. In two communications sent on 3 November 2010 and 26 May 2011, respectively, the board gave a preliminary opinion on the case, in particular on the question of added subject-matter.
- IV. In response to the board's second communication the appellant on 4 August 2011 filed two sets of claims to replace the existing first and second auxiliary requests. The main request having previously been withdrawn, it was requested that the application be remitted to the examining division for further prosecution on the basis of the first or the second auxiliary request.
- V. Claim 1 of the first auxiliary request reads as follows:

"An electronically implemented method for bookmarking messages, the method comprising:  
receiving and storing a voice message at a voice messaging system;  
receiving a user request to create a bookmark within the voice message, the request selecting a first location of the voice message;  
creating a first bookmark at a second location, the second location being a specific time duration before the first location;  
receiving a command from a user to play the voice message beginning at the first bookmark; and  
playing the voice message for the user, wherein the playing begins at the second location of the voice message."

In view of the board's decision it is not necessary to reproduce claim 1 of the second auxiliary request.

### **Reasons for the Decision**

1. The only issue to be decided by the board is whether the subject-matter claimed by the first or second auxiliary request meets the requirement of Article 123(2) EPC.
2. Claim 1 of the first auxiliary request seeks protection for a method which substantially corresponds to the preferred bookmarking method as discussed at paragraphs [0024] and [0025] of the published application, as modified by the "second alternative bookmarking method" as described in paragraph [0030]. In detail, the first feature in claim 1 corresponds to the voice message

recording described in paragraph [0024] of the application, see in particular the third sentence. The second and the third features make a clear distinction between a step to be carried out by the user, namely requesting that a bookmark be created and a step to be carried out by the voice recording system, namely creating the bookmark at an appropriate location in the voice message as discussed at paragraph [0030]. The fourth and fifth features concerning the reproduction of a voice message are based on the disclosure in paragraph [0025].

The feature of claim 2 is based on the disclosure of paragraph [0030], see final sentence. The additional feature of claim 3 is based on the passages referred to above in connection with the second and third features of claim 1. The additional features of claims 4 and 5 are based on the alternative given in paragraph [0032]. Claim 6 substantially corresponds to the fourth and fifth feature of claim 1. Claim 7 is based on the third sentence in paragraph [0024].

Claims 8-14 include the features of claims 1-7 in terms of an apparatus and are therefore based on the same passages as indicated above.

3. The board therefore concludes that the subject-matter as claimed in the first auxiliary request does not extend beyond the content of the application as filed.

Since the requirement of Article 123(2) EPC constituted the sole ground for refusal, the impugned decision is set aside and the case is remitted to the department of first instance for further examination on the basis of

the claims of the first auxiliary request as filed on  
4 August 2011.

**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.

The Registrar

The Chairman

G. Rauh

A. S. Clelland