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**Datasheet for the decision  
of 17 December 2013**

**Case Number:** T 0473/10 - 3.4.01

**Application Number:** 06740550.6

**Publication Number:** 1866795

**IPC:** G10L21/00, G06F17/21

**Language of the proceedings:** EN

**Title of invention:**

SYSTEM FOR GENERATING AND SELECTING NAMES

**Applicant:**

Sony Online Entertainment LLC

**Headword:**

**Relevant legal provisions:**

RPBA Art. 13(1), 13(3), 15(3)

EPC 1973 Art. 84

EPC Art. 123(2)

**Keyword:**

late-filed requests (not clearly allowable and thus not admitted)

**Decisions cited:**

T 1587/07

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 0473/10 - 3.4.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.01**  
**of 17 December 2013**

**Appellant:** Sony Online Entertainment LLC  
(Applicant) 8928 Terman Court  
San Diego, CA 92121 (US)

**Representative:** DeVile, Jonathan Mark  
D Young & Co LLP  
120 Holborn  
London EC1N 2DY (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 23 October 2009  
refusing European patent application No.  
06740550.6 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairwoman:** F. Neumann  
**Members:** H. Wolfrum  
M. Vogel

## **Summary of Facts and Submissions**

- I. European patent application 06 740 550.6 (publication No. WO 2006/110416) was refused by a decision of the examining division dispatched on 23 October 2009.

The examining division considered the subject-matter of the claims of the main request and the first auxiliary request then on file to lack inventive step (Articles 52(1) and 56 EPC 1973). Claim 1 of each of the second to fourth auxiliary requests then on file was held to comprise added subject-matter (Article 123(2) EPC).

- II. The applicant lodged an appeal against the decision with a notice received on 17 December 2009. The prescribed appeal fee had been paid already on 11 December 2009. A statement setting out the grounds of appeal was filed on 23 February 2010.

The appellant requested that the contested decision be set aside and a patent be granted on the basis of the claims of either a main request or one of three auxiliary requests, all requests being filed with the statement setting out the grounds of appeal. Oral proceedings were requested as well.

- III. On 27 June 2013 the appellant was summoned to oral proceedings to take place on 17 December 2013.

In an annex accompanying the summons pursuant to Article 15(1) RPBA the Board addressed a number of issues to be discussed concerning, in addition to the question of inventive step, clarity of the claims (Article 84 EPC 1973), sufficiency of disclosure (Article 83 EPC 1973) and added subject-matter (Article 123(2) EPC).

IV. By letter of 15 November 2013 the appellant filed four new sets of claims to replace the claims of the former main and auxiliary requests. It was requested that a patent be granted on the basis of the claims of any of the main request or the first, second or third auxiliary requests presented with the letter of 15 November 2013.

Moreover the appellant informed the Board that it did not intend to attend the oral proceedings.

V. By a further letter of 6 December 2013 the appellant reiterated that it would not attend the oral proceedings but asked that the oral proceedings should take place in its absence.

VI. On 17 December 2013 oral proceedings were held in the absence of the appellant.

VII. Independent claims 1 and 10 of the appellant's main request read as follows :

"1. *A system for generating a name, comprising:*  
*a user interface that receives user input including desired characteristics, and values corresponding to the characteristics, and name lengths;*  
*storage storing data, including data representing said user input and a rule dictionary; and*  
*a processor for executing instructions providing said user interface, a phoneme selector, and a phoneme compiler, wherein*  
*the rule dictionary includes a searchable database table having entries, each entry having a field for one of the characteristics and a field for a set of one or more phonemes indicating a relationship between the phoneme and the characteristic;*

*the phoneme selector that selects a phoneme using the value for the characteristic received through said user interface and a rule of sound symbolism corresponding to that characteristic by searching the database table for the characteristic and selecting the phoneme corresponding to the value for the characteristic; and*

*the phoneme compiler that combines selected phonemes to form a name, said name including a number of letters based on said user input name length, wherein the phoneme compiler uses a pseudo-random selection to arrange the plurality of phonemes."*

*"10. A method of generating a name, the method comprising:*

*receiving from a user interface user input including desired characteristics, and values corresponding to the characteristics, and name lengths;*

*providing a rule dictionary which includes a searchable database table having entries, each entry having a field for one of the characteristics and a field for a set of one or more phonemes indicating a relationship between a phoneme and a characteristic;*

*selecting using a phoneme selector a phoneme using a value for the characteristic received through said user interface and the rule of sound symbolism corresponding to that characteristic from the rule dictionary by searching the database table for the characteristic and selecting the phoneme corresponding to the value for the characteristic, and*

*combining the selected phonemes to form a name using a phoneme compiler, said name including a number of letters based on said user input name length, wherein the phoneme compiler uses a pseudo-random selection to arrange the plurality of phonemes."*

Claim 19 is directed to *"A computer program, stored on a tangible storage medium, for use in generating a name, the program comprising executable instructions that cause a computer to perform the method according to any of claims 10 to 18."*

Claims 2 to 9 and 12 to 18 are dependent claims.

The independent claims of each of the auxiliary requests contain additional limiting features. The exact wording of these claims is not relevant for the present decision. It is sufficient to note that, just as the independent claims of the main request contain the limitation *"wherein the phoneme compiler uses a pseudo-random selection to arrange the plurality of phonemes"*, so also do those of the auxiliary requests on file.

VIII. The appellant explained the motivation for and the nature of the amendments made to the claims of the various requests. On the other hand, no specific arguments were provided as to why the amended requests should be admitted into the proceedings.

In support of the limitation introduced into the independent claims of all the requests on file that the phoneme compiler used a pseudo-random selection to arrange the plurality of phonemes when generating a name, the appellant referred to paragraph [050], final sentence on page 9 and to paragraph [065], line 12, on page 12 of the published application. The limitation was of a technical nature and involved a technical effect and as such supported the presence of an inventive step since none of the documents of the cited prior art taught the arrangement of phonemes in a pseudo-random manner to compile a name from a plurality of selected phonemes. Pseudo-random processes were a well known concept in

computing fields for producing a random selection which might appear to be random but was entirely deterministic. As such two computers which were arranged and operated in the claimed manner and required to generate a name from the same input would come up with the same name.

### **Reasons for the Decision**

1. In the following reference is made to the provisions of the EPC 2000, which entered into force as of 13 December 2007, unless the former provisions of the EPC 1973 still apply to pending applications.
2. The appeal complies with the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is, therefore, admissible.
3. Admissibility of the appellant's requests of 15 November 2013
  - 3.1 Compared to the claims of the requests submitted with the statement setting out the grounds of appeal, the requests filed by letter of 15 November 2013 contain substantive amendments to the independent claims, including the limitation "*wherein the phoneme compiler uses a pseudo-random selection to arrange the plurality of phonemes*". This limitation is present in the independent claims of all current requests.
  - 3.2 The limitation has been derived from the description of the current application (see letter of 15 November 2013, page 1, penultimate paragraph) and thus had not and could not have been addressed by the Board in its observations as to lack of inventive step given in the annex to the summons to oral proceedings.

- 3.3 Moreover, the limitation in question relates to a concept which was not the subject of any of the claims on which the European Search Report was established.
- 3.4 Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) stipulates that *"Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy."* In accordance with consistent case law, if the amendments are not prima facie clearly allowable or if they lead to an excessive delay in the proceedings, it is likely that the amendments will not be admitted (see chapter IV.E.4.4.1 of the 7th edition (2013) of "Case Law of the Boards of Appeal of the European Patent Office").
- 3.5 In the present case, none of the independent claims of any of the requests can reasonably be considered as clearly allowable. Firstly, the patentability of the claimed subject-matter cannot be assessed without first performing an additional search of the prior art for the newly-introduced feature. Secondly, deficiencies addressed in the Board's communication regarding lack of clarity (eg it is not clear what is meant by "a rule of sound symbolism" in the context of claim 1 and how such a rule would be related to an entry of the database table) and added subject-matter (eg there is no basis for the **phoneme compiler** being arranged to generate multiple names and to receive a selection of one of the generated names) still persist in the new requests.

Moreover, in view of the interest of the public and the EPO in a speedy conclusion of examination proceedings the



requirement to carry out an additional search and to observe the appellant's right to be heard with regard to any new prior art citations would lead to an excessive delay in the proceedings.

3.6 As a result, the Board exercised its discretion under Article 13(1) RPBA and decided not to admit the appellant's requests of 15 November 2013 into the proceedings.

3.7 It may be left open whether Article 13(3) RPBA would in fact **oblige** the Board to come to this conclusion.

When considering whether Article 13(3) RPBA would be applicable in the present case, the Board would have to decide whether the new requests raise issues which cannot reasonably be dealt with without adjournment of the oral proceedings.

In the present case, the requirement to perform an additional search and to observe the appellant's right to be heard with regard to any new prior art citations would indeed necessitate an adjournment of the oral proceedings. Under these circumstances, Article 13(3) RPBA dictates that the new requests shall not be admitted into the proceedings. However, it could also be argued that Article 13(3) RPBA does not apply in the present case since a substantive decision could hypothetically be taken on the outstanding objections without adjournment of the oral proceedings. This course of action would, however, presuppose that the requests are admitted into the proceedings, which, as decided above, is not the case. Indeed, in the circumstances of the present case, the general discretion afforded by Article 13(1) RPBA allowed the Board to conclude the case in the oral proceedings.

- 3.8 In accordance with Article 15(3) RPBA, *"The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case."*

In the present case, the appellant submitted amended claims in response to the Board's communication but did not attend the oral proceedings. In such a case, it is to be expected that the Board will consider, and decide upon, the admissibility of the amended claims. By absenting himself from the oral proceedings, the appellant gives up the opportunity to be heard in this respect (see chapter IV.E.4.2(c) of the 7th edition (2013) of "Case Law of the Boards of Appeal of the European Patent Office"). The written case of the appellant contained no comments with regard to the admissibility of the newly-filed requests.

4. As a result of the above findings, there is no request of the appellant remaining on file. Under these circumstances, the appeal has to be dismissed (see in analogy T1587/07, unpublished, point 4. of the reasons).

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairwoman:



R. Schumacher

F. Neumann

Decision electronically authenticated