

**Internal distribution code:**

- (A) [ - ] Publication in OJ  
(B) [ - ] To Chairmen and Members  
(C) [ - ] To Chairmen  
(D) [ X ] No distribution

**Datasheet for the decision  
of 30 January 2014**

**Case Number:** T 0642/10 - 3.5.06

**Application Number:** 03014516.3

**Publication Number:** 1365311

**IPC:** G06F1/32

**Language of the proceedings:** EN

**Title of invention:**

Information processing apparatus having an HF-circuit switched on and off

**Applicant:**

FUJITSU LIMITED

**Headword:**

HF-circuit switch/FUJITSU

**Relevant legal provisions:**

EPC Art. 123(2)  
EPC 1973 Art. 56

**Keyword:**

Amendments - added subject-matter (no)  
Inventive step - problem and solution approach  
Remittal to the department of first instance - (yes)

**Decisions cited:**

**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 0642/10 - 3.5.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.06**  
**of 30 January 2014**

**Appellant:** FUJITSU LIMITED  
(Applicant) 1-1, Kamikodanaka 4-chome,  
Nakahara-ku  
Kawasaki-shi,  
Kanagawa 211-8588 (JP)

**Representative:** Stebbing, Timothy Charles  
Haseltine Lake LLP  
Lincoln House, 5th Floor  
300 High Holborn  
London WC1V 7JH (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 23 November  
2009 refusing European patent application No.  
03014516.3 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** D. Rees  
**Members:** S. Krischer  
C. Heath

## Summary of Facts and Submissions

I. The appeal is directed against the decision of the examining division, posted on 23 November 2009 , to refuse the application 03014516 for lack of inventive step of claim 1 of the then sole request. The following documents were used in the reasons:

D4 WO 97 09813 A, 13 March 1997

D5 US 6 115 239 A, 5 September 2000

II. A notice of appeal was received on 8 January 2010. The fee was received on 18 January 2010. A statement of the grounds of appeal was received on 26 February 2010. Claim sets of a main and an auxiliary request were filed.

III. The appellant requests that the decision under appeal be set aside and that the application be remitted to the department of first instance for further examination on the basis of claims 1-5 of the main request filed with the grounds of appeal. Furthermore, claims 1-4 of an auxiliary request are submitted with the grounds for possible future consideration by the board in the event that the main request is not found to be allowable.  
Oral proceedings are conditionally requested if the board is minded to refuse the main request.

IV. The independent claim of the main request reads as follows:

"1. An information processing apparatus having a plurality of functions including a function of wireless communication and comprising:

a first housing (2);

a keyboard (8) mounted on the first housing (2);  
a communication circuit (58) built into the information processing apparatus for transmitting or receiving high-frequency radio wave signals in said function of wireless communication;

an electrical circuit (31) related to operation by use of the keyboard (8) and performing a function different from said wireless communication function;

turning-off means (68) to turn off the built-in communication circuit (58), whereby said communication circuit can be turned off and the other functions can be kept on, without turning off said electrical circuit (31), in a place in which the radiation of high-frequency radio waves must be minimized; and

a second housing (6) pivotally connected to the first housing (2) by hinge portions (4), said keyboard (8) being covered by said second housing (6) when said second housing (6) is closed with respect to the first housing (2); and characterised by

a slider (16) provided at the edge of the second housing (6) opposite to the hinged portions (4) for locking the second housing (6) in its closed position, wherein said turning off means (68) is a generating means (68) for generating a turning-off signal (SCL), said communication circuit being turned off in accordance with the turning-off signal (SCL), said generating means being provided on the outer surface of the second housing (6) so as to be operative outside of the information processing apparatus and located in the vicinity of said slider (16)."

In the light of the board's conclusions, the text of the auxiliary request is irrelevant.

## **Reasons for the Decision**

### 1. *Overview*

1.1 The application *relates* to a portable personal computer (e.g. a laptop, see original description page 5, lines 24, 25; figures 1-4) with an additional communication circuit (58) for providing mobile phone functionality (page 11, last paragraph). This part can be switched off separately (e.g. in an airplane or hospital where the use of a mobile phone might be forbidden, see page 12, lines 15-23). This switching-off is done by a slide switch (68 in figure 1; page 13, line 3). The latter is part of the "generating means" (also called "turning-off means" in the claims) and is placed in the vicinity of the slider (16) for locking the lid of the laptop.

1.2 The board agrees with the appellant that for the reasons given below the arguments set out in the appealed decision (sections 1-3) do not convincingly demonstrate that claim 1 lacks an inventive step.

### 2. *Original disclosure of the main request*

2.1 The examining division did not raise any objections under Article 123(2) EPC in its decision and the board concurs that there was no reason to do so with respect to the claims as then on file.

2.2 In principle, claim 1 of the current main request describes the same invention as the refused claim 1, but contains several clarifications and a reorganisation in order to change the two-part form.

2.3 The board considers that the passages indicated in the grounds of appeal (page 2) sufficiently demonstrate that claim 1 of the main request satisfies the requirements of Article 123(2) EPC.

3. *Inventiveness of claim 1 of the main request*

3.1 The board agrees with the examining division that D4 should be considered the *closest prior art*. This has not been contested in the grounds of appeal.

3.2 According to the appealed decision (page 3, paragraphs 2, 3), the refused claim 1 merely differs from D4 in a "slider provided at the edge of the second housing opposite to the hinged portions for locking the second housing in its closed position, wherein said slider is located in the vicinity of said generating means." The problem is formulated as, "fixing the top half to the bottom half in a closed position of a mobile computer." A slider provided at the top of the edge half is said to be a solution known in the art ("cf. as a mere example D5") for this problem. When applying a slider to the device of D4, one arrives at the subject-matter of claim 1 without an inventive step. At this point in the decision, the relative locations of the slider and the "generating means" is not mentioned. Only in rebuttal of an argument from the appellant that their being close to each other is not suggested is it stated that "when using the specific locking mechanism shown in D5, Fig. 2, in the PCT of D4, slide knob 244 will be located in the vicinity of external telephone power switch 13 of D4," (page 4, point 3).

3.3 According to the grounds of appeal (page 4), there are four differences between claim 1 and D4:

- (a) a *slider* at the edge of the second housing opposite to the hinged portions for locking the second housing in its closed position;
- (b) the generation of a *turning-off signal*;
- (c) the generating/turning-off means is *at the outer surface of the top half* in order to be operative outside the laptop;
- (d) the generating/turning-off means is located in the *vicinity* of the slider.

3.4 As to difference (a), the board agrees with the appellant and the decision that a slider is missing in D4.

3.5 As to difference (b), the board cannot see any indication in D4 whether switch 13 interrupts the electrical current directly, i.e. mechanically (called a "simple on/off switch" in the grounds, page 4, paragraph 10) or indirectly by a turning-off signal for - presumably - a relay or something similar. Thus, switch 13 might be implemented either as a "direct" or as an "indirect" switch. It seems likely to the board that it was general practice at the filing date of the application to provide mobile phones or PDAs with "indirect" switches sending turning-off signals as in the claim. However, since there are other reasons to remit the case to the department of the first instance, the board leaves this point to be examined and decided by the examining division.

3.6 As to difference (c), the board agrees with the grounds (page 4, last but one paragraph) that among the phone power switches of D4, only switch 13 is positioned at the outer surface of the top half. Thus it is the only switch in D4 which fulfils the locational requirement

of the claim for the generating/turning-off means. The board also agrees with the grounds (page 6, paragraph 5) that switch 13 is only intended to be used when the device of D4 is closed and the PDA is off (see D4, page 5, lines 30-33; page 7, lines 3-5): There is no disclosure in D4 that switch 13 is functional when the device is open.

However, in case the device is closed (note that one such case suffices that the device of D4 can be read on the claim), the board agrees with the decision (page 3, last paragraph) that switch 13 matches the formulation "without turning off said electrical circuit" of the refused claim 1, since the open sensor circuit (35) of D4 is not turned off when the mobile phone function is turned off by switch 13 (see figure 4).

Furthermore, the board is of the opinion that switch 13 also matches the formulation "and the other functions can be kept on, without turning off said electrical circuit" of the present claim 1, since the claim does not specify "the other functions" of the electrical circuit 31. The detecting by the open sensor (35) must be seen as one of the other functions. The formulation "the other functions" also gives rise to a minor clarity objection under Article 84 EPC, since there are no "other functions" (emphasis added) mentioned before in the claim to which "*the other functions*" (emphasis added) could refer. Only "a function different from said wireless communication function" (emphasis added) appears in the preceding part of the claim. Further, the switch 13 has the same effect on the PDA in its open position in D4 as the switch 68 does in the application. That is, it may be operated while the device is closed, and it affects the state of the device when it is opened: when it is in the OFF



position, telephone power is off when the device is opened; when it is in the ON position, telephone power is on when it is opened.

To summarise, switch 13 is regarded as a generating/turning-off means in the sense of the claim so that feature (c) does not represent a difference to the claim.

- 3.7 As to difference (d), the board agrees with the grounds and the decision (page 3, first complete paragraph) that the relative position of the generating/turning-off means in the *vicinity* of the slider (16) for opening the device constitutes a difference to the claim.

According to the decision (3., second paragraph), when applying the locking mechanism of D5 to the device of D4, the slider (244) of D5 (figure 2) "will be located in the vicinity of external telephone power switch 13 of D4, thereby arriving at the subject-matter of claim 1 without inventive efforts". Nothing more is said about the feature "vicinity".

Even if the board assumes that the two elements (switch 13 of D4 and slider 244 of D5) are indeed in vicinity after having combined D4 and D5 (which is not clearly the case from the respective figures), the decision bases this vicinity on nothing more than a *mere coincidence*, in other words an *unintentional byproduct* or *side effect of the combination*. The skilled person performing the combination of D4 and D5 in order to solve the objective technical problem "of fixing the top half to the bottom half in a closed position of a mobile computer" (decision page 3, second

complete paragraph) has no motivation to achieve at the same time the advantage that the applicant states in his second letter of reply during examination (page 2, paragraph 5), namely that the user can first turn off the mobile phone function by the generating/tuning-off means (68), and then actuate the slider with the same hand to open the device, *without needing to relocate the hand*. He merely applies the "solution known in the art", namely "a slider provided at the edge of the top half" (decision page 3, second complete paragraph) to the PDA of D4. The position of the telephone power switch (13) in D4 (see figure 1) is maybe just the traditional position of power switches of mobile phones, and it has not been placed on this position because the designer of the device of D4 planned to put a slider there and wanted to avoid to move the hand when turning off the mobile phone function. Moreover, the skilled person would, in the view of the board, interpret D5 as allowing the slider to be anywhere convenient between the hooks (see figure 3). A reasoning is missing as to why a skilled person would find it obvious to intentionally place the switch 13 of D4 in vicinity of the slider 244 of D5 when applying the locking mechanism of D5 to D4. In addition, the decision seems to be inconsistent in its opinion on the combination of documents D4 and D5. Originally, the decision states that D5 is merely an example, asserting that a slider provided at the edge of the top half "is a solution known in the art", which the board understands to mean that D5 is intended merely as an illustration of the common general knowledge. A similar statement ("the skilled person would be aware of a solution as known from the portable computer of D5,") is made in rebuttal of an argument from the appellant that it is not obvious to combine D4 and D5. Leaving

aside the fact that a single patent document is generally not considered to establish a feature as common general knowledge, if common general knowledge is being relied on here, it applies only to what has been stated, i.e. the use of a slider in general; the decision cannot go on to rely on a coincidental feature arising from the combination of D4 with the specific (i.e. not merely exemplary) document D5.

- 3.8 Thus, the appealed decision does not convincingly demonstrate a lack of inventive step of claim 1. Therefore, the board grants the appellant's request to remit the case.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The application is remitted to the department of first instance for further prosecution on the basis of claims 1-5 of the main request filed with the grounds of appeal.

The Registrar:

The Chairman:



B. Atienza Vivancos

D. Rees

Decision electronically authenticated