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**Datasheet for the decision
of 19 July 2013**

Case Number: T 1789/10 - 3.5.03

Application Number: 99108702.4

Publication Number: 954150

IPC: H04M 1/65, H04N 7/14

Language of the proceedings: EN

Title of invention:
Image communication apparatus and storage medium

Applicant:
CANON KABUSHIKI KAISHA

Headword:
Call reception vibration suppression/CANON

Relevant legal provisions:
EPC Art. 56, 123(2)

Keyword:
"Inventive step - yes (after amendment)"

Decisions cited:
-

Catchword:
-



Case Number: T 1789/10 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 19 July 2013

Appellant: CANON KABUSHIKI KAISHA
(applicant) 30-2, 3-chome, Shimomaruko
Ohta-ku
Tokyo (JP)

Representative: TBK
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Decision under appeal: Decision of the examining division of the
European Patent Office posted 6 April 2010
refusing European patent application
No. 99108702.4 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: F. van der Voort
Members: B. Noll
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European patent application no. 99108702.4 (publication no. EP 0954150 A2).

The application was refused by the examining division on the ground that the subject-matter of claims 1 and 2 of a main request lacked an inventive step (Article 56 EPC) having regard to the following documents:

D1: US 5,550,754 A

D2: EP 0 772 334 A2

II. With the statement of grounds of appeal the appellant filed new sets of claims of a main request and an auxiliary request. It was requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, in the alternative, the auxiliary request. Further, oral proceedings were requested.

III. In a communication accompanying a summons to oral proceedings the board drew the appellant's attention to issues which might be discussed at the oral proceedings, concerning, *inter alia*, added subject-matter (Article 123(2) EPC) and inventive step (Article 56 EPC). In the communication the following document was cited by the board in accordance with Article 114(1) EPC:

D5: US 5,568,190 A.

IV. With a letter dated 19 June 2013 the appellant filed, by way of replacement, amended sets of claims of a main request and three auxiliary requests.

V. Oral proceedings were held on 19 July 2013.

In the course of the oral proceedings, after having discussed the main request and the first and second auxiliary requests, the appellant filed a new set of claims 1 and 2 of a "new auxiliary request 2" as the sole request. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 and 2 as filed during the oral proceedings.

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

VI. Claim 1 of the sole request reads as follows:

"A video camera with telephone, which has a telephone and video camera in a single housing, and comprising a call reception vibrator (205) which indicates a call reception by a vibration, comprising:
control means (230) which is adapted to prohibit an operation of the call reception vibrator (205) and to display, on a display means, a display which indicates that a call is received, when a call is received in a state in which said video camera performs an image sensing operation."

Claim 2 reads as follows:

"A method of controlling a video camera with telephone, which has a telephone and video camera in a single housing, and comprising a call reception vibrator (205) which indicates a call reception by a vibration, comprising the step of:

prohibiting an operation of said call reception vibrator (205) and displaying, on a display means, a display which indicates that a call is received, when a call is received in a state in which said video camera performs an image sensing operation."

Reasons for the Decision

1. *Amendments (Article 123(2) EPC)*

1.1 Claim 1 is based on claim 4 as originally filed and paragraph [0075] of the description (reference is made to the application as published). More specifically, in paragraph [0075], a vibration generated by an alerting vibrator ("an alerting bell, vibrator, LED, or the like functions" (emphasis added by the board)) is described as one of several call reception functions and is stopped if it may disturb normal image recording. Claim 2 relates to a corresponding method.

1.2 Therefore, claims 1 and 2 comply with the requirement of Article 123(2) EPC.

2. *Inventive step (Article 56 EPC)*

2.1 The board considers it appropriate to start out from D1 as the closest prior art. D1 discloses a teleconferencing camcorder which includes a portable

video camera with a telephone in a single housing 148 (cf. column 7, lines 24 to 50, column 8, lines 10 to 15, and Figs. 8 and 9). The video camera may be alternatively operated as a standard video camera or as a video conferencing terminal (see the abstract). The video camera also includes a display means 150.

2.2 The subject-matter of claim 1 differs from the camcorder of D1 in that the claimed video camera comprises a call reception vibrator which indicates a call reception by a vibration, and control means adapted to prohibit an operation of the call reception vibrator and to display, on the display means, a display which indicates that a call is received, when a call is received in a state in which the video camera performs an image sensing operation.

2.3 Starting out from D1 and having regard to the distinguishing features identified above, the objective technical problem may be defined as extending the functionalities and improving the operation and the user convenience of the known teleconferencing camcorder.

2.4 Seeking a solution to this problem, the skilled person would consider D2, which discloses a telephone which includes a call reception vibrator for alerting a user to an incoming telephone call (cf. column 3, lines 21 to 27). D2 further teaches to provide the telephone with a muting option whereby the call reception vibration is muted in response to a user input (column 4, lines 8 to 22, column 6, lines 37 to 50, and column 8, lines 7 to 15). However, the skilled person would not be led by D2 to provide a control means

adapted to prohibit an operation of the call reception vibrator when a call is received in a state in which a video camera performs an image sensing operation.

The board further considered document D5, which is in the field of video image recording in the presence of mechanical vibration. In order to avoid video sequence recording from being degraded by vibration, D5 discloses that the image recording is interrupted during a time period in which vibration is detected and that, instead, a still image, which was previously recorded, is output. However, D5 would not lead the skilled person to provide the above-mentioned control means.

2.5 Hence, starting out from D1 and having regard to D2 and D5, the skilled person would not have arrived at the claimed video camera and telephone, in which the operation of a call alerting vibrator is prohibited when a call is received in a state in which the video camera performs an image sensing operation. The same conclusion is arrived at when starting out from D2 and taking into account the teachings D1 and D5, none of these documents relating to problems concerning a function of a portable telephone, i.e. the operation of a call indication vibrator, and its negative impact on another function, i.e. the recording of video images.

2.6 In the impugned decision the following reasons were given as to why the subject-matter claimed lacked an inventive step (cf. Reasons for the decision, points 3.1 and 3.2):

"... Since the apparatus according to D1 is also intended for use as a standalone video camera (column 1, lines 6-11), it is to be expected that notification of an incoming call will corrupt the soundtrack of an ongoing video recording. In case corresponding controls are provided (column 7, lines 37 and 38), the user may choose to manually switch off the speaker or microphone and thus avoid spoiling the video soundtrack (albeit at the cost of losing some functionality).

One aspect of the solution according to claim 1 provides automatic suppression of any call notification that has the possibility to "disturb an image sensing operation". The mere automation of such a process is considered in line with the general trend in technology and thus cannot be considered inventive.

... The other aspect of the solution provided involves use of a vibrator as incoming call indicator. It is considered common general knowledge to use such indication means, particularly in portable devices. Since operation of such a vibrator while recording an image will obviously negatively affect image quality, it is also considered obvious to suppress its operation, as set out in the previous paragraph. Therefore, this aspect is also not considered inventive."

In the board's view, these reasons are based on hindsight, since none of the documents considered by the examining division relates to the effect an

alerting vibrator in a telephone may have on image recording by means of a built-in camera.

2.7 The reasons given above in respect of claim 1 apply, *mutatis mutandis*, to the method of claim 2.

2.8 For the above reasons the subject-matter of claims 1 and 2 involves an inventive step (Article 56 EPC).

3. *Procedural matters*

In view of the above, the decision under appeal is to be set aside. However, in order for the application to meet the requirements of the EPC, the description is yet to be adapted to the present claims.

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 with the order to grant a patent on the basis of claims 1 and 2 of the sole request remaining on file, i.e. the request filed during the oral proceedings and labelled new auxiliary request 2, and a description to be adapted.

The Registrar:

The Chairman:

I. Aperribay

F. van der Voort