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**Datasheet for the decision
of 19 July 2016**

Case Number: T 1355/11 - 3.5.04

Application Number: 00401314.0

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Language of the proceedings: EN

Title of invention:
Portable videophone unit

Applicant:
Kyocera Corporation

Headword:

Relevant legal provisions:
EPC 1973 Art. 56

Keyword:
Inventive step - (no)

Decisions cited:

Catchword:



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Case Number: T 1355/11 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 19 July 2016

Appellant:
(Applicant)

Kyocera corporation
6, Takeda Tobadono-cho,
Fushimi-ku
Kyoto-shi,
Kyoto (JP)

Representative:

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 18 January 2011
refusing European patent application
No. 00401314.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. Müller
Members: R. Gerdes
M. Paci

Summary of Facts and Submissions

- I. The appeal is directed against the decision to refuse European patent application No. 00 401 314.0, published as EP 1 054 563 A1.

- II. The patent application was refused by the examining division on the grounds that the subject-matter of claim 1 of the sole request then on file did not involve an inventive step in view of the following document:

D5: GB 2 273 630 A.

- III. The applicant appealed against this decision and submitted claims of a main request and first to eighth auxiliary requests together with the statement of grounds of appeal. The claims of the main request corresponded to those of the sole request underlying the decision under appeal.

- IV. The board issued a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal of the EPO, OJ EPO 2007, 536) annexed to a summons to oral proceedings and indicated inter alia that it tended to share the opinion set out in the decision under appeal with respect to the main request. The objections made in relation to the claimed subject-matter of the main request applied *mutatis mutandis* to the claims of the auxiliary requests.

- V. With a letter of reply dated 17 June 2016, the appellant submitted new claim sets according to a main request and first to fifth auxiliary requests and provided arguments in support of inventive step.

VI. Oral proceedings were held before the board on 19 July 2016. As announced beforehand, the appellant was not represented at them.

The chairman noted that the appellant requested that the decision under appeal be set aside and that a patent be granted

- on the basis of the claims of the main request filed with a letter of 17 June 2016, together with the description pages and drawing sheets as presently pending / originally filed, or
- on the basis of the claims of the first to fifth auxiliary requests, all filed with the letter of 17 June 2016, together with the description pages and drawing sheets as presently pending.

VII. Claim 1 of the main request reads as follows:

"A portable videophone unit (20) comprising:

an image display section (21) configured to display images; and

an image data transmitting-receiving section (15) configured to perform two-way communications by transmitting image data and sound data to an opposite party's unit and by receiving image data and sound data from the opposite party's unit,

the portable videophone unit being characterized by further comprising:

a control section (1) configured to automatically activate an automatic response mode of the portable

videophone unit when an incoming call is received from the opposite party's unit, if calling data of the incoming call contains a personal identification number, and the opposite party's unit is successfully authenticated by the personal identification number, the automatic response mode comprising setting the portable videophone unit to an off-hook status and enabling a two-way communication between the portable videophone unit and the opposite party's unit."

VIII. Claim 1 of the fourth auxiliary request is identical to claim 1 of the main request, whereas claim 1 of each of the first to third auxiliary requests and of the fifth auxiliary request differs from claim 1 of the main request in that the second feature specifying "an image data transmitting-receiving section (15)" has been amended to read "a data transmitting-receiving section (15)".

IX. In the decision under appeal the examining division considered D5 to be the closest prior art for the subject-matter claimed. The examining division acknowledged that D5 related to different aspects of the invention and that the transmission of video data was presented in D5 separately from the other features of the invention. The subject-matter of claim 1 differed from the "first aspect" of D5 in that it provided video communication. The examining division formulated the technical problem as how to enlarge the scope of application of the portable telephone of D5. It argued further that the skilled person would have readily proposed integrating the video communication with audio communication, since a reference to video communication was to be found in the "fourth aspect" of D5 (see points 15 to 20 of the decision under appeal).

X. The appellant's arguments relevant for the present decision may be summarised as follows:

D5 disclosed seven different aspects and, in addition, three different embodiments of the invention, which all had to be considered as individual disclosures. The first embodiment D5-8, illustrated by figures 1 and 2 and described between page 8, line 16 and page 11, line 14, represented the closest prior art.

D5-8 did not disclose "two-way communication" in the sense of the invention. The called telephone in D5-8 did not need to receive sound data from a calling telephone.

The differences between the portable unit according to claim 1 and D5-8 could be summarised as follows:

a) the portable unit was a videophone unit comprising an image display section which displayed images,

b) the two-way communications established by the data transmitting-receiving section comprised transmitting and receiving image data,

c) the control section was arranged for activating an automatic response mode and for automatically responding to an incoming call from the opposite party's unit if said automatic response mode was activated and the opposite party's unit was authenticated by a personal identification number input by the opposite party's unit.

These distinguishing features made it possible to provide a communication comprising image data and allowed the user to decide whether or not to activate

the automatic response mode using the control section. Therefore, the technical problem was to provide a portable unit that allowed to automatically establish a smooth two-way communication comprising transmitting and receiving image data while preserving the privacy of the user.

By allowing "spying" on the user, D5-8 addressed a technical problem which was the opposite of that underlying the invention. Hence, starting from D5 the skilled person would not have arrived at the invention (see statement of grounds, section 4).

With reference to D5, page 11, line 34 to page 12, line 6 the appellant also argued that according to D5 the receiver automatically entered off-hook status without ringing and maintained that status irrespective of whether or not the input command code was correct. Hence, the receiver lacked the function of authenticating whether or not the caller was a particular person allowed to remotely control the receiver to enter off-hook status. In contrast, the claimed receiver did not enter off-hook status as long as the caller was not successfully authenticated (see letter dated 17 June 2016, pages 4 and 5).

Reasons for the Decision

1. The appeal is admissible.

Main request

2. The disclosure of D5 is structured to contain seven aspects of the invention and three embodiments. The appellant argued that all of these aspects and

embodiments constituted individual disclosures. The appellant considered D5-8, i.e. the first embodiment of D5, as the closest prior art. This embodiment is illustrated by figures 1 and 2 and described between page 8, line 16 and page 11, line 14 of D5.

- 2.1 The board cannot agree with this argument. In particular, the "aspects", which each correspond to claims of D5, cannot be detached from the embodiments which these claims are intended to cover.

However, even if the appellant's analysis were followed in that respect, it would not change the outcome of this case. Thus, the board sees no need to decide which aspects and embodiments of D5 can be considered to relate to each other so as to form a set of coherent disclosures. The board therefore restricts its comparison of the claimed subject-matter with D5 to the first embodiment of D5, i.e. D5-8.

- 2.2 D5-8 discloses a portable telephone for two-way audio communication (see page 8, lines 17 to 30 and page 9, line 30 to page 10, line 2). The portable telephone is configured to automatically activate an automatic response mode when an incoming call is received from the opposite party's unit, if the calling data of the incoming call contains a command code and if this command code is successfully identified by a control unit of the portable phone. The automatic response mode comprises setting the portable telephone to an off-hook status and enables two-way communication between the portable videophone unit and the opposite party's unit (see figure 2: steps 19, 21, 22 and page 9, line 13 to page 10, line 2).

2.3 The appellant argued that the following features of claim 1 were not disclosed in D5-8:

(a) the portable unit was a videophone unit comprising an image display section which displays images,

(b) the two-way communication established by the data transmitting-receiving section comprised transmitting and receiving image data,

(c) the control section was arranged for activating an automatic response mode and for automatically responding to an incoming call from the opposite party's unit if said automatic response mode was activated and the opposite party's unit was authenticated by a personal identification number input by the opposite party's unit.

2.4 The board agrees that the aspects of features (a) and (b) relating to video/image communication are not disclosed in D5-8, which refers only to audio communication. However, the two-way communication of feature (b) is unambiguously disclosed in D5-8 (see page 9, line 30 to page 10, line 2).

The appellant argued in the statement of grounds (see page 6/10, section 4.2) that feature (c) allows "the user [at the portable videophone unit] to decide to activate or not the automatic response mode using the control section." The board is not convinced that the claim wording is limited to that interpretation. Alternatively, it could be understood that the automatic mode might be enabled remotely, as is disclosed in D5 (see page 9, lines 13 to 29), for example "when an incoming call is received from the opposite party's unit."

In addition, the board notes that according to D5-8 activation of an automatic response mode is carried out using a command code provided as calling data in an incoming call and identification of that code. In contrast, according to claim 1 an authentication is effected using a personal identification number. This is only a difference in terminology and not a technical difference. A distinction could possibly be made in a system where personal identification numbers might be associated with different users or different command codes might trigger different actions of the portable phone. However, no such distinction and associated technical consequences are apparent in the context of claim 1.

- 2.5 The appellant also argued with reference to D5, page 11, line 34 to page 12, line 6 that according to D5 the receiver automatically entered off-hook status without ringing and maintained that status irrespective of whether or not the input command code was correct.

The board notes that the cited passage is not part of the first embodiment, i.e. of D5-8. According to the first embodiment, ringing is suppressed only if the required command code has been transmitted (see figure 2: 19, 21, 22 and page 9, lines 1 to 5 and lines 17 to 28).

- 2.6 Hence, the board holds that the decision under appeal correctly identified the difference between D5-8 and the claimed subject-matter as being that the present invention provides video communication (see decision under appeal, point 18). This difference entails as a consequence that an image display section is provided and that image data are communicated.

- 2.7 Based on the distinguishing features asserted (see point 2.3 above), the appellant argued that the technical problem was to provide a portable unit that made it possible to automatically establish a smooth two-way communication comprising transmitting and receiving image data while preserving the privacy of the user.
- 2.8 The board, having accepted the more narrowly circumscribed difference found by the examining division (see point 2.6 above), cannot agree to the technical problem proposed by the appellant. In particular, compared to D5-8 there is no improvement in the preservation of the privacy of the user, for the reasons set out above (see point 2.5).
- 2.9 The board adopts the technical problem as formulated in the decision under appeal, which was how to enlarge the scope of application of the portable telephone of D5. The board also agrees with the assessment in the decision under appeal that the skilled person would have readily proposed integrating audio communication with video communication, since a reference to video communication was disclosed in the "fourth aspect" of D5 (see point 20 of the decision under appeal).
- 2.10 As a result, the subject-matter of claim 1 was obvious to a person skilled in the art in view of D5-8 and thus lacks inventive step (Article 56 EPC 1973).

First to fifth auxiliary requests

3. Claim 1 of the fourth auxiliary request is identical to claim 1 of the main request, whereas claim 1 of each of the first to third auxiliary requests and of the fifth

auxiliary request differs from claim 1 of the main request in that the second feature specifying "an image data transmitting-receiving section (15)" has been amended to read "a data transmitting-receiving section (15)".

This difference does not change the claimed subject-matter, because according to claim 1 of all of the modified claim requests the "data transmitting-receiving section" is specified to be "configured to perform two-way communications by transmitting image data and sound data to an opposite party's unit and by receiving image data and sound data from the opposite party's unit".

Hence, the reasoning in section 2 above also applies to each of the auxiliary requests.

As a consequence, the subject-matter of claim 1 according to each of the auxiliary requests does not involve an inventive step (Article 56 EPC 1973).

Conclusion

4. It follows from the above that none of the appellant's requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

B. Müller

Decision electronically authenticated