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Datasheet for the decision of 27 July 2012

Case Number: T 1898/11 - 3.5.01

Application Number: 05270042.4

Publication Number: 1630705

IPC: G06F17/30, G10L15/14, G10L15/18

Language of the proceedings: EN

Title of invention:
System and method of lattice-based search for spoken utterance retrieval

Applicant:
AT&T Corp.

Headword:
Utterance retrieval/AT&T

Relevant legal provisions:
EPC Art. 113(1)
EPC R. 137(4) (2007) sentence 1

Keyword:
"Right to be heard (infringed)"
"Substantial procedural violation (yes)"

Decisions cited:
R 0019/10, R 0017/11, T 0708/00, T 0763/04

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T1898/11 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 27 July 2012

Appellant: (Applicant)
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 18 April 2011 refusing European patent application No. 05270042.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: S. Wibergh
Members: P. Scriven
A. Pignatelli

Summary of Facts and Submissions

I. The appeal is against the Examining Division's decision, posted on 18 April 2011, refusing European patent application 05270042.4 (filed on 22 August 2005) on the grounds that it did not contain claims according to Articles 78(1) and 113(2) EPC. The lack of claims was a result of the Examining Division's decision not to admit claims 1 - 23, which the applicant had filed with the letter dated 15 August 2007, on the basis that they failed to comply with Rule 137(5) EPC, first sentence.

II. In its original form, the application had six independent claims (claims 1, 20, and 23 - 26). In the European search report, drawn up on 23 August 2006, the Search Division considered that claims 20 - 24 lacked unity with the others, but did not invite the payment of an additional search fee, because all claims could be searched without extra effort. In the accompanying European search opinion, there was an objection to a lack of novelty in the subject-matter of claims 1, 20, and 23 - 26.

III. The Examining Division's first communication, posted on 18 April 2007, was a formal one, indicating the objections raised in the European search opinion. The applicant responded by letter dated 15 August 2007, cancelling claims 20 - 24 and amending claims 1, 25 and 26. After the amendments, the independent claims were 1, 20 and 21.

Claims 1 and 20, as originally filed, read as follows.

> *1. A method of retrieving a spoken document, the method comprising:*
> *converting speech associated with a spoken document*

into a lattice representation;
indexing the lattice representation of speech;
upon receiving a query from a user:

searching the indexed lattice representation of speech; and

returning audio segments from the spoken document that match the user query.

20. A method of retrieving a spoken document wherein a word index and a sub- word index related to the spoken document exits, the method comprising, upon receiving a query from a user:

searching the word index based on the user query;

searching the sub-word index based on the user query; and

combining the results to retrieve the audio segments from the spoken document that match the user query.

Claim 1 as amended read as follows.

1. A method of retrieving a spoken document, the method comprising:
converting speech associated with a spoken document into a lattice representation; indexing the lattice representation of speech; and
upon receiving a query from a user, wherein the query comprises a combination of speech and text:

processing the speech and text query to enable data associated with the speech and text query to be used to search the indexed lattice representation of speech and return audio segments from the spoken document that match the user query.

IV. The Examining Division sent a communication, posted on 25 May 2010, in which they objected that the amended claims related to subject matter which was unsearched and which lacked unity with the original claims. Their reasoning read as follows.

The originally claimed subject-matter was defining the lattice representation of speech for the indexation of spoken documents, whereas the introduced feature "wherein the query comprises a combination of speech and text" is about the building of a query.

Although complementary, this is not interdependent with the lattice representation and can be separately implemented without any modification.

V. The applicant responded to that objection with the following arguments.

(a) Defining the subject-matter of original claim 1 as "the lattice representation of speech for the indexing of spoken documents" neglected several features defined in the claim.
(b) The "originally claimed invention" included the subject-matters of original claims 20, 23, 24 and 25, as well as of original claim 1.
(c) There were two differences between the original and the amended versions of claim 1, and they were such

that the subject matter of the amended claim was wholly contained in that of the original. The Guidelines, at C-VI, 5.2 (ii) stated that an objection under Rule 137(5) EPC should not be raised when a feature was added to a claim in order to meet an objection such as lack of novelty or inventive step.

(d) The added features related to the same technical problem as that addressed by original claim 1. As set out at [0003] of the description, the problem was that of providing good retrieval using spoken documents even though *the benefits of clear speech are unavailable*. A query with both speech and text was less likely to result in errors than a query without text.

(e) The subject matter of amended claim 1 was wholly within that of original claim 1, and so, if it had been filed together with the original claims, the applicant would not have been invited to pay an additional search fee for it. Reasoning as in T 708/00 "Trame de transmission/ALCATEL", OJ EPO 2004,160, an objection under Rule 137(5) EPC should not have been made. As that decision stated, it was generally permissible to add features to a claim.

VI. The Examining Division subsequently sent a summons to attend oral proceedings, posted on 20 December 2010. They maintained their objection in the following terms (A1, A2 are the Examining Division's names for the applicant's two replies; C2 is their name for their second communication).

> *The examining division maintains the objection raised in C2 2. (Rule 137(5), GL C-VI 5.2 (ii) second paragraph) and 4. (Art. 78(1) EPC). Allowing multimodal input for queries is a separate invention*

non unitary with the original invention of retrieving spoken documents from a query: there is no synergical effect, each invention can be separately implemented without any modification.

Contrary to what is stated in A1 and A2, the application only refers to a low quality of the audio within the documents to be retrieved, not for inputting a query. The inventions therefore solve different problems.

VII. The applicant responded to the summons with a further letter, which repeated the arguments set out above at V, and submitted the following additional argument.

(f) The allegation that amended claim 1 was unsearched was unsubstantiated. The search should have covered the different forms of queries set out in the description. If it did not, then it did not comply with Article 92 EPC.

VIII. Oral proceedings took place before the Examining Division. As the applicant had indicated in advance, it was not represented. The Examining Division announced the disputed decision, and the reasons were given subsequently in writing. Their reasons for not admitting the applicant's amended claims were given as follows (emphasis added by the Board).

*The originally claimed subject-matter concerned **lattice representation** of speech for the indexation of spoken documents, whereas the introduced feature is about the building of a query **from multimodal inputs**.*

Although complementary, this is not interdependent with the lattice representation and can be separately

implemented without any modification. ***There is no synergical effect between the two inventions.***

IX. The refusal also stated that even if the claims had been admitted, they would not have been allowable under Articles 52(1) and 56, 83, and 84 EPC.

X. In its statement setting out the grounds of appeal, the appellant argued that the Examining Division's finding regarding Rule 137(5) EPC was incorrect, for the reasons already set out in its letters to the Examining Division (see above at V and VII). Also included (at 3.8) is an argument against the Examining Division's assertion that the amendment concerned a different problem from that addressed by the subject-matter of original claim 1 (see above at VI), and arguments against the objections under Articles 52(1) and 56, 83, and 84 EPC.

The appellant also argued (at 7), by reference to T 763/04 (not published in the OJ EPO), that the Examining Division had committed a substantial procedural violation by not taking account of the arguments submitted to them.

Reasons for the Decision

1. The appellant's requests

The appellant, beyond stating that the *claims currently on file are maintained*, has not been explicit about its substantive requests. The Board understands the statement setting out the grounds of appeal as requesting that the Examining Division's decision be set aside, that a patent be granted on the basis of the claims filed with the letter dated 15 August 2007, and

that oral proceedings be held if a decision adverse to the appellant is contemplated.

2. *The relevant law*

2.1 Rule 137 EPC was amended by the Decision of the Administrative Council of 25 March 2009. According to Article 2 of that Decision, the amended Rule applies to European patent applications for which the European search report or the supplementary European search report was drawn up on or after 1 April 2010. In the present case, the search report was drawn up on 23 August 2006, and, therefore, the amended Rule does not apply.

2.2 The correct provision is, therefore, not Rule 137(5), first sentence, of the amended provision, but Rule 137(4) EPC pre April 2010. The provisions are the same, and the Board does not consider that either the appellant or the Examining Division was confused as to what the substantive questions were.

3. *The alleged procedural violation*

3.1 According to Article 113(1) EPC, a decision by the EPO can *only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments*.

3.2 It is the consistent case law of the Boards of Appeal, that the "grounds and evidence" under Article 113(1) EPC are to be understood as meaning the essential legal and factual reasoning on which the EPO has based its decision (*Case Law of the Boards of Appeal of the European Patent Office*, 6th Edition, VI.B.1.1). It is a contravention of Article 113(1) EPC if legal or factual

reasoning which, according to a party, is clearly central to its case and could present a challenge to the decision in question were completely disregarded in that decision (see for example T 764/04, not cited in OJ EPO).

3.3 In R 19/10 (not published in the OJ EPO), at point 6.2 of the reasons, the Enlarged Board of Appeal agreed "in principle" with the petitioner in that case that Article 113(1) EPC guaranteed a party's *right to have the relevant grounds fully taken into account in the written decision*, but added that *this principle is not without any limitation ... provided that the reasons given enable the* parties *concerned to understand whether the decision was justified or not, the deciding organ is under no obligation to address each and every argument presented by the party concerned.* In R 17/11 (not published in the OJ EPO) essentially the same statement is made at point 4 of the reasons.

3.4 In the view of the Board, a "relevant ground" in this context is an argument by a party which raises reasonable doubts as to the legal or factual basis underlying the reasons for the decision. Such an argument must be dealt with, if the parties are to understand the justification of the decision.

3.5 In the present case, the Examining Division raised an objection under Rule 137(4) EPC pre April 2010, and the appellant made a number of arguments, as set out above at V and VII. The question is what, if any, reasonable doubts these arguments created as to the legal or factual basis underlying the objection, and whether any such doubt which did arise was dealt with.

3.6 The Board finds that at least the following reasonable doubts arose, but were not dealt with.

3.6.1 V(a) (see above) asserts that the Examining Division's formulation of the technical problem (for original claim 1) failed to take account of all the claimed features. That is an attack on the factual basis of the objection. Since the claim defined not only a lattice representation, but also features directed to making the representation searchable, the applicant's argument did create a reasonable doubt as to whether the technical problem was properly formulated. In its written decision, the Examining Division simply repeated the statement that the *originally claimed subject-matter concerned lattice representation of speech for the indexation of spoken documents.* The Board can see no explanation of how the claim features contribute to the formulation of the problem, and concludes that the decision did not deal with this relevant argument.

3.6.2 According to V(c), the subject matter of the amended claim is wholly contained in that of the original claim, and the Guidelines state that an objection under Rule 137(5) EPC should not be raised when a feature is added to a claim in order to meet an objection such as lack of novelty or inventive step. It is evident that the applicant was referring to the 2010 version of the Guidelines (see point 2 above), but the 2007 version makes the same statement at C-III, 5.2 (ii) with reference to Rule 137(4) EPC pre April 2010.

The argument attacks the legal basis of the objection: if the Guidelines apply in the way asserted, then Rule 137(4) EPC pre April 2010 cannot debar the amendment. Unless that doubt is addressed, the

applicability of the Rule is doubtful. The written decision explains neither why the objection would not go against the Guidelines, nor why it would be justified in this case to go against them. The Board finds this objection relevant, and that it was not dealt with.

3.6.3 V (e) is similar to V (c), except that it refers to T 708/00 rather than to the Guidelines. The Board's conclusions are the same.

3.7 In conclusion, the Examining Division did not deal with relevant arguments, something which amounts to a substantial procedural violation. The decision under appeal should therefore be set aside and the appeal fee be reimbursed.

4. *Rule 137(4) EPC pre April 2010*

4.1 The Board has considered whether to examine the amendments to claim 1 with respect to Rule 137(4) EPC pre April 2010 on its own motion pursuant to Article 111(1) EPC. It will not do so, for the following reasons.

4.2 The appellant has identified two differences between the original and amended versions of claim 1. They are:

1) The original claim defined what happened when a query was received, without specifying the format of the query; in the amended claim, the received query must comprise a combination of speech and text;

2) the amended claim defines the additional step of processing the query to enable its use in search.

The Examining Division seems to identify the same two differences, at point II.2 of the written decision.

4.3 However, the Board notes that not only have the two changes referred to been made, but, in addition, some steps of the original claim have apparently been omitted. There is, in amended claim 1, a "processing" step which enables the query to be used for searching the lattice representation, but there is no actual step of searching the representation. Nor is there a step of returning results. Such steps were explicitly set out in original claim 1.

4.4 The question whether or not the subject-matter of the amended claims forms a single general inventive concept with that of the original claims cannot be decided without any consideration of these additional modifications. This is a different factual situation that should be examined by the Examining Division rather than the Board.

4.5 The Board would, nevertheless, like to add that, in its opinion, the sole addition of the feature "wherein the query comprises a combination of speech and text" would represent a mere restriction of claim 1 which, following the principles set out in decision T 708/00, should not be refused under Rule 137(4) EPC pre April 2010.

5. Since the Board's decision is not adverse to the appellant oral proceedings need not be held.

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.

3. The appeal fee is to be reimbursed.

The Registrar: The Chairman:

T. Buschek S. Wibergh

Decision electronically authenticated