

**Internal distribution code:**

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

**Datasheet for the decision  
of 5 April 2019**

**Case Number:** T 0056/13 - 3.4.01  
**Application Number:** 03798532.2  
**Publication Number:** 1548635  
**IPC:** G06K17/00, G06K19/00,  
G06K19/06, G06F3/03, G06F3/033,  
A63H3/33, A63H5/00  
**Language of the proceedings:** EN

**Title of invention:**

INFORMATION REPRODUCTION/I/O METHOD USING DOT PATTERN AND  
INFORMATION REPRODUCTION DEVICE

**Patent Proprietor:**

Yoshida, Kenji

**Opponent:**

Vossius & Partner  
Patentanwälte Rechtsanwälte mbB

**Headword:**

Information Reproduction I/O Method / Yoshida

**Relevant legal provisions:**

EPC Art. 100(a), 100(b), 100(c), 123(2), 83, 84, 56, 111(1)

**Keyword:**

Inventive step - main request (no)

Remittal to the department of first instance - (yes)

**Decisions cited:**

G 0010/91, G 0003/14, T 1151/11

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0056/13 - 3.4.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.01**  
**of 5 April 2019**

**Appellant:** Vossius & Partner  
(Opponent) Patentanwälte Rechtsanwälte mbB  
Siebertstrasse 4  
81675 München (DE)

**Representative:** Vossius & Partner  
Patentanwälte Rechtsanwälte mbB  
Siebertstrasse 3  
81675 München (DE)

**Respondent:** Yoshida, Kenji  
(Patent Proprietor) 26-21-1301, Koishikawa 3-chome,  
Bunkyo-ku  
Tokyo 112-0002 (JP)

**Representative:** Klunker IP  
Patentanwälte PartG mbB  
Destouchesstraße 68  
80796 München (DE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
19 October 2012 concerning maintenance of the  
European Patent No. 1548635 in amended form.**

**Composition of the Board:**

**Chairman** P. Fontenay  
**Members:** T. Zinke  
J. Geschwind

## Summary of Facts and Submissions

- I. An opposition was filed against European patent No. 1 548 635 as a whole.
- II. The opposition was based on the grounds for opposition of Article 100(a) EPC for lack of novelty and lack of inventive step, of Article 100(b) EPC and of Article 100(c) EPC.
- III. In an interlocutory decision, the Opposition Division maintained the patent in amended form based on a second auxiliary request filed by the patentee during oral proceedings.
- IV. The appellant (opponent) filed an appeal against the Opposition Division's decision.

With the notice of appeal, the appellant requested that the decision be set aside and the patent be revoked in full.

With the statement setting out the grounds of appeal, the appellant provided arguments with regard to inadmissible extension of the subject-matter of the patent (Article 100(c) EPC), lack of clarity and support (Article 84 EPC), insufficiency of disclosure (Article 100(b) EPC) and lack of inventive step (Article 100(a) EPC). In order to support common general knowledge, the appellant filed a further document (Exhibit 1: Bass M., et al., Handbook of Optics, Volume 1, Second Edition, McGraw-Hill, Inc. 1995).

- V. In the reply dated 2 July 2013 (in the following "*the reply*"), the respondent (patent proprietor) requested,

as a main request, that the appeal be dismissed and that the patent be upheld in the form allowed at the end of the oral proceedings before the Opposition Division.

In case the Board came to the conclusion that the terms "*various kinds of) multimedia information*" in claim 1 of the main request violated Article 123(2) EPC, the respondent requested to restrict claim 1 of the main request - and claim 1 of the auxiliary requests - by replacing the term "*various kinds of) multimedia information*" by the term "*voice information*".

The respondent further requested not to admit the document newly filed by the appellant (Exhibit 1) into the proceedings.

By way of expedience, the respondent further requested to "*uphold the patent*" in amended form according to one of the auxiliary requests 1 to 7 filed with the reply. These auxiliary requests correspond to the auxiliary requests of the oral proceedings before the Opposition Division.

In case the Board was minded to admit an allegedly fresh ground for opposition based on Article 100(b) EPC (cf. item IV of the grounds of appeal), remittal of the case to the first instance was requested.

With its reply, the respondent provided counter-arguments with regard to the issue of inadmissible generalisation (Article 100(c) EPC), lack of clarity and support (Article 84 EPC), insufficiency of disclosure (Article 100(b) EPC) and lack of inventive step (Article 100(a) EPC).

With regard to the auxiliary requests 1 to 7, filed with the reply, the respondent only stated (page 23): *"In order to avoid unnecessary repetition as regards the support for the claims of the auxiliary requests as well as the inventive step involved with regard to the cited prior art, we refer to our respective submission of August 20, 2012, items 1.4 to 1.10 and IV, respectively."*

- VI. Both parties requested oral proceedings.
- VII. Summons to attend oral proceedings on 5 April 2019 were issued on 3 January 2019 together with a Board's communication under Article 15(1) RPBA expressing the Board's provisional opinion. According to this provisional opinion the Board expressed its intention to set aside the decision under appeal and to remit the case to the Opposition Division for dealing with auxiliary requests 1 to 7 which had not been addressed in the course of the opposition proceedings.
- VIII. With letter of 4 March 2019, the respondent informed the Board that it would not attend the oral proceedings and requested a decision according to the state of the file.
- IX. The Board issued a further communication pursuant to Article 15(1) RPBA, indicating that it intended to decide according to its preliminary position as expressed in its communication sent out together with the summons. The appellant was invited to clarify, whether the auxiliary request for holding oral proceedings was upheld under the circumstances.

- X. With letter of 18 March 2019, the respondent confirmed that it would not attend the oral proceedings and that the corresponding request was withdrawn.
- XI. With letter of 27 March 2019, the appellant withdrew its request for oral proceedings. Further, the appellant requested not to remit the case back to the Opposition Division for further consideration of auxiliary request 1 to 7. The appellant argued that these requests did not become part of the respondent's case, since no substantiation was filed during appeal proceedings. Further, the case should not be remitted due to the long duration of the opposition proceedings.
- XII. The Board cancelled the oral proceedings.
- XIII. The respondent's main request is identical to the request considered allowable by the Opposition Division. Claim 1 reads:

*"1. An information reproducing method using a dot pattern, comprising the steps of:  
displaying instruction information on display means (613) on which a touch panel (612) is arranged;  
cutting off infrared light by arranging an infrared cutoff filter between the touch panel (612) and a screen of the display means;  
scanning image data of a dot pattern portion (607) formed on a transparent film (611) of the touch panel (612), the dot pattern portion (607) being formed by arranging in accordance with a given rule dots generated by a dot code generating algorithm, in order to recognize various kinds of multimedia information, the scanning being performed with scanning means (602) following the instructions displayed on the display means (613);*

*converting the image data of the dot pattern portion (607) into code data;  
reading multimedia information corresponding to the code data out of storing means; and  
reproducing the multimedia information."*

Independent claim 2 is a correspondingly formulated claim for an information reproducing device. It reads:

*"2. An information reproducing device using a dot pattern comprising:  
a touch panel (612) including a transparent film (611) on which is formed a dot pattern portion (607) that is formed by arranging in accordance with a given rule dots generated by a dot code generating algorithm, in order to recognize various kinds of multimedia information;  
the touch panel (612) being arranged on display means (613) of an electronic device (608);  
an infrared cutoff filter arranged between the touch panel (612) and a screen of the display means (613);  
scanning means (602) for scanning image data of the dot pattern portion (607) of the touch panel (612) following instruction information displayed on the display means (613); and  
an electronic device (608) for digitalizing the image data into numeric values and reading multimedia information corresponding to the dot pattern portion based on the numeric values out of storing means and reproducing the multimedia information."*

Claims 3 to 5 are dependent claims.

## **Reasons for the Decision**



1. Respondent's main request

1.1 Interpretation of *"cutting off infrared light by arranging an infrared cutoff filter between the touch panel (612) and a screen of the display means"* (claim 1) and *"an infrared cutoff filter arranged between the touch panel (612) and a screen of the display means"* (claim 2).

1.1.1 A major point of dispute between the appellant and the respondent is based on a different interpretation of the features relating to the infrared cutoff filter of claims 1 and 2.

The Board interprets this feature in accordance with paragraph [0082] of the B1-publication, i.e. that the infrared cutoff filter corresponds to the infrared cutoff film mentioned in this paragraph, whose function is described as *"thereby to cut off infrared light emitted from the monitor screen"*. This means that the filter is characterized by blocking transmission of infrared light from the monitor screen. How infrared light emitted from the inside of the scanning means (camera) is affected by this infrared cutoff filter, however, is not disclosed. Hence, it might be absorbed by the infrared cutoff filter or reflected by it, both possibilities resulting in cutting off infrared light emitted from the monitor screen.

1.2 Amendments (Articles 123(2), 100(c) EPC)

The appellant argued that there was no direct and unambiguous disclosure of the term *"various kinds of multimedia information"*, but only *"various voices or the like"* in relation to the embodiment of the touch panel in Figures 12 and 13, which seems to be the basis

for the subject-matter as claimed in the independent claims of the respondent's main request.

It is undisputed that there is no literal disclosure of the wording "*various multimedia information*" when describing Figures 12 and 13 (cf. [0082] of the A1-publication), but only of "*various voices or the like*".

The Board concurs with the position of the Opposition Division (cf. reasons, sections 13.1 to 13.11) that originally filed claims 6 and 7, however, provide a basis for an information reproducing device comprising a display, a touch panel, a dot pattern and an infrared cutoff filter that is used for reading more generic "*multimedia information*". Hence, a skilled person found a direct and unambiguous disclosure for using the claimed information reproducing device not only for voice or audio information, but also for more generic "*multimedia information*".

1.3 Insufficient disclosure (Articles 83, 100(b) EPC)

1.3.1 Since claim 1 of the respondent's main request was amended with a feature that was not recited in any of the dependent claims in the granted patent, objections under Article 83 EPC against this amended claim have to be considered.

With regard to the objection under Article 83 EPC against independent claim 2 of the respondent's main request, this objection does not amount to a "*fresh ground for opposition*" in the sense as discussed in decision G 10/91, which would need the patent proprietor's consent to be dealt with in appeal proceedings. The ground for opposition based on Article

100(b) EPC was introduced into the opposition proceedings with the notice of opposition and was sufficiently substantiated. Hence, the possibly new attack under Article 83 EPC is actually not a new ground of opposition but is only providing new facts, evidences or arguments with respect to a ground of opposition that was already raised with the opposition.

- 1.3.2 A first issue raised by the appellant with regard to the question of sufficiency of disclosure under Article 83 EPC is the question, whether a person skilled in the art could carry out the step of *"arranging a filter ..."*. The appellant argued that this step is performed during manufacturing of the display and not during using it.

In the originally filed specification, however, it is stated *"Between the touch panel (612) and the medium such as the paper sheet or the display means (613), an infrared cutoff filter may be arranged"* (cf. A1-publication, [0015]). This statement is broader than merely stating that the filter is arranged during manufacturing of the device. It is not necessary, in view of the technical effect to be achieved, that the filter be arranged already before using the display. It is equally possible (with some additional effort, but feasible) to arrange a filter in the optical path when making use of the display.

- 1.3.3 A second issue raised by the appellant is whether paragraph [0082] of the published B1-specification (corresponding to paragraph [0083] of the published A1-publication) provides enough information to the person skilled in the art to achieve the intended purpose (i.e. enhancing the contrast of the dots with regard to

the background), taking into account that this paragraph includes an - undisputed - error.

With regard to this second issue, it is to be noted that the existence of an error in paragraph [0082] of the B1-publication was already underlined by the appellant and discussed between the parties during the first instance proceedings (cf. opponent's letter dated 20 August 2012, page 5, 2nd paragraph; patent proprietor's letter dated 10 September 2012, page 2, point III; opponent's letter dated 10 September 2012, page 8), so that there is no reason to not consider these facts and evidences under Article 12(4) RPBA.

1.3.4 The Board concurs with the appellant (cf. grounds of appeal, section IV.1) that two possible corrections of this paragraph are plausible, i.e. that the dots absorb infrared light and the infrared filter reflects it, or that the dots reflect infrared light and the infrared cutoff filter absorbs it (section IV of the grounds of appeal). Hence, it is not possible for the skilled person to derive from this passage how the intended effect of enhancing contrast is to be achieved and, consequently, which kind of infrared cutoff filter (see the discussion above) should be selected in order to achieve the intended purpose.

1.3.5 With regard to the fulfillment of the requirements of Article 83 EPC, however, it has to be decided, whether the subject-matter of the claim - which is considered to define the "*invention*" - can be carried out by a person skilled in the art.

The independent claims only include the feature of an infrared cutoff filter without specifying its intended effect. It follows that any arbitrary infrared cutoff

filter (being it absorptive or reflective) can be used. There is therefore no reason hindering a skilled person from carrying out the claimed inventions.

1.3.6 Hence, Articles 83 and 100(b) EPC do not prejudice the maintenance of the patent according to the main request.

1.4 Clarity and support by the description (Article 84 EPC)

1.4.1 Since claim 2 of the respondent's main request is a combination of granted claims 1 and 5, following decision G 03/14, issues under Article 84 EPC can only be discussed with regard to claim 1, which was amended with features originating from the description.

1.4.2 The appellant raised the issue that it would not be clear when the step of *"arranging an infrared cutoff filter"* takes place, while performing the claimed method.

1.4.3 As already discussed above, the Board interprets this feature broadly, i.e. that it is not relevant when the infrared cutoff filter is arranged. The arrangement might happen during manufacturing the device or when using it. Both possibilities are covered, so that the claim is considered broad, but clear (cf. also the decision under appeal, section 14.2).

1.5 Inventive step (Articles 100(a), 56 EPC)

1.5.1 It is undisputed that the subject-matter of claims 1 and 2 of the respondent's main request is novel over document O1 (JP-A-2001-243006 (English translation)); and that O1 is an appropriate starting point to discuss inventive step.

- 1.5.2 In the decision under appeal, the Opposition Division focused on one distinguishing feature of the claimed subject-matter as compared to O1 (the infrared cutoff filter) and held that this distinguishing feature is not obvious for a person skilled in the art.
- 1.5.3 According to the interpretation of this feature by the Board (see above), however, this distinguishing feature does not necessarily have the effect of improving the contrast when trying to recognize the dots, as argued by the Opposition Division. The objective problem to be solved by the invention can thus not rely on this alleged effect. As a matter of fact, since the type of the infrared cutoff filter is not claimed and also not derivable from the patent specification, any infrared cutoff filter would do. The objective problem to be solved must thus be revised and take into account this lack of specificity regarding the filter.
- 1.5.4 Hence, the objective technical problem starting from document O1 can be defined under the circumstances as *"avoiding infrared disturbances from the display"*.

From document O4 (US-B-6,333,592) - and also from document O6 (US-B-5,804,102) - an infrared cutoff filter for a plasma display is known with the purpose of avoiding infrared light emitted from the display so that remote controls are not disturbed (cf. O4: col. 13, lines 26 to 38 in combination with col. 1, lines 29 to 37; O6: Abstract).

From document O4 (or O6) the person skilled in the art thus gets the hint that an infrared cutoff filter is useful for solving the problem addressed by the invention. Hence, the incorporation of this feature in

the device of O1 is considered to be obvious in the light of document O4 (or O6).

- 1.5.5 Possible further distinguishing features of independent claim 1 with regard to O1 that were identified by the Opposition Division during opposition proceedings (see sections 16 to 17.1 of the decision) are (using the feature analysis used by the Opposition Division in the decision under appeal):

*E. in order to recognize various kinds of multimedia information;*

*F. the scanning being performed with scanning means (602) following the instructions displayed on the display means (613);*

*H. reading multimedia information corresponding to the code data out of the storing means; and*

*I. reproducing the multimedia information.*

- 1.5.6 The Opposition Division did not see features H. and I. disclosed in O1. With regard to feature E., the Opposition Division pointed out that O1 would only disclose to recognize position coordinate information (instead of various kinds of multimedia information) and with regard to feature F. that scanning means were disclosed in O1 but not that the scanning is performed following the instructions displayed on the display means (see reasons, section 17.1).

- 1.5.7 In the reply the respondent argued that also feature

*B. displaying instruction information on display means (613) on which a touch panel (612) is arranged*

is not disclosed in document O1, because the concept of "instruction information" was not disclosed therein.

- 1.5.8 However, features H. and I. are disclosed in document O1, since the data that is used to edit an image on the screen of the display in O1 (cf. [0019], [0020]) qualifies as "*multimedia information*", which is reproduced on the display, when the edited image is displayed.
- 1.5.9 It is undisputed, as also being held by the Opposition Division (see reasons 18.1), that the further differences are not linked to the problem allegedly solved by the infrared cutoff filter (i.e. improving the contrast), but had to be assessed separately with regard to inventive step. The same applies with regard to the reformulated objective technical problem solved by the infrared cutoff filter, as discussed above.
- 1.5.10 With regard to the feature of displaying instruction information, the appellant argued that this feature only refers to a difference in content to be displayed (cf. grounds of appeal section V.8) and, being a non-technical feature, has to be disregarded in the assessment of inventive step.
- 1.5.11 The Board, however, sees a further "*technical effect*" in features B., E. and F. dealing with the instruction information being displayed, namely that scanning following the instructions (feature F.) results in a higher flexibility of using the reproduction method, because displayed instructions can include much more diverse information based on software than a hardware solution with dedicated buttons as disclosed in document O1 (cf. [0068]).
- 1.5.12 Hence, the objective technical problem solved by these features dealing with displaying and using instruction



information can be defined as *"providing a more flexible range of different instruction informations"*.

1.5.13 A skilled person trying to solve this objective technical problem would derive from document O2 (JP-A-2002-149331 (English translation)) that it is possible to display instructions on a display and use these instructions while scanning a dot pattern on the display with a scanning device (cf. e.g. [0031] of O2). It is evident for a person skilled in the art that the use of displayed instruction information is far more flexible than the use of dedicated buttons, as confirmed by document O2 which explicitly discloses *"In this case, various kind of application software may be operated by the pen 1."* (end of paragraph [0031]).

1.5.14 Hence, the subject-matter of claims 1 and 2 of the respondent's main request is not based on an inventive step.

2. Respondent's further requests

2.1 Request with *"voice information"* instead of *"multimedia information"*

These requests referred to in the reply under section I.2 were conditional, and as such, cannot be considered as formally filed. They thus do not form part of the appeal proceedings.

2.2 Respondent's auxiliary requests 1 to 7

2.2.1 Auxiliary requests 1, 2, 6 and 7 as filed with the reply dated 2 July 2013 are identical with auxiliary requests 1, 2, 6 and 7 as submitted in opposition

proceedings with letter of 10 September 2012. The order of auxiliary requests 3 - 5 in appeal proceedings is different from the order in opposition proceedings (new auxiliary request 3 is identical to former auxiliary request 5, new auxiliary request 4 is identical to former auxiliary request 3, new auxiliary request 5 is identical to former auxiliary request 4).

2.2.2 The auxiliary requests were filed and substantiated in the patentee's submission of 20 August 2012, that is in the course of opposition proceedings.

2.2.3 The decision under appeal did not deal at all with the auxiliary requests, since it maintained the patent based on the then pending main request. Already with its reply to the appeal dated 2 July 2013, the respondent requested to uphold the patent based on these auxiliary requests (cf. section 1.4). The appellant is correct when stressing that the respondent only referred to its submission of 20 August 2012, when discussing the merits of these auxiliary requests in this reply. Since the decision under appeal, however, only dealt with the then pending main request, there is no reason, in the absence of any adverse decision and associated reasoning regarding these requests, to elaborate on the substantiation already submitted with the letter of 20 August 2012.

2.2.4 The present situation differs from the situation underlying the case T 1151/11 cited by the appellant in its letter dated 27 March 2019. In that case the respondent had generally referred back to "all" arguments brought forward already during opposition proceedings. Such a generic back-referral indeed would not *"specify expressly the arguments relied on by the respondent, since it would thereby be left to the Board*

*and to the other party to find out which parts of such submissions are relevant to which parts of the impugned decision or of the arguments of the other party."* (T 1151/11, reasons, section 3.)

- 2.2.5 In the present case, however, the passages referred to by the respondent are expressly mentioned in the reply (section VI), and since the decision did not deal at all with these auxiliary requests, there seems to be no need for the respondent to change anything to the substantiation originally provided during opposition proceedings.
- 2.2.6 Due to the differences between the claims of the main request and the claims of auxiliary requests 1 to 7 various new issues are to be addressed . Specifically, the "*infrared cutoff filter*" discussed at length above, is not present in auxiliary requests 2 to 7, but other features have been introduced in the respective independent claims. All in all, the factual framework of the case shifted significantly. It is, however, not the function of an appeal to examine and decide on such a fresh case, irrespective of the length of the appeal proceedings.
- 2.2.7 For that reason, the case is remitted to the Opposition Division for further prosecution of auxiliary requests 1 to 7 in accordance with Article 111(1) EPC.

## **Order**

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

1. The decision under appeal is set aside.

2. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:



R. Schumacher

P. Fontenay

Decision electronically authenticated