

**Internal distribution code:**

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

**Datasheet for the decision  
of 25 January 2017**

**Case Number:** T 1939/13 - 3.5.07

**Application Number:** 02251358.4

**Publication Number:** 1262984

**IPC:** G11B27/34, G11B33/10,  
G11B20/10, G11B27/10, G11B19/02

**Language of the proceedings:** EN

**Title of invention:**  
File storing apparatus with file list display function

**Applicant:**  
Samsung Electronics Co., Ltd.

**Headword:**  
File-list display/SAMSUNG ELECTRONICS

**Relevant legal provisions:**  
EPC Art. 56, 113(2)  
RPBA Art. 11

**Keyword:**  
Basis of decision - text submitted or agreed by applicant (no)  
Remittal to the department of first instance - special reasons  
for not remitting the case  
Inventive step - all requests (no)

**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 1939/13 - 3.5.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.07**  
**of 25 January 2017**

**Appellant:** Samsung Electronics Co., Ltd.  
(Applicant) 129, Samsung-ro  
Yeongtong-gu  
Suwon-si, Gyeonggi-do, 443-742 (KR)

**Representative:** Walaski, Jan Filip  
Venner Shipley LLP  
200 Aldersgate  
London EC1A 4HD (GB)

**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 21 March 2013 refusing European patent application No. 02251358.4 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** R. Moufang  
**Members:** R. de Man  
M. Rognoni

## Summary of Facts and Submissions

I. The applicant (appellant) appealed against the decision of the Examining Division refusing European patent application No. 02251358.4.

II. The contested decision cites the following documents:

D1: WO 00/60599, 12 October 2000;

D2: "Getting Started - NOMAD Jukebox", August 2000, retrieved from the Internet at [http://www.minidisc.org/manuals/nomad/Nomad\\_Jukebox.pdf](http://www.minidisc.org/manuals/nomad/Nomad_Jukebox.pdf);

D3: Deely L.: "Digital Audio Mutates", 8 January 2001, retrieved from the Internet at <http://www.techtv.com/products/consumerelectronics/story/0,23008>; and

D4: "Learning MS-DOS Basics - A Tutorial", archived by the Internet Archive at [archive.org](http://archive.org) on 17 August 2000.

The Examining Division decided that the subject-matter of independent claims 1 and 15 of the then main request was not new in view of document D4, that the subject-matter of independent claims 1 and 14 of the then first auxiliary request lacked inventive step in view of document D4 and that the subject-matter of independent claims 1 and 14 of the then second auxiliary request infringed Article 123(2) EPC. Under the heading "Obiter Dicta", it briefly discussed documents D1, D2 and D3 and expressed its view on the inventive merits of the second embodiment of the description as depicted in Figures 6 and 7 and described on pages 7 and 8.

III. With the statement of grounds of appeal, the appellant filed a main request and first, second and third auxiliary requests.

- IV. In a communication accompanying a summons to oral proceedings, the Board noted that the Examining Division appeared not to have decided on the correct version of the first auxiliary request. It further drew attention to various problems of added subject-matter and clarity and expressed *inter alia* the preliminary view that claim 1 of each request lacked inventive step over document D1.
- V. By letter of 18 January 2017, the appellant informed the Board that it would not be represented at the oral proceedings. It did not comment in substance on the Board's communication.
- VI. Oral proceedings took place on 25 January 2017 in the appellant's absence. At the end of the oral proceedings, the chairman pronounced the Board's decision.
- VII. The appellant 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, on the basis of the claims of one of the first, second and third auxiliary requests.
- VIII. Independent claim 1 of the main request reads as follows:

"A file storing apparatus, including a display (60), user input means (11, 13, 15), data reading means (40) for reading data from a data storage medium (50) and control means (20), the control means (20) being configured for searching content files associated with a predetermined file type of all of the content files stored in the data storage medium (50) and for causing

the data reading means (40) to generate a file list for the content files associated with the predetermined file type and to display said list on the display (60), **characterised in that** the control means (20) is configured for causing the display (60) to display said list by grouping the files into non-overlapping sub-lists of a predetermined plurality of files, no sub-list being larger than the display capacity of the display (60), wherein in response to a sub-list moving command is [sic] input while one sub-list is displayed based on a display (60) the control means is configured to control the display (60) to display another sub-list in a direction corresponding to the input sub-list moving command."

- IX. Independent claim 1 of the first auxiliary request differs from claim 1 of the main request in that its characterising portion reads as follows:

"the control means (20) is configured for causing the display (60) to display said list by grouping the files into non-overlapping sub-lists of a predetermined plurality of files, no sub-list being larger than the display capacity of the display (60), wherein in response to the user input means indicating that a forward or backward display command is input, the control means is configured to create a sub-list for display, respectively comprising either a predetermined number of files listed in the file list after the currently displayed files or a predetermined number of files listed in the file list before the currently displayed files; and  
to display the sub-list."

- X. Independent claim 1 of the second auxiliary request differs from claim 1 of the main request in that the

text "user input means (11, 13, 15)" in the preamble has been replaced with "user input means (11, 13, 15, 17)" and in that its characterising portion reads as follows:

"the control means (20) is configured for causing the display (60) to display said list by grouping the files into a plurality of groups of files, wherein the control means is configured to control the display (60) to display files within the groups; and

wherein the user input means is arranged to control a cursor (60a) for selecting one of the displayed files, wherein forward and backward scrolling of the files in the group that includes the selected file is performed in response to input of forward and backward scroll commands respectively."

XI. Independent claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that its characterising portion reads as follows:

"the control means (20) is configured for causing the display (60) to display said list by grouping the files into a plurality of groups of files, wherein the control means is configured to control the display (60) to display a sub-list comprising a file within each group; and

wherein the user input means is arranged to control a cursor (60a) for selecting one of the displayed files, wherein forward and backward scrolling of the files in the group that includes the selected file is performed in response to input of forward and backward scroll commands respectively."

XII. The appellant's arguments as relevant to the decision are discussed in detail below.

## **Reasons for the Decision**

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.
2. *The decision under appeal*
  - 2.1 In preparation for the oral proceedings before the Examining Division, with a letter dated 8 January 2013 the applicant filed a main request, a first auxiliary request and a second auxiliary request. According to the minutes of the oral proceedings held on 8 February 2013, the applicant replaced its first auxiliary request with an amended first auxiliary request filed at 10:15 and replaced its second auxiliary request, after two intermediate amendments (at 10:35 and 10:50), with an amended second auxiliary request filed at 13:17. Annexed to the minutes of the oral proceedings are one page with claims 1 to 5 of the amended first auxiliary request filed at 10:15 and further pages containing the three amended versions of claims 1 to 21 of the second auxiliary request (versions of 10:35, 10:50 and 13:17). It is indicated on EPO Form 2009.2, which forms part of the minutes, that the other pages of the first auxiliary request are "as in main request".
  - 2.2 The contested decision makes mention of the requests filed by the appellant with the letter of 8 January 2013 but is silent on the amendments made in the course of the oral proceedings. Under the heading "Claims on file", it gives the text of independent apparatus claim 1 of each of "The Main Request", "The First Auxiliary Request" and "The Second Auxiliary Request". It further mentions that independent claim 15



of the main request, independent claim 14 of the first auxiliary request and independent claim 14 of the second auxiliary request define the corresponding methods. No further indication of the application documents on which the decision is based is given.

- 2.3 The text of claim 1 of "The Main Request" corresponds to the text of claim 1 of the main request filed with the letter of 8 January 2013. That request also includes an independent method claim 15.

The text of claim 1 of "The First Auxiliary Request", however, does not correspond to the text of claim 1 of the amended first auxiliary request filed during the oral proceedings but to the text of claim 1 of the first auxiliary request filed with the letter of 8 January 2013. In addition, neither version of the first auxiliary request includes an independent method claim 14.

The text of claim 1 of "The Second Auxiliary Request" does not correspond to the text of claim 1 of the second auxiliary request filed with the letter of 8 January 2013 or to the text of claim 1 in any of the three versions of the second auxiliary request filed during the oral proceedings. A comparison of the texts in all versions suggests that the Examining Division attempted to copy the text of the version filed during the oral proceedings at 13:17 but failed to do so correctly (the copied text includes features that had been crossed out).

- 2.4 From point 2.1 of the reasons for the decision, it is clear that the decision is indeed based on the text of claim 1 of the first auxiliary request filed with the

letter of 8 January 2013, i.e. on a text no longer approved by the applicant when the decision was taken.

On the other hand, from point 3.1 of the reasons for the decision it is apparent that the decision in respect of the second auxiliary request was indeed based on the text of claim 1 of the version filed at 13:17, i.e. on the text submitted by the applicant.

2.5 In summary, the Examining Division has violated Article 113(2) EPC by deciding on a version of the first auxiliary request that was no longer approved by the applicant and by not deciding on the text of the first auxiliary request submitted by the applicant during the oral proceedings.

2.6 According to Article 11 RPBA, a Board is to remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise. In the Board's view, such reasons do present themselves in the present case. First, the amendment of claim 1 of the first auxiliary request overlooked by the Examining Division, which was intended to overcome an objection under Article 123(2) EPC, was of minor importance for the question of inventive step. Second, the request was again amended on appeal. Third, the appellant has not requested a remittal. Accordingly, the Board proceeds with the examination of the case.

### 3. *The invention*

The application relates to a file storing apparatus such as, for example, an MP3 player. The file storing apparatus includes a display and control means. The

display is large enough to display a predetermined number of files corresponding to a "sub-list" of the entire list of files stored in the apparatus. By entering input commands, e.g. by pressing buttons, a user can cause the apparatus to switch to displaying another (non-overlapping) sub-list of the entire file list.

4. *Main request - interpretation of claim 1*

The file storing apparatus of claim 1 includes a "control means" for controlling the display of file lists on the display of the file storing apparatus. The files to be displayed are "grouped" into "non-overlapping sub-lists of a predetermined plurality of files, no sub-list being larger than the display capacity".

Claim 1 further states that "wherein in response to a sub-list moving command is [sic] input while one sub-list is displayed based on a display the control means is configured to control the display to display another sub-list in a direction corresponding to the input sub-list moving command".

The wording of this feature has a number of problems, which the Board pointed out in its communication. In the light of the description on, for example, page 4, line 17, to page 5, line 2, the Board understands the feature to mean that the control means is configured to respond to a "sub-list moving command" input by the user by displaying either the next or the previous sub-list. Whether the next or the previous sub-list is displayed depends on the semantics of the particular "sub-list moving command" entered (forward or backward).

5. *Main request - inventive step*

5.1 In its decision, the Examining Division essentially argued that the subject-matter of claim 1 of the then main request was not new and the subject-matter of claim 1 of the then first auxiliary request not inventive in view of the well-known "dir /p" MS-DOS command as disclosed in document D4. Using this command, a user can display a list of the files present in the file system of an MS-DOS computer (either on its hard disk or on a floppy disk). By including the "/p" switch after the "dir" command, the user can cause the computer to pause after it displays a screen of directory-list information and to display the next screen of information upon the user pressing "any key".

Although an MS-DOS computer is hardly a promising starting point for an invention relating to a digital media player, the independent claims considered in the decision under appeal were not limited to such a device, and the present claims still are not. The appellant's argument made in the statement of grounds of appeal that MS-DOS would be "inappropriate for displaying file lists for the types of high-capacity storage made available since its inception" is therefore not a convincing argument against document D4.

Nevertheless, the Board chooses to assess novelty and inventive step first on the basis of document D1.

5.2 Document D1 discloses a "digital-audio electronic cassette" storing digital-audio sound files (see page 1, lines 25 to 27), which the Board considers to be "content files associated with a predetermined file

type". The electronic cassette includes a display 302 allowing the user to view the names of the stored digital-audio sound files (page 2, lines 3 and 4; page 5, lines 4 to 7; Figure 3). By means of scroll-up and scroll-down buttons 312 and 313 the user can control a cursor to select a file (page 5, lines 14 to 20). If the electronic cassette contains more sound files than can be shown at one time on the display, "the scrolling button will also scroll names onto the display 302 and off of the display 302 in a manner similar to a conventional window on the Graphical User Interface (GUI) system such as, for example, the Microsoft Windows™ system" (page 5, lines 21 to 24).

- 5.3 The subject-matter of claim 1 differs from the electronic cassette of document D1 in that input of a "sub-list moving command" results in the display of another (e.g. the next) non-overlapping sub-list. This allows the user to browse through a long list of file names more quickly.
- 5.4 The skilled person, starting from document D1 and faced with the problem of making file navigation more efficient, would take into account conventional graphical user interface techniques known from, for example, the Microsoft Windows system which is mentioned in document D1 on page 5, lines 20 to 24, in the context of interacting with the electronic cassette's display. It is well-known that, in graphical user systems such as the Microsoft Windows system known at the priority date of the present application, it was conventional to efficiently browse through a large amount of information one page or screen at a time by means of the "Page Up" and "Page Down" buttons. Indeed, those keys were and still are present on any conventional personal computer keyboard. The skilled

person would therefore have considered adding buttons with "Page Up" and "Page Down" functionality to the electronic cassette of document D1 and would thereby have arrived at the subject-matter of claim 1 without the exercise of inventive skill.

5.5 Hence, the subject-matter of claim 1 lacks inventive step in view of document D1 and the common general knowledge of the skilled person (Article 52(1) and 56 EPC).

6. *First auxiliary request - inventive step*

6.1 Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the features relating to the "sub-list moving command" have been replaced with features specifying essentially that in response to the input of a forward or backward display command the control means switches to displaying a predetermined number of files listed in the file list either "after" or "before" the currently displayed files.

6.2 Since the functionality of the claimed "forward" and "backward" display commands corresponds to the well-known "Page Down" and "Page Up" functionality discussed in point 5.4 above, the subject-matter of claim 1 of the first auxiliary request likewise lacks inventive step (Article 56 EPC).

7. *Second auxiliary request - inventive step*

7.1 Compared to claim 1 of the first auxiliary request, claim 1 of the second auxiliary request adds that the user input means is arranged to control a cursor for

selecting one of the displayed files. This feature is disclosed in document D1 on page 5, lines 18 to 24.

- 7.2 In addition, the notion of "sub-list" has been replaced with the more general notion of "group". The control means displays "files within the groups", and "forward and backward scrolling of the files in the group that includes the selected file is performed in response to input of forward and backward scroll commands respectively".

Since the claim does not require the groups to be "non-overlapping", it could be argued that the forward and backward scrolling of claim 1 is anticipated by the scroll-down and scroll-up functionality of the electronic cassette of document D1. But even reading into claim 1 a limitation to "non-overlapping" groups, the claimed forward and backward scrolling still corresponds to the well-known "Page Down" and "Page Up" functionality.

- 7.3 Thus, the subject-matter of claim 1 of the second auxiliary request likewise lacks inventive step (Article 56 EPC).

8. *Third auxiliary request - inventive step*

- 8.1 Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that "wherein the control means is configured to control the display to display files within the groups" has been replaced with "wherein the control means is configured to control the display to display a sub-list comprising a file within each group".

8.2 In the embodiment described on page 7, lines 6 to 21, of the application with reference to Figure 6, the entire file list of 100 files is split into ten "groups" of ten successively listed files each. Thus, the first group corresponds to files 1, ..., 10, the second group to files 11, ..., 20, etc. In this embodiment, the first displayed sub-list consists of the first file from each of the ten groups (i.e. files 1, 11, ..., 91), the second displayed sub-list of the second file from each of the ten groups (i.e. files 2, 12, ..., 92), etc. Thus, each display sub-list does indeed comprise "a file within each group".

According to the description on page 8, lines 18 to 26, a forward or backward scroll operation may be performed "only in regard to the first file currently selected". The results of these operations performed on selected file 1 is shown in Figures 7 and 8: the selected file 1 is replaced with file 2 (the next file in the "group" of file 1) in case of a forward scroll operation and with file 100 in case of a backward scroll operation. (The Board observes that Figure 8 should have shown file 10 instead, since file 100 is not a file in the "group" of file 1.) The other displayed files are not affected.

8.3 The Board notes, however, that claim 1 does not specify that "only" the file at the position selected by the cursor is scrolled. Claim 1 encompasses the possibility that the files in all positions are scrolled.

Furthermore, since the claim is silent on how the entire file list is to be "grouped" into "groups", according to an alternative grouping the first group consists of files 1, 11, ..., 91, the second group of files 2, 12, ..., 92, and so on. The first displayed



sub-list may then consist of files 1, 2, ..., 10, the second displayed sub-list of files 11, 12, ..., 20, and so on. The well-known "Page Down" functionality then switches from the display of the first displayed sub-list with files 1, ..., 10, to the display of the second displayed sub-list with files 11, ..., 20, resulting in forward scrolling "of the files in the group that includes the selected files" (in addition to forward scrolling of the files in the nine other groups), and *mutatis mutandis* for the well-known "Page Up" functionality.

Thus, claim 1 still encompasses the obvious electronic cassette of document D1 provided with "Page Up" and "Page Down" buttons and corresponding functionality.

8.4 Thus, the subject-matter of claim 1 of the third auxiliary request lacks inventive step (Article 56 EPC).

8.5 For the sake of completeness, the Board notes that if a limitation were added to the claim to the effect that "only" the file at the position selected by the cursor is scrolled, it would still consider the subject-matter of claim 1 to be obvious, since allowing sub-list positions to be individually scrollable is an obvious design choice involving neither a surprising technical effect nor any technical difficulties in its implementation.

## 9. *Conclusion*

Since none of the requests on file is allowable, the appeal is to be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated