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**Datasheet for the decision  
of 3 April 2019**

**Case Number:** T 2029/13 - 3.5.04

**Application Number:** 08782542.8

**Publication Number:** 2183910

**IPC:** H04N5/228, H04N5/225

**Language of the proceedings:** EN

**Title of invention:**

COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA

**Applicant:**

Contour IP Holding, LLC

**Headword:**

**Relevant legal provisions:**

EPC R. 137(5) (version of 1 April 2010)

**Keyword:**

Amended claims - unity of invention with original claims (yes)  
Amended claims - relating to unsearched subject-matter which  
should have been searched (yes)  
Remittal to the department of first instance - (yes)

**Decisions cited:**

**Catchword:**



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

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Case Number: T 2029/13 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 3 April 2019**

**Appellant:** Contour IP Holding, LLC  
(Applicant) 5152 Edgewood Drive STE 375  
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**Representative:** Hanna Moore + Curley  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 26 April 2013  
refusing European patent application  
No. 08782542.8 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairwoman** T. Karamanli  
**Members:** M. Paci  
R. Gerdes

## Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 08 782 542.8, published as international patent application WO 2009/018391 A1.
- II. The documents cited in the decision under appeal included the following:
- D1: US 5,557,329 A and  
D3: US 5,218,439 A.
- III. The decision under appeal was based on the following grounds:
- the subject-matter of claim 1 according to the main request then on file did not involve an inventive step in view of prior-art document D1 and common general knowledge;
  - the subject-matter of claim 1 according to the first auxiliary request then on file did not involve an inventive step in view of prior-art documents D1 and D3 and common general knowledge;
  - the second and third auxiliary requests then on file were not admitted into the proceedings under Rule 137(5) EPC because their differentiating subject-matter with respect to the main request related to unsearched subject-matter (see point 1.8 of the "Summary of facts and submissions" and the minutes of the oral proceedings);
  - the subject-matter of claim 1 according to the fourth auxiliary request then on file did not involve an inventive step in view of prior-art documents D1 and D3 and common general knowledge; and
  - the fifth auxiliary request then on file was not admitted into the proceedings because of a *prima facie*

lack of inventive step (see point 1.8 of the "Summary of facts and submissions", point 4.3 of the "Obiter dictum" and the minutes of the oral proceedings).

- IV. With the statement of grounds of appeal dated 3 September 2013 and filed on the same day, the appellant maintained the first auxiliary request underlying the decision under appeal and filed amended claims according to a main, second and third auxiliary requests, which replaced the claims of the main, second and third auxiliary requests underlying the decision under appeal.

As to the first auxiliary request underlying the decision under appeal and maintained on appeal, a copy of the claims according to this request was annexed to the written decision, but one page thereof was missing. With the statement of grounds of appeal, the appellant re-filed this incomplete version of the claims according to the first auxiliary request.

- V. In a brief communication sent in advance by fax on 3 September 2013, the examining division invited the appellant to send the missing page of the claims according to the first auxiliary request.
- VI. With a letter dated 5 September 2013, the appellant filed a complete version of the claims according to the first auxiliary request.
- VII. By a communication dated 27 September 2018, the appellant was summoned to oral proceedings to be held on 19 December 2018. The board's communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536) was annexed to the

summons, and in this the board gave the following preliminary opinion:

- The subject-matter of claim 1 of the **main and first auxiliary requests filed with the statement of grounds of appeal** did not involve an inventive step (Article 56 EPC) in view of D1, D3 and common general knowledge.

- The examining division should not have raised an objection under Rule 137(5) EPC (in the version which entered into force on 1 April 2010) against the **second and third auxiliary requests underlying the decision under appeal** on the grounds that claim 1 of those requests comprised **unsearched** features relating to the "mounting mechanism", because those features should have been searched. Since these findings also applied to the **second and third auxiliary requests filed with the statement of grounds of appeal**, the board stated that it was prepared to remit the case to the examining division for further prosecution on the basis of these second and third auxiliary requests.

- It seemed that the **fourth and fifth auxiliary requests underlying the decision under appeal** were no longer pursued on appeal.

VIII. By letter dated 16 November 2018, the appellant reordered its requests as follows:

- its second and third auxiliary requests on file became its new main and first auxiliary requests, and

- its main and first auxiliary requests on file became its new second and third auxiliary requests.

The appellant also requested that the oral proceedings be cancelled and that the case be remitted to the examining division for further prosecution.

IX. By a communication dated 7 December 2018, the appellant was informed that the oral proceedings had been cancelled.

X. Claim 1 according to the appellant's **main request** reads as follows:

"An integrated point of view digital video camera (10) operable for mounting to a person, a vehicle, or equipment and operable for hands-free capture of video during motion of the person, the vehicle, or the equipment involved in an action sports activity, comprising:

a camera housing (22) containing a lens (26) and an image sensor (18), the camera housing (22) defining a housing plane (20) and the image sensor (18) operable for capturing light propagating through the lens (26) and representing a scene during motion of the person, the vehicle, or the equipment, the image sensor (18) producing image data representing an image of the scene that is oriented with respect to a horizontal image plane (16), and the lens (26) and the image sensor (18) having an orientation that is adjustable with respect to the housing plane (20);

a mounting mechanism (120) adaptable for secure mounting of the camera housing (22) to the person, the vehicle, or the equipment, whereby the mounting mechanism is operable to permit the person involved in the action sport activity to obtain hands-free point of view video during involvement in the action sport activity;

a horizon adjustment control for adjusting with respect to the housing plane (20) an orientation of the horizontal image plane (16) of the image of the scene, the horizon adjustment control forming part of the housing (22) but operationally independent of the

mounting mechanism (120) to enable adjustment of the orientation of the horizontal image plane (16) when the camera housing (22) is securely mounted to the person, the vehicle, or the equipment; and

a control axis (24) that extends through the camera housing (22), and the horizon adjustment control including a rotary controller (14) that is operable for rotation about the control axis (24) to rotate the lens (26) and the image sensor (18) which are supported in rotational congruence with the rotary controller (14) and thereby change the orientation of the horizontal image plane (16) with respect to the housing plane (20) such that the image sensor (18) is operable to produce image data with respect to the orientation of the horizontal image plane (16)."

XI. Claim 1 according to the appellant's **first auxiliary request** reads as follows (additions to claim 1 of the **main request** are underlined, deletions are ~~struck-through~~, long identical text portions are replaced by "[...]"):

"An integrated point of view digital video camera (10) operable for mounting to a person, a vehicle, or equipment and operable for hands-free capture of video during motion of the person, the vehicle, or the equipment involved in an action sports activity, comprising:

a camera housing (22) [...];

a rotationally adjustable mounting mechanism (120) adaptable for secure mounting of the camera housing (22) to the person, the vehicle, or the equipment, whereby the mounting mechanism is operable to permit the person involved in the action sport activity to obtain hands-free point of view video during involvement in the action sport activity, and whereby



the mounting mechanism facilitates rotational adjustment of the camera housing with respect to the person, the vehicle, or the equipment;

a horizon adjustment control [...]; and  
a control axis (24) [...]."

## Reasons for the Decision

1. The appeal is admissible.

### *Main and first auxiliary requests*

2. The claims of the main and first auxiliary requests are respectively based on the claims of the **second and third auxiliary requests underlying the decision under appeal**, from which they differ only by the following amendments in claim 1 (additions are underlined, deletions are ~~struck-through~~):

"... and the lens (26) and the image sensor (18) having an orientation that is adjustable with respect to the housing plane (20);

... to rotate the lens (26) and the image sensor (18) which ~~is~~are supported in rotational congruence with..."

3. The examining division did not admit the claims of the **second and third auxiliary requests underlying the decision under appeal** into the proceedings under Rule 137(5) EPC because "their differentiating subject-matter with respect to the main request related to unsearched subject-matter associated with the second invention identified during the supplementary European search" (see point 1.8 of the "Summary of facts and submissions" and the minutes of the oral proceedings).

4. Since the appellant's present main request and first auxiliary request are based on the second and third auxiliary requests underlying the decision under appeal, the board must review whether the examining division's decision not to admit the second and third auxiliary requests underlying the decision under appeal into the proceedings under Rule 137(5) EPC was correct.
5. In the present case, the version of Rule 137(5) EPC that entered into force on 1 April 2010 applies to the present application, because the supplementary European search report (hereinafter "SESR") under Article 153(7) EPC was drawn up on 22 December 2010, i.e. after 1 April 2010 (see Article 1(7) and Article 2(2) of the Decision of the Administrative Council of 25 March 2009 amending the Implementing Regulations to the European Patent Convention (CA/D 3/09), OJ EPO 2009, 299).

Rule 137(5), first sentence, EPC stipulates that "Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept".

6. The SESR was to be drawn up on the basis of amended claims 1 to 22, which had been filed when the international application entered the European phase. However, the search division considered that the application did not meet the requirements of unity of invention (Article 82 EPC) because the claims contained the following three groups of inventions which did not share a common inventive concept:

- Claims 1 to 6 (the first group) were directed to a digital video camera comprising a horizon adjustment

control for adjusting an orientation of the horizontal image plane with respect to the housing plane.

- Claims 7 to 14 (the second group) were directed to a digital video camera comprising a mounting mechanism (claims 7 to 13) and to a mounting mechanism adaptable for secure mounting of a camera housing to a support (claim 14).

- Claims 15 to 22 (the third group) were directed to a digital video camera comprising a manually operable switch for controlling operation of the image sensor.

In accordance with Rule 164(1) EPC (in the version which entered into force on 1 April 2010; see Decision of the Administrative Council of 27 October 2009 amending the Implementing Regulations to the European Patent Convention, OJ EPO 2009, 582 (CA/D 20/09)), the SESR was drawn up on those parts of the application which related to the invention, or the groups of inventions within the meaning of Article 82 EPC, first mentioned in the claims, i.e. in the present case only claims 1 to 6 relating to the horizon adjustment control (i.e. the first group of inventions).

7. As a consequence of this alleged lack of unity, the second and third auxiliary requests underlying the decision under appeal were not admitted into the proceedings by the examining division, because claim 1 of these requests contained "unsearched subject-matter associated with the second group of inventions identified during the supplementary European search", i.e. subject-matter relating to the mounting mechanism.

8. However, the board is of the view that claims 1 to 13 do **not** lack unity of invention (Article 82 and Rule 44 EPC) for the reasons set out below:

According to the search division, the special technical features (STFs) in the first group of inventions (claims 1 to 6 of the SESR) relate to the horizon adjustment control of the video camera, whereas the STFs in the second group of inventions (claims 7 to 14 of the SESR) relate to the mounting mechanism of the video camera.

However, claims 7 to 13 contain all the features of claim 1 and, hence, also the STF identified with respect to that claim 1, i.e. the horizon adjustment control.

9. Consequently, the search division should also have searched claims 7 to 13 of the SESR, including the features in those claims relating to the mounting mechanism, and the examining division should not have raised an objection under Rule 137(5) EPC against the second and third auxiliary requests underlying the decision under appeal on the grounds that claim 1 of those requests comprised **unsearched** features relating to the mounting mechanism.
10. The above findings also apply to the claims of the present main and first auxiliary requests, because they only differ from the claims of the second and third auxiliary requests underlying the decision under appeal in that a feature has been added in claim 1 (see point 2 *supra*).

11. *Conclusion on the main and first auxiliary requests and the procedural consequence*

Since the claims of the present main request and first auxiliary request comprise features relating to claims 7 to 13 of the SESR, which should have been searched but were not, the board considers it appropriate to remit the case to the examining division for further prosecution under Article 111(1), second sentence, EPC. The examining division is to perform an additional search for the combination of features of claims 7 to 13 and continue substantive examination on that basis.

*Obiter dictum - second and third auxiliary requests*

12. Since the case is remitted to the examining division for further prosecution on the basis of the appellant's main and first auxiliary requests, and the additional search to be carried out after remittal to the examining division is likely to reveal additional relevant prior-art documents, the board does not consider it necessary to decide on whether the subject-matter of claim 1 of the present second and third auxiliary requests (previously the appellant's main and first auxiliary requests, before the requests were reordered) involves an inventive step in view of the prior-art documents D1 and D3. However, a provisional non-binding opinion of the board on this matter of inventive step was expressed under points 6 to 14 of the board's communication pursuant to Article 15(1) RPBA.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairwoman:



K. Boelicke

T. Karamanli

Decision electronically authenticated