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**Datasheet for the decision  
of 7 June 2019**

**Case Number:** T 0904/16 - 3.2.04

**Application Number:** 06115077.7

**Publication Number:** 1757344

**IPC:** A63F13/04

**Language of the proceedings:** EN

**Title of invention:**  
Game operating device

**Patent Proprietor:**  
Nintendo Co., Ltd.

**Opponents:**  
Bigben Interactive SA  
Sunflex Europe GmbH  
Steup, Mike

**Headword:**

**Relevant legal provisions:**  
EPC Art. 123(2)

**Keyword:**  
Amendments - added subject-matter (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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Case Number: T 0904/16 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 7 June 2019**

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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
27 January 2016 concerning maintenance of the  
European Patent No. 1757344 in amended form.**

**Composition of the Board:**

**Chairman**           A. de Vries  
**Members:**         J. Wright  
                      W. Van der Eijk

## **Summary of Facts and Submissions**

I. The appellant-opponent I filed an appeal, received 5 April 2016, against the interlocutory decision of the opposition division posted on 27 January 2016 concerning maintenance of the European Patent No. 1757344 in amended form. The appellant paid the appeal fee at the same time. The appellant-opponent I's statement setting out the grounds of appeal was filed on 5 June 2016.

II. The opposition was based on, amongst other grounds, added subject matter, Articles 100 (c) with 123(2) EPC.

During the opposition proceedings, a further party (opponent II) filed a notice of intervention under Article 105(1) b EPC on 23 November 2012. They withdrew their opposition on 25 April 2014.

With letters of 27 December 2012, two further parties (opponents III and IV), filed notices of intervention under Article 105(1)b EPC.

The opposition division held that the patent as amended according to an auxiliary request met the requirement of the EPC because, amongst other reasons, it did not add subject matter extending beyond the application as filed.

III. The appellant-opponent I requests that the decision under appeal be set aside and that the patent be revoked in its entirety.

IV. The respondent (patent proprietor) requests that the appeal be dismissed and the patent thus be maintained as upheld in the decision under appeal, or

alternatively, that the decision under appeal be set aside and the patent be maintained in amended form according to one of its New auxiliary requests I, II or III, all filed at the oral proceedings before the Board, or alternatively according to one of auxiliary requests I, II, IIA, III, IIIA, IV, IVA, V or VA, all filed with letter of 28 May 2019.

- V. Opponents III and IV have neither made a request nor filed submissions in the appeal proceedings.
  
- VI. In a communication dated 23 January 2019 in preparation for oral proceedings the Board gave a provisional opinion on added subject-matter with regard to the application as filed, in particular regarding feature g, amongst others (see section 3.5).

Oral proceedings were held before the Board on 7 June 2019 in the absence of the opponents III and IV, who had been duly summoned.

- VII. Claim 1 of the main request (as maintained) reads as follows:

"A game operating device (10), comprising: a longitudinal housing (12) with a first, essentially plane surface (20) and a second surface (22), which is opposed to and essentially parallel to said first surface in the longitudinal direction;  
a first operating portion (26; 42) provided on said first surface (20) of said housing along a longitudinal direction at one end in the longitudinal direction (C1);  
a second operating portion (42;28) provided at said one end of said second surface (22);

a holding portion (18) formed in a direction of the other end along said longitudinal direction of said housing from said second operating portion; an acceleration sensor (68) provided within said housing (12); and an infrared imaging means (56) provided at said one end of said housing (12) in such a manner that it can perform imaging in a direction along said longitudinal direction (C1)".

VIII. Claim 1 according to the New auxiliary requests I to III reads as for the main request, except for amendments to the last part of the claim, following the feature "a holding portion (18) formed in a direction of the other end along said longitudinal direction of said housing from said second operating portion;". This last part of the claim, in its various versions, reads as follows:

New auxiliary request I:

"[...] from said second operating portion]; an acceleration sensor (68) provided within said housing (12); and an imaging information arithmetic unit (54) comprising an image processing circuit (76) and an infrared imaging means (56) provided at said one end of said housing (12) in such a manner that it can perform imaging in a direction along said longitudinal direction (C1) wireless output means (70, 72) including a wireless module (70) for outputting operation signals from the first operating portion (26;42) and the second operating portion (42;28), data from the imaging information arithmetic unit (54), and acceleration data from the acceleration sensor (68)".

New auxiliary request II:

"[... from said second operating portion];  
an acceleration sensor (68) and a processor (66)  
provided within said housing (12); the processor  
receiving acceleration data from the acceleration  
sensor and  
an imaging information arithmetic unit (54) comprising  
an image processing circuit (76) and an infrared  
imaging means (56) provided at said one end of said  
housing (12) in such a manner that it can perform  
imaging in a direction along said longitudinal  
direction (C<sub>1</sub>)  
wireless output means (70, 72) including a wireless  
module (70) for outputting operation signals from the  
first operating portion (26;42) and the second  
operating portion (42;28), data from the imaging  
information arithmetic unit (54), and acceleration data  
from the Acceleration sensor (68)".

New auxiliary request III:

"[... from said second operating portion];  
an acceleration sensor (68) provided within said  
housing (12); and  
an imaging information arithmetic unit (54) comprising  
an image processing circuit (76) and an infrared  
imaging means (56) provided at said one end of said  
housing (12) in such a manner that the infrared imaging  
means (56) can perform imaging in a direction along  
said longitudinal direction (C<sub>1</sub>);  
a processor receiving acceleration data from the  
acceleration sensor, operation signals from the first  
operating portion (26;42) and the second operating  
portion (42;28), and data from the imaging information  
arithmetic unit (54); and



wireless output means (70, 72) including a wireless module (70) for outputting the operation signals from the first operating portion (26;42) and the second operating portion (42;28), the data from the imaging information arithmetic unit(84), and the acceleration data from the acceleration sensor (68)".

IX. Auxiliary requests I, II, IIA, III, IIIA, IV, IVA, V, VA

The feature of claim 1 of the main request reading: "an acceleration sensor (68) provided within said housing" has been referred to by the parties as "feature g".

In claim 1 of auxiliary requests II, IIA, III and IIIA, feature g reads as in the main request.

In claim 1 of auxiliary requests I, IV, IVA, V and VA, feature g is amended to read:

"a linear acceleration sensor (68) provided within said housing".

Otherwise, claim 1 of these requests reads as for the main request or at most adds features related to the infrared imaging means and associated image processing.

X. The appellant-opponent I argued that claim 1 in all its versions adds subject matter extending beyond the application as filed. In particular, all versions of feature g (acceleration sensor) represent an inadmissible intermediate generalisation of the embodiment as originally disclosed. The auxiliary requests should not be admitted into the proceedings.

- XI. The respondent-proprietor argued that none of the versions of claim 1 add subject matter extending beyond the application as filed. The auxiliary requests are filed as a reaction to the Board's communication and discussions at the oral proceedings so should be admitted.

### **Reasons for the Decision**

1. The appeal is admissible.

2. Introduction

The patent (see published patent specification, paragraph [0001]) relates to a [hand held] game operating device.

One of the amendments to claim 1 as upheld by the opposition division with respect to claim 1 as originally filed is that the controller comprises "an acceleration sensor provided within [the] housing" (referred to as feature "g").

3. Amendments

- 3.1 In deciding the question of allowability of amendments under Article 123(2) EPC, following well established practice (see Case Law of the Boards of Appeal, 8th edition, 2016 (CLBA), II.E.1.2.1 and in particular G2/10, reasons 4.3), the Board must consider whether the amendments in question are directly and unambiguously derivable by the skilled person from the whole of the application as filed, using normal reading skills and, where necessary, taking account of their general knowledge.

3.2 It is furthermore established practice (see CLBA, II.E. 1.7 and the decisions cited therein) that it will normally not be allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, e.g. a specific embodiment in the description. Such an amendment results in an "intermediate generalisation". An intermediate generalisation is justified only in the absence of any clearly recognisable functional or structural relationship among the features of the specific combination or if the extracted feature is not inextricably linked with those features.

3.3 In the following, unless stated otherwise, references are to the published patent application (EP1757344A).

4. Added subject matter, main request, claim 1

It is not in dispute that feature g (acceleration sensor in the housing) has no basis in the original claim set. Thus, if the amendment were to have a basis in the original filing, it could but come from the description and drawings.

The opposition division (see impugned decision, reasons, points 36 and 37) considered there to be a basis for feature g in paragraph [0095]. The respondent-proprietor has agreed with this assessment.

Appellant-opponent I has argued that feature g is only disclosed in the particular embodiment with other, structurally and functionally related features which have not been claimed. From this they argue that the claim represents an inadmissible intermediate generalisation. The Board agrees with the appellant-opponent I.

- 4.1 The general disclosure of the invention (paragraphs [0008] to [0032]) makes no reference to an acceleration sensor. It is only presented as part of the controller in the detailed embodiment of the invention (see in particular paragraphs [0094] to [0104] with figures 6 and 8).
- 4.2 The acceleration sensor is first mentioned in paragraph [0095] that explains where it and a wireless module 70 are located in the controller. The Board notes that this paragraph is an integral part of the description of the detailed embodiment. Thus, the skilled person does not read it in isolation. Rather, they read the entire description of the embodiment in order to get a complete picture of how it is realised and how its various elements interact to provide this particular game controller.
- 4.3 The description explains (see paragraph [0098]) why the controller has an acceleration sensor 68. It is there because, through "additional processing" of its output signals, additional information such as tilt and attitude can be inferred: "the acceleration sensor 68 can be used in combination with the processor 66 (...) to determine tilt, attitude or position of the housing 12." Thus, the skilled person learns that the acceleration sensor 68 produces data that must be sent to the processor 66, implying a structural connection between the two. The processor 66 processes this to determine certain spatial parameters of the housing, thus the two are also functionally linked.
- 4.4 The following paragraph, [0099], confirms that the acceleration sensor and processor 66 work together to determine these spatial parameters: "[i]n this

embodiment, the acceleration sensor 68 and processor 66 function as a position and/or attitude determining means".

4.5 Thus, the acceleration sensor is disclosed functionally and structurally linked to the processor 66, which has not been claimed.

4.6 The description (see paragraph [0104]) goes on to describe what happens to this processed acceleration data. In particular, the controller comprises a wireless module 70 (cf. paragraph [0095]) with which, amongst other things, the detected acceleration data from the acceleration sensor 68 are modulated and output (as radio waves) to the game machine, so that the game progresses on the basis of these signals.

To output these radio signals, the embodiment has a particular electrical circuit structure (see paragraphs [0110] to [0112] with figure 8). In this regard, the skilled person learns (see in particular column 17, lines 49 to 56) that various signals, including an acceleration signal from the acceleration sensor 68 are input to the processor 66. The processor 66 (cf. paragraph [0112]) then outputs the acceleration data, amongst other data, to the wireless module 70 for emission by the antenna 72.

4.7 Figure 8 confirms this structure graphically: arrows show signals flow from the acceleration sensor 68 to the processor 66 and from the processor 66 to the wireless module 70.

4.8 From all of the above, the feature of the acceleration sensor 68 is not disclosed in isolation in the controller but rather only as the first link in a chain

structure with which acceleration data from the acceleration sensor is passed to the processor 66, processed there, and then passed to the wireless module 70 for sending out as radio signals. Thus, the acceleration sensor is originally only disclosed in a tight structural and functional relationship, that is inextricably linked, with the processor 66 and wireless module 70, neither of which have been claimed, let alone how they structurally and functionally interact with the acceleration sensor.

- 4.9 Applying the approach outlined above, lifting the feature of the acceleration sensor in isolation from these other features (processor and wireless module) and incorporating it into claim 1 therefore represents a new teaching which cannot be inferred from its original context. The Board concludes that it constitutes an unallowable intermediate generalisation.
- 4.10 In this regard, the Board is not convinced by the respondent-proprietor's argument that the processor 66 is an optional feature.
- 4.10.1 It may well be that parts of the description referring to the processor 66 disclose various alternative options, indicated for example by the use of the word "can", elsewhere by an alternative in parentheses (see column 14, lines 32 to 41): certain parameters *can* be calculated by the processor 66 "*(or another processor)*" -emphasis added by the Board.
- 4.10.2 However, in the Board's view, whatever parameters might be calculated as alternatives and whether or not this "other processor" is remote from the game operating device as the respondent-proprietor has suggested, does

not change the necessity of the acceleration sensor 68 sending signals to the processor 66 for processing.

- 4.10.3 This is because (see paragraph [0012]), wherever tilt attitude or position might be calculated, the processor 66 must process the acceleration data it receives from the acceleration sensor into part of a sequence of controller data, that it then sends to the wireless module 70 for outputting (to the game machine).

The semantics of paragraph [0012] ("[t]he operation data *is* output [from the processor 66] ... together with the acceleration data, and *is* input into the wireless module 70" - emphasis added by the Board) leaves the skilled person in no doubt that this structural and functional chain of acceleration sensor, processor and wireless module, with acceleration data passed from acceleration sensor 68 to processor 66, where it is processed into a data sequence before being output to the wireless module, is necessary for the game machine to progress a game using acceleration data.

The processor, as middle link in this chain, is consequently not optional.

- 4.11 By the same token, the Board is not convinced that the wireless module, as the last link in this chain, is optional. Although the respondent-proprietor has speculated that the wireless module could be replaced by a wired connection between the controller and game machine, this is nowhere described. Rather, the controller is a wireless controller (column 16, lines 20 to 24), with wireless module 70 and antenna 72. This is likewise, unmistakably shown in figure 8.

4.12 Moreover, the fact that some features, in particular the first and second operating portions are also in claim 1 of the main request without the processor and wireless module (yet disclosed in the embodiment with them) is irrelevant to the question as to whether it is justified to extract the feature of an acceleration sensor in isolation from the embodiment. This is because those particular features (the operating portions) are in original claim 1, and were therefore originally disclosed without the processor and wireless module. Consequently, their presence in present and original claim 1 implies nothing about the nature of any structural and functional relationships of features of the detailed embodiment that may subsequently be introduced into claim 1.

4.13 For all these reasons, claim 1 of the main request adds subject matter extending beyond the application as filed. Therefore this request must fail.

5. Auxiliary requests I, II, IIA, III, IIIA, IV, IVA, V, VA

5.1 Claim 1 of these requests appears to add subject matter for the same reasons as apply to the main request. Therefore, the question as to whether or not they should be admitted into the proceedings is moot.

5.2 In particular feature g of claim 1 of all these requests defines that the game operating device comprises an acceleration sensor (whether linear or not) but, as with the main request, the claim defines neither a processor for receiving acceleration data from the acceleration sensor nor a wireless module for sending the data processed by the processor.



At most, some of these requests (auxiliary requests III, IIIA, V and VA) add an image processing circuit processing image data, but not a processor processing acceleration data (cf. column 17, lines 36 to 39).

- 5.3 Therefore, as for the main request, the feature of an acceleration sensor is lifted from its functional and structural context (chain of acceleration sensor, processor and wireless module) in which it is originally disclosed, and included in claim 1 in isolation. Therefore, claim 1 of all these requests constitutes an inadmissible intermediate generalisation, which adds subject matter extending beyond the original disclosure.
6. Admissibility of the "New Auxiliary requests" I to III (filed at oral proceedings before the Board)
  - 6.1 These requests amount to an amendment to the appellant's case in the sense of Article 13 of the Rules of Procedure of the Boards of Appeal (RPBA) and their admittance is subject to the Board's discretion.
  - 6.2 Under Article 13(3) RPBA, any amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the parties cannot reasonably be expected to deal with without an adjournment.
  - 6.3 An approach frequently adopted by the Boards when exercising their discretion in admitting an amendment filed shortly before or, as in this case, during oral proceedings, can be summarised as follows: unless good reasons exist for filing the amendment so far into the proceedings, for example if it is occasioned by developments in the proceedings, it will be admitted

only if, amongst other things, it is clearly allowable, see CLBA, IV.E.4.2.1.

In accordance with established jurisprudence, amended claims are clearly allowable if the Board can quickly ascertain that they overcome all outstanding issues without raising new ones, see CLBA, IV.E.4.2.2 and, for example, T 183/09, reasons 4.

6.4 In the present case, the respondent-proprietor has argued that the new auxiliary requests have been filed at the oral proceedings in response to the Board's communication and discussions at the oral proceedings. The Board does not see this as a justification for filing the auxiliary requests so late into the proceedings.

The main issue discussed at the oral proceedings (added subject matter due to feature g) was extensively discussed in the appellant-opponent I's grounds of appeal (see pages 5 to 9). Therefore, the respondent-proprietor was aware of the "feature g issue" well before the Board issued its communication in preparation for the oral proceedings (which likewise mentioned the issue, see section 3.5).

The respondent proprietor could therefore have timely filed amendments to counter the appellant-opponent I's objection with their reply to the appeal (cf. Article 12(2) RPBA). However, they chose only to file counter arguments at that time (see pages 2-4).

6.5 Admissibility of New auxiliary request I

Claim 1 adds to the main request a wireless output means but no processor receiving acceleration data.

Here, as for the main request, the feature of an acceleration sensor is lifted from its original structural and functional context (chain of acceleration sensor, processor and wireless module, by which acceleration data is generated, processed then output), and included in claim 1 isolated from, at least the processor. Therefore, claim 1 appears to constitute an inadmissible intermediate generalisation, which renders the request not clearly allowable.

#### 6.6 Admissibility of New auxiliary requests II and III

Claim 1 of these requests adds a processor that receives acceleration data from the acceleration sensor and wireless output means, including a wireless module for outputting, amongst other things, data from the acceleration sensor. As already explained for the main request, these elements are only originally disclosed structured as a chain, with data from the acceleration sensor being passed to and processed by the processor then this processed data being passed to the wireless output means for outputting.

In these versions of claim 1, however, this original context is not present, with the wireless module outputting acceleration data from the acceleration sensor, but not necessarily after it has been processed by the processor.

Nor does the claim term "wireless output means" appear in the application as filed. Rather, the original application discloses a particular antenna pattern and a wireless module (see for example column 16, lines 20 to 24). The term "wireless output means" therefore appears to be a new generalisation of a specific

arrangement. Including this feature in the claim thus raises a new issue of added subject matter.

6.7 For these reasons, claim 1 of New auxiliary requests I to III appears not to be clearly allowable. Consequently, the Board decided not to admit these requests into the proceedings.

7. The Board concludes that claim 1 according to the main request and the auxiliary requests I, II, IIA, III, IIIA, IV, IVA, V, VA, irrespective of their admissibility, is not allowable under Article 123(2) EPC. The remaining requests, New auxiliary requests I, II and III, have not been admitted into the proceedings.

Since these are the only requests on file, the Board can but revoke the patent.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated