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**Datasheet for the decision  
of 15 December 2021**

**Case Number:** T 0282/17 - 3.5.04

**Application Number:** 06124409.1

**Publication Number:** 1755328

**IPC:** H04N101/00, H04N1/00,  
H04M1/725, H04N7/14

**Language of the proceedings:** EN

**Title of invention:**

Method and system for mobile telecommunication

**Patent Proprietor:**

Nokia Corporation

**Opponent:**

Hanna Moore & Curley Limited

**Headword:**

**Relevant legal provisions:**

RPBA 2020 Art. 13(2)

RPBA Art. 12(4)

EPC Art. 123(2), 123(3)

EPC 1973 Art. 54(1), 56

**Keyword:**

Respondent's revised second auxiliary request - admittance  
(yes)

Respondent's revised second auxiliary request - extension of  
protection (no)

Respondent's revised second auxiliary request - added subject-  
matter (no)

Respondent's revised second auxiliary request - novelty (yes)

Respondent's revised second auxiliary request - inventive step  
(yes)

Admittance of document E5 (no)

**Decisions cited:**

T 1480/16, T 0995/18, T 1792/19, T 0981/17, T 2243/18,

T 1151/18, T 0724/08, T 1911/15, T 2696/16, T 2091/18

**Catchword:**



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

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Case Number: T 0282/17 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 15 December 2021**

**Appellant:** Hanna Moore & Curley Limited  
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**Respondent:** Nokia Corporation  
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**Representative:** Swindell & Pearson Limited  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
30 November 2016 concerning maintenance of the  
European Patent No. 1755328 in amended form.**

**Composition of the Board:**

**Chair** M. Paci  
**Members:** B. Le Guen  
G. Decker

## **Summary of Facts and Submissions**

- I. The appeal is against the opposition division's interlocutory decision finding that European patent No. 1 755 328 as amended on the basis of the claims of the first auxiliary request filed during the oral proceedings of 22 September 2016 met the requirements of the EPC.
- II. The prior-art documents cited in the decision included the following:
- E1: EP 1 148 725 A2  
E2: US 6,317,609 B1
- III. The opposition division came to the following conclusions:
- The then main request did not meet the requirements of Articles 123(2) and 84 EPC.
  - The then first auxiliary request met the requirements of the EPC with respect to novelty, inventive step, clarity and added subject-matter (Articles 84, 54, 56 and 123(2) EPC).
- IV. The opponent ("appellant") filed notice of appeal. In its statement of grounds of appeal, it requested that the patent be revoked in its entirety and that oral proceedings be held if the board was not minded to grant this request. It also requested that the following prior-art document be admitted into the appeal proceedings:

E5: EP 1 158 786 A2

The appellant submitted arguments in support of the following objections against the request found allowable by the opposition division (first auxiliary request filed during the oral proceedings held on 22 September 2016):

- Claims 1 and 9 extended the protection conferred by the patent (Article 123(3) EPC).
- Claims 1, 5, 7, 8 and 9 contained subject-matter extending beyond the content of the application as filed (Article 123(2) EPC).
- The subject-matter of all claims lacked novelty (Article 54 EPC) over the disclosure of document E1 or document E5.
- The subject-matter of all claims lacked inventive step (Article 56 EPC) over the disclosure of document E1 or document E5 in combination with either the disclosure of document E2 or the common general knowledge of the person skilled in the art.

V. By letter dated 11 August 2017, the patent proprietor ("respondent") filed sets of amended claims according to first to fourth auxiliary requests. It requested that the patent be maintained either in the form upheld by the opposition division (main request) or on the basis of the claims of one of the first to fourth auxiliary requests filed with its letter. The respondent also requested that oral proceedings be held if the board was minded not to allow any of these requests.

The respondent further requested the board not to admit document E5 into the appeal proceedings. Alternatively, if the board were to consider document E5 relevant to the patentability of the invention and prejudicial to the maintenance of the patent, the respondent requested that the case be remitted to the department of first instance so that E5 could be examined at two levels of jurisdiction.

VI. In a letter dated 27 February 2018, the appellant provided further arguments in support of the admittance of document E5 into the appeal proceedings. It also provided arguments in support of the following objections with respect to the requests submitted by the respondent with its letter dated 11 August 2017:

- The main request and the first auxiliary request did not meet the requirements of Article 123(3) EPC.
- None of the requests met the requirements of Article 123(2) EPC.
- The subject-matter of the claims of all requests lacked novelty over the disclosure of document E1 or document E5.
- The subject-matter of the claims of all requests lacked inventive step over the disclosure of document E1 or document E5 in combination with either the disclosure of document E2 or the common general knowledge of the person skilled in the art.

VII. The board issued a summons to oral proceedings. In a communication under Article 15(1) of the revised version of the Rules of Procedure of the Boards of

Appeal 2020 ("RPBA 2020"; see OJ EPO 2019, A63) dated 30 March 2021 ("the board's communication"), it gave the following preliminary opinion with respect to the respondent's requests:

- Claim 9 of the main request and of the first auxiliary request extended the protection conferred by the patent but claim 1 did not.
- Claims 5, 7, 8 and 9 of the main request and of the first auxiliary request contained subject-matter extending beyond the content of the application as filed but claim 1 did not.
- Document E5 should not be admitted into the appeal proceedings.
- The subject-matter of claim 1 of all requests was new over the disclosure of document E1 but lacked an inventive step in view of the disclosure of document E1 combined with the common general knowledge of the person skilled in the art.

In its communication, the board also invited the parties to provide comments on specific issues pertaining to whether the respondent's second auxiliary request met the requirements of Article 123(2) and (3) EPC.

VIII. By letters dated 18 October 2021 and 25 October 2021, respectively, the appellant and the respondent requested that the oral proceedings scheduled for 15 December 2021 be held by videoconference.

IX. With a letter dated 12 November 2021, the respondent filed sets of amended claims according to a main

request and first to fourth auxiliary requests to replace the requests filed with its letter dated 11 August 2017. The respondent provided arguments as to why the claims of its requests met the requirements of Article 123(2) and (3) EPC and why their subject-matter was new and involved an inventive step.

X. By letter dated 23 November 2021, the appellant submitted *inter alia* that the requests filed by the respondent with the letter dated 12 November 2021 "should not be admitted in accordance with the RPBA 2007 Articles 12 & 13".

XI. The oral proceedings before the board were held by videoconference on 15 December 2021, as requested by the parties.

During the oral proceedings, the respondent withdrew the main request and the first auxiliary request filed with the letter dated 12 November 2021 and replaced the second to fourth auxiliary requests filed by that letter with a revised second auxiliary request, a revised third auxiliary request and a revised fourth auxiliary request.

The appellant's final requests were that the decision under appeal be set aside and that the patent be revoked in its entirety.

The respondent's final requests were that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims of the revised second auxiliary request filed during the oral proceedings of 15 December 2021 and description columns 1 to 7 of the patent specification and drawings sheets 1/5 to 5/5 of the patent



specification, or on the basis of the claims of the revised third or fourth auxiliary requests filed during the oral proceedings of 15 December 2021.

At the end of the oral proceedings, the chair announced the board's decision.

XII. Claim 1 of the **revised second auxiliary request** filed during the oral proceedings before the board reads as follows:

"A method comprising: establishing a wireless telecommunication connection between a first telecommunication device and another telecommunication device,

- creating, using a camera, image information in the first telecommunication device during the telecommunication connection to the another telecommunication device;

- offering on a user interface of the first telecommunication device, in response to a determination that image information has been created using the camera during said telecommunication connection, a user selectable option to send the created image information from the first telecommunication device to the another device with which the telecommunication connection has been established; and

sending, in response to user selection of the user selectable option, the created image information from the first telecommunication device to the another device, while the telecommunication connection between

the first telecommunication device and the another telecommunication device is still active."

XIII. Claim 4 of the **revised second auxiliary request** filed during the oral proceedings before the board reads as follows:

"A telecommunication device (200) comprising;

- a camera

- means for establishing a wireless telecommunication connection to another telecommunication device;

- means (201) for creating, using the camera, image information during the telecommunication connection with the another telecommunication device;

- means (201, 209) for offering on a user interface of the telecommunication device, in response to a determination that image information has been created using the camera during said telecommunication connection, a user selectable option to send the created image information to the another telecommunication device with which the telecommunication connection has been established; and

- means for sending, in response to user selection of the user selectable option, the created image information from the telecommunication device to the another device, while the telecommunication connection between the telecommunication device and the another telecommunication device is still active."

XIV. The main request and the second auxiliary request filed with the letter dated 12 November 2021 were both

withdrawn during oral proceedings before the board. The parties arguments' regarding the admittance of those two requests are relevant for deciding on the admittance of the revised second auxiliary request and may be summarised as follows.

*Respondent's arguments*

The amended claims of the **main request** resolved issues raised in the board's communication and did not give rise to any new objections or create a fresh case.

The **second auxiliary request** addressed an issue under Article 123(2) EPC raised for the first time in point 9.2 of the board's communication, namely the fact that the application as filed might not provide a basis for not specifying whether the created image information was sent while the telecommunication connection was active.

*Appellant's arguments*

The **main request** was filed at the very last minute. It could have been filed in 2017 or promptly after the summons to oral proceedings had been issued. Moreover, replacing the expression "at least one" with the term "another" in claim 5 *prima facie* did not address the issue under Article 123(2) EPC raised in the statement of grounds of appeal because it still did not exclude a connection to more than one telecommunication device.

The **second auxiliary request** could have been filed earlier. In the inventive-step analysis in its statement of grounds of appeal, the appellant had stated that the claims did not address the sending of image information at all. Moreover, introducing the

sending step in claim 1 created a fresh and more complex case. In particular, it rendered the combination of claims 1 and 2 unclear.

- XV. The parties' arguments regarding the **admittance of the revised second auxiliary request** may be summarised as follows.

*Respondent's arguments*

Deleting dependent claim 2 was a reaction to an issue under Article 123(2) EPC raised for the first time during oral proceedings before the board, namely the fact that the application as filed did not directly and unambiguously disclose that the created image information was provided to a user of "the another device" through the established telecommunication connection.

*Appellant's arguments*

Dependent claim 3 recited a method "in accordance with any preceding claim". In one dependency branch, therefore, dependent claim 3 was dependent on dependent claim 2. The combination of dependent claims 2 and 3 led to a method in which the telecommunication connection involved both a voice connection and a data connection. This scenario was *prima facie* not disclosed in the application as filed. For this reason, the revised second auxiliary request should not be admitted into the appeal proceedings.

- XVI. The parties' arguments regarding **whether the revised second auxiliary request meets the requirements of Article 123(3) EPC**, in so far as relevant to the decision, may be summarised as follows.

*Appellant's arguments*

Claim 1 as granted "at best" covered a method in which a user selectable option was offered during the same telecommunication connection in which the image information was created. Due to the deletion of the comma preceding the expression "during said telecommunication connection", claim 1 of the revised second auxiliary request also covered methods in which the user selectable option was offered once the established telecommunication had been terminated.

*Respondent's arguments*

The amendment to correct the commas in amended claim 1 as maintained by the opposition division rectified an obvious error.

- XVII. The parties' arguments regarding **whether the revised second auxiliary request meets the requirements of Article 123(2) EPC**, in so far as relevant for this decision, may be summarised as follows.

*Appellant's arguments*

- (a) Claim 1 covered methods in which the user selectable option was offered after the established telecommunication had been terminated. The application as filed did not disclose offering a user selectable option without an active telecommunication connection.
- (b) Claim 1 covered methods in which image information was created by a camera that was not integrated in

the telecommunication device. This was not disclosed in the application as filed.

- (c) The step of "establishing a wireless telecommunication connection between a first telecommunication device and **another** telecommunication device" in claim 1 and the "means for establishing a wireless telecommunication connection to **another** telecommunication device" in claim 4 (emphasis added by the board) did not exclude the possibility of a one-to-many wireless telecommunication connection being established. There was no basis in the application as filed for establishing a one-to-many telecommunication connection. It was not clear how the invention worked in the case of a one-to-many telecommunication connection.

*Respondent's arguments*

- (d) The application as originally filed did not state that the user selectable option had to be offered during a telecommunication connection or that any such feature was essential to the functioning of the invention.
- (e) Figure 2B clearly showed a system in which the camera 252 was not integral with the communication device 250.
- (f) Support for establishing a wireless telecommunication connection between a first telecommunication device and "another" telecommunication device was provided on page 1, lines 23 to 26, page 2, lines 28 to 31 and page 4, lines 23 to 31 of the application as filed. The

appellant's objection that it was not clear how the invention worked in the case of a one-to-many telecommunication connection related to the issue of sufficiency of disclosure, not of added subject-matter. An issue of sufficiency of disclosure had never been raised in the appeal proceedings.

XVIII. The parties' arguments regarding **the admittance of document E5 into the appeal proceedings** may be summarised as follows.

*Appellant's arguments*

Document E5 came to the appellant's attention after the decision under appeal was issued. It was a reaction to the opposition division's narrow interpretation of document E1, which had taken the appellant by surprise. Furthermore, it *prima facie* disclosed that, in response to a determination that image information has been created using a camera during an active telecommunication connection between a first and another telecommunication device, a user selectable option is offered, on a user interface of the first telecommunication device, to send the created image information from the first telecommunication device to "the another device" with which the telecommunication connection has been established, as required by claim 1 of the revised second auxiliary request. In particular, Figure 19 of document E5 illustrated how a user of a first telecommunication device specified a region of an image that was to be transmitted. The user selected the region and pressed a button ("button 56") to lock it. The button was responsive to the region being specified. Region information was created before the button was pressed. Any image captured afterwards was

adjusted according to these settings. The sending of the region information to the other telecommunication device was "inherent".

*Respondent's arguments*

The appellant had not provided any substantive reasons why document E5 had not been introduced into the proceedings before the appeal stage. In any case, document E5 was not *prima facie* prejudicial to the maintenance of the patent. It was not *prima facie* clear whether the region information selected by the user according to Figure 19 was sent to the other telecommunication device.

- XIX. The parties' arguments regarding whether **the subject-matter of claim 1 of the revised second auxiliary request is new in view of the disclosure of document E1** may be summarised as follows.

*Respondent's arguments*

- (a) Interpreted properly, claim 1 specified that a wireless telecommunication connection had already been established when image information was created using the camera and that the creation of the image information triggered the offering of the user selectable option. This meant that the user selectable option was offered dynamically in response to a determination that certain conditions had been met.
- (b) The offering of the two keys 111b and 111c described in document E1 was not triggered dynamically by the creation of image information. These keys were physical keys present at all times.



- (c) The keys 111b and 111c did not represent "a user selectable option to send the created image information from the first telecommunication device to the another device with which the telecommunication connection has been established", as required by claim 1. According to claim 1, the created image information to be sent after selecting the option was image information that had been created before the option had been selected, i.e. retrospective image information. In contrast, the image information sent in E1 after one of the keys 111b and 111c was pressed was image information created after the key had been pressed, i.e. prospective image information.
- (d) Figure 3 of document E1 showed the internal structure of the picture-data processing unit. It was not a flow diagram detailing the sequencing steps required to create the output of the picture-data processing unit. Therefore, it could not be deduced from this figure that image information created before one of the keys 111b and 111c was pressed (retrospective image information) was sent to the recipient.

*Appellant's arguments*

- (e) Claim 1 could not be read as specifying that the creation of the image information dynamically triggered the offering of the user selectable option because the application as filed did not disclose the concept of dynamically offering a user selectable option. Claim 1 encompassed the case where the user selectable option was offered permanently. Therefore, the offering specified in

claim 1 encompassed the keys 111b and 111c disclosed in document E1. These keys would be of no use if image information was not being created, so they were responsive to image information being created.

- (f) Paragraph [0101] of E1 disclosed that the key 111b was not offered until live pictures had been created. In particular, the last sentence of this paragraph specified that the user on the picture-sending side could be allowed to start sending their live picture when they actively wanted to show it to the other party.
  
- (g) E1 implicitly disclosed the case where retrospective image information was sent after one of the keys 111b and 111c was pressed. According to its abstract, E1 related to a videophone apparatus taking a live picture of the user. It was therefore implicit that the camera of the videophone apparatus captured a live picture at all times. According to Figure 3, this live picture was continuously fed to the unit 170a from the imaging unit. The case where a live picture had just been created at the time one of the keys 111b and 111c was pressed and was selected to be sent by the system control unit was inevitable. This live picture constituted retrospective image information.
  
- (h) Claim 1 did not exclude the possibility that image information other than the created information triggering the offering was also sent to the other telecommunication device. This would happen, for example, if the image information was a video, in which case no difference could be recognised

between the permanent offering of the keys 111b and 111c and the offering specified in claim 1.

XX. The parties' arguments regarding **whether the subject-matter of claim 1 of the revised second auxiliary request involves an inventive step**, in so far as relevant for the decision, may be summarised as follows.

*Appellant's arguments*

- (a) The technical effect of an offering of a user selectable option being triggered by the creation of image information was merely that the offering was represented not by a physical key but by a soft button on a graphical user interface. If the sole remaining difference was that image information was sent straight to the other telecommunication device after being taken while the connection was active, it was not clear what problem was solved.
- (b) Replacing the physical keys disclosed in document E1 with software keys would have been obvious for a person skilled in the art.
- (c) The person skilled in the art would have found it obvious to only activate the combined-picture option disclosed in E1 in response to a determination that image information had been created using the camera during said telecommunication connection because the combined picture was useless if no image information was being created and sent over the telecommunication connection.

*Respondent's arguments*

- (d) An offering of a user selectable option being triggered by the creation of image information improved the sending of image information from one device to another.
- (e) E1 was silent with regard to keys 111b and 111c being provided in any form other than physical keys. The person skilled in the art would not have replaced the physical keys described in document E1 with software keys. E1 related to a system designed to protect the privacy of a videophone apparatus user. Physical keys were better than software keys to protect the user's privacy.
- (f) Even if, for the sake of argument, it were considered obvious to replace a physical key with a software key, nothing in E1 hinted at dynamically offering the software key. Moreover, even if, for the sake of argument, it were considered obvious to modify E1 so as to both provide a software key and dynamically offer the software key, nothing in E1 hinted at dynamically offering a software key on the basis of the conditions specified in claim 1, namely "in response to a determination that image information has been created using the camera during the telecommunication connection".
- (g) Even if, for the sake of argument, it were considered obvious to replace a physical key with a software key and to dynamically offer a software key on the basis of the conditions specified in claim 1, the person skilled in the art would have found no prompt in E1 to modify the functionality of the software key in such a way that selecting it

triggered the sending of the retrospective image information whose creation generated (or activated) the software key.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Revised second auxiliary request, admittance (Article 13(2) RPBA 2020)*
  - 2.1 The respondent's revised second auxiliary request was filed during the oral proceedings before the board, i.e. after notification of the summons to oral proceedings. Since this notification was issued after the date on which the RPBA 2020 entered into force (i.e. 1 January 2020; see Article 24(1) RPBA 2020), Article 13(2) RPBA 2020 applies to the question of whether to admit this request into the appeal proceedings (see Article 25(1) and (3) RPBA 2020).
  - 2.2 Under Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings is, in principle, not to be taken into account unless there are exceptional circumstances which have been justified with cogent reasons by the party concerned.
  - 2.3 The set of claims of the revised second auxiliary request corresponds to that of the second auxiliary request filed with the letter dated 12 November 2021, except for the deletion of dependent claim 2.

In comparison with claim 1 of the second auxiliary request filed with the reply to the appeal dated 11 August 2017, claim 1 of the second auxiliary request filed by the letter dated 12 November 2021 comprises the step of sending, in response to user selection of the user selectable option, the created image information from the telecommunication device to "the another device", while the telecommunication connection between the telecommunication device and the another telecommunication device is still active; the same applies to the corresponding means in claim 5. Claims 1 and 4 of the revised second auxiliary request contain corresponding amendments.

The second auxiliary request filed by the letter dated 12 November 2021 also contained amendments present in the claims of the main request filed with this letter, namely the deletion of claims 7 to 10 and the replacement, in independent claim 5, of the expression "at least one other" with the term "another".

Since all the amendments mentioned in this point were made after the notification of the summons to oral proceedings, they are subject to Article 13(2) RPBA 2020.

- 2.4 The board agrees with the respondent that deleting dependent claim 2 from the second auxiliary request filed by letter dated 12 November 2021 was a reaction to an issue under Article 123(2) EPC raised for the first time during oral proceedings before the board, namely the fact that the application as filed did not directly and unambiguously disclose that the created image information was provided to a user of the another device through the established telecommunication connection (see point XV. above). Dependent claim 2 was

present in all the requests previously filed by the respondent in these appeal proceedings. The issue under Article 123(2) EPC not being raised until the oral proceedings constitutes an exceptional circumstance justifying the deletion of dependent claim 2.

2.5 The board also agrees with the respondent that the addition, in claims 1 and 5 of the second auxiliary request filed by the letter dated 12 November 2021 (corresponding to claims 1 and 4 of the revised second auxiliary request), of the step and means for "*sending, in response to user selection of the user selectable option, the created image information from the telecommunication device to the another device, while the telecommunication connection between the telecommunication device and the another telecommunication device is still active*" addressed an issue under Article 123(2) EPC raised for the first time in point 9.2 of the board's communication, namely the fact that the application as filed might not provide a basis for not specifying whether the created image information was sent while the telecommunication connection was active (see point XIV. above). Therefore, this amendment is also justified by exceptional circumstances.

2.6 Furthermore, replacing the expression "at least one other" with the term "another" in claim 5 of the main request filed by the letter dated 12 November 2021 (corresponding to claim 4 of the revised second auxiliary request) cannot create a fresh case since the term "another" was already present in claim 1 of the request considered allowable by the opposition division. Deleting claims 7 to 10 in accordance with the main request filed by the letter dated 12 November 2021 did not create a fresh case either. As

a result, while these amendments constitute "amendments" within the meaning of Article 13(2) RPBA 2020 (see T 2091/18, Reasons 3-5), they merely limit the respondent's appeal case and do not lead to a substantive change of the subject-matter that would require a complete reassessment of the case (see also decisions T 1480/16, T 995/18, T 1792/19, T 981/17, T 2243/18 and T 1151/18). These circumstances can be regarded as "exceptional" within the meaning of Article 13(2) RPBA 2020.

2.7 When exercising its discretion under Article 13(2) RPBA 2020, the board **may** also rely on criteria set out in Article 13(1) RPBA 2020 (see Document CA/3/19, section VI, Explanatory remarks on Article 13(2), fourth paragraph). However, the board is not required to do so.

2.8 The board notes that the alleged *prima facie* issue under Article 123(2) EPC put forward by the appellant with respect to dependent claim 3 of the revised second auxiliary request (see point XV. above) could have been raised in the statement of grounds of appeal with respect to claim 4 of the request that the opposition division had considered allowable, but it was not. For this reason, the board considers it inappropriate to take this alleged *prima facie* issue into account when deciding whether to admit the revised second auxiliary request. In any case, as pointed out by the respondent, the expression "voice or/and data connection" on page 3, line 27 of the application as filed appears to *prima facie* rebut the appellant's objection.

2.9 In view of the above, the board, exercising its discretion under Article 13(2) RPBA 2020, admitted the



revised second auxiliary request into the appeal proceedings.

3. *Revised second auxiliary request, extension of the protection conferred by the patent (Article 123(3) EPC)*

3.1 The European patent may not be amended in such a way as to extend the protection it confers (Article 123(3) EPC).

3.2 Claim 1 of the patent as granted reads:

"A method comprising: establishing a wireless telecommunication connection between a first telecommunication device and another telecommunication device,

- creating, using a camera, image information in the first telecommunication device during the telecommunication connection to the another telecommunication device; and

- offering on, a user interface of the first telecommunication device in response to a determination that image information has been created using a lumen, during said telecommunication connection, a user selectable option to send the created image information from the first telecommunication device to the another device with which the telecommunication connection has been established."

3.3 Claim 1 of the respondent's revised second auxiliary request reads (additions and deletions with respect to claim 1 of the patent as granted are underlined and crossed out, respectively).

"A method comprising: establishing a wireless telecommunication connection between a first telecommunication device and another telecommunication device,

- creating, using a camera, image information in the first telecommunication device during the telecommunication connection to the another telecommunication device; and

- offering on ~~a~~ user interface of the first telecommunication device, in response to a determination that image information has been created using ~~a lumen~~, the camera during said telecommunication connection, a user selectable option to send the created image information from the first telecommunication device to the another device with which the telecommunication connection has been established; and sending, in response to user selection of the user selectable option, the created image information from the first telecommunication device to the another device, while the telecommunication connection between the first telecommunication device and the another telecommunication device is still active."

3.4 The board disagrees with the appellant that deleting the comma preceding the expression "*during said telecommunication connection*" meant that claim 1 of the revised second auxiliary request covered methods in which the user selectable option is offered after the established telecommunication has been terminated (see point XVI. above). As stated by the opposition division in point 14.9 of the decision, "*the telecommunication being active is the condition in which claim 1 ... operates*". The method defined in claim 1 of the revised

second auxiliary request comprises a step of establishing a wireless telecommunication connection between a first telecommunication device and another telecommunication device and a step of "*offering ... a user selectable option to send the created image information from the first telecommunication device to the another device with which the telecommunication connection **has been established***" (emphasis added by the board). Interpreted properly in the context of the patent, the expression "has been established" in both claim 1 as granted and claim 1 of the revised second auxiliary request expresses the fact that the user selectable option is offered while the telecommunication connection is active. Indeed, the aim of the granted patent is to provide a solution that allows two (mobile) telecommunication devices to exchange text or multimedia messages during a voice call (see paragraphs [0003] and [0004]). Paragraphs [0010], [0015] and [0016] of the granted patent specify that, upon determining that an image has been taken by a user, the device edits the user interface by offering a possibility to send the captured image straight to the device with which it is in communication. Paragraph [0022] further clarifies that the communication connection is still active between the two devices when the image information is sent, which means that the user interface, i.e. the "*offering of a user selectable option*" according to claim 1 as granted, must also be displayed when the communication connection is active.

- 3.5 Therefore, the board concludes that the revised second auxiliary request meets the requirements of Article 123(3) EPC.

4. *Revised second auxiliary request, added subject-matter (Article 123(2) EPC)*

4.1 The European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

This means that the patent can only be amended within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole disclosure of the invention in the description, claims and drawings of the application as filed (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019 ("Case Law"), II.E.1.1).

4.2 *Offering a user selectable option without an active telecommunication connection (see point XVII.(a) above)*

For the reasons given under point 3.4 above, the board disagrees with the appellant that, when claim 1 of the revised second auxiliary request is interpreted properly, a user selectable option is offered **without** an active telecommunication connection. There is thus no need to consider whether this feature is disclosed in the application as filed.

4.3 *Camera not integrated with the device (see point XVII.(b) above)*

The board disagrees with the appellant that, interpreted properly, the expression "*creating, using a camera, image information **in** the first telecommunication device*" (emphasis added by the board)

encompasses creating image information using a camera that is not integrated in the first telecommunication device. According to page 2, line 6 of the application as filed, the act of creating an image is to be equated with the act of taking the image. If the image is taken with a camera **in** the first telecommunication device, then the camera must be part of the first telecommunication device. Therefore, there is no need to consider whether the application as filed discloses creating image information with a camera that is **not** integrated in the device.

- 4.4 *Establishing a wireless telecommunication connection between a first telecommunication device and **another** telecommunication device (see point XVII.(c) above)*

The passages of the application as filed cited by the respondent during the oral proceedings before the board (see point XVII.(f) above) provide verbatim basis for establishing a wireless telecommunication connection between a first telecommunication device and **another** telecommunication device. Therefore, this feature does not extend the claimed subject-matter beyond the content of the application as filed. The question of how something works (see appellant's last argument under point XVII.(c) above) is irrelevant for assessing whether the claimed subject-matter extends beyond the content of the application as filed.

- 4.5 For the above reasons, the appellant has not convinced the board that the revised second auxiliary request does not meet the requirements of Article 123(2) EPC.

5. *Admission of document E5, Article 12(4) RPBA 2007*
- 5.1 Under Article 12(4) RPBA 2007 (OJ EPO 2007, 536; as to its applicability, see Article 25(2) RPBA 2020, OJ EPO 2019, A63), the board has the discretionary power to hold inadmissible evidence which could have been presented in the first-instance proceedings.
- 5.2 Against that background, the decisive issue in the case in hand is whether there was a sound and plausible reason for not filing document E5 until the appeal proceedings (Case Law, V.A.4.11.3(a)).
- 5.3 The board cannot identify any late turn of events during the opposition proceedings that could have taken the appellant (then opponent) by surprise (see appellant's argument in point XVIII. above). An opponent should always plan for the eventuality that an opposition division may not accept its view on the disclosure of a document cited in the notice of opposition. This reason cannot, as such, be used as a pretext for restarting the opposition proceedings on appeal.
- 5.4 Admitting a new document into the appeal proceedings merely because an opponent only became aware of it after the first-instance decision was taken would mean that the opposition proceedings could last forever. This runs counter to the requirement of the EPC that all relevant information be presented within certain time limits. Document E5 could and should have been cited with the notice of opposition.
- 5.5 While, in exercising its power under Article 12(4) RPBA 2007, the board could consider the *prima facie* relevance of document E5, it is not required to do so

(see T 724/08, Reasons 3.4; T 1911/15, Reasons 1.3.6; T 2696/16, Reasons 1.2.8). In any case, the board has doubts about the *prima facie* relevance of document E5. The appellant stated that it was "inherent" in document E5 that the region information was sent to the other telecommunication device (see point XVIII. above) but did not cite any passage of the document in support of that assertion.

5.6 For the above reasons, the board did not admit document E5 into the appeal proceedings.

6. *Revised second auxiliary request, novelty (Article 54(1) EPC 1973)*

6.1 Under Article 54(1) EPC 1973, an invention must be considered new if it does not form part of the state of the art.

A prior-art document is novelty-destroying if it discloses the claimed subject-matter, explicitly or implicitly, in consideration of the common general knowledge of the person skilled in the art (Case Law, I.C.4.1).

6.2 The board agrees with the respondent that, when interpreted properly in the context of the patent, claim 1 specifies dynamically offering a user selectable option in response to a determination that certain conditions are met (see point XIX.(a) above). Interpreting claim 1 as encompassing the case where the user selectable option was offered permanently (see appellant's argument under point XIX.(e) above) would mean that the expression "in response to a determination that image information has been created using the camera during said telecommunication

connection" would have no limiting effect on its subject-matter. This would be inconsistent with the embodiments of the description, which all teach automatically triggering the offering of a user selectable option once it is determined that the user has captured image information and that the device is in a state of data connection with another device (see the description of steps 101 to 103 of Figure 1a and steps 111 to 113 of Figure 1b in the passage from page 2, line 24 to page 4, line 6 of the application as filed and paragraphs [0015] and [0016] of the patent, as well as the paragraph bridging pages 6 and 7 of the application as filed and paragraph [0021] of the patent).

6.3 The board agrees with the opposition division (see point 15.1 of the decision) and the respondent (see point XIX.(b) above) that the offering of the two keys 111b and 111c described in document E1 is not dynamically triggered by the creation of image information during the telecommunication connection. These keys are always available on the user interface and can be pressed by the user at any time to trigger the sending of either a live picture (key 111b) or a processed picture (key 111c). The last sentence of paragraph [0101] of E1, referred to by the appellant (see point XIX.(f) above), merely describes the possibility that the user can start sending their live picture when they are ready to show themselves to their interlocutor.

6.4 The board does not find it necessary to consider whether, when implementing the system of document E1, situations could occur in which a retrospective image would be sent to the other telecommunication device once one of the keys 111b and 111c is pressed (see



appellant's arguments under point XIX.(g) above). The reason being that, even in these situations, the offering of the option underlying the pressed key would still not be triggered by the creation of this retrospective image since this option is available to the user at any time.

- 6.5 The fact that claim 1 does not exclude the possibility that image information other than the created information triggering the offering is also sent to the recipient (see appellant's arguments under point XIX.(h) above) is irrelevant for the question of whether the subject-matter of claim 1 is new over the disclosure of document E1. Claim 1 requires that (i) the creation of image information triggers an offering of the user selectable option and (ii) the created image information that triggered the offering is sent to the other telecommunication device. These requirements are valid even where the operation selected by the user on their telecommunication device is the capture of a video. They are not disclosed in document E1.
- 6.6 The reasons given in this section with respect to claim 1 of the revised second auxiliary request apply similarly to independent claim 4.
- 6.7 In view of the above, the board concludes that the subject-matter of independent claims 1 and 4 of the revised second auxiliary request is new over the disclosure of document E1.

7. *Respondent's revised second auxiliary request, inventive step (Article 56 EPC 1973)*
- 7.1 An invention must be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art (Article 56 EPC 1973).
- 7.2 The appellant considers document E1 appropriate "closest prior art" in the context of the "problem/solution approach" (see point 7.1 of the statement of grounds of appeal). This was not disputed by the respondent.
- 7.3 The board disagrees with the appellant that the only technical effect achieved by the features identified under point 6.5 above is that the offering is represented not by a physical key but by a soft button on a graphical user interface (see point XX.(a) above). Offering the user of a telecommunication device an option in response to image information having been captured during a telecommunication connection with another device credibly assists the user in quickly sending the captured image information to the other device by avoiding the need to select the captured image information from the memory and to specify data identifying the other device.
- 7.4 The technical background of the patent is a telecommunication device establishing a voice connection with another device (see paragraph [0003]). As stated in paragraph [0010] of the patent, the purpose is to simplify and speed up the sending of various kinds of multimedia messages from one device to another when the device is in communication-connection with the other device. As indicated under point 7.3

above, this problem is solved by the subject-matter of claim 1.

- 7.5 In view of this, the board finds it justified to formulate the objective technical problem as improving the sending of image information from one device to another, as proposed by the respondent (see point XX.(d) above).
- 7.6 The board agrees with the respondent (see point XX.(g) above) that even if it were to be considered obvious to replace the physical keys described in E1 with software keys and to dynamically offer the software keys on the basis of the conditions specified in claim 1 (see the appellant's arguments under point XX.(b) and (c) above), the person skilled in the art would have found no prompt in E1 to modify the functionality of the software key in such a way that selecting it triggered the sending of the retrospective image information **whose creation generated (or activated) the software key**, as required by claims 1 and 4 of the revised second auxiliary request.
- 7.7 This reason is sufficient to arrive at the conclusion that the subject-matter of claims 1 and 4 involves an inventive step in view of the disclosure of document E1 combined with the common general knowledge of the person skilled in the art.
- 7.8 The board notes that the appellant did not make any comment in the appeal proceedings with respect to the disclosure of document E2. Therefore, the board does not consider it appropriate to consider this disclosure.

7.9 Consequently, the appellant has not convinced the board that the subject-matter of claims 1 and 4 of the revised second auxiliary request lacks an inventive step.

## 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 with the order to maintain the patent as amended in the following version:

#### Description:

Columns 1 to 7 of the patent specification

#### Claims:

No. 1 to 5 according to the revised second auxiliary request filed during the oral proceedings on 15 December 2021

#### Drawings:

Sheets 1/5 to 5/5 of the patent specification

The Registrar:

The Chair:



H. Jenney

M. Paci

Decision electronically authenticated