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Bezeichnung der Erfindung: System for electronic audio communication

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : H04M 3/50

ENTSCHEIDUNG / DECISION

vom / of / du 6 December 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

VMX Inc.

Einsprechender / Opponent / Opposant :

OI Ferranti International plc
OIII Standard Electric Lorenz AG
OV Nixdorf Computer AG

Stichwort / Headword / Référence :

EPO / EPC / CBE Article 123(2)

Schlagwort / Keyword / Mot clé : "Added subject-matter (yes)"

Leitsatz / Headnote / Sommaire



Case Number : T 339/89 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 6 December 1990

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Decision under appeal : Decision of Opposition Division of the European Patent Office dated 4 April 1989 revoking European patent No. 0 029 938 pursuant to Article 102(1) EPC.

Composition of the Board :

Chairman : P.K.J. van den Berg

Members : A. Clelland

F. Benussi

Summary of Facts and Submissions

- I. European patent No. 0 029 938 was granted on the basis of European patent application No. 80 106 949.3. Claim 1 was worded as follows:

"A telephone message communication system which is operable in a message deposit mode in which only an authorised message originator can deposit an original message in the system for one or more intended message recipients, and which is operable in a message inquiry mode in which only an authorised message recipient can inquire for and receive one or more messages from the system; the system comprising:

means responsive to a predetermined access code for enabling only an authorised message originator to gain access to the message system in said message deposit mode;

means for receiving audio messages from a telephone station and for converting said audio messages into digital representations;

memory means for storing said digital representations and for storing address data relating to one or more intended message recipients;

means to cause said digital representations and said address data to be stored in said memory means;

means for associating said digital representations with said address data;

means responsive to a predetermined access code for enabling only an authorised message recipient to gain access to the message system in said message inquiry mode;

means responsive to a special function code received by telephone from the authorised message recipient to associate any stored message intended for the inquiring message recipient with that message recipient;

means for reproducing audio messages from said digital representations; and

electronic digital signal processing means for controlling the operation of the message system, said processing means being operative, in the deposit mode, to enable only said authorised message originator to have access to the message system, in response to the predetermined access code possessed by said message originator, said access enabling storage in said memory means of one or more audio messages and address data relating to one or more intended message recipients, and said processing means being further operative, in the inquiry mode, in response to the predetermined access code possessed by the authorised message recipient and in response to the special function code, to enable sequential retrieval of any messages stored in said memory means for the authorised and intended message recipient."

- II. The patent was opposed by five opponents of whom two withdrew in the course of the proceedings, the remaining opponents being Ferranti International plc (OI), Standard Electric Lorenz AG (OIII) and Nixdorf Computer AG (OV).

- III. Oral proceedings took place on 1 March 1989. At these proceedings the Appellant (patentee) presented as a main and an auxiliary request sets of claims constituting amended versions of previously filed "subsidiary request A" and "subsidiary request F" respectively. The Respondents (opponents) requested revocation of the patent, inter alia on the ground that the revised claims did not comply with Article 123(2) EPC, in that the originally filed application did not disclose an immediate reply feature in combination with the inquiry mode as claimed in Claim 1 of both the main and auxiliary requests.

- IV. The Opposition Division revoked the patent by decision dated 4 April 1989 on the ground that Claim 1 as amended according to both the main request and the auxiliary request resulted in the patent containing subject-matter which extended beyond the content of the application as originally filed.
- V. The Appellant lodged a notice of appeal on 26 May 1989 and paid the fee on the same day. In a statement setting out the grounds of appeal, received on 3 August 1989, the main and auxiliary requests were implicitly maintained and it was argued that the revised claims did not add subject-matter. Observations were received from Respondent (OI) on 11 October 1989 and 6 October 1990, from Respondent (OIII) on 19 February 1990 and from Respondent (OV) on 12 December 1989.
- VI. In a communication pursuant to Article 110(2) EPC the Board expressed its preliminary view that Claim 1 of both the main and auxiliary request resulted in the patent containing subject-matter extending beyond the content of the application as originally filed (Article 123(2) EPC). The parties were summoned to oral proceedings.
- VII. In a telefax received 9 November 1990 the Appellant withdrew a request for oral proceedings which had been made in the statement of grounds and informed the Board and the Respondents of their intention not to attend the oral proceedings. Subsequently Respondents (OI) and (OV) announced their intention not to attend the oral proceedings.
- VIII. Oral proceedings were held on 6 December 1990 in the presence of Respondent (OIII).

IX. In the notice of appeal the Appellant requested that the decision under appeal be set aside. As observed in the Board's communication, the Appellant has not made wholly clear on what documents the appeal is based. It appears that the documents of the main request are those on which the revocation decision was based, i.e.:

Description: columns 1 to 45 of the published patent, with the amendments proposed in the letter dated 27 January 1989;

Claims: Claim 1 of "subsidiary proposal "A"" as amended, filed at the oral proceedings of 1 March 1989,
Claims 2 to 4 as filed with the letter of 27 January 1989;

Drawings: sheets 1 to 21 of the published patent.

It has been assumed that the Appellant also maintains the auxiliary request made in the course of the opposition procedure, replacing the above Claim 1 by Claim 1 in accordance with the amended "subsidiary proposal "F"".

The Respondents request that the appeal be dismissed.

X. Claim 1 in accordance with the main request reads as follows:

"A telephone voice message communication system which is accessible and operable by authorised users, whether message originators or recipients, the system being operable in:

(a) a message deposit mode in which only an authorised user can deposit a voice message and one or more addresses for one or more message recipients,

- (b) a message inquiry mode in which only an authorised user can inquire for and receive said voice message deposited in the system, and
- (c) a message reply mode in which the authorised message recipient can make an immediate voice reply to said voice message received in said inquiry mode, which voice reply can be made during one and the same telephone call and without entering an address,

the system comprising:

means responsive to a predetermined access code transmitted from any telephone by the authorised user to provide identification as an authorised user of the system;

means responsive to special function codes transmitted from said telephone to enable the authorised user to select, any one of a plurality of operating modes including said deposit, inquiry and reply modes;

means responsive to signals transmitted by said telephone to enable the message originator to enter one or more addresses into the system in said deposit mode;

means for receiving voice signals transmitted from said telephone and for converting said voice signals into digital signals representing said voice messages, in either the deposit or reply modes;

memory means for storing said digital signals and for storing data relating to said one or more addresses;

means to cause said digital signals and said data to be stored in said memory means;

means for associating the stored digital signals representing a voice message with the data relating to the respective address;

means for reproducing voice signals from the stored digital signals in said inquiry mode; and

electronic digital signal processing means for controlling the operation of the message system, said

processing means being operative in response to said access code to enable only an authorised user to gain access to the system, said access enabling the authorised user to select, by means of said special function code, the required operating mode for enabling (i) one or more voice messages and data relating to one or more addresses to be stored in said memory means in said deposit mode, (ii) sequential retrieval, in the inquiry mode, of any voice messages stored in said memory means for the intended message recipient, and (iii) an immediate reply voice message to be stored in said memory means, in said reply mode, and automatically to be associated with the requisite address."

Claim 1 of the auxiliary request reads as follows:

"A telephone voice message communication system which is operable in a message deposit mode in which only an authorised message originator can deposit an original voice message in the system for one or more intended message recipients, which is operable in a message inquiry mode in which only an authorised message recipient can inquire for and receive one or more voice messages from the system, and which is operable in a message reply mode in which the authorised message recipient can make an immediate voice reply to said voice message received in said inquiry mode, which voice reply can be made during one and the same telephone call and without entering an address;

the system comprising:

means responsive to a predetermined access code transmitted from any telephone station for enabling only an authorised message originator to gain access to the message system in said message deposit mode;

means for receiving voice messages from a telephone station and for converting said voice messages into digital representations;

memory means for storing said digital representations and for storing address data relating to one or more intended message recipients;

means to cause said digital representations and said address data to be stored in said memory means;

means for associating said digital representations with said address data;

means responsive to a predetermined access code for enabling only an authorised message recipient to gain access to the message system in said message inquiry mode;

means responsive to a special function code received by telephone from the authorised message recipient to associate any stored message intended for the inquiring message recipient with that message recipient;

means responsive to another special function code, received by telephone from the authorised message recipient in the inquiry mode, to select said reply mode whereby said immediate voice reply is received by said means for receiving voice messages and for converting them into digital representations;

means for reproducing voice messages from said digital representations; and

electronic digital signal processing means for controlling the operation of the message system, said processing means being operative, in the deposit mode, to enable only said authorised message originator to have access to the message system, in response to the predetermined access code possessed by said message originator, said access enabling storage in said memory means of one or more voice messages and address data relating to one or more intended message recipients, said processing means being further operative, in the inquiry mode, in response to the predetermined access code possessed by the authorised message recipient and in response to the special function code, to enable

sequential retrieval of any messages stored in said memory means for the authorised and intended message recipient, and said processing means being further operative, in the message reply mode, in response to said different special function code, to enable said immediate voice reply to be stored in said memory means without entering an address."

Claims 2 to 4 are the same for both the main and auxiliary requests and are dependent on Claim 1.

Reasons for the Decision

1. The appeal is admissible.
2. The patent relates to a so-called voice message system (VMS) which makes use of a computer arrangement connected to the normal telephone network. By means of the VMS a subscriber can send out messages to a single other subscriber or to a plurality of subscribers, and he can enquire whether there are any messages for him. Similarly, a caller can contact the VMS to leave a message for a subscriber. In each case the message is stored within the computer and synthesized for verbal retrieval. All subscribers to the system must identify themselves by means of an access code.

For the purposes of the present appeal it is only necessary to consider the three modes in which the system operates which are shown in the flow charts of Figures 11, 15 and 21 respectively, the DEPOSIT, DELIVERY, and INQUIRY modes. In the DEPOSIT mode, shown in Figure 11, a user records a message for forwarding to another user or users. In the DELIVERY mode, shown in Figure 15, the system calls a user with a message and if the user responds correctly, delivers the message; the user is then enabled to select

one of a number of options, including a REPLY mode in which the user is enabled to reply directly to a delivered message without the necessity of entering the sender's number. In the INQUIRY mode of Fig. 21 the user can inquire whether the system has any messages for him.

3. Claim 1 of both the main and auxiliary requests includes as a feature of the system the following mode:

"a message reply mode in which the authorised message recipient can make an immediate voice reply to said voice message received in said inquiry mode, which voice reply can be made during one and the same telephone call and without entering an address"

This feature was introduced in the course of the opposition proceedings and has no verbal counterpart in the originally filed description or claims. The flow chart for the INQUIRY mode, Figure 21, is silent as to an "immediate voice reply"; the flow chart refers to the DEPOSIT mode in connection with steps (760) and (768) but not to a reply mode. Step 764, "PLAY VOICE MESSAGE", has next to it the words "SEE FIG. 15"; the originally filed application states in connection with this Figure at page 51, lines 26 to 29 that when a user indicates that he wishes to hear a particular message, "The VMS 10 will then play the voice message at program step 764 in the same manner previously set forth in the message DELIVERY flow chart of Figure 15".

4. It is common ground that the skilled man can interpret Figure 21 and the passage quoted above in different ways, two of which are technically realistic, referred to by the Appellant as the "first choice" and "second choice". The Appellant's position is that on a fair construction of the originally filed description the skilled man would

interpret the operation of the INQUIRY mode as enabling him to make use of the REPLY mode as disclosed in connection with Figure 15. This is the "first choice". The "second choice" is based on the fact that it is technically not possible for the skilled man to import the whole of Figure 15 into Figure 21 and draws the conclusion that the references in both the description and drawing to Figure 15 are in error, Figure 17 being meant. If the skilled man chose this interpretation he would not understand a REPLY mode to be present in connection with the INQUIRY mode.

5. It is the established position of the Boards that the test for added subject-matter is a novelty test. This has recently been brought out in Decision T 194/84 as published in OJ 3/90. In the Reasons for the Decision, paragraph 2.4, it is stated:

"...The test for additional subject-matter corresponds to the test for novelty only insofar as both require assessment of whether or not information is directly and unambiguously derivable from that previously presented, in the originally filed application... It follows that an amendment is not allowable if the resulting change in content of the application, in other words the subject-matter generated by the amendment, is novel when compared with the content of the original application... Thus what "novelty test" really means is that the same standard should apply when examining novelty or allowability of amendments."

6. Applying this test to the text of the application as originally filed, it is noted that program step 764 is shown in Figure 21 as a double ended rectangle, the standard convention for a sub-routine. As an example of another sub-routine, box 754, "process user ID", may be

taken, the wording next to this box being "SEE FIG. 12". Figure 12 shows a complete sub-routine, the first and last steps being indicated by an oval bearing the number 604. The skilled man would accordingly expect program step 764, the adjacent wording to which says "SEE FIG. 15", to be represented in Figure 15 by a similar sub-routine. This is not however the case, Figure 15 merely showing at step 680 a similar "PLAY VOICE MESSAGE" sub-routine next to which are the words "SEE FIG. 17"; Figure 17 does indeed show the expected sub-routine. Moreover, the wording quoted at paragraph 3 above from page 51 of the originally filed text suggests that the "PLAY VOICE MESSAGE" sub-routine 764 of Figure 21 is carried out in the same manner as sub-routine 680 of Figure 15, i.e. as shown in Figure 17. This is also the only possibility which is technically fully consistent with the description.

7. If on the other hand the "first choice" is adopted, the skilled man is immediately faced with the difficulty that steps of Figure 15 cannot be imported into those of Figure 21 without extensive modification. If it is assumed that sub-routine 764 of Figure 21 corresponds to steps 678-696 of Figure 15, the simplest manner in which the two Figures can be combined, the resultant flow chart renders steps 766, 768 and 770 of Figure 21 redundant and with no path to the DEPOSIT option given by step 768. This points away from the skilled man making such a combination of the two Figures. Two other factors also point away from such a combination: first, throughout the description changes in mode are always explicitly indicated. For example, Figure 21 at two steps, 760 and 768, explicitly includes the possibility of switching into the DEPOSIT mode, whilst Figure 11 does the same for a change from DEPOSIT mode to INQUIRY mode at step 614. If in Figure 21 a switch into the DELIVERY mode or part thereof were intended then to be consistent with the remaining text this would be

explicitly stated. Furthermore, the presence in Figure 21 of a path to the DEPOSIT mode points away from the use of an additional REPLY mode as in the DELIVERY mode of Figure 15, there being no good reason why a REPLY mode should be included in addition to the DEPOSIT mode.

8. The Board accordingly concludes that the claimed subject-matter is not directly derivable from the originally filed application documents but requires the exercise of conscious choice on the part of the skilled man. This process cannot properly be described as "interpretation" in the sense of elucidating the technical content by the application of the common general knowledge of the art, but rather requires on the part of the skilled man the application of that knowledge to derive a new combination. As admitted by the Appellant, the skilled man seeking to combine Figures 15 and 21 is presented with two possible combinations; the information now presented in Claim 1 of both the main and auxiliary requests is thus neither directly nor unambiguously derivable from the originally filed application.

9. The Board accepts that the skilled reader would, after reading the patent, ask himself why no REPLY mode is included with the INQUIRY mode since it would obviously be desirable after receipt of a message to formulate an immediate reply, without the necessity of entering the caller's number. Nevertheless, just because the skilled man would appreciate the desirability of a feature does not mean that he would as a matter of course import it into the text. Viewed in terms of the novelty test, the subject-matter of Claim 1 of both the main and auxiliary requests is novel with respect to the originally filed description, even though it may well be obvious having regard to the description. Subject-matter has accordingly

been added, so that Claim 1 of both the main request and the auxiliary request fails to meet Article 123(2) EPC and these claims are not allowable. No other requests have been made.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



M. Kiehl

The Chairman:



P.K.J. van den Berg

