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File Number: T 367/91 - 3.5.1

Application No.: 81 109 039.8

Publication No.: 0 051 258

Title of invention: Electronic document information filing system

Classification: G06F 15/40

D E C I S I O N
of 14 December 1992

Proprietor of the patent: Kabushiki Kaisha Toshiba

Opponent: Grundig E.M.V. Elektro-Mechanische Versuchsanstalt &
Co. KG

Headword:

EPC Articles 52(1), (2), (3), 54, 56, Rule 67

Keyword: "Novelty (not necessary to establish)" - "Inventive step (no -
obvious application of known features to a known system)" -
"Exclusion from patentability (not relevant)" - "Reimbursement of
appeal fee (no - assessment of prior art not procedural issue)"

Catchword

A decision based only on a wrong assessment of the prior art and/or of the
claimed invention must be regarded as a substantive, but not as a procedural
"violation". Moreover, in the present case the Board is not convinced that the
decision under appeal was manifestly wrong, the "missing link" to a valid
obviousness objection not having been submitted to the Opposition Division.



Case Number : T 367/91 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 14 December 1992

Appellant :
(Opponent) Grundig E.M.V.
Elektro-Mechanische Versuchsanstalt
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Representative :

Respondent :
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Representative : Henke, Feiler, Hänzler & Partner
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Decision under appeal : Interlocutory decision of the Opposition Division
of the European Patent Office dated 6 March 1991
concerning maintenance of European patent
No. 0 051 258 in amended form.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : W.B. Oettinger
F. Benussi

Summary of Facts and Submissions

- I. The appeal contests the Interlocutory Decision of the Opposition Division which stated that, taking into consideration the amendments made by the proprietor of the European patent No. 0 051 258 during the opposition proceedings, the patent and the invention to which it relates were found to meet the requirements of the Convention.

The patent had been granted on European patent application No. 81 109 039.8 filed on 27 October 1981, and the opposition had been admissibly filed on the ground (Article 100(a) EPC) that the subject-matter of the granted patent would lack an inventive step (Article 56), having regard to the following prior art documents (of which D1 had already been considered in the pre-grant proceedings):

D1: Proceedings of the Fall Joint Computer conference, Anaheim, 5-7 December 1972, vol. 41, parts I and II, AFIPS Conference Proceedings, Montvala, N.Y., pages 479-488;

D2: DE-A-2 659 042.

The decision under appeal was announced in oral proceedings on 23 January 1991, and the written reasoned decision was posted on 6 March 1991. The basis on which it was taken comprised Claim 1 filed on 27 June 1989, considered to have been admissibly amended, as the only independent claim. The reasons given for this claim being considered allowable were that

- the Opponent's contention that the subject-matter of Claim 1 would lack novelty with regard to D2 was not

justified because novel features could be identified (Article 54);

- the auxiliary assertion that the subject-matter claimed would lack inventive step with regard to the same document (D2), at least when additional account is taken of D1, was not convincing because certainly one of the claimed features was based on an unobvious idea (Article 56);
- the Opponent's further auxiliary assertion that the subject-matter claimed would not present any technical contribution to the art (Article 52(2) EPC) had also to be discarded as being unconvincing because differences in structure against the system of D2 could be identified which are technical in nature and could not be reduced to, for instance, presentation of information.

II. The appeal was lodged by the Opponent (in German) on 10 May 1991, and the respective fee was paid on the same day. The Notice of Appeal contains a request that the patent be revoked.

On 12 July 1991, the Appellant filed a Statement of Grounds.

III. In the Statement of Grounds, the Appellant maintained the aforementioned contention and auxiliary assertions.

As an auxiliary request, later made unconditional, he solicited reimbursement of the appeal fee for the reason that, although a wrong interpretation of a prior art citation would not be a procedural violation (T 162/82, OJ 1987, 533), the reimbursement should be regarded as equitable by reason of the decision under appeal being,

due to wrong, inconsistent and unbalanced assessment of the prior art (D2), an "offensichtliche Fehlentscheidung".

- IV. In reply to a response from the Patent Proprietor, contesting the grounds of appeal and requesting dismissal of the appeal, the Appellant cited the following further prior art document:

D3: Fall Joint Computer Conference, 9-11 December 1968, San Francisco, AFIPS Proceedings, pages 255-265.

- V. In response to Communications from the Board (Article 110(2) EPC and Article 11(2) Rules of Procedure), the Respondent filed, on 17 November 1992, an amended Claim 1 which reads as follows:

"A document information filing system comprising

a recording means (26) for recording at least one piece of document picture information and at least one piece of filing information including first and second information parts (90, 92) corresponding to the picture information, said first information part (90) being formed of a plurality of retrieval codes (90-1, 90-2, 90-3, 90-4, 90-5, 90-6) and said second information part (92) being indicative of recording locations of the picture information,

input means (16) for allowing an operator to designate at least one of a given retrieval code of a desired document information, whereby, during a first period, said first information parts (90) of the filing informations which match the at least one retrieval code designated by said input means (16) are selected from said recording means (26) and, during a second period, filing informations corresponding to said selected first information parts (90) are read out from said recording

means (26), and said recording means (26) is accessed for retrieval on the basis of the second information parts (92) of the read out filing information to extract the picture informations corresponding to said read out filing information,

information processing means (66, 68) which retrieves said selected first information parts (90) for storage in memory means (64) and includes code-production means (72) for automatically producing a series of further codes independently of the first and second information parts (90, 92),

indication means (22, 24) for visually and simultaneously indicating said at least one retrieval code designated by the operator using said input means and said stored selected first information parts, and

control means (76) for retrieving from the memory means a specific first information part, and for controlling said indication means (22, 24) so as to display or print the real image of the desired document information having said specific first information part, characterized in that

said information processing means (66, 68), when the selected first information parts are displayed, temporarily adds a given further code (S) to each of said stored selected first information parts as an additional search data for enabling the operator to designate a corresponding document information when it is input through said input means (16),

said indication means (22, 24) also visually and simultaneously indicates said further codes (S) peculiarly added to said first information parts in a corresponding manner, and

said control means (76), when one of said further codes which accompanies with the desired document information is input by the operator through said input means (16), retrieves from the memory means said specific

first information part corresponding to the designated further code (S)."

- VI. On 14 December 1992, oral proceedings were held on the auxiliary requests of both parties.

The Appellant maintained his request for revocation of the patent, and the Respondent modified his request to the effect that maintenance of the patent as amended should be based on Claim 1 filed on 17 November 1992.

The Appellant based his request on the submission that the claimed system would lack novelty against D3, in particular the example given on pages 262-263. The Respondent disputed that the characterising features are known or would be obvious from that example.

Reasons for the Decision

1. The appeal (cf. paragraph II) is admissible.
2. Amendments

An objection under Article 123(2) (or 100(c)) and/or 123(3) EPC was never raised by the Appellant, and the Board sees no reason for raising such an objection against the amendments made, in particular not against those made to Claim 1.

3. The issue(s) to be decided

In the Statement of Grounds of Appeal, three of the four requirements for patentability (Article 100(a) EPC) were invoked; cf. points I and III above.

In the oral proceedings, the Appellant relied only on lack of novelty (Article 54 EPC). However, this restricted submission does not necessarily render any other objection irrelevant. On the contrary, as a matter of course, if the outcome of the issue of novelty is other than alleged by the Appellant, it will be clear that the issue of inventive step (Article 56 EPC) is still relevant and possibly valid.

On the other hand, the issue of non-invention under Article 52(2) and (3) EPC will turn out not to have an impact on the decision (cf. point 5).

In these circumstances, the Board will subsequently consider the questions of novelty and of inventive step, but no possible other issue.

4. Novelty

Contrary to the Appellant's view, in the Board's opinion the claimed system is new for the following reasons:

- 4.1 Novelty against D1 (or any other document considered in the pre-grant procedure) was never disputed and the Board sees no reason for having doubts in this respect.
- 4.2 According to the Respondent, the preamble of Claim 1 (cf. paragraph V above) has been formulated with respect to D2, and the features in the characterizing portion are novel against this piece of prior art.

The Appellant seems, after Claim 1 has been so amended, no longer to dispute that the temporary addition of a further code to the retrieval codes forming the first information parts selected, its visualization and use as an additional search code to be input for retrieving the corresponding

specific information part cannot be said to be identical with, in D2, the storing of a suitably chosen text stripe per document and their being displayed for allowing a particular document to be retrieved, and the Board sees no reason for a different finding.

- 4.3 What was alleged by the Appellant, is lack of novelty against D3. But, in accordance with the Respondent, the Board is inclined to accept that a system as defined in the preamble of Claim 1 is not clearly and unambiguously described in D3.

Certainly, D3 relates to a document information filing system comprising recording means, input means, processing means, indication means and control means having similar functions as mentioned in the preamble of Claim 1; but the Appellant has not shown that, and where, the definition of the "document information" as comprising "at least one piece of document picture information" and "at least one piece of filing information" of which the latter includes a "first information part formed of a plurality of retrieval codes" and a "second information part indicative of recording locations" can expressly be found in D3.

It may be that the "computer-driven display facilities for an experimental computer-based library" of D3 must be understood as necessarily implying features which correspond essentially with those defined in the preamble of Claim 1. Furthermore, in accordance with the Appellant's view, the Board considers the characterizing features of this claim to be known to a great extent from D3 and, for the rest, to be implied by D3.

But, in fact, it is not really necessary to further pursue this point because, in the end, it is not relevant and does not affect the parties' interests, whether the

examination of the appeal leads to a finding that the claimed subject-matter is implicitly disclosed in D3, i.e. would lack novelty, or to a finding that it is an obvious application of the teaching of D3 to a system known from D2, i.e. would lack an inventive step.

5. Inventive step

Having considered the parties' arguments in favour and against patentability of the claimed system, the Board concludes that, independently of whether it is new (cf. paragraph 4), it is in any case obvious to a person skilled in the art, having regard to D2 and D3.

This finding is based on essentially the following considerations:

5.1 As already said (point 4.2), a system as defined in the preamble of Claim 1 (refer to paragraph V) is to be regarded as known from D2.

5.2 Apparently in accordance with the Appellant's view, and as was not disputed by the Respondent, the said "facilities" of D3 (cf. paragraph 4.3 above) must be regarded as implying a system which is at least essentially of, or similar to, the kind as known from D2 and, thus, as defined in the preamble of the claim.

This needs no further explanation but it appears worth mentioning that the example described on pages 262-263 of D3 clearly shows that this system allows consecutively finer search steps (yielding e.g. at first 500, then 50, then 10 documents) to be made by corresponding retrieval codes until, eventually, a single document can be selected.

5.3 This system according to D3 further implies, in terms of the preamble of Claim 1, code-production means for automatically producing a series of further codes independently of the first and second information parts, as will be explained below in conjunction with the characterizing features of Claim 1.

5.4 From the description of the example on page 263, left-hand column, lower half, and right-hand column, upper half, it can be derived that the documents found in the search, i.e. selected, are "numbered". In the opinion of the Board, this "number" is not only a thought number but it is real in the sense that means must be provided for generating a code representing this number.

The assumed dialog contains such user (U) instructions as "Erase document number 2 and number 7", whereupon the system (S) not only displays the remaining documents but does so "renumbering" them 1 through 8.

The dialog further contains such instructions as "Display ..." or "Print out abstract ... of document number 2", and (in the text-access mode) "Show me page 1 of document number 1".

It appears worthwhile noting that D3 uses the expression "document number" in one place (when referring to number 617 369 2257) apparently for the "library identification number" (referred to also as "call number"); but it is very clear from D3 that, where it refers to a "document number 1", the numeral 1 is not a library identification number but a listing number of the selected group of documents.

It follows therefore, in the opinion of the Board, from the said instructions that the user is somehow informed of

the said document numbers. It would appear devious to assume that if, e.g., the essential data identifying eight documents are displayed, the user would have to count through them for being able to enter an instruction like "Show me (page 1 of) document number 6". It is therefore considered that such document numbers are displayed together with the said data, implying that they have been generated (e.g. in the renumbering step).

5.5 The Respondent's counter-arguments based on the fact that the example in D3 is largely described with reference to a light-pen or a cursor as a selecting means, are not relevant. As a third possibility, typing the command directly is expressly mentioned on page 263, left-hand column. At least in this alternative the above consideration applies that the user would have to be informed by displayed document numbers what command to type for selecting a document having a particular number, for instance the command "Show me page 1 of document number 6".

In this context, it appears to be a matter of course that in real life this command would not contain the words "page 1 of". Plural page documents cannot normally be displayed as a whole, so the page displayed first in the text-access mode will commonly be page 1.

It is further noted that in the example described in the patent the code input by the operator may solely consist of the document number itself, e.g. "2", followed by actuating a read key (56); i.e. the operator inputs a command consisting of an instruction meaning "Show me" and of the document number "2" but not the words "document number". However, apart from the fact that Claim 1 is not so restricted, such a difference could not be regarded as being based on an unobvious consideration.

5.6 For these reasons, the subject-matter of Claim 1 must be regarded, starting from a system as known particularly from D2, as being rendered obvious by the teaching of D3.

6. Conclusions

The Appellant's request for revocation of the patent must therefore be allowed, and the Respondent's request for its maintenance rejected.

7. Reimbursement of the appeal fee

The Appellant did not repeat his request for reimbursement of the appeal fee (cf. point III) in the oral proceedings (cf. point VI). However, he did not withdraw this request either. Moreover, reimbursement does not depend upon such a request. This issue will therefore be dealt with, as follows:

Apart from the appeal being allowable, a second requirement for reimbursement is that it is equitable by reason of a substantial procedural violation (Rule 67 EPC). This latter requirement is, however, not met.

A procedural violation would, for instance, be a violation of the provisions of Article 113(1) or (2) or of Article 116(1), first sentence, EPC.

Oral proceedings were held in the first instance procedure (Article 116) and the Appellant's submission that he did not have "Rechtliches Gehör" (Article 113) is unconvincing because, according to the file, he was given in those oral proceedings an opportunity to present his comments. For the procedural issue to be decided it is not relevant whether these comments, i.e. the submitted facts and

evidence, were examined "einseitig zuungunsten der Einsprechenden". Such a wrong assessment of the prior art and/or of the claimed invention would always be a substantive issue. As a consequence, a decision based only on such a wrong assessment must be regarded as a substantive, but not as a procedural "violation", and certainly not as a substantial procedural violation.

This will normally apply to decisions on substantive issues even if the reasoning given in those decisions is not satisfactory as long as there are any reasons given at all (Rule 68(2)).

Moreover, the Board is by no means convinced that the decision under appeal was manifestly wrong, given the fact that it had to be based on D2 as the only relevant prior art document available. The "missing link" to a valid obviousness objection, viz. D3, was not submitted to the Opposition Division but only to the second instance Board. As the appeal procedure reveals (cf. Communication of 2 April 1992), without D3 at hand, the Board could not exclude the possibility that it would have come to a similar conclusion as the first instance Division.

The Appellant's request concerning the appeal fee is therefore refused, i.e. reimbursement not ordered.

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:

M. Kiehl

P.K.J. van den Berg