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File Number: T 837/91 - 3.5.2
Application No.: 87 305 595.8
Publication No.: 0 252 646
Title of invention: Paperless portable book

Classification: G11B 33/06

D E C I S I O N
of 23 October 1992

Applicant: Semiconductor Energy Laboratory Co., Ltd.

Headword:

EPC Articles 56, 111(1) and 114(1)

Keyword: "Inventive step (yes, with respect to the state of the art taken into consideration during the examination procedure)"
"Remittal to the Examining Division for further prosecution taking into account newly introduced documents"

Headnote
Catchwords



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 837/91 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 23 October 1992

Appellant : Semiconductor Energy Laboratory Co., Ltd.
398 Hase
Atsugi-shi Kanagawa-ken, 243 (JP)

Representative : Milhench, Howard Leslie et al
R.G.C. Jenkins & Co.
26 Caxton Street
London SW1H 0RJ (GB)

Decision under appeal : Decision of Examining Division 067 of the
European Patent Office dated 7 May 1991 refusing
European patent application No. 87 305 595.8
pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : R.E. Persson
Members : M.R.J. Villemin
J.A. Van Voorthuizen

Summary of Facts and Submissions

I. The Appeal contests the decision of the Examining Division to refuse Appellant's European patent application No. 87 305 595.8. The reason given for the refusal was that Claims 1 to 10 received on 10 January 1991 did not involve an inventive step having regard to common knowledge of the skilled person combined with the prior art document:

D1: EP-A-0 126 542,

II. The Appellant requested in his statement of grounds of appeal that the decision under appeal be set aside and:

- the grant of a patent on the application in its form as refused by the Examining Division and refund of the appeal fee (first request),
- in the event that the Board felt that Claim 1 of the first request did not meet the requirements for patentability, consideration of the dependent claims according to the first request to see if any of them, in combination with this Claim 1, satisfied the requirements of Articles 54 and 56 EPC (second request).

III. In a communication dated 12 August 1992, the Rapporteur made some preliminary observations citing following additional prior art documents on the basis of Article 114(1) EPC:

D2: "Videodisc and optical memory systems" by Jordan Isailovic, Prentice-Hall, Inc., 1985,

D3: "Encyclopedia of computer science and engineering",
second edition, Van Nostrand Rheinhold Company,
1983.

In response, the Appellant by letter dated 4 September 1992 requested postponement of oral proceedings scheduled for 7 October 1992 and suggested alternatively that the case be remitted to the first instance for further prosecution.

IV. In its present form, the application consists of:

- Description; pages 1 and 8 as originally filed, pages 2-7 as filed with the letter received 10 January 1991, with additional amendments to pages 2 and 7 as requested in the letter received 15 January 1991,
- Claims: 1-10 as filed with the letter received 10 January 1991,
- Drawings: Figures 1-3 as originally filed.

V. Claim 1 reads as follows:

"A portable information display device for use as a paperless portable book, said device comprising, in an integrated unit, a reader (7) for a magnetic floppy disc, optical disc or other interchangeable compact data storage medium, a processor (11), an input facility (3) operable to cause said processor to selectively process for display information retrieved from or written to the data storage medium, a display panel (2) for displaying such information, and a solar panel (6) for powering the unit, the unit being generally in the shape of a book comprising a body portion (1) and a cover portion (5) hingedly connected thereto, the display panel being provided in

said body portion and occupying a major part of the surface area of the body portion that is covered by the cover portion, and the solar panel being provided in said cover portion."

VI. The Appellant argues that the very idea of a portable paperless book was new at the priority date of the application and that the Examining Division has neglected to consider that it might never have occurred to the skilled person to make the modifications necessary to convert the portable computer of D1 into the claimed paperless book. The mere fact that the capacity of the memory of an office word-processor might be given in terms of a number of text pages cannot be said to suggest the idea of a paperless portable book intended inter alia to solve the problem approached by the application. To say that minimizing of the input facility would provide more space for the solar panel clearly presupposes a foreknowledge of the invention. The comment that the display has to be provided in the body portion because the whole cover portion has to be used for the solar panel is wholly without factual basis and can only be the product of an incorrect and improper ex post facto analysis.

Reasons for the Decision

1. The Appeal is admissible.
2.
 - 2.1 D1 discloses a portable computer comprising a full alphanumeric keyboard and a central processing unit coupled to a display arrangement. This known computer is mounted in a case composed of a base and a cover hinged to the base and is powered by battery voltage sources.

The essential problem to be solved by this portable computer is to overcome some disadvantages of other portable computers which generally exhibit limited internal memories and reduced speed with which an operator may use these computers.

The problem at the basis of the disputed application is to provide a portable information display device. This device is intended for use as a paperless book and will be referred to as such in the following. The said paperless book is meant to replace the use of printed paper in that it provides a handy device principally for reading written text material which is recorded on an interchangeable storage medium. The storage media can be assembled in a collection like books.

The problems addressed by the portable computer according to D1 and that addressed in the present application are therefore different. None of the documents cited in the search report deals with or even suggests a paperless book. The Board observes, however, that any portable computer has the ability of displaying a text stored in an interchangeable memory. As the portable computer known from D1 also has the greatest number of components in common with the claimed device, D1 may be considered as representing the closest prior art among the documents cited in the search report.

- 2.2 The question then arises whether it would have been obvious to the person skilled in the art to modify the device known from D1 in order to arrive at the paperless book claimed in the present application. In this respect, the opinion of the Examining Division, that the portable computer disclosed in D1 can be considered as storing a book, because the capacity of its memory is sometimes

expressed by reference to the number of text pages capable of being stored, cannot be accepted.

2.3 The display panel of the claimed device occupies a major part of the surface area of the body portion due to the making use of a reduced input facility which dispenses with a full alphanumeric keyboard. This arrangement has been seen as self-evident by the Examining Division, although it has been designed in contradistinction with the known arrangement adopted in the portable computer disclosed in D1. There, the display screen is provided in the cover part designed to stand up in front of the operator working with his hands at the keyboard occupying the whole surface area of the body portion. This known arrangement has become the standard arrangement for portable computers. The above-mentioned distinction makes it clear that the inventors of the claimed paperless book departed from the obvious route which consisted in arranging the display panel and the keyboard (input facility) according to the known standard arrangement.

2.4 The Appellant has further provided a copy of an announcement regarding the recent launch by the firm SONY of an electronic book which substantially remains in the form of the portable computer disclosed in D1. In particular, the input facility occupies the whole part of the case body and the display panel is accommodated in the cover portion. This illustrates that, even nowadays, it cannot be taken for granted that the skilled person would have thought of minimizing the input facility of a portable computer in order to transform it into a paperless book of the kind as defined in claim 1 of the present application, which is principally intended for reading a recorded text.

2.5 The claimed paperless book is further provided with a solar panel disposed in the cover portion. The Board cannot agree with the Examining Division that it would have been obvious to the skilled person starting from D1 to make use of a solar panel as defined in the invention, because the portable computer according to D1 teaches rather away from this. It is indicated in D1 that this portable computer has to be powered by battery voltage sources which are continuously applied to the memory units to make them nonvolatile. It is therefore apparent that the teaching of the portable computer known from D1 cannot lead towards the use of a solar panel, since it is manifest that, in darkness condition, stored data would be lost.

The statement by the Examining Division that partitioning an available surface in order to provide "as much as possible" solar panel surface and "as little as needed" input facility surface is a matter of plain straightforward design is not tenable under the circumstances of the present case. It presupposes first that the use of a solar panel in the portable computer according to D1 was a trivial technical measure by itself, which is not regarded as being well founded in view of the teaching of this prior art. Furthermore, this statement implies that the partition as claimed is merely a simple choice among several equivalent possibilities. The Board takes the view, however, that the question how to partition the available surface could present itself only after the inventors had the idea of modifying the device known from D1 so as to function as a paperless book intended principally for reading and thus not requiring a full keyboard.

2.6 The Board is therefore of the opinion that the arguments of the Examining Division in its decision do not permit to

conclude that it was obvious to the person skilled in the art to modify the portable computer disclosed in D1 in such a manner as to arrive at the claimed paperless book.

3. It appears to the Board, however, as discussed in the communication of 12 August 1992, that the combined teachings of D1, D2 and D3 could be relevant when considering the question of inventive step in respect of the subject-matter of Claim 1 of the first request.

Since documents D2 and D3 cited by the Board have not yet been taken into consideration by the Examining Division and in order not to deprive the Appellant of an examination by two instances, the Board, making use of its power under Article 111(1) EPC, finds it appropriate to remit the case to the Examining Division for further prosecution as also suggested by the Appellant as an alternative.

4. Incidentally, the Board has noted that in the description of the published application, column 2, lines 52-54 and column 3, line 44, reference numbers 5 and 6 seem to be not properly associated with the technical features to which they refer according to Figure 1 and Claim 1 of the first request.

This point should be dealt with in the course of the further prosecution by the Examining Division.

5. As regards the request for reimbursement of the appeal fee the Board considers that there has occurred no such procedural violation which could justify reimbursement.

Order

For these reasons, it is decided that:

1. The Decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of the first and the second requests (see paragraph II above) taking into account documents D2 and D3 referred to in paragraph III above.
3. The request for refund of the appeal fee is refused.

The Registrar:



M. Kiehl

The Chairman:



E. Persson

