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D E C I S I O N
of 16 May 1994

Case Number: T 0572/93 - 3.5.1

Application Number: 86301910.5

Publication Number: 196815

IPC: G06F 15/02

Language of the proceedings: EN

Title of invention:
Personal computer note-taking facility

Applicant:
(I) American Telephone and Telegraph Company
(II) Convergent Technologies Inc.

Opponent:
-

Headword:
-

Relevant legal norms:
EPC Art. 52(1), 56

Keyword:
"Inventive step (yes)"

Decisions cited:
-

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0572/93 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 16 May 1994

Appellant I: American Telephone and Telegraph Company
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Appellant II: Convergent Technologies Inc.
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Decision under appeal: Decision of the Examining Division of the European Patent Office dated 27 January 1993 refusing European patent application No. 86 301 910.5 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P.K.J. van den Berg
Members: A.S. Clelland
F. Benussi

Summary of Facts and Submissions

- I. The Appellant contests the decision of the Examining Division dated 27 January 1993 refusing European patent application No. 86 301 910.5.
- II. The reason given for the refusal was that the subject-matter of independent Claims 1 and 5 lacked an inventive step having regard to the prior art known from the following documents:
- D1: NTC RECORD 1981, 29th November - 3rd December 1981, New Orleans, Louisiana, pages 231-235, IEEE, New York, US; W.M. Schell: "Control software for an experimental teleterminal"
- D2: DE-A-3 307 375 (Siemens AG).
- III. On 10 March 1993 the Appellant filed a Notice of Appeal and paid the prescribed appeal fee. Cancellation of the decision was requested. A statement setting out the grounds of appeal was subsequently filed on 24 March 1993 and amendment of Claim 6 of the main request was requested. As an auxiliary request a further set of Claims 1 to 8 was filed.
- IV. In a communication pursuant to Article 110(2) EPC dated 29 October 1993, the Rapporteur expressed the preliminary opinion that Claim 5 of the main request lacked novelty whilst Claim 1 of the main request and Claims 1 and 5 of the auxiliary request arguably did not involve an inventive step having regard to prior art referred to in a document cited by the Appellant in the course of the proceedings before the Examining Division:

D3: Bellsoft Program Manual, September 1984, Bellsoft Inc., ISBN 0-916435-05-9.

V. In a submission received on 14 February 1994 the Appellant withdrew his main request and filed revised claims corresponding to those of the auxiliary request filed with the Statement of Grounds of appeal. The Appellant accordingly requests grant of a patent on the basis of the following documents:

Claims: 1 to 8 as received on 14.2.94;
Description: pages 4, 5 and 7 to 11 as originally filed,
pages 1 to 3, 6 and 12 as received on 27.6.91;
Drawings: sheets 1 to 7 as originally filed.

VI. Claim 1 reads as follows:

"A computer arrangement for use with a telephone, said arrangement including input means (13) for generating a succession of characters, note-taking means (113) including means operative for receiving from said input means characters representing notes taken by a user of said computer arrangement during a transaction over said telephone and for storing the received characters in said computer, and CHARACTERISED BY means (111, 112) operative in response to the receipt of an incoming voice call on said telephone and operative in response to the initiating of a voice call by said user over said telephone for initiating said receiving and storing operation of said note-taking means."

Claim 5 reads as follows:

"A method for operating a computer which has a telephone connected thereto and which includes note-taking means for receiving from an input device, operated by a user of said computer, notes taken during a transaction over said telephone and for storing said notes in said computer, said method being CHARACTERISED by said computer automatically initiating the operation of said note-taking means in response to the initiating of a voice call by said user over said telephone."

VII. The Appellants' argument in favour of patentability can be summarised as follows:

None of the prior art documents suggests the automatic operation of a note-taking program in response to initiation of a telephone transaction. Although note-taking programs were known at the claimed priority date, the Bellsoft program described in D3 being one example thereof, such programs invariably require action on the part of the operator in order to initiate operation. Nowhere in the prior art was there any appreciation of the advantage to be obtained from linking telephone operation to the note-taking facility so that when the user initiates a telephone call or receives an incoming call he can immediately take notes without further action on his part. Since both note-taking and telephoning are two separated, automated, operations there is no reason why the skilled man would seek to link the two to provide further automation. Nor would the existence at the priority date of modems connected to personal computers have led the skilled man to the claimed arrangement; although in response to an incoming message there is an automatic response, this response is on the part of the modem and not the computer, the computer program serving merely to enable communication

between the modem and the computer. Moreover what is stored is the incoming message rather than notes based on that message whilst in the case of an outgoing message the entire, previously composed, message is sent and cannot be altered.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 68 EPC and is, therefore, admissible.
2. Claims 1 and 5 contain all the features of original Claims 1 and 5 respectively and accordingly comply with Article 123(2) EPC.
3. *Exclusion from patentability under Article 52(2) EPC*
 - 3.1 The Board considers that the claimed subject-matter is not excluded from patentability under Article 52(2) EPC.
 - 3.2 Although in the impugned decision the Examining Division does not explicitly refer to Article 52(2) EPC, there are indications in the grounds for the decision that the issue - even if not explicitly raised - influenced the Examining Division's view of inventive step. Thus at page 5, first full paragraph, it is stated that it would be obvious for the skilled man "to change a known computer arrangement .. and in particular the **software**, to obtain an integrated note-taking arrangement ...". Similarly at page 8, paragraph 5 the Examining Division states that "major parts of the description of the current application disclose a detailed description of the **software** that implements a note-taking facility ... the technical features ... are well-known components of a computer arrangement". In each case the word

"software" has been underlined by the Examining Division. Moreover, in discussing the independent claims, the Examining Division states at page 7, fifth paragraph of the page that "All these features form part of the software of the present computer arrangement ... and either represent a special step of the computer program ... or represent separate screen areas ... displayed by the computer arrangement"; in the subsequent paragraph the Examining Division states "Therefore the additional feature of dependent Claims 2 to 4 and 6, 7 cannot contribute to a technical limitation of independent Claims 1 and 5 respectively, and consequently cannot be used to overcome the lack of inventive step objection".

- 3.3 The established jurisprudence of the Boards of Appeal (cf. T 208/84 [VICOM], OJ EPO 1987, 14) is that "a claim directed to a technical process which process is carried out under the control of a program (whether by means of hardware or software), cannot be regarded as relating to a computer program as such ... claims which can be considered as being directed to a computer set up to operate in accordance with a specified program (whether by means of hardware or software) for controlling or carrying out a technical process cannot be regarded as relating to a computer program as such". The Boards have also held (T 26/86 [Koch and Sterzel] OJ EPO 1988, 19) that "an invention must be assessed as a whole ... the EPC does not ask that a patentable invention be exclusively or largely of a technical nature ... it does not prohibit the patenting of inventions consisting of a mix of technical and non-technical elements". However, the technical contribution to the art must be in a field not excluded from patentability (cf. T 38/86 [IBM] OJ EPO 1990, 384).

3.4 In the case of the present application the Board takes the view that the technical contribution to the art is that in response to operation of a telephone a computer is caused to be switched to a different, new, program. This is analogous to use of a telephone to - for example - cause a device to be switched on or off, clearly a technical function. That in the present case the "device" is a computer program does not detract from the fact that the function of the computer is being changed by means of this switching. The result is not merely a change in a display of information but to give the user the possibility of entering or retrieving data by means of the computer.

3.5 The subject-matter of each of Claims 1 and 5 (as well as of each of the dependent claims) is thus held to constitute an invention within the meaning of Article 52(1) EPC.

4. *Inventive step*

4.1 The Board considers that the most relevant single prior art document is represented by D3. It is common ground that D3 shows a well-known form of computer program at the claimed priority date, namely a note-pad facility running in the background independently of whatever program is primarily being used by the computer operator; by means of a so-called "hot key" combination the note-pad facility is brought into operation, so that notes can be taken, stored, and subsequently read. Thus, in the event of an incoming or outgoing telephone call, the user can write or retrieve notes by means of the "hot key" combination. Such an arrangement is acknowledged as known in the preamble of independent Claims 1 and 5.

- 4.2 To this known subject-matter the present application adds - put in its simplest form in Claim 5 - that the computer automatically initiates the operation of the note-taking means in response to the initiating of a voice call by the user over the telephone. Claim 1 further refers to initiation in response to receipt of an incoming voice call. It is common ground that automatic initiation of the facility is not disclosed in any of the cited documents, so that the subject-matter of each of Claims 1 and 5 is novel.
- 4.3 The question addressed by the Board is accordingly whether, at the claimed priority date, it would have been obvious for the skilled man to modify the known computer arrangement so as to respond **automatically** to use of the telephone.
- 4.4 The Examining Division reached its conclusion starting out from the fact that the taking of notes is a standard procedure when making (or receiving) phone calls. The skilled man, starting out from D1 or D2 would have access to a computer arrangement which by means of key-strokes can be used to initiate a note-taking facility during a telephone transaction. It would therefore be obvious for the skilled man to replace the use of key-strokes by an automatic arrangement in which the note-taking facility is called up whenever the telephone is used. The Board observes that although D1 and D2 do not explicitly disclose the provision of a note-taking facility, D3 does so and the Examining Division's argument can be equally applied to D3.
- 4.5 However, for the reasons given below the Board are not able to concur with the Examining Division's conclusions. The prior art is concerned with the solution to a problem which arises when in the course of carrying out a piece of work by means of a computer the

worker wishes to write himself a note on a completely separate subject; this problem is solved by means of the aforementioned note-pad facility as shown in D3. Such a facility meets the need of the computer user to take notes independently of the working program, for example when he is interrupted by a telephone call. The prior art as disclosed in D3 accordingly satisfies the user's requirement for a note pad. The prior art does not suggest why the skilled man would consider a telephone interruption to be different to any other form of interruption. The present applicant has appreciated that in the specific case of a telephone interruption the computer user can be assisted by automatic start-up of the note pad program. It is this automaticity which is not disclosed by the prior art and which the skilled man would not consider until the problem is posed in its correct form. Although the automation of manual tasks is a well-known aim of industry, the Board do not consider that the skilled man would at the claimed priority date have been led to combine the tasks of telephoning and use of a computer. Although D3 discloses the provision of a phone list and an auto-dial facility based on the phone list, this is clearly designed to make the act of telephoning easier rather than to make note-taking easier; indeed, it appears from D3 that use of the auto-dial facility involves leaving the note-pad in order to display and use the phone list, so that a further key stroke is necessary if the note-pad is to be reactivated.

- 4.6 Thus, the skilled man is not led by D3 or any of the other cited documents to the appreciation that a telephone can profitably be linked to a computer so as automatically to provide a note-pad facility when the telephone is used. The Board agrees that once the idea is mooted its implementation is immediately obvious; nevertheless, the skilled man is not led by the prior

art to adopt this, admittedly simple, idea. The subject-matter of each of Claims 1 and 5, which incorporate this idea in their characterising features, therefore involves an inventive step.

5. Although the present claims have been held allowable, the Appellant has not yet filed an introduction to the description acknowledging D3. The Board is moreover in some doubt as to the significance of the reference numeral "113" at line 3 of Claim 1. For these reasons it is necessary to remit the application to the Examining Division for examination to be completed.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order that further prosecution is to be based on Claims 1 to 8 received on 14 February 1994.

The Registrar:

The Chairman:

M. Kiehl

P.K.J. van den Berg

