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D E C I S I O N
of 16 November 2000

Case Number: T 0381/99 - 3.5.1

Application Number: 91304533.2

Publication Number: 0458563

IPC: H04Q 7/32

Language of the proceedings: EN

Title of invention:

A multi-function telephone apparatus

Patentee:

NOKIA MOBILE PHONES LTD.

Opponent:

Robert Bosch GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 56, 100(a), 100(c), 123(2), 123(3)

Keyword:

"Inventive step (yes)"
"Added subject-matter (no)"
"Claim broadening (no)"

Decisions cited:

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Catchword:

-



Case Number: T 0381/99 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 16 November 2000

Appellant: Robert Bosch GmbH
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Representative: -

Respondent: NOKIA MOBILE PHONES LTD.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 25 January 1999
rejecting the opposition filed against European
patent No. 0 458 563 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
P. H. Mühlens

Summary of Facts and Submissions

I. This is an appeal against the decision of the Opposition Division to reject an opposition against patent No. 458 563. The appellant (opponent) requests that this decision be set aside and the patent revoked; The respondent (patentee) requests that the patent be maintained in amended form on the basis of the claims of a main request, or those of a first or a second auxiliary request, all received by fax on 28 September 2000.

II. The Opposition Division's decision makes reference, *inter alia*, to the following document:

D3 US-A-4 747 122.

III. Claim 1 of the **main request** reads as follows:

"A telephone apparatus (RPK) which is made up of a telephone part, in particular a radio telephone part, comprising:

a memory unit for storing a telephone number or telephone numbers;

a first electrical circuit for forming an outgoing call in accordance with a number in the memory unit;

a display (D) for displaying text including numbers and other text based on the alphabet;

a keyboard (K);

a radio receiver part for receiving messages including

a telephone number and for displaying them in the said display;

a third circuit, connected to the keyboard, for transferring the telephone number in the display at each given time to the memory unit for forming a call and/or further processing;

characterised in that the telephone apparatus is a cellular radio telephone, in that

the radio receiver part is for receiving arbitrary alphanumeric messages, having text including a telephone number and other text based on the alphabet and for displaying the text in the said display

and in that the cellular radio telephone additionally includes:

a memory for temporary storage of an incoming alphanumeric message in its entirety;

a second electrical circuit for displaying in the said display a telephone number possibly included in the present message temporarily stored in the memory; and

a fourth circuit for searching text of the received arbitrary alphanumeric message temporarily stored in the memory to identify a telephone number and transferring the found telephone number to the display from where it may be transferred by the third circuit to the memory unit for forming a call and/or further processing, wherein the text of the received alphanumeric message includes a telephone number and other text based on the alphabet, and the text of the

received alphanumeric message, including the telephone number and other text based on the alphabet, is displayable on the display."

Independent claim 3 of the main request differs from claim 1 in that the final feature of the characterising part, the "fourth circuit", is replaced by the following feature:

"a fifth circuit which can be pre-programmed to scroll in the display an alphanumeric present message having text including a telephone number and other text based on the alphabet which is in the temporary memory, either continuously or in sequences in portions depending on the length of the display, and that this fifth circuit is connected to the keyboard in such a manner that the user can by means of the keyboard halt in the display the desired portion of this message which is being scrolled thereby displaying a telephone number for transfer by the third circuit to the memory unit for forming a call and/or further processing."

Claim 8 of the main request reads as follows:

"A method for use in a telephone apparatus which is made up of a telephone part comprising a memory unit, a circuit for forming an outgoing call, a display for displaying text including numbers and other text based on the alphabet, a keyboard, and a radio receiver part for:
receiving messages including a telephone number; and
for processing a received message electronically,
characterised in that the telephone apparatus is a cellular radio telephone, in that the radio receiver part is for receiving, for display, arbitrary

alphanumeric messages wherein the text of the received alphanumeric message includes a telephone number and other text based on the alphabet; and in that the processing of the received present message is made up of at least the following steps:

(1) the telephone apparatus searches out one at a time from the telephone number strings possibly contained in the text of the received alphanumeric message, and displays the found telephone number string in the display

(2) the user by keying either rejects or accepts the found telephone number displayed in the display

(3) the telephone apparatus places a call to the accepted telephone number accepted in the preceding step."

IV. Independent claims 1, 3 and 8 of the **first auxiliary request** differ from the respective claims of the main request in being limited to the reception of messages provided by a mobile telephone network using a short message service.

V. The **second auxiliary request** comprises a single independent claim generally similar in scope to claim 1 of the main request.

Reasons for the Decision

1. *Added subject-matter (Article 123(2) EPC) and claim broadening (Article 123(3) EPC)*

1.1 At the start of the oral proceedings the appellant drew attention to the language of the amended claims. With particular reference to claim 1 of the main request he raised objection that the claim included subject-matter which was not derivable from the originally filed application, Article 123(2) EPC, whilst the breadth of the claim was said to be greater than that of granted claim 1, Article 123(3) EPC.

1.2 The objection of added subject-matter arose from the definition of the expression "alphanumeric" now present in claim 1. The originally published application at column 4, lines 50 to 56 defined an alphanumeric message as one which "may contain telephone numbers and/or other text based on the alphabet or other numeric data ... a telephone number alone is not here included in the concept alphanumeric". The revised claim 1 was said not to be so limited in that the radio receiver part could be interpreted as permitting two different kinds of message to be received, the preamble referring to "messages including a telephone number" and the characterising part to "arbitrary alphanumeric messages, having text including a telephone number and other text based on the alphabet". The claim accordingly covered a possibility not envisaged in the original application, namely the reception of messages which merely included a telephone number.

1.3 In consequence of this the claim was said also to be broader than that granted, the granted claim not envisaging the reception of messages merely including a telephone number.

1.4 Further objection arose from the use of optional

language in the final feature of the characterising part, which referred to a found telephone number which "may be transferred" by the third circuit to the memory unit whilst text of a received message is said to be "displayable" on the display.

1.5 The Board does not consider that these objections are well founded. Dealing first with the objection based on the alleged discrepancy between the radio receiver part in the claim preamble and that in the characterising part, it is noted that the claim is delimited with respect to document D3, which discloses a radio receiver capable of receiving a telephone number; this subject-matter is accordingly acknowledged in the preamble as being known. The invention as claimed is on the other hand not merely for receiving a telephone number but, in the words of the characterising part, "arbitrary alphanumeric messages, having text including a telephone number". The wording of the claim appears to the Board to be based on the original disclosure at column 4, lines 50 to 56 of the published application. A fair reading of the claim, even without considering the description, can only lead to the conclusion that the same radio receiver part is meant in both parts of the claim, being claimed in greater detail in the characterising part.

1.6 Turning now to the question of optional language in the claim, the Board notes that the claim is directed to apparatus and the features which the appellant has queried involve the use of the apparatus. They are moreover new features, not present in claim 1 as granted and intended to further limit the claim. In the circumstances the Board does not consider that they can either add subject-matter or broaden the

claim.

1.7 The Board accordingly concludes that no objection arises to claim 1 of the main request under Article 123(2) EPC or Article 123(3) EPC. Since the objections to claims 3 and 8 of the main request, and the objections to the corresponding claims of the auxiliary requests, are, *mutatis mutandis*, the same as the objections to claim 1 of the main request, these objections fall also.

2. *Inventive step*

2.1 The patent is concerned with a problem which arose in mobile telephones at the claimed priority date, namely identifying telephone numbers received from a paging network or an SMS service and transferring them for automatic dialling by the mobile phone. At that time it was necessary to read the information from the display and input it into the mobile phone key pad in order to make a call.

2.2 It is observed that the priority date of the patent is May 1990; at that time mobile telephones were largely analogue and indeed the patent refers at column 4, line 13 to the "so-called GSM recommendations on which the future PLMN mobile telephone network will be based". Facilities which are now taken for granted in the use of mobile telephones, such as the automatic display of the number of an incoming call and its storage for redialling, were not available, although in the course of the oral proceedings the respondent accepted that so-called "call line identification" was known in the context of the wired telephone

network.

2.3 It was common ground at the oral proceedings before the Board that the single most relevant document is D3. D3 discloses a combined mobile phone and pager. In essence, because mobile phones may leave the cells in which they are operational, the pager is provided in D3 to enable a party to inform the mobile phone user that a party wishes to communicate with him. Pagers are seen as a nationwide service (column 1, line 38) whilst mobile phones are seen as limited to specific cells (column 1, line 65 to column 2, line 6).

2.4 The point at issue is whether the skilled person, reading D3, would understand it to disclose a pager which could receive arbitrary alphanumeric messages as opposed to messages including merely a telephone number. The appellant argued that various passages in D3 made the former interpretation more likely. Column 1, lines 21 to 26 referred to a radio paging system typically leaving a message for an individual, the same column referring at lines 35 to 37 to pagers which "can also display other alpha-numeric information, such as the time and date of the message". Further on at lines 44 to 48 reference is made to "an individual carrying a pager" learning that "a paging party wishes to initiate a telephone conference". Other passages in the specific description also suggested that information in addition to a telephone number was being transmitted in the D3 pager. Column 5, lines 19 to 21 referred to a paging signal, "which includes data representing a telephone number"; the same wording was used further on in the column at lines 28 to 33. At lines 41 to 47 reference was made to a logic circuit programmed to

identify a valid telephone number in data. Moreover, the patent itself included a description of apparatus said to be the technological background of the invention, see column 3, line 8 ff, which suggested that the use of alphanumeric messaging was well known at the claimed priority date.

2.5 The respondent argued that D3 was exclusively concerned with the provision of telephone numbers. The D3 system arose from the absence of call line identification in mobile phones, so that it was necessary to provide some other means of informing a called party that a call should be returned; for this reason a separate pager was provided and means made available to transfer the number shown on the pager to the dialler. In any paging system data was transmitted to identify a specific pager in addition to the "payload" data which comprised the telephone number. It was therefore unsurprising that D3 referred to the telephone number as part of the received data. At no point did D3 indicate that alphanumeric messages could be transmitted and received; the reference at column 1, lines 35 to 37 to pagers which could also display other alphanumeric information such as the time and date of the message, referred to a time and date-stamping mechanism making use of an internal timer in the pager to determine and display the time and date the message was received.

2.6 The Board takes the view that D3 does not disclose the transmission of information other than a telephone number to a receiving party, nor does it point the skilled person in the direction of the provision of alphanumeric information. D3 is apparently exclusively concerned with the problem of

"a paging call back system which permits telephone numbers received with a radio paging unit to be responded to using a mobile radio telephone" (column 1, lines 7 to 10). The various references to a message appear in the context to refer only to a telephone number, the message being implicitly that the user should telephone the number; the reference at column 1, lines 44 to 48 to the paging party wishing to initiate a telephone conference should apparently be understood as indicating that the paging party wishes to initiate a call. Similarly, the various references in the specific description to data appear in the context to refer to a data packet made up of an address and a "payload" in the form of the telephone number to be called. Indeed, the various passages cited by the appellant at column 5 of D3 always refer to a telephone number and nowhere suggest that transmitted data other than a telephone number might be displayed.

2.7 Since claim 1 of the main request is limited to a radio receiver part for receiving arbitrary alphanumeric messages it is apparent that the claim is novel with respect to the disclosure of D3. Moreover, the problem with which the invention is concerned, namely the identification of telephone numbers in such an alphanumeric message, does not arise in D3. Although D3 refers at column 5, lines 44 to 47 to a logic circuit "programmed to identify as a valid telephone number any data which has the requisite number of digits to represent a telephone number", this merely involves searching for a string of digits of predetermined length rather than identifying a telephone number from arbitrary alphanumeric data. The Board accordingly concludes that the skilled person, given the disclosure of D3

and aware of the appellant's problem, would not derive the claimed solution without the exercise of invention.

- 2.8 The above arguments apply *mutatis mutandis* to claims 3 and 8 of the main request.
3. Since the main request is allowable it has not been necessary to consider the first and second auxiliary requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is maintained on the basis of the respondent's main request.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg