

ET1080.99 - 021260020

DECISIONS OF THE BAORDS OF APPEAL

Decision of Technical Board of Appeal 3.5.1 dated 31 October 2001

T 1080/99 - 3.5.1

(Language of the proceedings)

Composition of the board:

Chairman: S. V. Steinbrener

Members: R. Randes

E. Lachacinski

Patent proprietor/Respondent: TEKTRONIX, INC.

Opponent/Appellant: Mannesmann VDO AG

Headword: Touch control/TEKTRONIX

Article: 23(3), 54(2), 56, 85 EPC

**Keyword: "Request for postponement of oral proceedings (not allowed)" -
"Prior art status of Patent Abstracts of Japan" - "Inventive step (no)"**

Headnote

I. In a case where a Board in a letter, almost three months before appointed oral proceedings, makes clear that a request by a party for postponement of the oral proceedings, although meeting the requirement of filing the request as soon as possible after the summons to oral proceedings, does not meet the other

requirements of the "Notice of the Vice-Presidents Directorates-General 2 and 3 dated 1 September 2000 concerning oral proceedings before the EPO", OJ EPO 2000, 456, and that party, instead of attempting to supplement their original request as soon as possible, chooses to react to the Board's letter only one week before the appointed oral proceedings, it must be considered that the additional reasons and evidence for the request for postponement and the fixing of a new date for oral proceedings were received too late and that these reasons can therefore not be accepted (see points 2.1 to 2.3 of the reasons).

II. In view of its legal nature and intended purpose, a Japanese patent abstract in English ("Patent Abstracts of Japan") is a publication intended to reflect the technical content of the corresponding Japanese patent application for the purpose of quick prima facie information of the public, as is the purpose of any kind of abstract or summary of technical subject matter.

Hence, the contents of such abstracts are to be interpreted and possibly re-evaluated in the light of the original document if the latter is available. Indeed, if an abstract appears to add something to the original document then this points to an error in the abstract, or at least to an error in its interpretation (see point 4.6 of the reasons).

Summary of facts and submissions

I. This appeal is against the decision of the Opposition Division to reject the opposition because the ground for opposition invoked under Articles 100(a), 52(1) and 56 EPC, lack of inventive step, did not prejudice the maintenance of the patent as granted.

II. Claim 1 as granted reads as follows:

"A method of touch control of cursor (32) position on a display device (30) having a touch sensitive screen (26) comprising the steps of:

determining from an initial contact point (1) by a pointer (34) on the touch sensitive screen (26) whether a cursor (32) is positioned at the initial contact point;

and if the cursor is positioned at said initial contact point updating the cursor position, as the pointer moves from the initial contact point in contact across the touch sensitive screen, to correspond to an instantaneous point of contact during the movement so that the cursor appears to move on the display device with the pointer."

III. Inter alia the following documents were cited in the decision:

D1: JP-A-01 125612 and an English translation thereof provided by the EPO

D1a: Patent Abstracts of Japan, vol. 13, No. 368 (P-919), 16 August 1989, corresponding to document D1

D2: RESEARCH DISCLOSURE, April 1990, 31240 anonymous: "Dynamic Scanned Image Interface"

D4: EP-A-0 496 383

IV. In the statement setting out the grounds of appeal the Appellants requested that the decision under appeal be set aside and the patent revoked.

In a reply the Respondents argued in favour of the patent and requested dismissal of the appeal.

Both parties made auxiliary requests for oral proceedings.

V. The Board issued a summons to oral proceedings, dated 18 July 2001, to be held on 31 October 2001. In an annex to the summons the Board expressed the preliminary opinion that it was doubtful whether the subject-matter of claim 1 involved an inventive step, in particular having regard to the teaching of documents D1 and D2. Although the Respondents had expressed the opinion that D2 was concerned with the movement of specific "objects" on the screen and therefore taught away from using cursors, the Board took the view that such "objects" nevertheless appeared to have a character similar to that of cursors. In this respect the Board referred to its own decision in case T 333/95 (not published in OJ EPO).

VI. In a fax, received on 26 July 2001 and signed by Martyn W. Molyneaux, the Respondents requested that a new date be set for the oral proceedings "for some time after 19 November 2001". They stated: "We regret that the undersigned has a pre-existing series of engagements booked in the Far East extending from 17 October 2001 through 19 November 2001".

VII. In a letter dated 3 August 2001 the Board referred to OJ EPO 2000, 456, which sets out the "Notice of the Vice-Presidents Directorates-General 2 and 3 dated 1 September 2000 concerning oral proceedings before the EPO" and stated that "the scheduled oral proceedings will not be cancelled" since "the Board does not consider the Respondents' request for postponement of the oral proceedings appointed on 31 October 2001 to meet the requirements set out in OJ EPO 2000, 456".

VIII. On 24 October 2001 the Respondents sent a fax in which they stated:

"We cannot agree that the reasons given in our request for postponement do not meet the requirements set out in OJ EPO 2000, 456". They referred in particular to paragraph 2.3 of the Notice of the Vice-Presidents and argued that "a pre-existing series of engagements booked in the Far East must surely be a valid reason for requesting a new date for oral proceedings". The engagements were said to be "business engagements" and that the undersigned was the only person familiar with

the present case and authorised by the Patentee to attend the oral proceedings. The letter was signed by Clifford J. Want on behalf of Martyn W. Molyneaux, who wrote in the name of Wildman, Harrold, Allen & Dixon.

It was also stated in the letter that, although no evidence was required according to the Notice of the Vice-Presidents, such evidence was enclosed. Copies of two flight tickets from London (departure on 19 October) to Taipei via Singapore, Phuket and Singapore and from Taipei back to London via Seoul, San Francisco and Chicago were annexed to the letter. They were apparently issued on 17 October 2001.

A copy of the letter was also sent to the President of the EPO, Mr I. Kober.

IX. On 26 October 2001 the Registry of the Board faxed the following message to the parties: "The parties are informed that the Oral Proceedings will take place on 31.10.01 as notified in our summons of 18.07.01".

X. On 29 October 2001 the Respondents sent a fax, addressed to the President of the EPO, Mr I. Kober, a copy being enclosed for the Chairman of the present Board of Appeal. The Respondents referred to the Board's message to the parties dated 26 October 2001 and stated that they found the response of the Board unacceptable. Since Mr Molyneaux was the only representative familiar with the case, they again requested adjournment. This letter (fax) was signed in the same way and apparently by the same person as the Respondents' letter (fax), dated 24 October 2001.

XI. The oral proceedings were held on 31 October 2001 without the participation of the Respondents.

Regarding the Respondents' request to postpone the oral proceedings, the Appellants' representative argued that the "Notice of the Vice-Presidents" was clear in the sense that a request for changing the date for oral proceedings must be

substantiated and that reasons must also be given as to why another representative cannot replace the representative prevented from attending the proceedings. In the present case the Respondents only tried to substantiate their case 6 days before the oral proceedings by filing evidence. In fact, this was apparently done after the representative concerned had already departed for the Far East. Postponement of oral proceedings at such a late stage was however not appropriate because the Board and the other party (parties) might have started their final preparations for the oral proceedings. The Appellants' representative said that in cases where he could expect oral proceedings and he was aware that such proceedings might clash with business engagements or his personal holidays he had tried to inform the Opposition Division or the Board in advance, before oral proceedings were appointed, as to the dates on which he would be unable to attend.

XII. As to inventive step, the Appellants in proceedings before the Board relied mainly on documents D1, D1a and D2 to argue that the subject-matter of Claim 1 did not involve an inventive step. D4 was used to show that it was known to decide the exact position of a pointer on a screen. In proceedings before the Opposition Division the Appellants had already argued that it was obvious to arrive at the invention in view of D1 alone by combining the teachings of D1 and D2 or those of D1 and D1a. During proceedings before the Board they considered the most obvious way to arrive at the invention to be the combination of the teachings of D1a and D1; it would however also be obvious to arrive at the invention from either D1 or D1a alone.

According to the Appellants the sentence in D1a describing the movement of a cursor on the screen, "*the cursor can be moved quickly by pushing the cursor position by a finger on a pressure sensitive touch panel...and releasing the finger.... after moving the cursor to the designated position*", must be so interpreted that the user touches the old cursor and drags it to the desired point on the screen. This was certainly the only interpretation the skilled person would prima facie arrive at. In fact, on this understanding of D1a, the skilled person would immediately arrive at the

invention. The only difference to the claimed invention would then be (in accordance with the first characterising feature of Claim 1) that it was not explicitly stated in D1a that the position of the contact point of the finger must be identical to that of the cursor, if the cursor has to be moved. It would however be self-evident that a check must be made that this is the case.

Alternatively it could be considered that the skilled man would combine the teachings of D1a and D1. The first embodiment in D1 concerned menu selection with the aid of icons which were displayed on the display screen. In order to select a specific menu a touch panel in front of the display had to be pressed to select the desired icon. A CPU read the relevant co-ordinates of the finger touching the panel and the corresponding icon was highlighted ("inverted") on the screen to show which icon was selected. As long as the finger was not removed from the touch panel the processing of the corresponding menu was not executed. Thus if the operator had selected the wrong icon by mistake (for example Menu B) he could move his finger along the touch panel to the correct icon (Menu C). He only removed his finger from the panel when the correct icon was highlighted. Thus, according to this first embodiment in D1, the highlighting of different icons while moving the finger over different icons on the screen very much resembled dragging a cursor. In any case it was clear that the co-ordinates of the finger were checked in relation to the icons. The skilled man would therefore arrive at the invention by combining this feature of D1 with the method disclosed in D1a.

D1 also disclosed a second embodiment which concerned the movement of a cursor. According to this embodiment, the old cursor was deleted and a new cursor was created at a position that was touched with a finger. The new cursor could be moved by the finger to a desired position on the screen. After the finger was removed from the cursor (and from the touch panel) the shape of the cursor was changed and this shape remained on the screen until the touch panel was touched again. Having regard to this second embodiment in D1, according to the Appellants the skilled person would realise that it would not always be convenient for the

operator for a new cursor to be created when the panel was touched. He would therefore consider using the old cursor already on the screen. Since the first embodiment in D1 taught how to check the position of the finger on the touch-panel in relation to an icon on the screen, the skilled man would arrive at the invention in a straightforward way.

XIII. The Respondents' written submissions during proceedings before the Board can be summarised as follows:

D1 did not mention a search procedure to determine whether a cursor was positioned at the initial contact point. Instead a specific mark was generated for the new cursor at the contact point each time a person touched the screen. Moreover, the original cursor was deleted from the screen at the moment the screen (ie the touch-panel) was touched and only the generated mark (representing the cursor) was moved across the screen.

The abstract D1a, which related to D1, did not indicate how the cursor position was initially generated, whether it was generated when the finger touched the touch panel or as a result of a cursor already on a screen which had to be dragged to a new position by the finger. The Respondents argued that the skilled reader of D1a would not rely on that abstract, but would instead turn to the original patent application D1, since the abstract was ambiguous. In any case D1a did not disclose the step of "determining from an initial contact point...", as required by the present Claim 1.

Thus a skilled person would not arrive at the invention having regard to either of the two documents. In particular it was stressed that D1a must be based upon the technical teaching of D1 and cannot therefore disclose features differing from D1.

Turning to D2, the Respondents expressed the opinion that this document related to a design package in which objects could be touched and dragged across a desktop

displayed on the screen. However this document related to "seeking a change from the iconic interfaces in other products" and taught away from the use of cursors to move objects. This application was not concerned with cursors having fine lines, but with the movement of objects. Also there was no disclosure as to how the co-ordinates of the objects were derived and how to identify the object to be moved. Thus the combination of D2 with D1a did not lead to the present invention.

XIV. Having regard to the view expressed by the Opposition Division and the Respondents that a Japanese abstract had to be interpreted in the light of the corresponding patent application, the Appellants submitted that a Japanese abstract ("Patent Abstracts of Japan") should be considered as a quite independent document. It was true that in case T 77/87, cited by the Opposition Division, it was concluded that an abstract in "Chemical Abstracts" that was inconsistent with the disclosure of the original document (a DE-A document) should be interpreted by reference to the original document. However, the abstract D1a did not concern the chemical field, but concerned a Japanese patent abstract published in English, thus an abstract which had been derived from the published Japanese patent application. Since the Japanese language was not common in Europe and it was normally not possible to provide a translation of a Japanese patent application immediately when needed, it appeared to be appropriate to rely on the abstract. In the present case most skilled readers would have interpreted the abstract as the Appellants had done. In fact the disclosure of the abstract (D1a) could be seen as a third embodiment in addition to the two embodiments disclosed in the corresponding published patent application. The Appellants however conceded that another interpretation of the abstract, i.e. in accordance with the published application D1, was possible regarding the text of D1a, but would be artificial.

In the oral proceedings the Appellants requested that the Board in the present decision should consider the value of Japanese abstracts in general, and of the present abstract D1a in particular, as references used in the assessment of novelty and inventive step.

XV. At the end of the oral proceedings the Chairman announced the Board's decision.

Reasons for the decision

1. Admissibility of appeal

The appeal meets the provisions mentioned in Rule 65(1) EPC and is therefore admissible.

2. Procedural matters

Regarding the Respondents' request for a new date for oral proceedings (see points VI to X above), in the present case the Board considered it expedient to refer to the "Notice of the Vice-Presidents Directorates-General 2 and 3 dated 1 September 2000 concerning oral proceedings before the EPO" (OJ EPO 2000, 456; hereinafter the "Notice") which was issued in order to streamline procedures before the EPO and, in particular, to enhance the effectiveness of the work of the boards of appeal, and gives clear guidance to the parties seeking postponements.

According to point 2.2 of the "Notice", a request for postponement of oral proceedings can only be allowed if

- the party concerned filed a request as soon as possible after the grounds preventing the party concerned from attending the oral proceedings have arisen,
- the request is accompanied by a sufficiently substantiated written statement indicating the reasons for the postponement, and
- the party concerned can advance serious reasons justifying the postponement.

2.1 In the letter of 3 August 2001 (see point VII above), that is almost three months before the appointed oral proceedings, the Board made clear that the Respondents' original request of 26 July 2001 (see point VI above) to fix a new date, although filed as soon as possible after the summons to oral proceedings, did not meet the requirements of the "Notice". The Board thus considers that the Respondents in the request of 26 July 2001 did not advance "serious reasons which justify the fixing of a new date"; nor can it be said that the request was accompanied by a "sufficiently substantiated written statement indicating these reasons" (see point 2.2 of the "Notice"). The only reason mentioned in the request of 26 July 2001, ie the "pre-existing series of engagements booked in the Far East", was not substantiated at all, since the "series of engagements" were not identified (see points 2.3 and 2.4 of the "Notice") and their purpose and/or character was not explained. Neither was there a statement as to why another representative within the meaning of Articles 133(3) or 134 EPC could not substitute the one (Mr Molyneaux) prevented from attending the oral proceedings, as required by point 2.5 of the "Notice".

Thus, having regard to the "Notice", it follows that the Respondents' original request (of 26 July 2001) for postponement of the oral proceedings was not allowable and that therefore the Board could not grant the Respondents' request (see point VII above).

2.2 The Board notes that the Respondents, instead of attempting to supplement their original request as soon as possible, chose to react to the Board's letter of 3 August 2001 in the letter (fax) of 24 October 2001, thus only one week before the appointed oral proceedings. They alleged that the "series of engagements in the Far East" mentioned in the original request were business engagements. In this respect they pointed out that, according to point 2.3 in the "Notice", holidays which had been firmly booked before the notification of the summons to oral proceedings were considered to be a serious reason justifying the fixing of a new date. They expressed the opinion that the business engagements "must be in the same category of valid reasons for requesting a change of date for oral proceedings as a holiday".

Moreover the Respondents stated in this letter (24 October 2001) that Mr Molyneaux was the only person familiar with the present case and the only one who was authorised by the Patentee to attend the oral proceedings.

Thus after receiving the letter of 24 October 2001 the Board had to decide whether the additional reasons were filed in time and/or whether they were valid with regard to the "Notice" in the sense that they were serious substantive reasons.

2.3 Since the additional reasons were filed only one week before the oral proceedings (the received fax is annotated "Empfangszeit 24.Okt 15:09", the Board however only received copies of the fax the next day), preparations within the Board for the oral proceedings had already started. The file of an appeal case is always circulated within the Board before oral proceedings, circulation normally commencing two weeks before oral proceedings in order to make the original papers of the case available to all Members of the Board. Once it has been circulated the file of the case normally remains with the Rapporteur. Thus if a request for postponement is only filed one week before the oral proceedings it is plain that preparations have already commenced and that a postponement of oral proceedings would detract from the effectiveness of the Board's work and also increase costs for the EPO.

It is also evident that in an inter-partes case the other party to the proceedings, who is not requesting postponement, is affected if the oral proceedings are cancelled or postponed, not only because of the interrupted preparations concerning the technical and legal issues to be settled in the oral proceedings, but also because travel schedules have to be cancelled or changed and forthcoming tasks replanned. Hence it follows that such late postponements may only be granted under exceptional circumstances.

According to point 2.2 of the "Notice", the request to fix another date "shall be filed as soon as possible after the grounds preventing the party concerned from attending oral proceedings have arisen". The Board therefore considers that the additional

reasons for the request to fix a new date for oral proceedings in the letter (fax) of 24 October 2001 were received too late and that these reasons cannot therefore be accepted.

It appears in the present case that the Respondents should have tried to improve the substantiation of their request for postponement of 26 July 2001 as soon as possible after they received the Board's negative response of 3 August 2001.

2.4 Having regard to the substance of the Respondents' late-filed reasons, the Board would like to add the following:

in their letter of 24 October 2001 the Respondents expressed the opinion (see point 2.2 above) that business engagements should fall under point 2.3 of the "Notice" and should therefore be considered, like holidays, as a valid reason for postponement of oral proceedings.

The Board is however of the opinion that business engagements should not be considered as covered by point 2.3 of the "Notice". This point concerns an inability to attend oral proceedings due to personal circumstances, such as serious illness, marriage or a death in the family, as well as holidays which have already been firmly booked. In addition, this point covers an inability to take part in oral proceedings because of a summons to other legal hearings notified to the party before the summons by the Board and also the performance of obligatory civic duties.

In the Board's view all the reasons explicitly mentioned in point 2.3 relate to reasons which arise due to circumstances beyond the control of the party. In this respect the Board finds that holidays relate to such an external circumstance because a representative or a patent agent normally has a certain number of days leave, which he or she "is forced" to use within a year. Therefore such holidays are not considered to be influenced by the party (or in reality by the office of the corresponding patent agent or firm) and thus are external to normal work.

Thus the Board takes the view that a series of business engagements is not a reason falling within point 2.3 of the "Notice", since business engagements are directly governed and planned by the office of the patent agent or the representative and are not normally affected by "external forces" within the meaning of point 2.3 of the "Notice".

In this respect it appears that point 2.4 of the "Notice" relating to "excessive work pressure" could be relevant to the "series of business engagements" referred to by the Respondents. However, according to point 2.4, "excessive work pressure" is normally not acceptable as a ground for postponement of oral proceedings. This appears to be consistent with the considerations made by the Board regarding point 2.3 of the "Notice", since "excessive work pressure" is a result of internal planning and has not arisen due to "external forces".

2.5 In the present case it also appears to the Board that the Respondents did not sufficiently substantiate their request for postponement regarding the statement that the series of business engagements were already firmly booked before the party received the Board's summons of 18 July 2001. The "evidence" received by the Board on 24 October 2001 did not prove this. The copies of the flight-tickets appended to the letter only showed that they were issued on 17 October 2001 and that the representative Mr Molyneaux had apparently departed for Bangkok on 19 October 2001, the dates being about three months after the date of the summons to oral proceedings.

2.6 The Board also notes that the Respondents did not explain why another Representative could not replace Mr Molyneaux at the appointed oral proceedings. In the letter of 24 October 2001 they merely stated that Mr Molyneaux was the only person familiar with the case. Such a statement does not constitute a reason, since it is usual that only one person in a patent agents' office is responsible for and familiar with a particular case.

The assumption underlying point 2.5 of the "Notice" is, of course, that another representative of the patent agents' office or firm should normally take over the case, at least for the appointed oral proceedings, if the responsible representative is prevented from attending and that in such a case the new representative naturally has to study the case and make himself familiar with it, so that he can prosecute the case before the Board. However, if for some reason it is not possible for a patent agents' office or firm to replace the responsible representative by another representative, then the reason should be clearly substantiated in every request for postponement according to point 2.5 of the "Notice".

2.7 Thus the Board concludes that the additional reasons for the Respondents' request for postponement of the appointed oral proceedings (fax of 24 October 2001) were not only filed too late (see point 2.3 above), but were also insufficient within the terms of the "Notice".

3. The Board also notes that two days before the appointed oral proceedings (see point X above) the Respondents sent a letter by fax addressed to the President of the EPO, a copy of which was provided to the Board, in which the Respondents applied to the President to postpone the oral proceedings appointed by the Board. Since this letter was addressed to the President of the EPO, it appears that the Board is not obliged to respond to it. Nevertheless, in view of the fact that a copy of the letter was provided to the Board, the Board points out that the boards of appeal are independent in their work (see Article 23(3) EPC) and are only bound by the EPC and its Implementing Regulations. In this respect the boards of appeal are not bound by instructions from anyone.

4. *State of the art*

As can be seen above (see point XIV), the Appellants in the present case are of the opinion that an English abstract of a Japanese patent application ("Patent Abstracts of Japan") should be interpreted independently of the corresponding published

application. The abstract would thus constitute a separate disclosure irrespective of whether it confirms, diverges from or contradicts the contents of the corresponding application. The Appellants are consequently of the opinion that a Japanese patent abstract and the corresponding application can be combined to show that a claim lacks inventive step. In the present case they are of the opinion that the abstract D1a generates a new embodiment which is not present in the corresponding published patent application. Having regard to its text when taken alone, the Board agrees that such an interpretation of the abstract D1a is possible. The question is however whether such an independent prior art status of the abstract is consistent with its intended purpose and legal nature.

4.1 Patent Abstracts of Japan, which also make up part of the search material of the EPO, are English-language versions of Japanese Publication (Kokai) Abstracts summarising the corresponding Japanese patent applications. Like other kinds of abstracts and summaries of scientific or technical articles, patent abstracts are to be read and interpreted in the light of the full disclosure of the corresponding original documents. Hence, taken alone, their content can only be considered to be provisional and acceptable on a prima facie basis. In the Board's opinion, this view corresponds to the reasonable expectation of a skilled person that the abstracting process involves an unavoidable condensation and simplification of the full contents of a document which may lead to clarity problems. These problems are, of course, aggravated if the abstract is moreover translated into a foreign language. This means, that patent abstracts - even if clear when taken alone - are only useful as a prima facie source of information attracting a skilled person's attention and pointing to the disclosure of the original document for full assessment of its contents, which becomes essential in case of doubt or for detailed study. It may be necessary to rely on an abstract as an isolated source of disclosure if the originals or their translations are not available. If however it can be proved using the original document that the content of an abstract does not concur with the original disclosure then the original disclosure prevails, and the abstract will be interpreted or corrected in the light of this disclosure.

4.2 This conclusion is supported by the legal nature of European patent abstracts which, according to Article 85 EPC, "...shall merely serve for use as technical information; it may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of protection sought...". The Board notes that the provisions of the Japanese Patent Law concerning Japanese Publication Abstracts correspond to the provisions of the EPC concerning patent abstracts. Hence, although translated and issued separately by the JPO, the Patent Abstracts of Japan, by their legal nature, cannot be considered to be independent of their associated applications, but, on the contrary, are intended to reflect their contents.

4.3 In the Board's view these findings are also consistent with the established case law of the boards of appeal.

In case T 77/87 (OJ EPO 1990, 280), referred to by both parties, the Board stated (see point 4.1.2 of the reasons) that "When determining the state of the art for the purpose of Article 54 EPC, what has to be considered is what has been made available to a skilled man. A skilled man is interested in technical reality". In that case, although a feature of the invention of the patent in suit was disclosed in a chemical abstract, the published patent referred to in the abstract showed that the abstract was wrong. It was held that the feature disclosed in the abstract did not form part of the state of the art, since "...the disclosure of abstract document (7) should be interpreted by reference to its original, ie to document (7'), for the purpose of ascertaining the technical reality of what has been disclosed and should not be regarded as an independent document in isolation". The original application document was considered to be the primary source of what had been made available as technical teaching and its abstract was by its nature merely a secondary and derivative source (see point 4.1.4 of the reasons).

4.4 The Appellants have pointed out that decision T 77/87 relates to abstracts published in a chemical journal and hinted that such abstracts were not comparable with official Patent Abstracts of Japan (see point XIV above). The Board is however

of the opinion that the present case can indeed be compared to case T 77/87. In both cases there is a discrepancy between the abstract and the original document. In both cases there is a clear cross-reference from the abstract to the original document. The title of the chemical abstract makes this clear and in the case of "Patent Abstracts of Japan" the cross-reference to the original document is inherently included in the system, since every abstract is related, and refers to, the corresponding original patent application.

In this respect attention is also drawn to decision T 160/92 (OJ EPO 1995, 35) the headnote of which states that "The teaching of a prepublished abstract of a Japanese patent document, considered per se without its corresponding original document, forms prima facie part of the prior art and may be legitimately cited as such if nothing on file points to its invalidity as prior art". In this case the Board also pointed out (see point 2.5 of the reasons) that T 77/87 had concluded that the disclosure of an abstract "...should not be regarded as an independent document in isolation", but should be interpreted by reference to its original if both documents are available and contain conflicting teachings. In case T 160/92 however only the Japanese abstract was on file and there was no indication that its disclosure might be erroneous or might otherwise have to be interpreted differently in the light of the disclosure of the original document. The literal disclosure of the abstract thus belonged prima facie to the state of the art. The Board added that the appellants would have had the burden of proof to show on the basis of the teaching of the original document that this disclosure was not actually part of the state of the art.

4.5 The Appellants have also referred to decision T 412/91 (not published in OJ EPO), which concludes that "If a statement [in a prior art document] is plainly wrong,... then although published it does not form part of the state of the art" (see point 4.6 of the reasons) and can be disregarded, and have pointed out that the decision nevertheless states that if the skilled reader of a document "...would not recognise that the teaching is wrong, it does belong to the state of the art".

The Board agrees with the statement in T 412/91, but only in the sense that if it is not possible to discern that the teaching concerned is wrong, then the practical result is that the teaching is considered to be prior art. However if (contrary to T 160/92, see point 4.4 above) it is shown that the English-language version of a Japanese abstract does not correspond to the published patent application, then the "technical reality" (see T 77/87, point 4.3 above) of the prior art should normally be resolved with the aid of the published Japanese patent application.

4.6 Consequently, it appears that, in view of its legal nature and intended purpose, a Japanese patent abstract in English ("Patent Abstracts of Japan") is a publication intended to reflect the technical content of the corresponding Japanese patent application for the purpose of quick prima facie information of the public, as is the purpose of any kind of abstract or summary of technical subject-matter. Hence, the contents of such abstracts are to be interpreted and possibly re-evaluated in the light of the original document if the latter is available. Indeed, if an abstract appears to add something to the original document then this points to an error in the abstract, or at least to an error in its interpretation.

4.7 In this context the Board does not accept the argumentation of the Appellants that the Patent Abstracts of Japan have a special status because of the language of the original documents. It is true that these abstracts are produced to inform the public outside Japan about patent applications in Japan. However also under these circumstances a skilled reader lacking knowledge of the Japanese language will establish the "technical reality" in case of doubt or particular interest by having the original documents translated.

4.8 In the present case, the original document D1 and an English translation thereof are available so that the contents of the abstract D1a can be compared with the full original disclosure. As accepted by the Appellants (see point XII above), document D1 describes two distinct embodiments of controlling a cursor system, the first of which (see Figures 2 to 4 and associated text) relating to highlighting of pre-existing

different icons while moving the finger on the screen from one icon to another, and the second of which (see Figures 5 to 7 and associated text) relating to the creation of a new cursor at a position touched with a finger and to moving the new cursor by the finger to a desired different position on the screen. Document D1 however does not disclose an embodiment where a pre-existing cursor is touched and dragged to a desired point on the screen, as could be understood from document D1a taken alone. Such an interpretation of D1a would combine features of the two embodiments of D1 to form a third "embodiment", as was conceded by the Appellants in the oral proceedings.

The Board therefore concludes that in the present case a skilled person would have considered the interpretation of abstract D1a suggested by the Appellants which diverges from the disclosure of original document D1 to be misleading in the sense that it adds something to the original document. This addition consequently does not belong to the state of the art.

Even on the basis of the Appellants' argument that the abstract should be considered as an independent source of disclosure since the corresponding Japanese application was not available or not comprehensible, it would be illogical to combine the "independent" abstract with an available and comprehensible version of said "unavailable" application.

5. Inventive step

The Board considers D1 to represent the closest prior art.

5.1 As accepted by both parties the claimed invention differs from the second embodiment of D1 (see Figures 5 to 7 and the corresponding text) in that it is determined whether a cursor is positioned at the initial contact point of a pointer on the screen and only if the cursor is positioned at the initial contact point is the cursor position updated as the pointer moves across the screen. In contrast, according to

D1 a new cursor (mark 51) is produced at any contact point and the previous cursor 50 is removed.

5.2 As stated in the communication by the Board, the problem to be solved can be seen in "avoiding errors in data entry when an operator is interacting with a touch sensitive screen", the Opposition Division having formulated this problem in assessing inventive step. Thus the invention is intended to avoid the cursor being moved by accident to the wrong position on the screen. Merely posing this problem in itself does not involve an inventive step. It would be self-evident that it is annoying to create a cursor at the wrong position on the screen and to lose the old one by accidentally touching the screen, as may happen when using the arrangement of D1.

5.3 As mentioned above (see point XIII), the Respondents were of the opinion that D2 did not relate to cursors having fine lines, but dealt with moving large objects around a screen using a pointer. However, as already pointed out by the Board in the communication annexed to the summons to oral proceedings, a close similarity nevertheless exists between on the one hand touching a cursor and moving it around a screen and on the other hand performing the corresponding operation with symbols, such as the telephone and "file cabinet" objects explicitly mentioned in D2. Moreover, cursors may have a variety of different forms and appearances.

In this respect it is also noted that the present Board in case T 333/95, relating to European patent application No. 88 480 023.6, dealt with a claim, the key feature of which was "making said graphics objects the current cursor under the control of a pointing device". The "graphics objects" in this case were figures, "sprites", which were used for creating an animated display and which could be moved across the screen. The Board concluded that the feature "making said graphics objects the current cursor" clearly had a technical character and moreover that the prior art cited in that case did not mention "that a graphics object itself was made a cursor".

Hence, it must be assumed that a person skilled in the art was aware of the close relationship between cursors and "objects" to be moved around on a screen before the priority date of the patent in suit.

5.4 The Board therefore finds that the "objects" mentioned in D2 would be regarded as cursors, as suggested by the Appellants, or at least would be seen as being very similar to cursors in their use and "behaviour".

It appears that the arrangement of D2 must identify the different "objects" displayed on the screen by some means, just as the present invention identifies the cursor, since it must also be important in D2 to verify that the pointer is correctly positioned on the "object". Only if the "object" is positioned at the contact point of the pointer can a moving operation be started. If the pointer does not hit the "object", or hits a wrong "object", the "object" intended to be moved does not move. Hence the present invention must rely on considerations already made in D2.

5.5 The Board is therefore of the opinion that the skilled person would arrive at the invention in a straightforward way. Starting out from the second embodiment disclosed in D1 and having regard to the posed problem, it would be obvious to use the techniques disclosed in D2 and so arrive at the invention.

5.6 The Board moreover agrees with the Appellants that the first embodiment of D1 (together with the second embodiment of D1) also appears to lead the skilled person to the invention, since it teaches that if the position of an "object", an icon used as a push-button, is correctly touched the "object" is highlighted, i.e. it is determined from an initial contact point whether an "object" is positioned at said point and only in this case is a further step performed (execution of the highlighted icon if the pointer is removed or transferring the highlighted state to another icon if the pointer is moved on the screen to said another icon).

5.7 Thus the Board finds that the subject-matter of Claim 1 of the patent in suit does not meet the requirements of Articles 52(1) and 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.