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D E C I S I O N
of 12 August 2005

Case Number: T 0858/02 - 3.5.3

Application Number: 00304079.7

Publication Number: 1056267

IPC: H04M 3/533

Language of the proceedings: EN

Title of invention:
Structured voicemail messages

Applicant:
Lucent Technologies Inc.

Opponent:
-

Headword:
Structured voicemail messages/LUCENT

Relevant legal provisions:
EPC Art. 84, 52(2)(d)

Keyword:
"Presentation of information - no"

Decisions cited:
G 0002/88, G 0006/88, T 0410/96, T 0163/85, T 1194/97,
T 0378/88, T 0659/04

Catchword:

1. When considering the nature or category of a claimed invention attention must be paid to the substance of what is claimed, rather than only taking into account how the claimed subject-matter is designated, which can be deceptive.
2. An electronic message is not automatically excluded from patentability under Article 52(2)(d) EPC as a presentation of information. This will depend on whether the message is defined by its structure or its content.



Case Number: T 0858/02 - 3.5.3

D E C I S I O N
of the Technical Board of Appeal 3.5.3
of 12 August 2005

Appellant: Lucent Technologies Inc.
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Representative: Watts, Christopher Malcolm Kelway, Dr.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 2 April 2002
refusing European application No. 00304079.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: D. H. Rees
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This is an appeal from the decision of the examining division to refuse European patent application number 00 304 079.7 with publication number 1 056 267. The decision was dispatched on 2 April 2002. The reasons given for refusing the application were that the claimed subject-matter violated Article 84 EPC and further that it was solely a presentation of information and therefore not patentable according to Article 52(2)(d) EPC.

II. Notice of appeal was filed with a letter dated 24 April and received on 29 April 2002. The fee was paid on 29 April 2002. A statement setting out the grounds for the appeal was submitted on 2 August 2002.

III. The appellant requests that the decision of the examining division be cancelled in its entirety and a patent granted. The text of the application is as follows:

Claims 1 to 11
Description pages 1 to 48 and
Drawing sheets 1 to 8,

all as originally filed.

The appellant has made no request for oral proceedings.

IV. The single independent claim 1 reads as follows:
"An electronic message comprising:
a plurality of messaging elements, at least one of the messaging elements being associated with at least a

portion of the content of the message and at least one of the messaging elements comprising instructions that define a structure of the message; and an address of a recipient of the message on a messaging system that stores the message and is capable of interpreting the instructions, assembling the content-related messaging elements in accordance with the instructions, and presenting the assembled message to the recipient when the recipient retrieves the message from storage."

Reasons for the Decision

1. *The objection under Article 84 EPC*
- 1.1 The examining division gave Article 84 EPC as its first ground for refusing the application. It would appear that the fundamental objection was that the term "message" defined neither a physical entity such as a product or apparatus nor an activity such as a method or process, these being the only allowable categories of patent claim. It was not explained how this objection arose from Article 84 EPC. The board notes that the decision of the Enlarged Board of Appeal G 2/88 (OJ EPO 1988, 347) distinguishes two basic types of claim, namely claims to physical entities and claims to physical activities, at point 2.2, although it goes on to point out that claims including both features relating to physical activities and features relating to physical entities are also possible, and that there are no rigid lines of demarcation between the various possible forms of claims (see also T 410/96 (unpublished) at point 4). Article 84 is further

mentioned in G 2/88, together with Rule 29(1) EPC, at point 2.5, but only to say that physical entities must be defined in terms of physical parameters of the entity, and physical activities must be defined in terms of their physical steps. The board further notes that the section of the Guidelines for Examination cited by the examining division (C-III 3.1) is marked as relating to Rule 29(2), not Article 84.

- 1.2 The examining division considered that a "message" related to the communication between two entities, and that such a communication could not be considered as a physical entity but rather related exclusively to the information content, which was non-physical information of an essentially abstract character. But when considering the nature or category of a claimed invention attention must be paid to the substance of what is claimed, rather than only taking into account how the claimed subject-matter is designated, which can be deceptive. In the board's view the content of the information in the message, in the sense used by the examination division, is not claimed. It is commonplace that the same word may be used both for the physical realisation of some information and its content, in the sense of what is understood by its recipient (consider the word "film"). Thus whereas the term "message" may in some contexts refer merely to the information it is intended to convey ("The message of 'Don Quixote' is ..."), when qualified by the term "electronic" the natural meaning refers to its physical realisation. An electronic message is an electrical, magnetic or electromagnetic signal or collection of signals and moreover clearly the product of an electronic process. This conclusion is congruent with the decision in

- T 163/85 (OJ EPO 1990, 379) to grant a patent containing a claim directed to a "colour television signal".
- 1.3 Thus the board concludes that the examining division's rejection of the application under Article 84 EPC was not well-founded.
2. *The objection under Article 52(2)(d) EPC, "presentation of information"*
- 2.1 The examining division also very briefly argued that the message was "solely characterised by the content of the information therein," citing Article 52(2)(d) EPC and the Guidelines for Examination C-IV 2.3.
- 2.2 In response, the appellant cited T 163/85 and T 1194/97 (OJ EPO 2000, 525) and argued that the claimed "instructions" were "functional data" in the sense of the latter decision.
- 2.3 The examining division did not accept the applicability of these two decisions. In relation to the former decision it considered that the electronic message claimed was not analogous to the colour television signal of that case because it did not inherently comprise the technical features of the messaging system. As to the latter decision, it noted that in that case a reading device had been separately claimed in the same application, whereas in the present application there was no claim to the messaging system and thus no claim which defined physical interactions. It was further argued that the feature of the claim specifying a messaging system "capable of interpreting the

instructions" did not have a limiting effect on the features of the claimed message. Finally, it argued that the message was exclusively defined by its "format (i.e. data structure)" and not by functional data, since the claim specified that "the instructions ... define a structure of the message."

2.4 The board does not share this view. In order to handle the claimed electronic message properly the messaging system must be able firstly to distinguish those elements of the message which constitute instructions from those which represent content, and secondly to assemble content elements according to the instructions. In the language of computer technology it must have an appropriate interpreter and automatically apply it to the received message to produce a processed message. These are technical restrictions on the nature of the messaging system, not satisfied by an everyday answering machine (in the case of a voice system), or by a simple text (as opposed to HTML) email system, for example. The messaging system may have a very wide range of possible implementations, but it is nonetheless restricted to specific technical features, and the claimed electronic message does inherently comprise those technical features relevant to the invention.

2.5 Moreover, since the parts of the message which constitute "instructions" must be automatically recognised and processed by the receiving message system, which processing in turn determines how the message is presented to its final recipient, the board considers that the instructions do constitute

"functional" rather than "cognitive" data in the sense in which those terms are used in T 1194/97.

- 2.6 The reasoning which leads to these conclusions is unaffected by the question of whether or not the application contains a separate independent claim to the messaging system. In the board's view it is irrelevant that in the application dealt with in T 1194/97 there was a separate claim to a picture retrieval system. Moreover, as pointed out by the appellant in the statement of grounds of appeal, the independent claim to a signal dealt with in T 163/85 did not refer to any other claim.
- 2.7 The examining division's final argument, that the instructions are not unambiguously "functional" data because according to the claim they "define a structure of the message", seems to be based on a misconception of the claimed subject-matter. As the board interprets the claim, the reference to the "structure of the message" here relates to the message as it is passed on to the intended recipient, not as it is received. Thus in this context "defin[ing] a structure of the message" essentially refers to the same feature as "assembling the content-related messaging elements in accordance with the instructions," later in the claim. While the Guidelines for Examination do not bind the Boards of Appeal in any way, it is noted that even according to the section of the Guidelines cited by the examining division, a computer data structure is not under all circumstances excluded from patentability; that the instructions "define a structure of the message" does not automatically lead to the conclusion that a "format (i.e. data structure)" is unpatentable.

- 2.8 In the board's view the reasoning leading to this conclusion is congruent not only with T 163/85 and T 1194/97 but also with T 378/88 and T 659/04 (both unpublished) concerning formats of data on a carrier.
- 2.9 Thus the board concludes that the examining division's reasons for rejecting the application under Article 52(2)(d) EPC were also incorrect.
3. The appellant has requested the grant of a patent. However the examining division has not yet expressed any opinion on the other requirements for patentability, in particular novelty and inventive step, nor even on clarity in the conventional sense, and in the circumstances the board cannot share the appellant's view that the examining division's silence on these issues meant that it had no such objections. Rather it would appear more likely that the examining division has not yet considered them. Moreover the board does not consider the fact that a patent has been granted in an application dealing with similar subject-matter (as mentioned in the statement of grounds of appeal) to be relevant. Hence the board considers it would be more appropriate to remit the case to the examining division for further prosecution.

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.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland