

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 31 January 2006

Case Number: T 1122/03 - 3.5.03

Application Number: 93119152.2

Publication Number: 0602438

IPC: H04H 1/00

Language of the proceedings: EN

Title of invention:
RDS broadcast receiver

Patentee:
CLARION Co., Ltd.

Opponent:
Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG

Headword:
RDS broadcast receiver/CLARION

Relevant legal provisions:
EPC Art. 100(a), 56

Keyword:
"Inventive step - main request and auxiliary request 1 (no)"
"Auxiliary request 2 - not admitted"
"Auxiliary request 3 - remittal"

Decisions cited:
T 0887/98

Catchword:
-



Case Number: T 1122/03 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 31 January 2006

Appellant: CLARION Co., Ltd.
(Proprietor of the patent) 5-35-2, Hakusan
Bunkyo-ku
Tokyo (JP)

Representative: Schuhmann, Albrecht
c/o Merten & Pfeffer Patentmanagement
Allersbergerstrasse 185/G-3
D-90461 Nürnberg (DE)

Respondent: Interessengemeinschaft für
(Opponent) Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co.KG
Bahnstrasse 62
D-40210 Düsseldorf (DE)

Representative: Eichstädt, Alfred
Maryniok & Eichstädt
Kuhbergstrasse 23
D-96317 Kronach (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 6 August 2003
revoking European patent No. 0602438 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: D. H. Rees
R. Moufang

Summary of Facts and Submissions

- I. This is an appeal by the proprietor of European Patent No. 0 602 438 against the decision of the opposition division to revoke the patent.
- II. The opponent (respondent) had requested revocation of the patent in its entirety on the ground that the subject-matter of the claims as granted did not involve an inventive step, Article 100(a) EPC. During the opposition proceedings a further objection was raised under Article 100(b) EPC, that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- III. In oral proceedings the opposition division decided not to admit an amended claim 1 which had been submitted and went on to reject the proprietor's (appellant's) only remaining request, which was for maintenance of the patent with the claims as granted and a description amended during the oral proceedings. The claimed subject-matter was held not to involve an inventive step in the light of documents

D3: EP 0 498 233 A and

D7: Bedienungsanleitung des Grundig Autoradios WKC 3851 RDS, Grundig AG, Fürth.

In the written reasons the opposition division also stated its view that the patent did however satisfy the requirements of Article 100(b) EPC.

- IV. This decision was appealed, the appellant requesting that the decision be set aside and implicitly that the patent be maintained as granted. The respondent maintained both grounds for revoking the patent.
- V. In an annex to its summons to attend oral proceedings the board gave its preliminary opinion that although there were difficulties in interpreting the claimed subject-matter it appeared to involve an inventive step and that the patent satisfied Article 100(b).
- VI. Prior to the oral proceedings, and within the time limit set for further submissions, the respondent submitted the document

D8: "Guidelines for the implementation of the RDS system", Tech 3260-E, European Broadcasting Union, Geneva, January 1990.

- VII. In the oral proceedings the appellant requested that the decision under appeal be set aside and the patent be maintained as granted, or in the alternative, the case be remitted to the department of first instance for further prosecution or, in the alternative, the patent be maintained on the basis of Auxiliary Requests 1, 2 or 3, all filed at the oral proceedings.

The auxiliary requests 1, 2 and 3 consisted of new sets of claims 1 to 6, 1 to 7 and 1 to 7 respectively.

The respondent requested that the appeal be dismissed.

VIII. The single independent claim of the patent as granted reads as follows:

"An RDS receiver (100) having a plurality of keys including an RDS key (10), comprising:

means for receiving broadcast transmission signals;
said means for receiving including means for deriving a first audio signal from said broadcast transmission signals;

means (2) for determining a broadcast category of a broadcast signal;

controller (3) means including means for storing a desired category item;

said controller (3) means including means for activating an interrupt mode;

means for deriving a second audio signal from said broadcast signals;

characterized in that:

said controller (3) means having means for activating a selection mode of said storing means when said RDS key (10) is actuated for a specified interval;

said controller (3) means including means for outputting said second audio signal when said first audio signal does not match the desired category item;
said means for outputting said second audio signal being activated when said interrupt mode is inactive;
and

said controller (3) means including means for outputting said first audio signal when said interrupt mode is activated and a desired category item, stored in said controller means, matches the category of a broadcast transmission signal received."

In the independent claim of Auxiliary Request 1, the feature "said controller (3) means having means for activating a selection mode of said storing means when said RDS key (10) is actuated for a specified interval," is replaced by,

"said controller (3) means including means for storing a desired category item having first means for activating a selection mode of said storing means when said RDS key (10) is actuated for a specified interval, second means for indicating a consecutive one of a stored list of selectable category items when a predetermined key is actuated and said selection mode is selected and third means for deactivating said selection mode after an interval during which said predetermined key remains deactivated."

This replacement text corresponds to claim 5 as granted, except that "for about two seconds" has been replaced by "for a specified interval", as in claim 1 as granted.

The independent claim of Auxiliary Request 2 adds further matter to Auxiliary Request 1 and reads as follows:

"An RDS receiver (100) having a plurality of keys including an RDS key (10), comprising:

means for receiving broadcast transmission signals;
said means for receiving including means for deriving a first audio signal from said broadcast transmission signals;

means (2) for determining a broadcast category of a broadcast signal;

controller (3) means including means for storing a desired category item;
said controller (3) means including means for activating an interrupt mode;
means for deriving a second audio signal from said broadcast signals;

characterized in that:

said controller (3) means including means for storing a desired category item having first means for activating a selection mode of said storing means when said RDS key (10) is actuated for a specified interval, second means for indicating a consecutive one of a stored list of selectable category items when a predetermined key is actuated by a user and said selection mode is selected and third means for deactivating said selection mode after an interval during which said predetermined key remains deactivated, such that the last indicated category item is selected by the user and when said selection mode is deactivated;
said controller (3) means including means for outputting said second audio signal when said first audio signal does not match the desired category item;
said means for outputting said second audio signal being activated when said interrupt mode is inactive;
and
said controller (3) means including means for outputting said first audio signal when said interrupt mode is activated and a desired category item, stored in said controller means, matches the category of a broadcast transmission signal received;
said controller means comprising means to automatically adjust the said means for receiving when said interrupt mode is active and said desired category item matches

the said category of said received transmission signal."

The independent claim of Auxiliary Request 3 is the same as claim 1 as granted with the following feature added:

"said controller means including means for confirming the receivability of said second audio signal after the category of said first audio signal changes; and said controller means including means for subsequently tuning said means for receiving to receive said second audio signal when said receivability is confirmed."

IX. At the end of the oral proceedings the chairman announced the decision taken.

Reasons for the Decision

1. *Late-filed document D8*

1.1 According to the Rules of Procedure of the Boards of Appeal, Article 10a(2), "The statement of grounds of appeal and the reply shall contain a party's complete case." They should specify "all the facts, arguments and evidence relied on." Further, Article 10b states that "Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion." The fact that a time limit for new submissions is commonly mentioned in the communication accompanying the summons to oral proceedings is not a *carte blanche* to file new

evidence; such evidence can only be admitted to the procedure in exceptional circumstances.

- 1.2 The document D8 filed by the respondent constitutes guidelines for the implementation of the Radio Data System (RDS), issued by the European Broadcasting Union. The board considers that knowledge of these guidelines would be fundamental to developing an RDS receiver, and would therefore be part of the general background knowledge of any person working in this field.

The appellant argued on this point that the "person skilled in the art" in this case should be taken to be a well-read general electrical engineer, who would know little about RDS, a new field at the time. To the skilled person, therefore, D8 would represent a very obscure document and not common general knowledge. The board cannot agree; RDS was a well-developed technology at the priority date of the contested patent, as witnessed by the fact that prior art document D7 is the instruction manual of a car radio using at least some aspects of the RDS standards. D3 also states at column 1, lines 4 to 7, that RDS was already defined in 1984, i.e. eight years before the earliest priority date of the opposed patent. RDS receivers were therefore an active field of development, of interest to all major manufacturers of car radios for the European market, before the claimed priority dates. In the board's view the relevant "person skilled in the art" is an engineer involved in that development.

- 1.3 Thus the board takes the view that D8 illustrates the common general knowledge of the person skilled in the art. It was, moreover, submitted one month before the

oral proceedings and is relatively easy to understand, so that the appellant and the board had adequate time to consider it. Finally, it is even at first glance very relevant, discussing Enhanced Other Networks (EON) and the Programme Type (PTY) codes which are fundamental to the claimed invention. All these considerations, taken together, led the board to decide to admit D8 into the proceedings.

2. *The main request*

2.1 The claimed subject-matter is not wholly clear, an observation disputed by neither party. However, this is not of itself a ground for revocation of the patent. The skilled person would consult the description and drawings to elucidate the unclear terms. The board understands the embodiment of the invention described as working as follows. The user of an RDS radio receiver is listening to a broadcast on some frequency. He or she indicates to the system that a specific category of broadcast (called a "Programme Type", PTY), e.g. news, is desired, by pressing the RDS key for at least a certain length of time, which first of all puts the receiver into a "selection mode". This means that a first category name is displayed in the radio display, and that the user can progress through the available categories by repeatedly pressing certain buttons, e.g. the "tune up" and "tune down" buttons, until the desired category name is displayed. When this displayed category name has not been changed for a specific length of time, the system stores it as the desired broadcast category, exits the "selection mode" and enters a "standby mode", see column 5, lines 4 to 32 and Fig. 3 of the granted patent. In this mode, if the

category of broadcast currently being received matches the desired category, the receiver continues to output this broadcast (column 5, lines 36 to 41). Otherwise the EON (Enhanced Other Networks) information received with the current broadcast is scanned for another PI (Programme Identification) code which has the desired PTY code associated with it. If such a PI code is found, the receiver enters an "interrupt mode", retuning to an appropriate frequency associated with the found PI code. If no such PI code is found the receiver continues to output the original broadcast, i.e. remains in the "PTY standby mode", and scans the EON information regularly looking for such a PI code (column 5, lines 41 to 47 and Fig. 4). When the receiver is in the "interrupt mode" and the PTY code of the frequency to which it has retuned changes to another category (which is therefore not the desired category), the receiver retunes to the frequency which was being received when the "interrupt mode" was activated (column 6, lines 3 to 12, where the expression "PTY standby mode" in line 3 should clearly be "PTY interrupt mode", and Fig. 6, where Box 60 should clearly be "PTY interrupt reception", rather than "PTY interrupt standby reception"). The receiver attempts to read the PI code sent on the frequency to which it has retuned; if it fails, the signal quality is taken to be too poor and the station is tuned to yet another station according to one of two described procedures (column 6, lines 12 to 18). The receiver apparently then returns to the "PTY standby mode" see Fig. 5, Box 95.

In passing, the board notes that in the opposition proceedings the respondent argued that features relating to different figures of the disputed patent

could not be combined because the patent, in its section "Brief Description of the Drawings", refers to each figure as a separate embodiment of the invention. The board does not agree; it would be clear to the skilled person reading the patent that although some alternatives are shown (e.g. the methods of Figs. 7 and 8 respectively), the figures generally relate to the same system, so that most of the flow charts may indeed be considered in combination as aspects of the same embodiment.

2.2 The board considers that the features specified in claim 1 of the main request are consistent with this interpretation of the description. The "second audio signal" corresponds to the frequency originally being received and the "first audio signal" is that received in the interrupt mode, having the desired PTY code. "Activating an interrupt mode" is interpreted as entering the "interrupt mode". The "interrupt mode" being "inactive" is interpreted as meaning that the receiver is not in the "interrupt mode". Finally, the board interprets "when said interrupt mode is activated and a desired category item, stored in said controller means, matches the category of a broadcast transmission signal received," not as two separate conditions, but rather as a condition and its result, i.e. the receiver enters the "interrupt mode" because the category (PTY code) of a broadcast transmission signal matches the stored desired category.

2.3 The appellant further argued that the claimed subject-matter specified not only entry into "interrupt mode" but also exit from this mode when no broadcast transmission signal had the desired category, i.e. that

the "when" in this condition should be understood to mean "while". However, the board considers that there is no basis for such a narrow interpretation, since the broader interpretation that the claim relates only to entry into the "interrupt mode" and how the receiver behaves in "interrupt mode" is also consistent with the wording of the claim.

- 2.4 The respondent argued that because of inconsistent use of expressions in the description, the term "interrupt mode" in the independent claim was not clear and therefore had to be interpreted broadly. It was then argued that D3 disclosed all of the claimed features except the actuation of a key for a specified length of time to put the receiver into selection mode. A similar use of a key for two functions was disclosed in D7. The opposition division followed this argument in its decision. The board does not agree. It would appear that that the respondent and opposition division have interpreted the term "interrupt mode" so broadly as to have no limitative effect. As stated above, the skilled person would consult the description and drawings to elucidate unclear terms. Although the description is not completely consistent and contains errors the person skilled in the art would, in the board's view, understand that the term "standby mode" denotes the state in which the receiver is repeatedly scanning EON information to check whether one of the stations is broadcasting the desired category, and that "interrupt mode" denotes the state where such a station has been detected and the receiver retuned to it, the new station being output as long as it continues to broadcast the desired category. One of the important characteristics of the "interrupt mode" as described is

that the receiver is in this mode all the time that the "first audio signal" is output. This corresponds to the - somewhat unclear - feature of the claim, "outputting said first audio signal when said interrupt mode is activated and a desired category item, stored in said controller means, matches the category of a broadcast transmission signal received."

2.5 In D3 different PTY codes are assigned to selection keys (column 2, lines 42 to 45), and at the same time lists of stations broadcasting with each PTY code are stored (column 2, line 56 to column 3, line 13). When the user chooses to listen to a particular category of broadcast, he or she presses the appropriate selection key (column 2, lines 40 and 41) and the system retunes to the station at the top of the relevant list (column 3, lines 25 to 28). It checks that this station is still broadcasting with the desired PTY code. If not it tunes to the next station on the list, and so on (column 3, lines 33 to 49).

2.6 Pressing a key to change stations may possibly be called "interrupting" the first station. However with such an interpretation the skilled person would not understand the receiver to be in an "interrupt mode" for the duration of playing the new station. Thus the skilled person would not understand an "interrupt mode" to be activated by the radio user pressing a selection key to change the received station, as disclosed in D3. Nor would the claimed feature, "outputting said first audio signal when said interrupt mode is activated and a desired category item, stored in said controller means, matches the category of a broadcast transmission signal received," be anticipated by the process of

tuning to a station, checking its PTY code and tuning to another station if the PTY code is not the desired one, and so on, disclosed elsewhere in D3. The skilled person would realise that during this process there is no audio signal output. Thus D3 does not disclose an "interrupt mode" within the terms of the claim as interpreted by the person skilled in the art in the light of the description. The board accordingly concludes that the subject-matter of claim 1 of the main request is neither known from, nor rendered obvious by, the disclosure of D3.

2.7 D7 on the other hand does disclose an "interrupt mode" in the same sense as in the disputed patent. The user actuates a "TP" ("Traffic-Program", in English "Traffic Announcement", TA) key and thereby puts the receiver into a "standby mode" where it is waiting for the RDS data received to include a set TA flag, at which time cassette playback is interrupted by and for the length of the traffic announcement (D7, page 10, column 1, and page 15, column 2). While the traffic announcement is being output, the receiver is in an "interrupt mode".

2.8 This feature of D7 is intrinsic to the RDS system. From general background knowledge of RDS as illustrated by D8, the skilled person would further have known at the claimed priority dates that TA information in the Enhanced Other Networks (EON) part of the RDS data can also be used as the trigger to go into an "interrupt mode" which causes the receiver to tune from one station to another for a traffic announcement, the receiver being retuned to the original station when the TA code ceases (D8, page 43, lines 37 and 38). As evidenced by D8 the person skilled in the art would

- further have known that an interrupt could also be based on the PTY "alarm code", 31, designated for emergency announcements, and contained in the EON information, causing the receiver to tune to the station broadcasting the emergency announcement and retune to the original station at the end of the announcement (page 47, line 42 to page 48, line 17).
- 2.9 The appellant argued that this disclosure in D8 in practice referred only to interrupting cassette playback. However the board considers it clear that the skilled person would understand the cited passage to refer to the interruption of radio reception, since it is stated that the receiver should "retune" back to the original programme at the end of the announcement.
- 2.10 It is stated in D8, see section 4.3.1, "EON feature", that EON information is intended "to assist automated tuning to other programme services," and that the EON data transmitted can include PTY codes. The purpose of this is clearly to provide additional information which could aid the user in choosing a station to play. While this information could be used in a number of ways, one obvious way to use it would be to extend the existing ability to interrupt on the TA code and "alarm" PTY code 31 to interruption on a user-specified PTY code.
- 2.11 The appellant argued that the known "alarm code" interrupt would be "hard-wired" into the receiver, not under the user's control, so that this knowledge would not lead the skilled person to the selection process claimed. However, the board notes that at least the traffic announcements can be selected or deselected, so that pressing the "TP" key in the receiver of D7 would

put the receiver into "TA standby mode" and a TA flag in the EON data could cause the receiver to go into a "TA interrupt mode". The necessity for a further selection stage to specify which programme category is desired follows directly from the fact that there are plural categories which different users might be interested in. Whether that selection takes place separately from putting the receiver into standby mode, or every time immediately before it goes into said standby mode as in the disputed patent, would simply be a matter of everyday design choice from obvious alternatives.

- 2.12 Thus the skilled person's common general knowledge as evidenced by the disclosure of D8, applied to the disclosure of D7, would lead to a system having at least the following claimed features:
- An RDS receiver having a plurality of keys including an RDS key (D7, page 3, item 17), comprising
 - means for receiving broadcast transmission signals (D7);
 - said means for receiving including means for deriving a first audio signal from said broadcast transmission signals (traffic announcement or emergency announcement from D7 and D8 cited passages, or a broadcast having a specified PTY value, see point 2.10 above);
 - means for determining a broadcast category of a broadcast signal (PTY code in the EON information, D8);
 - controller means including means for storing a desired category item (obviously required);
 - said controller means including means for activating an interrupt mode (D7 and D8, cited passages);
 - means for deriving a second audio signal from said broadcast signals (the "original tuning frequency" or

"original programme" in D8, page 43, line 38 and page 48, line 17);
said controller means having means for activating a selection mode of said storing means (obviously required in conjunction with the "TP" button, item 19 at page 3 of D7);
said controller means including means for outputting said second audio signal when said first audio signal does not match the desired category item (the standby mode of D7 or D8, discussed above);
said means for outputting said second audio signal being activated when said interrupt mode is inactive (the cassette playback of D7 or original programme of D8); and
said controller (3) means including means for outputting said first audio signal when said interrupt mode is activated and a desired category item, stored in said controller means, matches the category of a broadcast transmission signal received (interruption of cassette or retuning to another station when TA or PTY alarm code is detected in D7 and D8, see point 2.10 above as regards the extension to a desired broadcast category).

- 2.13 Thus the only feature of the independent claim of the main request not directly following from the above considerations is that the selection mode is activated when the RDS key is actuated for a specified interval. However the board considers that it was routine design practice for car radios to provide keys with more than one function, given the limited front panel space available, and to distinguish between the functions on the basis of the length of time for which the key is pressed. As an example D7 shows the RDS key being used

in this way, although to invoke a different function, at page 10, column 2, lines 20 to 26.

2.14 The board accordingly concludes that the subject-matter of the independent claim of the main request does not involve an inventive step with respect to the common general knowledge of the person skilled in the art (as illustrated by D8) applied to the disclosure of D7.

3. In the course of the oral proceedings, after the chairman had presented the board's negative conclusions with respect to the main request, the appellant made a request that the case be remitted to the opposition division for further examination on the basis of that request, since the facts and arguments on which the claim was held to lack an inventive step had changed and the proprietor had not had the chance to present counter arguments before two instances. However, the board considered that at the stage reached, when the main request had been discussed substantively and the board's conclusions announced, it could not grant the request for remittal, since the process of further examination by the opposition division would clearly be influenced by the parties' knowledge of the board's view. Moreover, it is a matter for the board's discretion whether to remit a case in accordance with Article 111(1) EPC; there is no absolute right to have a case remitted whenever new circumstances arise. In this case, the opposition division had already come to the same conclusion as the board, that the subject-matter of the independent claim of the main request did not involve an inventive step, albeit based on document D3 as closest prior art. The introduction of document D8 would therefore not have altered the opposition

division's decision (see T 0887/98, unpublished, at point 5). Thus the request for remittal was refused.

4. *Auxiliary Request 1*

4.1 Auxiliary request 1 was filed in the course of the oral proceedings. Accordingly, the board considered whether this late-filed request should be admitted. Moreover, the request for remittal to the opposition division on the basis of the main request having been refused, the appellant further asked for remittal on the basis of Auxiliary Request 1, for the same reasons.

4.2 The independent claim of Auxiliary Request 1 corresponds largely to granted dependent claim 5, the only difference being that the feature "about two seconds" for the actuation of the RDS key has been replaced by "a specific interval". This generalisation does not however add subject-matter to the patent, since both claim 1 as granted and claim 2 of the original application refer to a "specified interval". The request includes a relatively modest number of dependent claims. The respondent had already expressed the opinion during the opposition procedure that none of the dependent claims involved an inventive step. Thus the request did not put an undue burden on the respondent or the board to deal with it. The board therefore decided to admit the request.

4.3 However for the same reasons the board did not consider it appropriate to remit the case for further prosecution on the basis of this request, which does not represent a significant change in the case when compared to the main request.

- 4.4 The additional features of the independent claim of this request relate to the selection of which category of broadcast is desired, that is, the display of one or more category names (the claim is not limited to displaying one category at a time), moving through the list of categories by pressing a key, e.g. "Tune Up", and taking the selected category to be the desired category if this key is not pressed for a certain interval of time.
- 4.5 The board considers this to be merely routine interface design practice. Progressing down a menu by pressing a specific key repeatedly is an everyday experience, as is implicit confirmation of choice by non-action. The respondent mentioned the example of selection of a 1-digit or 2-digit programme number on a TV as an implicit confirmation of choice (if a digit, e.g. "2", is input and not followed within a certain interval by another, then the system tunes to programme number 2, rather than to twenty-something). Equally, pressing the "programme up" key repeatedly on a TV remote control progresses through the available programmes.
- 4.6 The appellant objected that TV was a different field of technology; however, TV is merely an illustration of how commonplace these features are, and the skilled person in the field of RDS receiver development can be expected to be familiar with TV remote controls.
- 4.7 The appellant also argued that the feature of confirmation of choice by non-action was advantageous, solving the problem of how to reduce the number of actions to be taken by the user compared with D3, where

after selecting a menu entry by progressing through a menu, the selection had to be confirmed by pressing another key (D3, column 2, lines 49 to 55). The board finds this unconvincing. Firstly, the fact that another alternative may have been used in another case does not necessarily make the present choice inventive; it is still a matter of everyday experience. Secondly, the pressing of another key in D3 is necessary, since it is desired to assign a number of broadcast categories to different programme keys. The pressing of a programme key therefore indicates to the system the key to which the currently displayed category should be assigned. This is not the situation in the patent in suit, where only one category needs to be chosen, and the action to be taken requires no further information from the user.

4.8 Thus the board concludes that the subject-matter of the independent claim of Auxiliary Request 1 also does not involve an inventive step, in the light of common general knowledge applied to the disclosure of D7.

5. *Auxiliary Request 2*

5.1 *Prima facie* the additional features of the independent claim of Auxiliary Request 2 merely recite explicitly features which the board has already taken into account in its considerations of the main request and Auxiliary Request 1. The appellant did not contest this view. Since this request had no prospect of success the board decided not to admit it.

6. *Auxiliary Request 3*

6.1 The appellant argued that the subject-matter introduced into the independent claim in this request was taken from column 6, lines 12 to 18 of the patent as published, which corresponds literally, apart from the appropriate renumbering of the figures, with column 9, line 54 to column 10, line 3 of the application as published. In fact, the new features of the claim are not restricted specifically to trying to read the PI code as described in this part of the specification, referring only to "confirming the receivability" of the second audio signal. However, the board notes that the amendment was disclosed in claim 17 of the original application, the wording having been changed only slightly to bring the terminology into correspondence with that used in claim 1 as granted. The board concludes therefore that the proposed amendment does not extend beyond the content of the application as filed.

6.2 The independent claim of Auxiliary Request 3 does however introduce an aspect to the claimed subject-matter which was not discussed in the opposition procedure, namely how the return to the "second audio signal" is handled. Thus it significantly changes the appellant's case. Articles 10a(2) and 10b of the Rules of Procedure of the Boards of Appeal (quoted at point 1.1 above) apply to all parties; it was therefore necessary for the board to decide at the oral proceedings whether to admit this further request.

6.3 The amendment was submitted at a very late stage in the procedure, i.e. during the oral proceedings before the

board, but it is plausible that nonetheless the appellant submitted it as soon as it could, given that the document D8 was only submitted one month before the date set for the oral proceedings. The board therefore concluded that in the specific circumstances of this case Auxiliary Request 3 should be admitted into the procedure.

6.4 The request having been filed at the oral proceedings, the respondent has had no opportunity to prepare a response. For this reason, and in order to preserve two instances, the board considers it appropriate to remit the case to the department of first instance.

6.5 The board points out that throughout the proceedings the respondent has maintained objections under Article 100(b) EPC, i.e. that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Since this objection is dependent on the subject-matter being claimed it will be necessary for the department of first instance to reconsider this objection in the light of the amended claims.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of Auxiliary Request 3 filed at the oral proceedings.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland