

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 March 2006

Case Number: T 1144/03 - 3.5.03

Application Number: 97906605.7

Publication Number: 0880860

IPC: H04Q 7/10

Language of the proceedings: EN

Title of invention:

Method for selecting information services from a menu in
selective call transceivers

Applicant:

MOTOROLA, INC.

Opponent:

-

Headword:

Selecting information services/MOTOROLA

Relevant legal provisions:

EPC Art. 84

Keyword:

"Clarity - yes, after amendment"

Decisions cited:

-

Catchword:

-



Case Number: T 1144/03 - 3.5.03

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

Appellant:

MOTOROLA, INC.
1303 East Algonquin Road
Schaumburg
IL 60196 (US)

Representative:

Cross, Rupert Edward Blount
Boulton Wade Tennant
Verulam Gardens
70 Grays' Inn Road
London WC1X 8BT (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 10 April 2003
refusing European application No. 97906605.7
pursuant to Article 97(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 from the decision of the examining division to refuse the European patent application number 97 906 605.7, originally filed as International application PCT/US97/02317, with publication numbers 0 880 860 and WO 97/31488 respectively. The decision was announced in oral proceedings held on 8 November 2002, and the written reasons for the decision dispatched on 10 April 2003. The reason given for refusing the application was that the application did not satisfy Article 84 EPC since claims 1 and 2 were not clear.

- II. Notice of appeal was filed and the fee paid on 10 June 2003. A statement setting out the grounds for the appeal was filed on 19 August 2003.

- III. In a preliminary communication the board raised a number of objections concerning lack of clarity of the claims. It further gave its preliminary opinion that the description was also unclear but that the skilled person would be able to understand the central idea sufficiently well to be able to implement it, and went on to give its view of how the skilled person would interpret the claimed invention. The board indicated that if a clear set of claims were to be filed the case would probably be remitted to the department of first instance for further prosecution. In response the appellant submitted a new set of claims.

IV. The appellant requests that the decision be set aside and a patent be granted on the basis of:

claims 1 to 10 filed with the letter dated 01 and received on 2 February 2006;

description pages

1 and 3 to 10 as published,

2 and 2a filed on 17 December 2001;

drawing sheets 1 to 4 as published.

V. Independent claims 1 and 8 read as follows:

"1. A selective call transceiver comprising:

a plurality of assignable address ports, each address port of the plurality of assignable address ports having a respective address and being operable to receive an assigned information service;

a receiver operable to receive a directory of information services;

a controller operable to generate a menu of information services from the directory of information services;

a display operable to display the menu of information services;

a user interface operable to enable a user to select an information service from the menu of information services;

the controller, coupled to the user interface, further operable to assign an address port of the plurality of assignable address ports to the selected information service;

a memory, coupled to the controller, operable to store the assignment of the address port to the selected information service; and

a transmitter operable to transmit a request for the selected information service, the request including an address of the assigned address port.

8. A method for a selective call transceiver to dynamically select available information services, the method comprising:

receiving a directory of information services;

generating a menu from the directory of information services;

displaying the menu to a user;

receiving a selection of an information service from the menu;

assigning an address port of a plurality of assignable address ports to the selected information service;

transmitting a request for the selected information service, the request including an address of the assigned address port; and

receiving the selected information service at the assigned address port."

Reasons for the Decision

1. Admissibility of the amended claims

1.1 The appellant has put forward the following sources in the published application for the presently claimed subject-matter:

- claim 1: original claim 9, page 10, lines 7 to 19 and page 5, lines 3 to 7;
- claim 2: page 3, lines 15 to 18;
- claim 3: page 8, lines 34 to 36;
- claim 4: page 3, lines 5 to 7 and 15 to 28, and page 4, lines 21 and 22;
- claim 5: page 10, lines 1 to 7;
- claim 6: page 5, lines 10 to 14 and page 10, lines 19 to 21;
- claim 7: page 3, lines 5 to 7;
- claim 8: page 8, line 13 to page 9, line 17, page 10, lines 7 to 19 and page 5, lines 3 to 7;
- claim 9: page 8, lines 32 to 36;
- claim 10: page 5, lines 7 to 14.

The board confirms that these sources, together with page 7, lines 12 to 15 for claim 2 and page 8, line 21 and page 9, lines 3 to 5 for claim 4, disclose the subject-matter of the present claims. This subject-matter therefore does not extend beyond the content of the application as filed, satisfying the requirements of Article 123(2) EPC.

- 1.2 The amendments were directed to overcoming objections raised by the board. The board therefore holds them to be admissible.

2. *Clarity and support by the description*

- 2.1 The description is difficult to understand, being unclear and in part contradictory. However, the board takes the view that reading it as a whole the skilled person would come to the following understanding of the invention as described in the preferred embodiment. It

relates to a device ("selective call transceiver") which receives wireless messages selectively, based on a destination address contained within the messages. The device receives messages having a number of different addresses. One of these addresses is the "group" or "mail drop" address. Others are called "port" addresses. A directory of available information services is transmitted with the group address and received by the device. The device creates and displays a menu of these available information services. The user can then select an information service and an associated port address - how the port address is selected is not clearly described, but the skilled person would, in the opinion of the board, be able to supply an implementation of this feature. The association of the information service and the port address is stored (i.e. the port address is "assigned" to the information service), for use for example in the case where the user selects a new service to be associated with a port address already assigned to a service, or selects a service which is already assigned to a different port. Finally the device sends a message to a central transmitter requesting that the selected information service send its messages to the device using the particular port address selected.

- 2.2 In the light of this interpretation of the described embodiment, the claimed subject-matter is both clear and supported by the description, and Article 84 EPC is satisfied. The examining division took the view that the expression "assignable address port" was capable of a number of interpretations and pointed to a variety of confusing statements in the description. The board takes the view that while the description does indeed

contain vague and even contradictory passages, the skilled person, with the help of the conventional definition of the term "port", would understand both from the description and from the independent claims as now formulated that an "assignable address port" is a logical or physical interface to the device, having an address in the sense that messages can be addressed to individual ones of said ports, and assignable in the sense that each one may be associated internally with a particular information service.

- 2.3 The further objections with respect to clarity enumerated by the examining division in its decision are no longer relevant in view of the reformulation of the claims.

3. Thus the grounds for refusing the application given by the examining division have been overcome. The board notes that the first examiner has given, in the communication dated 6 June 2001, a positive opinion as to novelty and inventive step. However, this opinion related to a hypothetical, not precisely defined, claim, and the other members of the division have not yet expressed their agreement or otherwise with the first examiner's opinion. It appears appropriate therefore to remit the case to the department of first instance 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 department of first instance for further prosecution.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland