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**Datasheet for the decision
of 15 June 2010**

Case Number: T 0347/08 - 3.5.03

Application Number: 01305619.7

Publication Number: 1182901

IPC: H04Q 7/38

Language of the proceedings: EN

Title of invention:

Mobile telephone and associated method for non-RF mode operation

Applicant:

Nokia Corporation

Opponent:

-

Headword:

Mobile telephone/NOKIA

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Added subject-matter - main and auxiliary request (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0347/08 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 15 June 2010

Appellant: Nokia Corporation
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Representative: Read, Matthew Charles
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Decision under appeal: Decision of the examining division of the
European Patent Office posted 20 September 2007
refusing European patent application
No. 01305619.7 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
R. Menapace

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European patent application No. 01305619.7 (publication number EP 1 182 901 A).

The refusal was based on the ground that claim 1 of both a main and an auxiliary request contained subject-matter which extended beyond the content of the application as filed, Article 123(2) EPC.

II. With the statement of grounds of appeal the appellant submitted claims of a new main and auxiliary request. It was requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further examination on the basis of the main request or, alternatively, on the basis of the auxiliary request. In respect of the claims of both requests, the appellant argued that claim 1 met the requirement of Article 123(2) EPC, that its subject-matter involved an inventive step (Article 56 EPC), and that the claims were clear (Article 84 EPC). Oral proceedings were conditionally requested.

III. In a communication annexed to a summons to oral proceedings, the board gave its preliminary view that that the application as filed did not provide a basis for the feature of claim 1 of each request, according to which the means for operating the mobile telephone comprised a processor arranged to control the RF communication functionality and the non-communication functionality, and that, consequently, claim 1 of each request violated Article 123(2) EPC. Further, the appellant was informed that the subject-matter of

claim 1 of each request did not appear to involve an inventive step (Article 56 EPC) having regard to the disclosure of a user's manual of the Nokia 9110 Communicator, which was referred to by the examining division in the decision under appeal, and taking into account the common general knowledge of the person skilled in the art at the priority date of the patent application in suit.

- IV. In response to the board's communication, the appellant withdrew its request for oral proceedings and requested that a decision according to the state of the file be taken. No substantive response to the objections raised in the communication was submitted.

- V. Oral proceedings were held on 15 June 2010 in the absence of the appellant. In accordance with its written submissions, the appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further examination on the basis of the main request or, alternatively, on the basis of the auxiliary request. At the end of the oral proceedings, after deliberation, the board's decision was announced.

- VI. Claim 1 of the main request reads as follows:

"A mobile telephone (200, 250, 260, 270) having RF communication functionality and non-communication functionality capability, wherein, when the mobile telephone is in a first operating mode, said RF communication functionality and said non-communication functionality are accessible and useable, comprising:
means for storing a set of instructions for

selectively controlling the operation of the mobile telephone in the first operating mode and in a second operating mode;

means for selecting a desired one of said first and second operating modes;

means for retrieving an instruction from said set of instructions corresponding to said selected one of said first and second operating modes; and

means for operating the mobile telephone in response to the instruction retrieved from said set of instructions;

characterised by:

sensing means responsive to the first operating mode; and

means responsive to said sensing means for providing an indicating signal (30, 34) to verify and validate the operation of the mobile telephone in the second operating mode;

wherein said means for operating the mobile telephone comprises a single processor arranged to control said RF communication functionality and said non-communication functionality; and

wherein, when the mobile telephone is in the second operating mode, only said non-communication functionality is accessible and useable."

Claim 1 of the auxiliary request differs from claim 1 of the main request in that in the penultimate paragraph the word "single" is deleted and in that the feature according to the last paragraph is moved to the first paragraph of the claim, i.e. between "usable" and "comprising".

Reasons for the Decision

1. *Procedural matters*

Although the appellant withdrew its request for oral proceedings, the board considered it to be expedient to hold oral proceedings for reasons of procedural economy (Article 116(1) EPC). Having verified that the appellant was duly summoned, the board decided to continue the oral proceedings in the absence of the appellant (Rule 115(2) EPC, Article 15(3) RPBA).

2. *Article 123(2) EPC - main and auxiliary requests*

2.1 Claim 1 of the main request includes the feature that "said means for operating the mobile telephone comprises a single processor arranged to control said RF communication functionality and said non-communication functionality". Claim 1 of the auxiliary request includes the same feature, except that the word "single" is deleted.

2.2 In its statement of grounds of appeal the appellant submitted that a communication device comprising a single processor was directly and unambiguously derivable from the application as filed, since the description of the embodiments mentioned only one "controller or digital signal processor (DSP)", for example, and referring to the description as originally filed, at page 6, lines 1 and 2, 4 to 12, and 20 to 22, and page 9, lines 7 and 8. There was no suggestion of a second controller or DSP being provided. From the absence of any mention of a second processor or controller in the description, the skilled reader would appreciate that a single processor is used for controlling both telephone and PDA functionality and,

hence, for controlling the operation of the telephone in its RF and non-RF operating modes.

This also followed from the discussion of the prior art at page 2, lines 25 to 30, in which the provision of two controllers in a prior art device was presented as highly unconventional. As the description of the present invention and embodiments did not explicitly mention the provision of multiple processors, the person skilled in the art would presume that the present communication device did not depart from what was conventional and that therefore a single processor was provided for controlling both RF and non-RF functionality.

The appellant further argued that the passage at page 6, lines 20 to 26, of the description as filed disclosed the storage of the instruction set for control of the mobile telephone functions and PDA-like functions in the memory means of the DSP. A skilled reader would understand that the DSP thus controls both RF and non-RF functionality of the communication device. If this were not the case, and a second processor were provided for control of the mobile telephone functions, the storage of an instruction set for control of the mobile telephone functions in the DSP would be wholly redundant.

- 2.3 The board does not find the appellant's arguments convincing for the following reasons:

The board concurs with the appellant that in the description of the preferred embodiments reference is made to "a controller or digital signal processor (DSP)". This does not however exclude that the means for operating the mobile telephone includes one or more

further processors. In other words, the reference to "a controller" does not imply that the operating means necessarily includes a single processor only.

As already pointed out in the board's communication, the prior art statements at page 2 of the description of the application as filed do not implicitly provide a basis for the feature in question, since there is no statement in the application as filed according to which the claimed methods and mobile telephone are concerned with modifications or improvements of a specific type of prior art mobile telephone only, in particular those having a single processor.

The board notes that the application as filed discloses that a processor DSP controls the process to disable the RF power function, which relates to the control of an RF communication functionality. However, as already pointed out in the board's communication, this does not imply that the processor is also arranged to control the non-communication functionality of the mobile telephone. In particular, it is noted that the application discloses that program software retrieves and uses a set of instructions which is stored in a memory means, in order to carry out operations relating to RF communication and non-communication functionalities (page 4, lines 13 to 16, page 5, lines 28 to 30, and page 6, lines 22 to 26 (cf. col. 3, lines 29 to 34, col. 4, lines 38 to 41, and col. 5, lines 16 to 22)). This memory means may be part of the DSP (page 6, lines 20 to 22 (cf. col. 5, lines 13 to 16)). However, the program software is not within the DSP, since the program software generates and forwards the non-RF activate signal to the DSP (page 5, line 30, to page 6, line 4 (cf. col. 4, lines 41 to 46)). Hence, the program

software is executed elsewhere, i.e. in another processor. The argument that if a second processor were provided for control of the mobile telephone functions, the storage of an instruction set for control of the mobile telephone functions in the DSP would be wholly redundant, is not convincing, since the program software can be executed by the other processor, whilst the set of instructions to be retrieved and used by the program software is stored in the memory means of the DSP.

2.4 The board therefore concludes that the application as filed does not provide a basis for the feature that the means for operating the mobile telephone comprises a processor arranged to control the RF communication functionality and the non-communication functionality. Consequently, claim 1 of both the main and the auxiliary request does not meet the requirement of Article 123(2) EPC.

3. None of the appellant's requests is therefore allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland