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Datasheet for the decision of 17 July 2014

Case Number: T 0333/10 - 3.5.04

Application Number: 07010519.2

Publication Number: 1841225

IPC: H04N7/14, G06F1/16, H04M1/02

Language of the proceedings: EN

Title of invention:
Mobile communication device with enhanced image communication capability

Applicant:
LG Electronics Inc.

Headword:

Relevant legal provisions:
EPC R. 137(4) (version of 13 December 2007)

Keyword:
Amendments of application - amended claims relating to unsearched subject-matter

Decisions cited:
T 2334/11

Catchword:
see point 3.7

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Case Number: T 0333/10 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 17 July 2014

Appellant: (Applicant)	LG Electronics Inc. 20 Yoido-dong Yongdungpo-gu Seoul 150-010 (KR)
Representative:	Beyer, Andreas Wuesthoff & Wuesthoff Patent- und Rechtsanwälte Schweigerstraße 2 81541 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 2 October 2009 refusing European patent application No. 07010519.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	F. Edlinger
Members:	R. Gerdes
	T. Karamanli

Summary of Facts and Submissions

I. The appeal is directed against the decision to refuse European patent application No. 07 010 519.2, published as EP 1 841 225 A2. The application was filed as a divisional application of earlier European application No. 04 029 465.4.

II. The search division established a partial European search report for the application, indicating that the application did not comply with the requirements of unity of invention and that it related to four groups of inventions. The applicant paid three additional search fees, whereupon the final search report was drawn up for all claims. In the opinion under Rule 62 EPC accompanying the European search report it was indicated that the subject-matter of claim 1 was not novel in view of the following document:

D1: GB 2 384 384 A.

The remaining features of the dependent claims compared to those of claims 1, 2 and 3 related to four different aspects which were technically quite disparate and had no corresponding technical features. Hence, the requirement of unity of invention (Article 82 EPC) was not fulfilled. The applicant was invited to state upon which invention the further prosecution of the application should be based and to limit the application accordingly.

III. In response to the Extended European search report the applicant, with a letter dated 20 March 2008, submitted amended claims according to a sole request.

IV. In a communication dated 8 August 2008 and in a communication annexed to a summons to oral proceedings dated 5 February 2009, the examining division *inter alia* raised objections under Rule 137(4) EPC (version of 13 December 2007) against the filing of these amendments.

V. In letters dated 11 December 2008 and 14 August 2009, the applicant submitted a sole set of amended claims and provided arguments concerning the admissibility and patentability of these claims.

VI. In oral proceedings on 15 September 2009, the examining division declined to admit the amended claims under Rule 137(4) EPC and refused the application pursuant to Article 97(2) EPC.

VII. The applicant appealed against this decision and with the statement of grounds of appeal submitted claims 1 to 24 which were identical to those that had not been accepted by the examining division (the sole set of claims filed with the letter dated 14 August 2009).

VIII. The board sent a communication annexed to the summons to oral proceedings indicating that it tended to concur with the examining division concerning the application of Rule 137(4) EPC.

IX. The appellant replied with a letter dated 17 June 2014 presenting further arguments.

X. Oral proceedings were held before the board on 17 July 2014. At the beginning of the oral proceedings only Mrs C. Walther-Braun was present and submitted a sub-authorisation dated 2 June 2014, by which the representative Mr B. Thum authorised her to represent

the applicant during the oral proceedings. The board informed the representative that it could not be established from the file whether the representative Mr B. Thum had the power to give a sub-authorisation to another representative. The chairman interrupted the oral proceedings from 09:10 to 09:40 hours to give the representative an opportunity to clarify whether Mr B. Thum was authorised by the appellant to sub-authorise another representative. When the oral proceedings were continued the representative Mr B. Thum was also present and asked permission for Mrs C. Walther-Braun to make oral submissions as an accompanying person and not as the appellant's representative. He further declared that her submissions would be made under his continuing responsibility and control. The board gave its permission.

XI. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims filed with the statement of grounds of appeal. As an alternative, the appellant requested that the case be remitted to the department of first instance for further prosecution.

XII. Claim 1 of the sole request reads as follows (amendments to claim 1 as originally filed are highlighted in bold):

"A mobile terminal (100) for a video telephony, comprising:
a housing **having a call button (112a) to start an image call**;
a first camera (124) disposed at a front of the housing;
a second camera (118) disposed at a rear of the housing;

at least one input unit configued to allow a user to select at least one of the first (124) and second (118) cameras to perform an image capturing function; and
a display unit (122) having a viewing direction generally being the same as a capturing direction of the first camera (124), the display unit (122) configured to function as a viewfinder by showing the image captured by at least one of the first camera (124) and the second camera (118),
wherein the first camera (124) having a capturing direction different from the capturing direction of the second camera (118),
characterized in that said display unit comprises at least two display regions (122a, 122b), wherein a first display region (122a) is adapted to display an image captured by said first camera (124) after said call button (112a) is pressed and wherein said second display region (122b) is adapted to display an image received from another mobile communication device during an image communication
wherein the image captured by the first camera (124) is selectively transmitted to the other mobile communication device based on the user selection."

XIII. The reasons given in the decision under appeal may be summarised as follows:

The features of original claims 1 and 2 were known from D1. The additional features of claims 3, 7 and 10 were "notorious not requiring a search". The remaining features of the original claims were technically disparate and related to four non-unitary inventions which solved four different technical problems. Claim 1 under consideration added features which were technically very different from the aspects of the four originally claimed inventions. The added features

concerned the way to perform an "image call", in particular, with respect to "what has to be displayed (in different regions) and sent". These additional features solved the problem of "detailing how to perform an 'image call'". Therefore, no features corresponding to any of those of the four inventions as originally claimed were present. As a consequence, the technical relationship required by Rule 44(1) EPC was lacking. The added features were extracted from the description and had not been searched because the examiner could not expect these features to be a fallback position for original claim 1. All dependent claims as originally filed were directed to structural features of a mobile communication device but none were directed to the way of performing an image call. The description was written in a "permutational" manner with tens of features that could be combined together to form a new claim. If dependent claims directed to the way to perform an image call had been present in the application as filed, the search examiner would have considered the amended claim 1 as relating to a fifth invention based on the common concept in original claim 1 (see decision under appeal, Reasons 6 to 10). Since the invention defined in claim 1 had not been searched and lacked unity with the originally claimed inventions, the amended claims were not admitted under Rule 137(4) EPC. As there were no further requests on file the application had to be refused (Article 97(2) EPC).

XIV. The appellant's arguments may be summarised as follows:

Neither of the two conditions specified in Rule 137(4) EPC was fulfilled in the present case. According to Article 92 EPC the European search report should have been drawn up "with due regard to the description and

any drawings". The set of claims submitted included only one independent claim, which was based on original claim 1 as filed and supplemented with additional features from the specification regarding the use of the display unit when performing an image call. The application related to video telephony. It was a matter of course for the person skilled in the art and indeed every user of a mobile phone that video telephony always required capturing images and transmitting these images to another mobile terminal in which the image was received and displayed on an appropriate display device. Claim 1 as originally filed specified "a display unit (122) ... configured to function as a viewfinder by showing the image captured by at least one of the first camera (124) and the second camera (118)". Hence, claim 1 indicated that several images were to be displayed on the mobile phone. Original claim 7 specified that the mobile terminal might further comprise a transceiver to send an image captured by at least one of the first and second cameras and to receive an image captured by another mobile terminal to perform the video telephony mode. Therefore, it had already been clearly defined in the original claims that features relating to performing video telephony with the claimed mobile terminal belonged to one important aspect of the application.

Claim 1 did not only comprise structural features of the mobile phone, but also related to its function (see "the display unit configured to function ..."). According to T 2334/11 (see sections 2.2.1 and 2.2.2), no "a posteriori" unity judgement should be made; rather, it was to be generally examined if the added feature taken from the description combined with the originally claimed invention to form a single general inventive concept focused on in the claims and

description as originally filed. If the amended claim was to be judged from an "a posteriori" view, this would imply that each limitation of originally claimed subject-matter based on an unsearched feature was to be rejected in general as, due to the lack of novelty of original claim 1, the subject-matter of amended claim 1 would never be combinable by an inventive concept with the invention as originally claimed. In the present case, the concept of the invention was disclosed in paragraph [0010] of the application as published, and could be regarded as to provide a mobile terminal having two cameras and a first display unit with features allowing easy and comfortable performance of video telephony.

With respect to the auxiliary request for remittal of the application, the appellant argued that an additional search should be carried out if the additional features of amended claim 1 were considered not to have been searched by the search division.

Reasons for the Decision

1. The appeal is admissible.

2. The scope of the appeal proceedings

2.1 Claim 1 as originally filed with the divisional application related to a mobile terminal for video telephony comprising inter alia a first and a second camera disposed at front and rear sides of the housing. According to that claim the cameras had different capturing directions and a display unit having a viewing direction "generally being the same" as the capturing direction of the first camera. The display

unit was configured to function as a viewfinder by showing the image captured by at least one of the two cameras.

2.2 The subject-matter of this claim was considered by the search division to lack novelty in view of D1. In addition, the search division considered claim 2 to lack novelty and claims 3, 6 and 7 to "contain only obvious details" (see opinion accompanying the European search report, section 3). The search division indicated special technical features in the dependent claims and took the view that the inventions specified by these claims did not have a technical relationship in the sense of Rule 44 EPC. Hence, the search division held that the claims lacked unity (Article 82 EPC) and related to the following four inventions:

(a) Claims 4 and 10 specified that there was one camera device per 'body',
(b) Claim 5 provided a second display to serve as 'viewfinder' when the mobile communication device was closed,
(c) Claim 8 specified that operating a protective device automatically generated a display, and
(d) Claims 9 and 18 specified that the cameras had different resolutions.

2.3 The examining division followed the opinion of the search division. With respect to the sole set of claims submitted with the letter of 14 August 2009, the examining division set out that claim 1 added features from the description which had not been searched and which solved the problem of detailing how to perform an image call which was different from those of the four searched inventions ("find another position for the cameras of D1", "allow the folding mobile communication

device of D1 to take photos when closed", "find a way to activate the photo (- viewfinder) mode" and "allowing a cheaper design of [the] mobile communication device of D1"). Therefore, claim 1 related to unsearched subject-matter and did not combine with the originally claimed inventions to form a single general inventive concept (Rule 137(4) EPC, version of 13 December 2007).

2.4 The appellant did not challenge the finding of the search division, in either the examination or the appeal proceedings. However, it argued that the claims under consideration were searched. At least the subject-matter of amended claim 1 should have been searched pursuant to Article 92 EPC because it related to the same concept as original claim 1 and was unitary therewith.

2.5 Hence, the question of non-unity of invention (and the number of non-unitary inventions) of the originally claimed subject-matter is not an issue for this appeal. The decisive question is whether the amended claims according to the appellant's sole request should have been considered admissible under Rule 137(4) EPC (version of 13 December 2007).

3. Admissibility of claims, Rule 137 EPC

3.1 Rule 137 EPC was amended by decision of the Administrative Council of 25 March 2009 (OJ EPO 2009, 299) and entered into force on 1 April 2010. According to Article 2 of that decision, the amended rule applies to European patent applications for which the European search report or the supplementary European search report was drawn up on or after 1 April 2010. In the present case, the final search report was drawn up on

24 January 2008, and therefore the amended rule does not apply.

In the following, the board will refer to Rule 137(4) EPC (version of 13 December 2007, which was valid until 1 April 2010 and corresponds to Rule 137(5) EPC which entered into force on 1 April 2010).

According to Rule 137(4) EPC, amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

Hence, for the purposes of Rule 137(4) EPC it has to be examined whether the subject-matter of amended claim 1 was searched in the context of one of the four inventions identified by the search division, or whether its subject-matter at least should have been covered by a search correctly carried out in accordance with the requirements of the EPC.

3.2 As indicated in the European search report and its accompanying opinion (see point 2.2 above) and in view of the claim dependencies, the search division searched the subject-matter corresponding to the combination of the features of claims 1, 2 and 4 as a first invention. As a second invention it searched the combination of the features of claims 1, 2 and 5. The search for the third invention related to the combined features of claims 1, 2, 3 and 8, whereas the fourth search - with claim 9 being directly dependent on claim 1 - concerned the combined features of claims 1 and 9.

Amended claim 1 under consideration contains only the features of claim 1 as originally filed, supplemented

with features extracted from the description (see paragraphs [0051], [0058] and [0059] of the published application). It does not contain the special technical features for which a search has been carried out in the context of any of the four inventions that were identified by the search division. The additional features of amended claim 1 essentially specify that the display unit comprises two display regions, the first region being adapted to display an image captured by the first camera and the second region being adapted to display an image received from another mobile communication device during an image communication. This special technical feature is disparate from those of the searched inventions. Hence, on the face of it, the European search report and its accompanying opinion do not support the view that the subject-matter of amended claim 1, consisting of the combination of features of claim 1 with features extracted from the description, has been searched.

3.3 According to Article 92 EPC, the European search report shall be drawn up in respect of the European patent application on the basis of the claims, with due regard to the description and any drawings. This principle is reflected in the Guidelines for Examination in the EPO, B-III, 3.1 and 3.2 (revised edition September 2013): "The search should on the one hand not be restricted to the literal wording of the claims, but on the other hand should not be broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings." In particular, the search division needs to consider the content of the description (and/or drawings) when performing the search in order to identify the technical problem and its solution and to ascertain whether a fallback position exists. Hence, it remains

to be checked whether the search should have included the subject-matter of amended claim 1 in view of possible fallback positions set out in the application as originally filed as well as in view of the technical problem that could be deduced from the application.

3.3.1 The description (see paragraphs [0010] and [0037]) refers to the technical problem of easily performing simultaneous voice and image communication with high-quality image information. However, transmitting or receiving high-quality image information is not served by the provision of two regions on a display. Hence, the splitting of the display into two regions according to amended claim 1 is not directly related to the technical problem set out in the description.

Furthermore, the board cannot see a clear indication in the description that the search division should have identified the additional features of amended claim 1 as a fallback position. The board agrees with the examining division that the description discloses various features which might be combined or permuted at will, and some of these were present in original dependent claims which were covered by a search for four inventions. Even if, as argued by the appellant, the patent application is "clear and manageable", a search cannot be expected to cover each aspect of the description, because it is the claims which define the matter for which protection is sought (Article 84 EPC 1973). Thus the board does not see how the search division could reasonably have discerned paragraphs [0051], [0058] and [0059] as a fallback position, in view of the different aspects for which protection was sought in the original claims and the very general aim originally mentioned in the description.

3.3.2 It was also not apparent from any one of the four different technical problems (see point 2.3 above) corresponding to the four inventions identified by the search division that the additional features of amended claim 1 might have been a possible fallback position for any of these inventions. It was stated in the decision under appeal that the first invention (claims 1, 4 and 10) solved the technical problem of how to "find another position for the cameras of D1". Actually, only the position of the second camera was changed with respect to D1, the first camera being located at the front of the housing's first body (see D1, figure 9: 10b and present application, figure 9: 124). Hence, the first invention relates to the technical problem of how to find another position for the second camera, essentially in order to be able to capture images with the mobile communication device even if the folder was closed.

According to amended claim 1, the special technical features required to solve this technical problem are replaced by the feature that the display unit comprises at least two display regions, so that the first display region may display an image captured by the first camera and the second display region may display an image received from another mobile communication device. The purpose of this latter feature can be regarded as simplifying an "image call" so that the user may view an image of himself and the image of another user at the same time (see paragraphs [0051], [0058] and [0059]).

The image of the second camera is not shown in any of the display regions. Hence, the position of the second camera cannot be related to this latter purpose. It

follows that the concept of the searched invention was essentially changed by the replacement of features relating to camera positions with features specifying different display regions on the display unit.

3.4 Also the technical problems identified by the examining division for the second to fourth inventions (see point 2.3 above) differ substantially from that of amended claim 1. Hence, the board sees no reason, and the appellant has provided no arguments, why the above analysis would be different if the subject-matter of any of the second to fourth inventions were taken as the "originally claimed invention or group of inventions" in the sense of Rule 137(4) EPC.

3.5 In conclusion, the subject-matter of amended claim 1 cannot be considered to have been searched and it does not combine with any of the originally claimed inventions to form a single general inventive concept.

3.6 The appellant's arguments did not convince the board.

3.6.1 According to the appellant it had already been clearly defined in the original claims that features relating to performing video telephony with the claimed mobile terminal belonged to one important aspect of the application. The reference to a mobile terminal for video telephony in claim 1 is, however, in the board’s view, much too general to serve as a practical basis for meaningfully determining the extent of a search. Moreover, the term "video telephony" is not mentioned at all in the description as filed.

3.6.2 In addition, the appellant argued that the feature "a display unit ... configured to function as a viewfinder by showing the image captured by at least one of the

first camera (124) and the second camera (118)" in claim 1 as originally filed indicated that several images were to be displayed at the mobile phone. Moreover, original claim 7 specified that the mobile terminal further comprised a transceiver to send an image captured by at least one of the two cameras and to receive an image captured by another mobile terminal to perform the video telephony mode. These features are, however, too unspecific to indicate that the core of the invention is about simplifying an "image call" for video telephony. The feature of claim 1 to which the appellant referred may be understood in the sense of paragraphs [0017], [0030] and [0050] to the effect that either an image of the first camera or an image of the second camera or "information entered by a user" may be displayed selectively on the first display unit. The feature of claim 7 was rightly allocated to the first invention by the search division as notorious in the technical field of the invention. Since original claim 1 already specified a "mobile terminal (100) for a video telephony" and two cameras, the additional features of claim 7 specifying a transceiver to send an image captured by one of the cameras and to receive an image captured by another mobile terminal can be considered as being implied in claim 1 or at least as being notorious in the field of video telephony.

3.7 The appellant also referred to decision T 2334/11 (sections 2.2.1 and 2.2.2) and argued that, in a case like the present one, no "a posteriori" unity judgement was to be made; rather, it was to be generally examined if the added feature taken from the description combined with the originally claimed invention to form a single general inventive concept focused on in the claims and description as originally filed.

As set out above (see point 2.2), in the present case the claims as originally filed were found to lack unity by the search division. Due to a lack of novelty of the subject-matter of claim 1 the search had to cover four different inventions (for which fees were paid). In particular, the first invention was based on the combination of features in claims 1, 2 and 4. The amended claims submitted by the applicant resulted in the examining division being faced with the combination of features of claim 1 as originally filed, together with features extracted from the description. The features of claims 2 and 4 were, however, not comprised in amended claim 1. Hence, the present case concerns the replacement of some of the features from the combination of features on which the search was based by features which may not be considered as corresponding special technical features within the meaning of Rule 44(1) EPC and which could not be expected to constitute a pure limitation of one of the searched inventions. In contrast, decision T 2334/11 concerns a factual situation in which added features restricted the scope of the searched subject-matter. This difference is also addressed in decision T 2334/11 (see point 2.2.2, penultimate paragraph) which essentially states that the jurisprudence concerning Rule 137(5) EPC (version of 1 April 2010) distinguishes between cases in which the claimed subject-matter is substantially changed, in particular by replacement or omission of a feature in a claim, and which can give rise to an objection under Rule 137(5) EPC, and those cases which concern the pure limitation or concretisation of a claim by adding a feature disclosed in the application as originally filed, and which do not normally cause lack of unity with the originally claimed invention in the sense of Rule 137(5) EPC. In the present case, the board does not see a limitation

or concretisation of any of the four inventions that were initially searched and that could have been pursued by the appellant in the present application (see points 3.2 to 3.5 above).

In addition, the board notes that decision T 2334/11 cannot be understood to the effect that the amendment of an independent claim by a feature extracted from the description is generally admissible under Rule 137(4) EPC, if the subject-matter of the independent claim has been searched and lacks novelty with respect to a prior-art document. Instead, the board in decision T 2334/11 (see Reasons 2.2.2) emphasises that - in such cases - it always has to be examined whether the added feature is linked to the general inventive idea that can be deduced from the claims and description as originally filed.

4. Hence, the amended set of claims is not admissible.

Remittal

5. Since the board found that the examining division correctly applied Rule 137(4) EPC (version of 13 December 2007) in considering the amended claims as not admissible, there is no need for an additional search to be carried out by the department of first instance. Hence, the board cannot accede to the appellant's auxiliary request that the case be remitted to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

K. Boelicke F. Edlinger

Decision electronically authenticated