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**Datasheet for the decision
of 18 January 2017**

Case Number: T 1092/12 - 3.5.03

Application Number: 07024223.5

Publication Number: 1936928

IPC: H04M3/00, H04M1/247, H04M1/725

Language of the proceedings: EN

Title of invention:
System and method for interfacing a wireless telephone to a personal computer

Applicant:
Siemens Aktiengesellschaft

Headword:
Interfacing cordless telephone and computer/SIEMENS

Relevant legal provisions:
EPC Art. 56, 84

Keyword:
Novelty (main request, first auxiliary request) - (no)
Claims (modified main request) - clarity (no)



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Case Number: T 1092/12 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 18 January 2017

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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 29 December
2011 refusing European patent application No.
07024223.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman F. van der Voort
Members: B. Noll
O. Loizou

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European application No. 07024223.5 (publication No. EP 1 936 928 A).

II. The first-instance proceedings may be summarised as follows:

(a) At the oral proceedings before the examining division on 17 March 2011, the chairman informed the applicant that the examining division intended to grant a patent based on claims 1 to 22 as filed during the oral proceedings at 15.30 hrs as a first auxiliary request and that a communication under Rule 71(3) EPC would be issued, which would also include the reasons why the main request was not allowable. A communication under Rule 71(3) EPC was sent on 26 April 2011.

(b) With a letter dated 6 July 2011 in response to the communication under Rule 71(3) EPC, the applicant requested amendments to the claims under Rule 71(4) EPC.

(c) The examining division finally refused the application on the ground that the subject-matter of claims 1, 9 and 16 of the main request lacked novelty (Articles 52(1) and 54 EPC). Further, the amended claims filed with the letter dated 6 July 2011 were not admitted. The following document was referred to in the decision:

D1: US 6 308 062 B.

III. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of a main request with claims as filed with the letter dated 9 July 2009 or, in the alternative, on the basis of a first auxiliary request with claims as filed with the statement of grounds of appeal or a second auxiliary request with claims 1 to 22 as filed on 13 April 2011 during the oral proceedings before the examining division at 15.30 hrs as a first auxiliary request. Oral proceedings were conditionally requested.

IV. In a communication accompanying the summons to oral proceedings, the board gave a preliminary opinion, in particular as to the novelty of the subject-matter of claim 1 of the main request and of the first auxiliary request.

V. Oral proceedings before the board were held on 18 January 2017.

In the course of the oral proceedings the appellant filed a further set of claims as an amended main request.

The appellant finally requested at the oral proceedings that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request as filed with the letter dated 9 July 2009 or, in the alternative, on the basis of the claims of the amended main request as filed during the oral proceedings or on the basis of the claims of the first auxiliary request as filed with the statement of grounds of appeal or the claims of the second auxiliary request as filed on 13 April 2011 during the oral

proceedings before the examining division at 15.30 hrs as a first auxiliary request.

After closing the debate and after deliberation, the chairman announced the board's decision.

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

"A system (10), comprising:
a computer (18) having a wireless interface (20);
a cordless telephone system (12, 14, 16) having a wireless computer interface (304, 306) and adapted to interface to said wireless interface (20);
at least one user interface key (22) on said cordless telephone system (12, 14, 16),
characterized in that said at least one user interface key (22) is adapted to supervise communicating with said wireless interface (20) and an alerting controller (302) is used on said cordless telephone system (10) for providing an alert responsive to a predetermined condition on said computer (18)."

VII. Claim 1 of the amended main request differs from claim 1 of the main request in that, after "a cordless telephone system (12, 14, 16)", the wording "including at least one handset (14, 16)" has been inserted and in that the last paragraph has been replaced by the following wording:

"characterized in that said at least one user interface key (22) is adapted to supervise communicating with said wireless interface (20) and used in an idle state of the handset (14, 16) when an alerting controller (302) on said handset (14, 16) of the cordless telephone system (10) provides an alert responsive to a predetermined condition on said computer (18)".

VIII. Claim 1 of the first auxiliary request differs from claim 1 of the main request in that "a predetermined condition on said computer (18)" has been replaced by the following wording:

"an alerting signal being sent from the personal computer (18) to the cordless telephone system (12, 14, 16) due to a received message or a status information on said computer (18), wherein the user can select the at least one user interface key (22) for transmitting a further signal to the personal computer (18), which in response sends the received message or at least one function menue *[sic]*".

IX. In view of the board's decision, it is not necessary to give further details of the second auxiliary request.

Reasons for the Decision

1. *Main request - novelty (Article 54 EPC)*

1.1 D1 discloses a wireless telephony system (Fig. 1) which is enabled to provide access to computer-based additional functionalities. The system comprises a computer having a wireless interface (personal computer 10 in conjunction with radio-fixed part 20; see Fig. 1 and column 2, lines 43 to 45), a cordless telephone system having a wireless computer interface adapted to interface to the wireless interface of the computer (the portable devices 15, each including a DECT radio module 138; see Figs 1, 3 and 4 and column 4, lines 22 to 24 and 50 to 53), and a user interface key on the cordless telephone system (the intelligent agent key 147 on cordless handset 141; see column 4, lines 28 to 30). Further, the user interface key is adapted to

supervise communication with the wireless interface (i.e. actuating the intelligent agent key initiates communication between a portable device and the intelligent agent residing on the personal computer through the wireless interfaces, cf. column 5, lines 34 to 41).

Further, in column 6, lines 26 to 28, a reminder functionality is described, which provides the user with the possibility to activate the intelligent agent key 147 at the cordless handset 141 and to enter or modify settings relating to a reminder, such that an alert is automatically output to the user at the time specified in the reminder. Consequently, D1 discloses that an alert at the portable device is triggered by a signal received from the personal computer. The alert is responsive to a predetermined condition on the computer, which is that the reminder condition as set is complied with. Thus, D1 also discloses the feature of an alerting controller used on the cordless telephone system for providing an alert responsive to a predetermined condition on the computer.

- 1.2 The appellant argued that the telephone system of D1 was configured to generate an alert only after the reminder had previously been set by the user by actuating the intelligent agent key 147. The cordless handset in D1 was, therefore, necessarily in communication with the computer. The cordless telephone system according to the present application, however, was configured to generate an alert even if the telephone system was in an idle state and was not in communication with the computer. Hence, the receipt of a message at the computer was announced to the user by an alert, even though the telephone system was not in communication with the computer. Therefore, the feature

in claim 1 relating to the alerting controller was not known from D1.

1.3 This argument is not convincing, however, since claim 1 is not limited to a system having a configuration in which the cordless telephone system has to be in an idle state. Nor is the claim limited to a system in which the "predetermined condition" on the computer is the receipt of a message at a computer.

1.4 For the above reasons, the subject-matter of claim 1 lacks novelty (Articles 52(1) and 54 EPC). The main request is therefore not allowable.

2. *Amended main request - clarity (Article 84 EPC)*

2.1 The characterising portion of claim 1 specifies that the user interface key "is ... used in an idle state of the handset (14, 16) when an alerting controller ... provides an alert responsive to a predetermined condition on said computer".

This feature lacks clarity, since it is concerned with the use of the handset, in particular as regards when the user interface key is operated by the user, which does not clearly define further constructional features of the claimed system. In this respect, it is noted that the feature in question may be understood, for example, such that the user interface key can only be operated in an idle state of the handset and only after the alerting controller has provided the alert, or such that the idle state is actually defined by the alerting controller providing the alert. In any case, the claim does not exclude a system in which the user interface key may also be used in a non-idle state of the handset

and/or one in which an alert is provided in the non-idle state.

- 2.2 This lack of clarity renders the claim as a whole unclear. Therefore, claim 1 does not meet the requirements of Article 84 EPC.
- 2.3 The appellant argued that the amendments to claim 1 more clearly outlined the configuration of the cordless telephone system as explained (cf. point 1.2 above).
- 2.4 The board notes however that this is not achieved by the amendments made, for the reasons set out in point 2.1 above.
- 2.5 The amended main request is therefore not allowable either.
3. *First auxiliary request - novelty (Article 54 EPC)*
- 3.1 Due to "or" appearing twice in the new wording of claim 1 (see point VIII above), the claim covers four possible configurations of the system, one being that the alert is provided due to status information on the computer and that the selection of the user interface key results in the sending of at least one function menu.
- 3.2 The feature of providing an alert due to status information on the computer is known from D1 for the reasons given above, cf. point 1.1, second paragraph. Further, the configuration of the system such that a selection of the user interface key results in at least one function menu being sent is known from Fig. 6 in D1, according to which the user is provided with a function menu ("Hold", "Transfer", etc.), which enables

the user to access the corresponding software functionalities.

- 3.3 The appellant argued that the amendment specified a relation between the actuation of the user interface key and the operation of the alert controller, which was not known from D1.
- 3.4 The board is not convinced by this argument, since it applies to only one of the four configurations referred to above (point 3.1), in which the alert is provided due to a message received at the personal computer and in which a selection of the user interface key results in the sending of the received message. This does not however concern the considerations set out above in points 3.1 and 3.2.
- 3.5 The subject-matter of claim 1 therefore lacks novelty (Articles 52(1) and 54 EPC). The first auxiliary request is thus not allowable.
4. *Second auxiliary request - remittal*
- 4.1 As set out above (cf. point V), the claims of the second auxiliary request are identical to the claims of the first auxiliary request as filed on 13 April 2011 during the oral proceedings before the examining division at 15.30 hrs. The latter request was however not the subject of and hence was not decided on, in the decision under appeal.
- 4.2 The board therefore considers it appropriate to remit the case to the department of first instance for further prosecution of the application on the basis of the claims of the second auxiliary request (Article 111(1) EPC).

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 the claims of the second auxiliary request.

The Registrar:

The Chairman:



L. Malécot-Grob

F. van der Voort

Decision electronically authenticated