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**Datasheet for the decision  
of 14 March 2023**

**Case Number:** T 1036/20 - 3.5.03

**Application Number:** 11800556.0

**Publication Number:** 2590386

**IPC:** H04M1/2745

**Language of the proceedings:** EN

**Title of invention:**

Telephone and auto-redial method

**Applicant:**

NEC Corporation

**Headword:**

Auto-redial method/NEC

**Relevant legal provisions:**

EPC Art. 54, 56

RPBA 2020 Art. 12(4), 12(6), 13(2)

**Keyword:**

Novelty - main request (no)

Inventive step - auxiliary request 1 (no)

Admittance of requests filed on appeal - auxiliary request 3  
(no): "fresh case"

Admittance of requests filed after summons - auxiliary  
requests 2 and 4: no exceptional circumstances justified with  
cogent reasons + "fresh case"

**Decisions cited:**

T 1127/16



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Case Number: T 1036/20 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 14 March 2023**

**Appellant:** NEC Corporation  
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Minato-ku  
Tokyo 108-8001 (JP)

**Representative:** Vossius & Partner  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 13 January 2020  
refusing European patent application  
No. 11800556.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chair** K. Bengi-Akyürek  
**Members:** J. Eraso Helguera  
C. Heath

## Summary of Facts and Submissions

- I. The appeal was lodged against the decision of the examining division to refuse the present European patent application for lack of novelty (Article 54 EPC) with respect to a main request and for lack of inventive step (Article 56 EPC) with respect to an auxiliary request.
- II. The decision under appeal made reference *inter alia* to the following prior-art documents:
- D1:** JP H02-5671 A  
**D4:** JP 2001-119469 A.
- III. Oral proceedings before the board were held on 14 March 2023.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of one of five claim requests:

- **main request** and **auxiliary request 1**, both subject to the decision under appeal,
- **auxiliary request 2**, filed with the reply to the board's communication under Article 15(1) RPBA 2020,
- **auxiliary request 3**, filed for the first time with the statement setting out the grounds of appeal, and
- **auxiliary request 4**, filed with the reply to the board's communication under Article 15(1) RPBA 2020.

At the end of those oral proceedings, the board announced its decision.

IV. Claim 1 of the **main request** reads as follows:

"A telephone having a redialing function, comprising:

an audio database (40) for storing a tone or a message received when a phone call is not connected; and

an audio recognition unit (20) for determining whether a tone or a message received, when making a phone call, matches the tone or the message stored in the audio database (40);

characterized by:

a redialing unit for carrying out redialing until the phone call is connected or until an operation for cancelling the redialing is carried out when it is determined by the audio recognition unit (20) that the received tone or message matches that stored in the audio database (40)."

Claim 1 of **auxiliary request 1** reads as follows:

"A telephone having a redialing function, comprising:

an audio database (40) for storing a tone or a message received when a phone call is not connected; and

an audio recognition unit (20) for determining whether a tone or a message received, when making a phone call, matches the tone or the message stored in the audio database (40);

characterized by:

a redialing unit for carrying out redialing until the phone call is connected or until an operation for

cancelling the redialing is carried out when it is determined by the audio recognition unit (20) that the received tone or message matches that stored in the audio database (40), and

an output unit for outputting, when the phone call is connected by the redialing carried out at the redialing unit, a message by voice or vibration indicating that the phone call has been connected."

Claim 1 of **auxiliary request 2** reads as follows:

"A telephone having a redialing function, comprising:

an audio database (40) for storing a tone or a message received when a phone call is not connected; and

an audio recognition unit (20) for determining whether a tone or a message received, when making a phone call, matches the tone or the message stored in the audio database (40);

a redialing unit for carrying out redialing until the phone call is connected or until an operation for cancelling the redialing is carried out when it is determined by the audio recognition unit (20) that the received tone or message matches that stored in the audio database (40), and

means for automatically issuing, when the phone call is connected, a message to that effect through a speaker (14)."

Claim 1 of **auxiliary request 3** reads as follows:

"A telephone having a redialing function, comprising:

an audio database (40) for storing a tone or a message received when a phone call is not connected;

an audio recognition unit (20) for determining whether a tone or a message received, when making a phone call, matches the tone or the message stored in the audio database (40);

a redialing unit for carrying out redialing until the phone call is connected or until an operation for cancelling the redialing is carried out when it is determined by the audio recognition unit (20) that the received tone or message matches that stored in the audio database (40), and

an output unit for automatically outputting, when the phone call is connected by the redialing carried out at the redialing unit, a message by voice through a speaker (14) indicating that the phone call has been connected."

Claim 1 of **auxiliary request 4** reads as follows:

"A telephone having a redialing function, comprising:

a display unit (13);

an audio database (40) for storing a tone or a message received when a phone call is not connected; and

an audio recognition unit (20) for determining whether a tone or a message received, when making a phone call, matches the tone or the message stored in the audio database (40);

characterized by:

a redialing unit for carrying out redialing until the phone call is connected or until an operation for cancelling the redialing is carried out when it is determined by the audio recognition unit (20) that the received tone or message matches that stored in the audio database (40), and

an output unit for outputting, when the phone call is connected by the redialing carried out at the redialing unit, a message by voice or vibration or by flashing a backlight of the display unit (13) indicating that the phone call has been connected."

## Reasons for the Decision

### 1. MAIN REQUEST

Claim 1 of the **main request** comprises the following limiting features:

A telephone having a redialing function, comprising:

- (a) an audio database for storing a tone or a message received when a phone call is not connected;
- (b) an audio recognition unit for determining whether a tone or a message received, when making a phone call, matches the tone or the message stored in the audio database;
- (c) a redialing unit for carrying out redialing until the phone call is connected or until an operation for cancelling the redialing is carried out when it is determined by the audio recognition unit that the received tone or message matches that stored in the audio database.

#### 1.1 *Claim 1 - novelty (Article 54 EPC)*

- 1.1.1 The board agrees with the novelty analysis in view of document **D1** set out in Reasons A.1 of the appealed decision. In particular, the telephone set of Fig. 1 of D1 comprises a memory circuit 8 storing a pre-registered busy tone (**feature (a)**), a voice recognition circuit 7 determining whether the received



signal matches the stored busy tone (**feature (b)**) and a control circuit 13 carrying out redialing, in case such match is found, until the phone call is connected or until the operation is cancelled (after a maximum number of trials) (**feature (c)**).

- 1.1.2 As to the interpretation of **feature (a)**, the appellant submitted that the "tone" or the "message" stored in the audio database did not constitute a dial tone previously registered. It rather constituted a tone or a message which was *actually* received when a phone call was made but not connected.

The board first emphasises that the subject-matter of a claim is to be interpreted on its own merits, i.e. without the necessity of resorting to the application's description and drawings (see e.g. **T 1127/16**, Reasons 2.6.1). As to the present case, the board concedes that the wording of claim 1 taken alone allows both technically meaningful interpretations of **feature (a)**, i.e. (i) *actually* received, as alleged by the appellant, and (ii) *to be* received, as interpreted by the examining division on the basis of paragraph [0022] of the application. Since prior-art document D1 already anticipates at least feature (a) within the meaning of the technically sensible interpretation (ii), there is no need to further dig into the teaching of the description. However, for the sake of argument, the board adds that interpretation (i), as invoked by the appellant, is in stark contrast to the application's description itself. Paragraph [0022] of the description as filed reads (emphasis added):

*"Audio database 40 stores a voice tone such as a busy tone received as a busy sound when*

*nonconnection of a phone call necessitates calling-back, or a message such as "Very busy now, please call back later". **Such a voice tone or a message is stored beforehand** by a telephone vendor at the time of shipment of the portable telephone. When the message is changed or added, a user can download the message later from the homepage of the telephone vendor."*

On the one hand, the appellant seems to infer from this paragraph three alternative embodiments, one per sentence, and interprets "received" in the first sentence as "actually received", as opposed to the other two embodiments, where the voice tone or message is stored beforehand by a telephone vendor at the time of shipment of the portable phone or downloaded later from the homepage of the telephone vendor.

However, neither paragraph [0022] nor any other passages of the description provide any information about how the telephone should recognise that a tone or message "received when a phone call is not connected" indeed constitutes a busy tone or message that needs to be stored in the audio database, e.g. whether the telephone should store the received tone or message every time the phone call is not connected, whether the tone or message should be analysed for specific characteristics (tone frequencies, semantics of the message, etc.), or whether user intervention would be required for this purpose. For this reason, the appellant's interpretation, if accepted *arguendo*, would additionally raise issues in respect of support of the claim by the description (Article 84 EPC) and sufficiency of disclosure of the claimed invention (Article 83 EPC).

1.1.3 Accordingly, the board interprets "received" in **feature (a)** of claim 1 and in paragraph [0022] as "to be received" in the sense that the audio database 40 needs to be populated in advance with recordings to be matched in real time by the audio recognition unit with the voice tone or messages actually received according to **features (b) and (c)**. At any rate, the examining division's interpretation (ii) of **feature (a)** cannot be discarded in favour of the appellant's interpretation (i), even if the latter were generally also acceptable.

1.2 If follows that the main request is not allowable under Article 54 EPC.

## 2. AUXILIARY REQUEST 1

Claim 1 of **auxiliary request 1** comprises all the limiting features of claim 1 of the main request and the following additional feature (board's outline and highlighting):

(d) an output unit for outputting, when the phone call is connected by the redialing carried out at the redialing unit, a message by voice or vibration indicating that the phone call has been connected.

### 2.1 *Claim 1 - inventive step (Article 56 EPC)*

2.1.1 The board also endorses the inventive-step analysis set out in Reasons B.5 of the appealed decision in view of either of **D1** and the skilled person's common general knowledge and **D1** combined with **D4**. Specifically, the board agrees that the effect associated with distinguishing **feature (d)** could be seen as *warning the user that a call has been connected* and that the

skilled person seeking to achieve this effect would have indeed considered the options appearing in feature (d), i.e. voice or vibration, as straightforward options to be selected from the skilled person's common general knowledge. Moreover, no further counter-arguments were presented by the appellant in this regard. At any rate, the board doubts whether the mere presentation of warning information to the redialling user could credibly assist the user in performing a technical task by means of a continued and/or guided human-machine interaction process.

- 2.1.2 The appellant submitted that **feature (d)** was at least novel and inventive in combination with features (a) to (c) discussed in respect of the main request. The present disclosure also encompassed the possibility of flashing the backlight when the call was connected, which was not envisaged by D4 or any other cited prior-art document.

As stated above, the board does not share the appellant's stance with respect to novelty of features (a) and (c) vis-à-vis document D1. As to the possibility of flashing the backlight, **feature (d)** is formulated in much broader terms and does not necessarily include this limitation (see also point 3.1.3 below).

- 2.2 Auxiliary request 1 is thus not allowable under Article 56 EPC.

3. AUXILIARY REQUESTS 2 TO 4

Claim 1 of **auxiliary request 2** comprises all the limiting features of claim 1 of the main request and

the following additional feature (board's highlighting):

(e) means for automatically issuing, when the phone call is connected, a message to that effect through a speaker.

Claim 1 of **auxiliary request 3** comprises the same limiting features as claim 1 of auxiliary request 1, except that feature (e) has been introduced in feature (d) (board's highlighting):

(d) an output unit for automatically outputting, when the phone call is connected by the redialing carried out at the redialing unit, a message by voice ~~or vibration~~ through a speaker indicating that the phone call has been connected.

Claim 1 of **auxiliary request 4** comprises the same limiting features as claim 1 of auxiliary request 1, except that the following feature has been added:

(f) a display unit;

and that feature (d) has been amended by introducing an additional alternative (board's highlighting):

(g) the output unit for outputting the message also by flashing a backlight of the display unit.

### 3.1 *Admission into the appeal proceedings*

3.1.1 The claims of **auxiliary requests 2 and 3** were submitted with the statement setting out the grounds of appeal. The appellant did not demonstrate that *this* part of the appeal case (i.e. the part relating to these auxiliary

requests) was "admissibly raised and maintained" in the opposition proceedings, as required by Article 12(4) RPBA 2020. In consequence, it is an "amendment" which may be admitted only at the discretion of the board, which shall exercise its discretion in view of, *inter alia*, the complexity of the amendment, the suitability of the amendment to address the issues which led to the appealed decision, and the need for procedural economy.

The appellant submitted that the additional features of these auxiliary requests further clarified that the "audio message" was automatically issued *when* the phone call was connected. Such an automatic audio message was not disclosed in document D1 or any of the other prior-art documents. Amended claim 1 additionally defined that the telephone comprised means for automatically issuing, when the phone call was connected, a message to that effect through a speaker (feature (e)). This feature was closely related to claim 2 defining that an output unit may output a message by voice or vibration when the phone call is connected. In other words, the added features were merely a refinement of the features of claim 2 which had been thoroughly examined and discussed. The claimed subject-matter was therefore narrower than the previous requests. Hence, a completely new examination and re-assessment of the available prior art did not appear to be necessary. Moreover, feature (e) *prima facie* established novelty over the cited prior art. None of the cited prior-art documents disclosed or suggested automatically issuing a message through a speaker when the phone call was connected.

- 3.1.2 The claims of **auxiliary request 4** and **auxiliary request 2 as amended** (including a correction of a spelling error in claim 1) were filed *after*

notification of the summons to oral proceedings before the board. Hence, the admittance of these requests is governed by Article 13(2) RPBA 2020, according to which any amendment to a party's appeal case is, in principle, not taken into account, unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

Additionally, at the stage of appeal proceedings when Article 13(2) RPBA 2020 applies, the board may, in its exercise of discretion, also rely on the criteria mentioned in Article 12(4) RPBA 2020.

As to the admissibility of **auxiliary request 4**, the appellant submitted that it had been specified in claim 1 that the telephone comprised a display unit (feature (f); cf. paragraph [0021] of the application as filed) and that a message indicating that the phone call had been connected might also be output by flashing a backlight of the display unit (feature (g) of claim 1). This was originally disclosed e.g. in paragraph [0031] of the application as filed. As for the other amended sets of claims, the amendment introduced only a minor modification to claim 1 which did not require further search or examination efforts. Moreover, the amendment *prima facie* rendered the subject-matter of claim 1 novel and inventive over the cited prior art and should thus be admitted into the proceedings. Document D4 and the remaining cited prior art neither taught nor suggested indicating a connection state of the phone call by flashing a backlight of the display. This enhanced recognition and perceivability of a call connection with respect to the prior art.

3.1.3 The board notes that the appellant's case presented in the statement of grounds of appeal with respect to

**auxiliary requests 2 to 4** is now based on the presence of additional limitations according to features (e) and (f), which have been extracted from the description and were not present in any of the preceding claim requests. More specifically, neither claim 2 of the main request nor claim 1 of auxiliary request 1 mentioned a speaker (feature (e)) but an "output unit" for outputting a message by voice or vibration. Additionally, none of the claims of the main request and auxiliary request 1 mentioned a display unit (i.e. feature (f)).

The appellant now turns to the board with three additional auxiliary requests which would require examination from the ground up and a re-assessment of the prior art on file in view of the additional features or even a remittal to the examining division for further prosecution, which would in turn be clearly detrimental to procedural economy. However, the purpose of appeal proceedings is not to examine a "fresh case", i.e. subject-matter which is substantially different from that considered by the department of first instance. Rather, the primary object of appeal proceedings is to review in a judicial manner the correctness of the appealed decision (cf. Article 12(2) RPBA 2020). Moreover, the appellant did not identify any "exceptional circumstances", nor did it provide "cogent reasons" that could justify the admittance of **auxiliary request 4**.

3.2 Thus, the board did not admit auxiliary requests 2 to 4 into the appeal proceedings (Article 12(4) and (6), second sentence, RPBA 2020 and Article 13(2) RPBA 2020).



4. Since there is no allowable claim request on file, the appeal must be dismissed.

## Order

### For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated