

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 27 November 2023**

Case Number: T 0686/22 - 3.2.04

Application Number: 17154170.9

Publication Number: 3216502

IPC: A63F13/34, A63F13/235,
A63F13/327

Language of the proceedings: EN

Title of invention:

INFORMATION PROCESSING APPARATUS, INFORMATION PROCESSING
SYSTEM, INFORMATION PROCESSING METHOD, AND INFORMATION
PROCESSING PROGRAM

Applicant:

NINTENDO CO., LTD.

Headword:

Relevant legal provisions:

EPC Art. 56, 111(1), 123(2)
RPBA 2020 Art. 11, 12(4), 13(1), 13(2)

Keyword:

Inventive step - main request and auxiliary requests I to VII
(no)

Late-filed request - admitted (yes)

Remittal - special reasons for remittal

Decisions cited:

T 0336/07, T 1543/06, T 0641/00

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0686/22 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 27 November 2023

Appellant:
(Applicant)
NINTENDO CO., LTD.
11-1, Hokotate-cho,
Kamitoba
Minami-ku,
Kyoto (JP)

Representative:
Karl, Christof
Bardehle Pagenberg Partnerschaft mbB
Patentanwälte, Rechtsanwälte
Prinzregentenplatz 7
81675 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 29 November 2021 refusing European patent application No. 17154170.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman J. Wright
Members: C. Kujat
T. Bokor

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (applicant) against the decision of the examining division to refuse the patent application in suit.
- II. The examining division held that the subject-matter of the main request and all auxiliary requests then on file, auxiliary requests I to VI, lacked inventive step.
- III. In preparation for oral proceedings before the Board, which were duly held on 27 November 2023, the Board issued a communication.
- IV. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, in the alternative, on the basis of one of auxiliary requests I to VII, all filed or refiled with the notice and statement of grounds of appeal dated 1 February 2022, or alternatively based on auxiliary requests VIII or IX, both filed at the oral proceedings before the Board.
- V. Claim 1 of the main request reads as follows:

"An information processing apparatus comprising:
display means (12) for displaying an image; external image output means (27, 81) for outputting an image to an external display apparatus (6) which has a larger display than the display means (12); and operation input reception means (81, 83, Dc) for receiving operation inputs from a plurality of operation devices (3, 4); game processing means (81, S230, S254, S266) for, based on the operation inputs to the operation

input reception means, performing predetermined game processing and generate a game image based on the game processing; and output destination control means (81, Df, S203, S301, S306) for switching to which of the display means and the external image output means the game image is to be output, wherein in accordance with the number of the operation devices used for the game processing, the game processing means generates a game image for multiplayer play using a split screen, and the game processing means includes restriction process means (81, Df, S203, S205, S264, S267) for performing a restriction process for, in a case where an output destination to which the output destination control means is to output the game image is the display means, placing a restriction so that multiplayer play is not performed by players exceeding a predetermined number of players, and in a case where the output destination to which the output destination control means is to output the game image is the external display apparatus, not placing the restriction."

Claim 1 of auxiliary request I reads as for the main request except that the following wording is added to the end of the claim:

"wherein during a game by multiplayer play in which the output destination to which the output destination control means is to output the game image is the external display apparatus, and which is performed by participants exceeding the predetermined number of players, and in a case where the output destination control means switches, to the display means, the output destination to which the game image is to be output, the restriction process means suspends the game by multiplayer play."

Claim 1 of auxiliary request II reads as for the main request except that the wording "the game processing means includes restriction processing means" is replaced by the wording: "the game processing means includes: restriction processing means" and at the end of the claim, the following wording is added:

"wherein the restriction process means is configured to
- suspend the game by multiplayer play during a game by multiplayer play in which the output destination to which the output destination control means is to output the game image is the display means (12), and which is performed by participants exceeding the predetermined number of players, and
- to resume the suspended game by multiplayer play in a case where during the suspension of the game, the output destination control means switches, to the external display apparatus, the output destination to which the game image is to be output, the restriction process means."

Claim 1 of auxiliary request III reads as for the main request except that the following wording is added at the end of the claim:

"wherein during a game by multiplayer play in which the output destination to which the output destination control means is to output the game image is the external display apparatus, and which is performed by participants exceeding the predetermined number of players, and in a case where the output destination control means switches, to the display means, the output destination to which the game image is to be output, the restriction process means suspends the game by multiplayer play, and in a case where during the suspension of the game, the output destination control

means switches, to the external display apparatus, the output destination to which the game image is to be output, the restriction process means resumes the suspended game by multiplayer play."

Claim 1 of auxiliary request IV reads as for the main request except that the wording "the game processing means includes restriction processing means" is replaced by the wording: "the game processing means includes: restriction processing means" and at the end of the claim, the following wording is added:

"wherein the restriction process means is configured to

- suspend the game by multiplayer play during a game by multiplayer play in which the output destination to which the output destination control means is to output the game image is the display means (12), and which is performed by participants exceeding the predetermined number of players, and
- resume the suspended game by multiplayer play in a case where during the suspension of the game, the output destination control means switches, to the external display apparatus, the output destination to which the game image is to be output, the restriction process means; and wherein the information processing apparatus is configured to notify the players to change the output destination to the external image output means, after the suspension of the game."

Claim 1 of auxiliary request V reads as for the main request except that at the end of the claim, the following wording is added:

"wherein during a game by multiplayer play in which the output destination to which the output destination control means is to output the game image is the

external display apparatus, and which is performed by participants exceeding the predetermined number of players, and in a case where the output destination control means switches, to the display means, the output destination to which the game image is to be output, the restriction process means suspends the game by multiplayer play, and in a case where during the suspension of the game, the output destination control means switches, to the external display apparatus, the output destination to which the game image is to be output, the restriction process means resumes the suspended game by multiplayer play, and wherein the information processing apparatus is configured to notify the players to change the output destination to the external image output means, after the suspension of the game".

Claim 1 of auxiliary request VI reads as for the main request except that at the end of the claim, the following wording is added:

"the game processing means further includes number-of-participants selection process means (81, S204, S205) for, when or before a game performed by the game processing is started, performing a process for selecting the number of participants in the game, and in a case where the output destination to which the output destination control means is to output the game image is the external display apparatus, the restriction process means enables the number-of-participants selection process means to select a larger number of players than the predetermined number of players in a way that each player is displayed by screen splitting with split display areas of appropriate sizes; wherein, the information processing apparatus is configured to notify the players to change

the output destination to the external image output means, in a case where an output destination to which the output destination control means is to output the game image is the display means and multiplayer play is not performed by players exceeding a predetermined number of players."

Claim 1 of auxiliary request VII reads as for the main request except that at the end of the claim, the following wording is added:

"and the game processing means further includes number-of-participants selection process means (81, S204, S205) for, when or before a game performed by the game processing is started, performing a process for selecting the number of participants in the game, and in a case where the output destination to which the output destination 30 control means is to output the game image is the external display apparatus, the restriction process means enables the number-of-participants selection process means to select a larger number of players than the predetermined number of players; wherein, the information processing apparatus is configured to notify the players to change the output destination to the external image output means. in a case where an output destination to which the output destination control means is to output the game 5 image is the display means and multiplayer play is not performed by players exceeding a predetermined number of players."

The independent claims of auxiliary request VIII read as follows, with added features of claim 1 with respect to claim 1 of the main request highlighted by the Board in italics (correspondingly amended features being in claims 13 and 19):

"1. A *portable* information processing apparatus comprising a *main body apparatus (2) comprising*: display means (12) for displaying an image; *first and second operation devices (3,4) slidably attachable to and detachable from the main body apparatus (2)*;
external image output means (27, 81) for outputting an image to an external display apparatus (6) which has a larger display than the display means (12); and operation input reception means (81, 83, Dc) for receiving operation inputs from a plurality of operation devices (3,4) *including the first and second operation devices (3,4) through wireless communication*;
game processing means (81, S230, S254, S266) for, based on the operation inputs to the operation input reception means, performing predetermined game processing and generate a game image based on the game processing; and
output destination control means (81, Df, S203, S301, S306) for switching to which of the display means and the external image output means the game image is to be output, wherein
in accordance with the number of the operation devices used for the game processing, the game processing means generates a game image for multiplayer play using a split screen, and
the game processing means includes restriction process means (81, Df, S203 - S205, S264, S267) for performing a restriction process for, in a case where an output destination to which the output destination control means is to output the game image is the display means, placing a restriction so that multiplayer play is not performed by players exceeding a predetermined number of players, and in a case where the output destination to which the output destination control means is to

output the game image is the external display apparatus, not placing the restriction".

"13. An information processing system including a portable information processing apparatus, which comprises a main body apparatus, and a plurality of operation devices, the main body apparatus comprising: display means for displaying an image; first and second operation devices (3, 4) slidably attachable to and detachable from the main body apparatus (2); external image output means for outputting an image to an external display apparatus, which has a larger display than the display means (12); and operation input reception means for receiving operation inputs from the plurality of respective operation devices including the first and second operation devices (3, 4) through wireless communication; game processing means for, based on the operation inputs to the operation input reception means, performing predetermined game processing and generate a game image based on the game processing; and output destination control means for switching to which of the display means and the external image output means the game image is to be output, wherein in accordance with the number of the operation devices used for the game processing, the game processing means generates a game image for multiplayer play using a split screen, and the game processing means includes restriction process means for performing a restriction process for, in a case where an output destination to which the output destination control means is to output the game image is the display means, placing a restriction so that multiplayer play is not performed by players exceeding a predetermined number of players, and in a case where the output destination to which the

output destination control means is to output the game image is the external display apparatus, not placing the restriction".

"19. An information processing method executed by a processor or cooperation of a plurality of processors, the processor or the plurality of processors included in an information processing system including a portable information processing apparatus comprising a main body apparatus (2) including display means configured to display an image, and first and second operation devices (3, 4) slidably attachable to and detachable from the main body apparatus (2) a plurality of operation devices, the information processing method comprising:

an operation input reception step of receiving operation inputs from a plurality of operation devices including the first and second operation devices (3, 4) through wireless communication;

a game processing step of, based on the received operation inputs, performing predetermined game processing and generating a game image based on the game processing; and

an output destination control step of setting which of the display means and an external display, which has a larger display than the display means, the game image is to be output, wherein in the game processing step, in accordance with the number of the operation devices used for the game processing, a game image for multiplayer play using a split screen is generated, and the game processing step includes a restriction step of, in a case where an output destination to which the game image is to be output in the output destination control step is set to the display means, placing a restriction so that multiplayer play is not performed by players exceeding a predetermined number of players,

and in a case where the output destination to which the game image is to be output in the output destination control step is set to the external display apparatus, not placing the restriction."

VI. In the present decision, reference is made to the following prior art:

D4: Wii U system comprising a Wii U console and Wii U GamePad and Nintendo on-line customer support information "How to Start a Multiplayer Game (Minecraft: Wii U edition)".

VII. The appellant's arguments can be summarised as follows:

The subject-matter of the main request and auxiliary requests I to VII involves an inventive step when starting from D4.

Auxiliary request VIII was filed in response to the Board citing new prior art in its communication. The request has a basis in the application as filed.

Reasons for the Decision

1. The appeal is admissible.
2. Background

Amongst other things, the application relates to an information processing apparatus comprising game processing means. An object of the invention (see published patent application, paragraph [0004]) is to enable the apparatus to perform game play by splitting a screen at a place, that is on a display means, desired by a user. The apparatus is provided with a

restriction process means which restricts the number of players permitted to play a multi-player game when the apparatus display means is used rather than an external TV (see published application, paragraph [0006] and claim 1).

3. Main request, claim 1, inventive step starting from a Wii U game console and Wii U Gamepad controller (D4)

3.1 Before looking at inventive step in detail, the Board finds it useful to review the context of examining inventive step of inventions concerned with games. Article 52(2)(c) with Article 52(3) EPC explicitly mentions schemes, rules and methods for playing games as being excluded from patentability as such. As explained in T 0336/07, reasons 3.3.1. "a game in the usual sense of the word is characterized by ... its rules of play which govern the conduct and actions of the players during game play...[A] set of game rules thus determines how game play evolves from beginning to end in response to player actions and decisions...". That decision went on to emphasise that such a set of rules is "normally so perceived by the players involved, and as serving the explicit purpose of playing a game".

In dealing with "mixed" inventions, that is inventions including technical and non technical aspects, the Board adopts the approach as set out in T 1543/06 (Gameaccount) which is based foremost on T 0641/00 (Comvik, OJ EPO 2003, 352). Thus, only those features that contribute to technical character are to be taken into account when assessing inventive step. That requirement cannot rely on excluded (non-technical) subject-matter alone, however original it may be. The mere technical implementation of something excluded

cannot therefore form the basis for inventive step. Rather, it is necessary to consider in detail how that matter has been technically implemented.

3.2 In its communication (point 4.1), the Board discussed for the first time the Nintendo Wii U system with its Wii U game console and Wii U GamePad operator device as prior art, in particular with reference to Nintendo customer support documentation for a Minecraft game, available on-line at the time of writing the communication. The Board will refer to this collectively as D4. The relevant part of the Board's communication read as follows:

4.1 Amongst other prior art tablet devices, the appellant-applicant will undoubtedly be aware of the Wii U game console (released 2012) with its Wii U gamepad. The Wii U gamepad has its own screen which can be used to display game play. It can also be connected to an external screen by HDMI cable. Therefore, it has an output destination control means. Like D1, the Wii U console also supports multiplayer games. According to the Nintendo customer support, Minecraft on the Wii U (released December 2015, thus at least a month before the relevant date of the present application) has a multiplayer split screen mode which is only supported for a [larger] HDMI external screen connected by a HDMI cable. Whist [sic] the Board realises that the above customer support information is not prior art, the Board has no reason to doubt that the Wii U playing a minecraft game would have been the same at the relevant date. [https://en-americas-support.nintendo.com/app/answers/detail/a_id/15831/~how-to-start-a-multiplayer-game-%28minecraft%3A-wii-edition%29#:~:text=How%20to%20Start,mode%20will%20begin](https://en-americas-support.nintendo.com/app/answers/detail/a_id/15831/~/how-to-start-a-multiplayer-game-%28minecraft%3A-wii-edition%29#:~:text=How%20to%20Start,mode%20will%20begin)

.

17:52 Wed 28. Jun en-americas-support.nintendo.com 100%

Using & Troubleshooting
 Games & Apps
 Games
 Apps
 Parental Controls
 Internet Connection

Other Systems > Wii U > Games & Apps

How to Start a Multiplayer Game (Minecraft: Wii U Edition)

Applies to: Wii U Deluxe, Wii U Basic

In this article, you'll learn how to start a multiplayer game.

Note

- Multiplayer is available only when the Wii U console is playing in High Definition mode which requires a HDMI cable or Wii Component video cable connection between the Wii U console and the TV.
- Only a Wii U GamePad and Wii U Pro Controller or Wii Classic Controller can be used in multiplayer mode.
- The first Player LED on the Wii U Pro Controller will light up when it's [synced](#).

Complete these steps

1. Ensure that the Wii U is [connected to the TV](#) using High Definition mode (720p).
2. Start *Minecraft* and at the Main Menu, select **Play a Game** and press the A Button.
3. Load or Create a game to play.
4. During gameplay and while the game is playing on the TV, player two will press the +Button on the Wii U Pro Controller to activate multiplayer mode.
 - To activate multiplayer mode, the game must **not** be playing on the GamePad exclusively (Off-TV Mode). If playing Off-TV Mode, click the **TV Mode** icon on the bottom-right of the GamePad screen. If done correctly, the GamePad should be displaying a Minecraft block.
5. Player two will select a character and press the A Button.
6. The game screen will switch to split screen and multiplayer mode will begin.

3.3 Neither in writing nor at the oral proceedings did the appellant-applicant comment on the status of D4 as prior art. Therefore, the Board confirms its preliminary opinion that the Wii U system and how Minecraft is played on it constitutes prior art.

3.4 Claim features disclosed in D4

D4 discloses an information processing apparatus (WiiU console and Wii U GamePad). The GamePad comprises a display means for displaying an image. The set up also has an external image output means (see Nintendo customer Support - TV can be on or off) for outputting a (High Definition - HD) image to an external TV display apparatus, and an output destination control means for switching the output to whichever of the display means and TV is to show the game. It is not

disputed that such an HD TV would have a larger display than the display means of the GamePad.

The Wii U console has operation input reception means for receiving operation inputs from a plurality of operation devices - otherwise it would not be able to play a multiplayer game (see Nintendo customer support). It also has game processing means for, based on such inputs, performing game processing and generating a game image based thereon. Therefore, although it is true that the Wii U Gamepad input controls appear to be conceived for single user *operation*, the Wii U console can accept inputs from multiple controllers and process a game. Indeed, the game processing means generates a game image for multiplayer play using a split screen when the TV is selected as output destination (see Nintendo customer support, step 6). Since this is specific to multiplayer mode, the Board understands that the screen will be split in accordance with the number of operation devices used for the game processing (that is the number of players).

D4's game processing means also includes a restriction process means for performing a restriction process that places a restriction on the number of players to a single player if the game image destination is the Gamepad display means. However, in TV Mode, no such restriction is placed, so a multiplayer split-screen game can be played (see Nintendo customer support, first bullet point).

3.5 The subject-matter of claim 1 differs from D4 in that, when the restriction is in place, that is when the game is played on the display means rather than the TV, *multiplayer play is not performed by players exceeding*

a predetermined number of players. Because this claim feature is concerned with multiplayer play, it is implicit that the predetermined number of players is more than one (cf. D4's restriction to a single Minecraft player). For example, according to the invention it could be two players in accordance with the number of [two] operation devices (cf. published application, paragraph [0026]).

3.5.1 Whilst, in the present case, the claimed *restriction process means* determines this number according to the screen used, the Board is not convinced that this makes the restriction process means technical as the appellant has argued. Rather, the idea of restricting the number of players permitted to play a certain game according to the screen used (display or TV) determines how gameplay is permitted to develop and thus lies firmly in the domain of the game designer who conceives the game. The game designer will make this choice based, amongst other things on the screen area and screen resolution needed for a player to comfortably view the content of a particular game. Moreover, the players will be well aware of the game designer's choice in this respect: They would know that using a certain screen determines how many players can play the game. Thus the Board considers that a game rule underpins this feature.

3.5.2 The appellant has counter argued that the restriction process means cannot be based on a game rule because it operates identically regardless of the type of game that is being played.

The Board disagrees. Nothing in the claim defines that the predetermined number is independent of the game being played. Moreover, the application itself (see

paragraph [0159]) discloses placing limitations on the number of participants in games, including the number of participants [using] each apparatus. These limitations are, according to the same paragraph, *appropriately set in accordance with the content of the game to be performed*. Therefore, the appellant's argument is moot.

3.6 In the Board's view, the skilled person would modify D4's Wii U system by increasing the number of players allowed to play the game using the Wii U GamePad screen from a single player to not more than a predetermined number greater than 1, and to display the game in split screen, as a matter of obviousness, for the reasons that will now be explained.

3.6.1 For a game such as Minecraft, with its visually complex virtual gameworld, it may well be that only one player could comfortably perceive the state of gameplay on the Wii U GamePad's smaller display, as the Minecraft Wii U game designer appears to have decided, in spite of Minecraft being a game that can otherwise be played by multiple players (see above, Nintendo customer support, step 6). Similarly, when playing a Minecraft game it may well be that a first player's frequent interaction with the GamePad button controls would make it difficult for a second player to share the Gamepad screen. Thus, in the case of Minecraft played on the Wii U system, a game rule applies which can be expressed as follows: When playing the game viewed only on the GamePad screen, no more than one player may participate.

3.6.2 However, Minecraft is not the only Wii U game. Visually simpler games can also be played, for example simple quizzes. Players of such games would have little

interaction with the controls, they may only need to occasionally select options with the controller's buttons, for example to select their answer to a quiz question, so that a second player would be able to comfortably share the Gamepad screen with a first player. In the Board's view, the designer of such games would set a different rule reflecting the nature of the game, one that allowed more than one player to use the Wii U Gamepad screen whilst each additional player provided inputs using their own [screenless] Wii U Pro controller for example, just as they do when the TV is used for playing Minecraft (cf. Nintendo customer support, step 4, first two lines).

That said, just as for Minecraft, the game designer will know that, even when playing a visually simple game, there will be a limit as to how many players can comfortably share a GamePad screen. The underlying game rule could read: When using the Gamepad display no more than [a number greater than one] players can participate in the game. For example this number could be two.

- 3.6.3 Turning first to the question of inventive step with regard to this rule and bearing in mind how inventive step is examined for game rules, inventive step can only lie in its implementation. The problem can be formulated as: how to implement the above game rule in the Wii U system. In the Board's view, the skilled person would have no choice but to modify D4's restriction process means so that it no longer limited participation to a single player but limited it to a number of players greater than one, for example two.

Turning secondly to the split-screen aspect of the differing feature when playing a multiplayer game using

the gamepad screen, the Board notes that this aspect is essentially independent of the above game rule. Rather, it relates to the type of multiplayer game being played. In some multiplayer games, such as ones in which individual players operate different avatars that interact in the gameworld, both players may need to see the same view of the gameworld, so a split screen would make no sense. In other games, individual players need to view different things. For example, in a quiz game, individual players may need to answer different questions. This consideration thus lies in the realm of game rules and will be determined by the game designer. Nevertheless, the Board agrees with the appellant that the particular solution of a split screen is technical *per se*.

With this in mind, the objective technical problem associated with this differing feature (split screen on the Wii U Gamepad) can be formulated as: How to present visual information to multiple players on a Wii U gamepad when playing a game where each player needs to view different things.

D4 (see Nintendo customer support, step 6) already discloses a solution to the problem when using the TV: Namely, a split screen is used. Therefore, the Wii U console has the capability of generating a split screen display. In solving the objective technical problem, the Board holds that it would be immediately obvious for the skilled person to solve the problem posed by making use of this Wii U capability (split-screen view) also when the game was viewed by more than one player on the Gamepad screen.

3.7 From all of the above, the Board concludes that the skilled person would arrive at the subject-matter of claim 1, as a matter of obviousness.

4. Auxiliary requests I to VII

4.1 In its communication (see section 7), the Board gave its preliminary opinion regarding these requests, in particular that, its (then preliminary) opinion of lack of inventive step for the main request (starting from D4 amongst others), would likewise apply to these requests. The Board wrote the following:

"7. Auxiliary requests

In the Board's view, if the Board finds the subject-matter of the main request to lack inventive step then the same applies to the auxiliary requests.

7.1 Auxiliary requests 1 and 2, define suspension of the game when switching to the display means in a game played by more than the predetermined number of players. Auxiliary request 3 defines its resumption when it can be displayed again. In the Board's view, underlying all these requests is a game rule which determines what happens in the game when it cannot be displayed (there appear to be only two possibilities: termination or suspension, and suspension implies the possibility of resumption). The rule could read: If the game cannot be displayed then the game is suspended until it can be displayed. Its implementation by a processor would be obvious whether or not this is labelled part of the restriction processor means (auxiliary request 2).

7.2 Auxiliary requests 4 and 5 correspond to auxiliary requests 1 and 2 but add a notification to the players to change display. Providing such an information appears to be obvious. It is generally the case that users of game consoles, computers, tablets etc. are informed of available options during their use.

7.3 Auxiliary requests 6 and 7 correspond to auxiliary requests 4 and 5 except that they are concerned with what happens before the game starts with a number of player selection process. In all multiplayer games the number of players must be selected, either explicitly or implicitly. It stands to reason that if it is obvious to have a multiplayer game in which player numbers are restricted for a certain display means, then informing them of this before the game starts is an obvious thing for the game designer to do. Its implementation by the skilled person would be obvious. As already explained, informing users of available options as they use an apparatus is universally known".

4.2 The subsequent arguments of the appellant-applicant, in writing (see letter of 27 October 2023, pages 8 to 11) and at the oral proceedings, which only addressed features of auxiliary requests I to V, have not convinced the Board that its preliminary opinion (lack of inventive step of auxiliary requests I to VII when starting from D4) was wrong.

4.2.1 According to the appellant, neither the suspension of a game due to the number of players exceeded the predetermined number when using the display means (auxiliary requests I to V), nor the consequent [automatic] resumption of the game when connected to the external display (auxiliary requests II to V), were driven by an underlying game rule, because these

aspects would be governed by console software independently of the particular game software running the game, as evidenced by the fact that merely suspending the game and resuming it later would not effect gameplay which would merely continue just as if there had been no suspension. Furthermore, the appellant argued that the technical effect of suspending the game was to ensure that the gaming experience was constant and not lost even if the game image output destination was switched to a different display.

In the Board's view, where the [internal] display means is selected and a game in progress is *suspended* and subsequently resumed, the outcome of gameplay would be manifestly different from if the game were to be abandoned for some or all players. Therefore, whether or not the software that controls this aspect is designated game software or console software, it fundamentally determines how gameplay can develop and players would perceive this as an aspect of gameplay. Therefore, contrary to how the appellant-applicant has argued, even if the remaining rules of the game are unchanged, auxiliary requests I to V are all based on an underlying game rule whose implementation would be obvious for the skilled person, as was explained in section 7 of the communication reproduced above.

- 4.3 That said, even if it were to be considered that suspending the game and then restarting it according to auxiliary requests I to V was not underpinned by a game rule (the Board considers it is) but was a technical feature having a technical effect, this would not change the Board's conclusion that the subject-matter of these requests lacks inventive step.

4.3.1 As in the main request, auxiliary requests I to V define a restriction process means (multiplayer play is not performed by players exceeding a predetermined number of players using the [internal] display means). In the Board's view, following on from the inventive step discussion for the main request, when playing on the external TV (display apparatus) with the number of players exceeding the predetermined number (1 in D4), on switching to the Gamepad display means, whether or not game continuity for players is a technical effect, there are only a small number of possible ways in which this restriction requirement can be met, and all are held to be obvious.

Gameplay can either be suspended or it can be ended for some or all players. In the Board's view, all these options would be immediately obvious for the skilled person from their general knowledge, so they cannot be considered to involve an inventive step.

4.3.2 In this regard, the Board has not been convinced by the appellant's argument (see letter of 27 October 2023, page 11, point 2.cc) that, because [Nintendo customer support for the Minecraft game] discloses that the multiplayer game is not available for the Gamepad display, it is even less likely that this multiplayer game would pause due to running on the internal display of the Wii U gamepad.

Leaving aside the fact that the Board has found that a multiplayer mode on the Gamepad would be obvious, whether a particular multiplayer game can no longer continue after switching from the TV because the number of players exceeds 1 or exceeds some other number greater than 1 does not influence the likelihood of the skilled person (or game designer) deciding to implement

a suspension or abandonment of the game for all or for the excess players. In both cases the game cannot be continued in the manner hitherto so the decision is the same. Therefore, the argument is moot.

- 4.3.3 In the Board's view, if the skilled person chose, as a matter of obviousness, to suspend play - this implies it can later be resumed. Such a resumption can happen in one of just two ways: Either automatically or on request. Both would be obvious for the skilled person from their general knowledge. The former (automatically) is all the more obvious in the present case since, according to D4 (see the Nintendo customer support for the Minecraft game step 4), during gameplay, merely selecting the TV option starts multiplayer mode, thus it is started automatically. A resumption is no more than a restarting, therefore, D4 itself gives the skilled person a strong suggestion to *automatically* resume a game as soon as the conditions monitored by the restriction means (which screen is being used) allow.

For these reasons, the Board confirms its preliminary opinion that the subject-matter of auxiliary requests I to VII lacks inventive step when starting from D4.

5. New auxiliary request VIII, filed at the oral proceedings before the Board

- 5.1 Admittance

Article 13(2) RPBA 2020 specifies that any amendment to a party's case filed after notification of a summons to oral proceedings shall, in principle, not be taken into account unless justified by exceptional circumstances.

The appellant-applicant argued that the auxiliary request VIII pending at the beginning of the oral proceedings had been filed in response to the Board's communication introducing new objections (inventive step starting from D4) to the higher ranking requests, which constituted exceptional circumstances justifying admittance. The added subject-matter objections of the Board against this request were equally not foreseeable, while not disputing the permanent obligation of an applicant to file requests complying with the requirements of Article 123(2) EPC. The auxiliary request filed in the course of the oral proceedings was a legitimate reaction to the new objections under Article 123(2) EPC.

- 5.2 The Board agrees and accepts the arguments presented by the appellant. According to established jurisprudence (see CLBA V.A.4.5.4a), such "*[e]xceptional circumstances*" generally concern new or unforeseen developments of the appeal proceedings themselves, such as new objections raised by the Board. The auxiliary request VIII pending at the start of the oral proceedings was admitted into the proceedings by the Board, though it was later replaced by the current auxiliary request VIII. The amendments made in reaction to D4 had to be taken from the description and the disclosure in the application allowed several levels of generalisation. The Board accepts that, in selecting the limiting features necessary to distinguish the claimed subject-matter from the disclosure of D4, it was not immediately evident which related features could or could not be omitted from the description.

Therefore, the Board admits the request into the proceedings, Articles 12(4), 3rd paragraph, 13(1), 1st paragraph and 13(2) RPBA.

5.3 Clarity and added subject-matter

5.3.1 The impugned decision did not raise any objections against the clarity of the main request, nor does the Board see any reason as to why the claims of the present request might lack clarity.

5.3.2 The Board is also satisfied that auxiliary request VIII does not add subject-matter extending beyond the application as filed (Article 123(2) EPC). The independent claims to: a portable information processing apparatus (claim 1), to an information processing system (claim 13) and information processing method (claim 19) are based on respective original claims bearing the same numbers.

To these original claims, features related to the information processing apparatus have been added from the description of the embodiment (see paragraphs [0035] to [0039] with figures 1 and 2). In particular, it is now claimed that information processing apparatus is *portable* and comprises a *main body apparatus* (see paragraphs [0035] and [0039] and figures 1 and 2, reference 2) and that first and second operation devices communicate wirelessly with the operation input means (as disclosed in paragraph [0023] and claim 9 for example) and that they are *slidably attachable to and detachable from the main body apparatus*, which is disclosed in paragraphs [0035] and [0037].

With regard to this latter feature, paragraph [0035] discloses the idea that left and right controllers are attachable to and detachable from the main body apparatus, without specifying where this attachment should be. In view of this, and the fact that the

controllers themselves are portable and can be used spatially independent of the main body apparatus, the Board considers that no subject-matter is added by claiming the controllers without specifying them as being *left and right* controllers. By the same token their being slidably attachable and detachable (cf. paragraph [0037]) can be claimed independently of being on a left and right side. This is all the more true, given that the [main body] housing *may have any shape and size* (paragraph [0039]) and, being portable, can be used in any orientation.

Therefore, the Board considers that the claims of this request do not add subject-matter extending beyond the application as filed.

5.4 Further prosecution

5.4.1 The amendments in this request take the claimed subject-matter in a direction which may not have been hitherto foreseen by the examining division. Examining this request, particularly for novelty and inventive step, may require considerable investigation possibly necessitating a further search, for which the examining division is the most appropriate forum. In the view of the Board, these constitute special reasons justifying the remittal of the case to the examining division, Article 11 RPBA, a course of action to which the appellant-applicant had no objection.

5.4.2 Therefore, the Board considers it appropriate to exercise its powers under Article 111(1) EPC for remitting the case to the examining division 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 Examining Division for further prosecution**

The Registrar:

The Chairman:



G. Magouliotis

J. Wright

Decision electronically authenticated