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D E C I S I O N
of 23 April 1996

Case Number: T 0941/93 - 3.5.1

Application Number: 86104764.5

Publication Number: 0203324

IPC: G06F 15/72

Language of the proceedings: EN

Title of invention:

Graphic highlight adjacent a pointing cursor

Applicant:

International Business Machines Corporation

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 56, 111(1), 123(2)

Keyword:

"Amendments (admissible) - based on description"

"Novelty (yes) - not at issue"

"Inventive step (new claim not yet examined against prior art including new document) - remittal appropriate"

Decisions cited:

-

Catchword:

-



Case Number: T 0941/93 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 23 April 1996

Appellant: International Business Machines
Corporation
Old Orchard Road
Armonk, N.Y. 10504 (US)

Representative: de Pena, Alain
Compagnie IBM France
Département de Propriété Intellectuelle
F-06610 La Gaude (FR)

Decision under appeal: Decision of the Examining Division of the European
Patent Office posted 25 May 1993 refusing European
patent application No. 86 104 764.5 pursuant to
Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: W. B. Oettinger
G. Davies

Summary of Facts and Submissions

I. The appeal contests the examining division's decision to refuse the European patent application No. 86 104 764.5 filed on 8 April 1986 (publication No. 0 203 324).

II. The reason given for the refusal was that the subject-matter of claim 1, and of all dependent claims, filed on 13 February 1993 lacked an inventive step, having regard to the following prior art documents:

D1: Proceedings of the Fall Joint Computer Conference, Anaheim 14-16 November 1967, vol. 31, pages 713-721,

D2: IBM Technical Disclosure Bulletin, vol. 21 (1979) No. 8 (January), page 3284,

D3: EP-A-0 114 422,

D4: US-A-4 017 680.

More particularly, in the division's view the method of claim 1 was rendered obvious, starting out from D1, by D2 and D3.

III. That decision was issued on 25 May 1993.

The appeal was lodged on 20 July 1993 with a request that said decision be reversed. The appeal fee was paid on the same day.

On 29 September 1993, the appellant filed a Statement of Grounds.

IV. In the Statement of Grounds, the appellant argued that the lack of inventive step objection had been overcome by the amended claim 1 filed together with that Statement.

V. In a Communication, the Board drew the appellant's attention to the following standard text book and suggested that the claimed method would appear to be known from this document, or rendered obvious by it, at least if combined with the teaching of D3:

D5: W. M. Newman et al: "Principles of Interactive Computer Graphics", McGraw-Hill, second edition (1979), pages 159-173.

VI. In response, within the framework of a procedure according to Article 121 EPC, the appellant filed on 13 February 1996 a new claim 1 and dependent claim 2, and renumbered the dependent claims 2 to 11 filed on 29 September 1993.

VII. The independent claim reads as follows:

"1. A method of selection of graphic objects including line segments on a display screen, said method including the steps of:

a) displaying a pointing cursor on said display screen, said cursor being controlled by the operator, and initializing a pointed object and previous point to nil;

b) reading (block 42) the position of the pointing cursor and computing the nearest point (x, y) of the line segments that are displayed on the screen;

c) determining (block 43) whether said pointing cursor points to a graphic object that is to say whether there exists a line segment within that object such that the distance between that line to the current pointing cursor position is either less than or equal to a predefined gravity distance;

d) if said pointing cursor points to a gravity object, then setting (block 44) a NEW POINT parameter to the nearest point (x, y) which was computed; and

d1 - checking (block 45) whether said NEW point and PREVIOUS point are different and, in this case, testing (block 46) whether said PREVIOUS point parameter is defined and, in this case, dehighlighting (block 47) said PREVIOUS point;

d2 - highlighting (block 48) a part of the object comprising the new point and set the previous point to be equal to the new point;

e) if the pointing cursor does not point to a graphic object, determining (block 49) whether the previous point is defined implying that the previous point was the last highlighted point and, in this case, setting to nil and dehighlighting (block 50) the previous point; and

f) determining (block 51) whether a select button controlled by the operator is pressed and, in this case, testing (block 52) whether one graphic object is found and highlighting the whole graphic object being found."

VIII. By implication, the appellant requested that this claim, and the dependent claims, be declared patentable.

Furthermore, it requested column 5 of the published application description to be amended in accordance with Rule 88 EPC.

IX. In support of the amended claim 1, the appellant submitted, in essence, that it had been so clarified and restricted, that it would define the specific process illustrated in Figure 4, and that the succession of technical features now claimed would be neither shown nor suggested in D5 or any other citation.

New claim 2 would recite the features carried out for computing the nearest point as illustrated in Figure 5.

Reasons for the Decision

1. The appeal (cf. paragraph III) is admissible.
2. *Amendments*
 - 2.1 The procedure defined in claim 1 (cf. VII) is disclosed in the description (column 6, line 32 to column 8, line 7) of the flow chart shown in Figure 4.
 - 2.2 The sub-procedure defined in claim 2, concerning the individual steps of the computing process in step b) of claim 1, is, in essence, disclosed in the description (column 9, line 37 to column 10, line 26) of the flow chart shown in Figure 5.

- 2.3 It is, however, noted that this claim would require some correction of clerical errors; in particular, in feature b) "pointing" should read "pointed" and, after "object", "to nil" should be inserted.
- 2.4 The dependent claims 3 to 12 (cf. VI) are based on the original claims 2 to 11.
- 2.5 It is, however, noted that, apart from their being renumbered, also the references to preceding claims, at least of claims 4 to 12, must be adapted.

3. *Novelty*

- 3.1 The lack of novelty objection, based on D5 (cf. V), has clearly been overcome. Claim 1 is much more specific, in at least some of the claimed steps, than the teaching of D5.
- 3.2 Novelty against any of the other citations, D1 to D4, was disputed neither, with respect of claim 1 then on file, by the examining division nor, with respect of present claim 1, by the Board.

4. *Inventive step*

- 4.1 The method of claim 1 is defined in much more specific terms than was the method defined in claim 1 that was considered to be obvious from D1 to D3 (and possibly D4), in the decision under appeal.

In fact, a claim having the restricted scope of present claim 1 was never considered by the examining division.

More particularly, it was never considered whether or not the subject-matter of that claim would be rendered obvious, starting out e.g. from the method that can be derived from D5, by any other prior art.

What was considered, were the dependent claims then on file but, as was already indicated (paragraph 2.1 above), claim 1 on file is based on the description, and not on any of the earlier dependent claims.

4.2 The Board's provisional assumption, made in its Communication, that the subject-matter of the previous independent claim would be rendered obvious by D5 in combination with D3, does not necessarily apply to claim 1 now on file.

4.3 The subject of the present appeal procedure being primarily the decision under appeal, it would appear to go too far if the Board decided on the issue of inventive step of a claim quite different from the one which was refused, and on the basis of prior art which is also quite different, in that it includes an additional relevant document, from the one considered in the decision under appeal.

Rather, this case calls for remittal in accordance with Article 111(1) EPC.

4.4 In addition, it is noted that, even if claim 1 will turn out to be allowable, some amendments of the other application documents will be necessary before a decision to grant a patent could be issued.

Reference is made, in this respect, to paragraphs 2.3 and 2.5 above and, in addition, to the following points:

- It would appear inappropriate to make the requested correction of column 5 under Rule 88 EPC (cf. VIII), but the requested amendment would appear allowable under Article 123(2) and Rule 86(3) second paragraph;
- however, the appellant's respective request is not fully clear in respect of how far column 5 is to be replaced by the text proposed in the appellant's letter;
- in column 1, lines 11 to 24, the references to European patent applications, constituting prior art according to Article 54(3) EPC, by their application numbers should be replaced by references to their publication numbers (EP-A-0 173 123, 173 122, 173 125, published in the priority interval);
- the documents reflecting the background art are to be cited (Rule 27(1)(b) EPC);
- where the invention is disclosed (column 2), this should be "as claimed" (Rule 27(1)(c) EPC);
- in column 10, the inadmissible attempt to extend the scope of protection conferred by the claims (cf. Article 84 first sentence EPC) by suggesting unspecified modifications (lines 27 to 31) is to be deleted;

- where specific modifications or replacement by functional equivalents are suggested (lines 31 to 43), this is likewise inadmissible to the extent that a particular means mentioned in claim 1 is proposed to be replaced by other means (lines 39 to 43).

The necessary amendments will best be done in further prosecution before the examining division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of:
 - claim 1 filed on 13 February 1996,
 - the dependent claims filed on 13 February 1996 and on 29 September 1993,
 - the description as proposed to be amended on 13 February 1996,
 - the drawings as published.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg