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D E C I S I O N
of 14 September 1994

Case Number: T 0435/94 - 3.5.1

Application Number: 87304022.4

Publication Number: 0246021

IPC: G06F 1/00

Language of the proceedings: EN

Title of invention:
Compact computer terminal

Applicant:
AT&T Corp.

Opponent:
-

Headword:
-

Relevant legal norms:
EPC Art. 54, 111(1)

Keyword:
"Novelty (yes)"
"Remittal to Examining Division"

Decisions cited:
-

Catchword:



Case Number: T 0435/94 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 14 September 1994

Appellant:

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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office dated 3 November 1993
refusing European patent application
No. 87 304 022.4 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. Randes
G. Davies

Summary of Facts and Submissions

- I. European patent application 87 304 022.4 (publication No. EP-A-0 246 021) was refused by decision of the Examining Division, dated 3 November 1993.
- II. The decision was based on Claims 1 to 9 filed on 6 September 1993, with Claims 1 and 9 being independent claims. The independent claims read as follows:
- "1. A compact input and output computer interface characterized by
- a touch-sensitive element (16) for detecting the coordinates at which said element is touched,
- a flat screen display (15) coextensive with said touch-sensitive element, and
- means (51,52) selectively responsive to touches on said touch-sensitive element for controlling the display on said flat screen display.
9. The method of providing data to a computing facility characterized by
- a) displaying a simulated keyboard on a flat display device,
- b) detecting the position of the point of touching said simulated keyboard using a touch-sensitive layer associated with said flat display device,

- c) translating said position of the point of touch into a signal associated with the key of said simulated keyboard corresponding to said point of touch, and
- d) transferring said signal to said computing facility."

III. The reason for the refusal was that the subject-matter of the Claims 1 and 9, the wording of which was identical to the wording of original independent Claims 5 and 10, was not new (Articles 52(1) and 54(1) and (2) EPC) having regard to the teaching of document

D1: DE-A-2 739 157.

The Examining Division made the following statement with regard to Claim 1:

"In his letter of reply the applicant alleges that the invention includes two features that are different from the prior art:

- a) the feature of having different keyboard displays at different times and
- b) the feature of permitting the keyboards to appear anywhere within the flat display.

However, none of these features is mentioned in Claim 1. Particularly, the term "co-extensive" does not give any hint to anyone of these features. The Applicant's argument is, therefore, not suitable for a different judgement of Claim 1."

IV. On 15 December 1993, the Appellant filed a notice of appeal against that decision and paid the appeal fee in due time. A Statement of Grounds of Appeal was filed on 3 March 1994.

With the grounds of appeal the Appellant filed a new set of Claims 1 to 12. The independent Claims 1 and 12, corresponding to the refused Claims 1 and 9, read as follows:

"1. A compact computer terminal

characterized by

a touch-sensitive element (16) for detecting the coordinates at which said element is touched,

a display (15) coextensive with said touch-sensitive element, and control-means (51,52) for

- displaying on said display an arrangement of input data touch areas,
- responding to touches of said touch-sensitive element at said touch areas, and
- controlling the display on said display, including modifying said arrangement of touch areas.

12. The method of providing data to a computing facility

characterized by

- a) displaying an image of a key arrangement on a display device,

- b) detecting the position of the point of touching said key arrangement using a touch-sensitive layer associated with said flat display device,
- c) translating said position of the point of touch into a signal associated with the key of said key arrangement corresponding to said point of touch,
- d) transferring said signal to said computing facility, and
- e) altering the key arrangement image in response to specified touching of prespecified key or keys of said key arrangement."

The Appellant in the Statement of Grounds of Appeal pointed out that he had tried to overcome the Examining Division's criticism put forward in the decision under appeal by amending the two independent claims and stated:

"The new set of claims includes elements which, in combination, clearly define novel subject-matter.

In the new Claim 1, the "control means" corresponds to the old "means" and it clearly calls for three capabilities: displaying an "arrangement of input data touch areas", responding to touches of the touch sensitive element, and controlling the display "including modifying said arrangement of touch areas". This last clause clearly incorporates the concept that one can have the "keyboard" changed.

Such a capability is neither present nor suggested in the reference, and such a capability represents a novel and important advance in the art. Accordingly it is believed that Claim 1 is patentable.....

....Claim 12 corresponds to the previous Claim 9. It too was modified to highlight the aspect of modifying the arrangement of touch areas. To that end, Claim 12 includes step (e) which alters the key arrangement image in response to specified touching of a key or keys of the displayed key arrangement."

- V. The Appellant requests that the decision be set aside and the patent granted.

Reasons for the Decision

1. The appeal is admissible.
2. Document D1 discloses an arrangement of a liquid crystal flat computer (to be kept in a briefcase) where a portion of the display is devoted to the keyboard. However, nowhere in the document does there appear to be an indication that said keyboard could be changed or turned into another keyboard.

The Board, therefore, agrees with the opinion of the Appellant that the only document (D1) cited in the decision under appeal discloses neither the last amended feature of Claim 1 that control means are present for

"controlling the display on said display, including modifying said arrangement of touch areas"

nor the added last feature (e) of Claim 12.

These amendments, thus, appear to have been made in an attempt to distinguish more clearly the subject-matter of Claim 1 from the teaching of D1 and to overcome the

Examining Division's objections in the decision under appeal (see under III, cited point (a)).

3. The Board notes that the Examining Division, in a communication dated 19 May 1993, expressed the opinion that the additional feature of original Claim 6, i.e.

"means for displaying simulations of a plurality of computer input devices on said flat screen display"

was disclosed by EP-A-0 149 762 (D2). The Examining Division apparently was of the opinion that it would be obvious for a skilled man to add said feature to the subject-matter of independent Claim 5 (identical to refused Claim 1).

The Board in this respect, however, notes that the amended last feature of the present Claim 1 is distinguished from the additional feature of original Claim 6 in that it is made clear in the present Claim 1 that said arrangement of touch areas can be modified. The last feature (e) of Claim 12 is still more clearly distinguished from the said additional feature of original Claim 6.

4. Thus, the Appellant has made amendments that the Examining Division did not consider in its decision, neither in isolation nor in combination with other features of the claim concerned. The Examining Division has not rectified the decision under Article 109 EPC. Nor is it obliged to explain the grounds on which it based its refusal to rectify the decision under appeal. For this reason, the Board is unable to examine that refusal.

The Board has come to the conclusion that the Appellant has made serious amendments intended to overcome the objections made by the Examining Division in the decision under appeal and that the subject-matter of the independent Claims 1 and 12 is new having regard to the teaching of the only cited document D1 in the decision under appeal.

As indicated in paragraph 3 above, the Examining Division superficially touched on the question of possible lack of inventive step during the examining proceedings but did not pursue this in the decision refusing the application. The Board, therefore is of the opinion that it should not deny the Appellant the possibility of having other aspects of patentability examined by two instances. The Board, therefore, makes use of its power under Article 111(1) EPC to remit the case to the Examining Division for further prosecution.

It should be noted that the Board in the present decision has investigated only whether the subject-matter of the independent Claims 1 and 12 is new having regard to the teaching of D1 and has, thus, e.g. not examined whether the requirements of Article 84 or Article 123(2) EPC are met with regard to those claims, or to the dependent claims appended to those independent claims.

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 of the application on the basis of the Claims 1 to 12 filed with the Statement of Grounds of Appeal (see under IV above).

The Registrar:

The Chairman:

M.Kiehl

P.K.J. van den Berg