

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 15 June 1999

Case Number: T 0204/97 - 3.5.2

Application Number: 89309712.1

Publication Number: 0363056

IPC: G11B 7/08

Language of the proceedings: EN

Title of invention:
Compact disk player

Patentee:
Pioneer Electronic Corporation

Opponent:
Interessengemeinschaft für Rundfunkschutzrechte E.V.

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56, 114(2)

Keyword:
"New documents filed in appeal proceedings - those responsive and relevant admitted, those not responsive and not sufficiently relevant disregarded"
"Novelty - yes"
"Inventive step - yes"

Decisions cited:
T 0389/95

Catchword:

-



Case Number: T 0204/97 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 15 June 1999

Appellant: Interessengemeinschaft
(Opponent) für Rundfunkschutzrechte E.V.
Bahnstrasse 62
40210 Düsseldorf (DE)

Representative: -

Respondent: Pioneer Electronic Corporation
(Proprietor of the patent) No. 41, Meguro 1-chome
Meguro-ku
Tokyo (JP)

Representative: Brunner, Michael John
Gill Jennings & Every
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 December 1996
rejecting the opposition filed against European
patent No. 0 363 056 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
J. H. P. Willems

Summary of Facts and Submissions

I. This appeal is against the rejection of the opposition to European patent No. 363 056.

II. In the notice of opposition the opponent (now appellant) had requested revocation of the patent in its entirety on the grounds that the subject-matter of the claims of the patent was not new and did not involve an inventive step (Article 100(a) EPC) having regard in particular to the following prior art documents:

D1: DE-A-3 423 887

D2: "Keine Angst vor der Compact Disc", parts 1 and 2: Funkschau No. 20/1983, pages 77 to 80 and No. 21/1983, pages 86 to 89

D3: "Spurtreu": Funkschau No. 11/1983, pages 59 and 60.

III. In the statement of grounds of appeal the appellant referred to three new prior art citations, copies of which were filed shortly after expiry of the time limit for filing the statement of grounds of appeal:

D4: "Plattenspieler technisch verfeinert": rme (Radio Mentor Elektronik) 1977, No. 8, pages 310 and 311

D5: "ADC Accutrac 4000": KlangBild 1976 (May/June) page 9

D6: "HiFi-Fonoautomat PA 225" RFE (radio fernsehen

elektronik) 1979, No. 10, pages 659 to 663

and argued that the subject-matter of the opposed patent was obvious in view of D4, D5 and D6. No justification was offered for submitting this new evidence for the first time on appeal.

In a subsequent letter of 12 May 1999 the appellant cited two family members of D1:

D1': BE-A- 897 174

D1": FR-B-2 548 424

both published before the priority date of the opposed patent, as support for his contention that the opposition division had misinterpreted D1 in the decision under appeal. D1' corresponded to the priority claimed by D1; D1" was cited for convenience because the photocopy of D1' to hand was of poor quality.

IV. The respondent objected to the late submission of the documents D4 to D6. In a communication accompanying a summons to oral proceedings the board indicated that it was likely that the new citations D4 to D6 would be disregarded pursuant to Article 114(2) EPC.

V. The patent has not been amended. Claim 1, the sole independent claim, reads as follows:

"1. A compact disk player, for playing back data recorded on a compact disk (1) having a surface on which a lead-in area, a program area and a lead-out area are distinctly provided wherein the program area contains data to be played back to which an address is

allocated, comprising:

a pickup (3), movably positioned relative to the surface of the compact disk (1), for reading the data contained in the lead-in area, the program area and the lead-out area; and,

a servo mechanism (4) for controlling the position of the pickup (3);

control means (8) for servo-locking the pickup (3) to the position where the reading of the data contained in the program area is interrupted characterised by: said control means controlling the servo mechanism (4) so that the pickup (3) is positioned in a predetermined position allocated with a predetermined address for subsequent resumption of the data reading if the address of the servo-locked position is outside the program area."

VI. Oral proceedings were held before the board on 15 June 1999.

VII. The appellant argued essentially as follows:

The documents D4 to D6 were sufficiently relevant to be admitted even at the appeal stage. The documents related to stylus pickup analogue record players but apart from this single difference all features of claim 1 of the opposed patent were known from D4 and D5, which related to the same apparatus, when the teaching of the latter was interpreted in the light of the background information in D6 relating to muting circuits.

The decision under appeal pivoted on the finding that the person skilled in the art would not combine the two

separate embodiments in D1 because the second embodiment was explicitly presented in that document as an alternative to the first embodiment. This finding was supported by a reference to page 6, of D1 which indicated that in the fully electronic second embodiment the electronic means for determining the laser position at interrupt was provided as a replacement for the mechanical locking means ("statt der mechanischen Verriegelung") of the first embodiment. In coming to this conclusion, however, the opposition division had overlooked the fact that the embodiments in claims 1, 2 and 3 of D1 were readily combinable; a mechanical locking means as specified in claim 6 was not incompatible with the electronic solution specified in claim 3. Indeed, contrary to the finding of the opposition division, the person skilled in the art would be positively encouraged by the claims of D1 to consider combinations of the different elements of the solutions set out in these claims. This was particularly evident in the claims of the Belgian patent application from which D1 claimed priority. In the Belgian priority document D1' of D1 as well as in the French family member D1", claim 1 contains the following passage:

"caractérisé [...] en ce que, à cet effet, au tourne-disque, sont associés des moyens mécaniques, électriques **et**/ou électroniques assurant la mémorisation des informations relatives à un disque [...] et l'endroit où la reproduction des informations a été interrompue" [emphasis added by the appellant].

Thus claim 1 of D1' and D1" explicitly teaches the person skilled in the art to provide mechanical,

electrical **and**/or electronic means to store information relating to the position at which reproduction of program data was interrupted. The use of the expression and/or ("et/ou") in D1' and D1" confirmed that the teaching of D1 could not properly be interpreted as relating to mutually exclusive alternative embodiments.

The D1 CD player was particularly intended for installation in vehicles (page 1, first sentence of description of D1). The person skilled in the art would realise that such an apparatus would be subject to significant vibration and would require both the precision of the electronic storage of the interrupt position and an additional mechanical storage means (locking the pickup position) to prevent the pickup from drifting away from the interrupt position. By applying such straightforward considerations as to the particular strengths and weaknesses of the mechanical and electronic elements of the solutions represented by the illustrative embodiments in D1 and explicitly inspired by the wording of the claims, especially those of the family members D1' and D1", the person skilled in the art would arrive at the CD player specified in claim 1 of the opposed patent without an inventive step being involved.

In considering what claim 1 actually specified it was important to note that the phrase "so that the pickup (3) is positioned in a predetermined position allocated with a predetermined address for subsequent resumption of the data reading" in the characterising portion of the claim did not amount to anything more than recommencing at the interrupt position and address as known in the prior art, since the interrupt operation

determined the interrupt position and address which was thereafter a **predetermined** position and address for use in the subsequent resumption operation.

VIII. The respondent argued essentially as follows:

In considering D1, the person skilled in the art would not look at the claims for a teaching, but would look at the description and drawings which show distinct alternative solutions. This was just as true for the French language documents D1' and D1" as for the German language document D1.

There was no teaching in D1 of any advantage in combining the separate embodiments. In particular there was no discussion of the problem of attempted reproduction of a non-programme area, in particular of the unpleasant acoustic effect resulting from attempting playback from the lead-out area. Nor was there any discussion in D1 of movement to a predetermined position allocated with a predetermined address in the sense of claim 1 of the opposed patent. The appellant's interpretation of 'predetermined position' in claim 1 of the opposed patent to mean simply the interrupt position or the disc start position following the lead-in area was not a reasonable interpretation since it did not take into account the problem solved by the teaching of the patent. In the context of that problem and the solution taught in the patent, the term 'predetermined' in the claim clearly meant 'determined beforehand' (ie before interrupt occurs) and included making provision for the servo-locked position being jolted into the lead-out area.

- IX. The appellant requested that the decision under appeal be set aside and that the patent be revoked.
- X. The respondent requested that the appeal be dismissed.

Reasons for the Decision

- 1. The appeal is admissible.
- 2. *Evidence filed on appeal*
 - 2.1 D4 to D6

These documents are used by the appellant to support an argument which is not strictly responsive to the first instance debate which culminated in the decision under appeal. The argumentation introduced by the phrase "Im übrigen..." in the statement of grounds of appeal (page 1, fourth paragraph) represents a fresh factual case presented for the first time on appeal. As was stated by the present board (in a different composition) in its decision T 389/95 dated 15 October 1997 (not published in the OJ EPO) at point 2.14 such evidence "should normally be disregarded pursuant to Article 114(2) EPC unless convergence of the debate is guaranteed, eg by a manifestly unanswerable challenge to the validity of the opposed patent necessarily resulting in restriction or revocation of the patent. Furthermore the conclusiveness of this challenge should normally be manifest from the statement of grounds of appeal." Since the argument based on D4 to D6 does not

meet this standard of *prima facie* relevance, and since the respondent does not consent to the admission of these documents, the board will disregard them.

2.2 D1' and D1"

These documents are responsive and relevant to the pivotal reasoning in the decision under appeal and the respondent has not objected to their introduction. The board will therefore not disregard them.

3. *Interpretation of claim 1*

3.1 The parties disagree as to the interpretation of claim 1, in particular the meaning of 'predetermined'. The board interprets the characterising portion of claim 1 as implying the presence of means for detecting that the address of the servo-locked position is outside the program area. This follows from the wording "so that...if..." which specifies an operation which is effected on the occurrence of a specified condition. In the judgement of the board, this implies that the control means is operative to detect occurrence of the condition. Further, the board interprets "outside the program area" as meaning **anywhere** in the disc area accessible to the pickup other than the program area; for the person skilled in the art this means lead-in (inclusive-) or lead-out area and hence, in particular the lead-out area. These steps of interpretation lead in turn to the conclusion that 'predetermined position' cannot mean simply (ie exclusively) the position in the program area at which interrupt actually occurred since this is no longer determinable when the servo-locked position is in the lead-out area and must instead

include (in the case of the servo-locked position ending up in the lead-out area) a resumption position and address which is predetermined within the CD player prior to any interrupt. Thus the sense of 'predetermined' in the claim varies according to the servo-locked position on resumption but it is nonetheless, in the judgement of the board, clear that the meaning of 'predetermined' embraces these respective senses in the respective conditions.

3.2 This interpretation, based solely on the internal context of claim 1, is confirmed by claims 2 to 4 (which relate to the special cases when interrupt occurs in the programme area, the lead-in area and the lead-out area respectively) and is also consistent with the teaching in the body of the specification. Thus at column 1, line 47 ff of the patent it is stated that:

"If the pickup enters into the lead-in area of the CD, reproduction of a recorded music would start from the beginning because the address read out from the TOC indicates the restart address.

If the pickup enters into the lead-out area, reproduction would start from that area where no music signal exists, which creates unnatural acoustic circumstances when reproduction of a recording music is resumed.

Accordingly, it is an object of the present invention to provide a CD player which presents less unnatural feeling at the time when data reproduction is resumed."

3.3 It would, in the judgement of the board, be utterly

inconsistent with this statement of the problem and the teaching in the body of the specification as to how the problem is to be solved to interpret "outside the program area" in claim 1 other than as encompassing in the lead-in (inclusive-) or lead-out area.

4. *Novelty*

It is not disputed by the opponent that the closest prior art document D1 (nor its family members D1', D1", nor any other document in the file) does not disclose means for determining if the address of the servo-locked position is outside the program area in the sense of being in the lead-out area.

The appellant's contention of lack of novelty is in reality based on the fact that the claimed CD player deals with the previously recognised modes of resumption after interrupt in the same way as prior art players but this argument fails to take account of the fact that the CD player specified in claim 1 of the opposed patent **also** solves the hitherto unrecognised problem of the risk of resumption in the lead-out area by a novel functionality of the control means.

The board concludes therefore on the basis of the interpretation arrived at point 3.1 above that the subject-matter of claim 1 of the opposed patent is new.

5. *Inventive step*

5.1 On the basis of the interpretation above claim 1 is correctly delimited with respect to D1, the agreed closest prior art, and the objective technical problem

is accordingly also that referred to at point 3.2 above. The appellant does not dispute the fact that this problem is not referred to in D1 or any other document on the file.

5.2 Even if it is conceded, for the sake of argument, that the person skilled in the art would realise that vibration, in particular road induced vehicle vibration would cause the servo-locked position to drift, the board has not been persuaded by the appellant's argumentation that the person skilled in the art would as a matter of routine design have anticipated the consequence of this drift at a program area just prior to the lead-out area, nor, if he did, that he would have realised that the problem could be solved whilst still retaining the advantage of a mechanical servo-locking means.

5.3 Neither is the board convinced by the appellant's argument based on the claims of D1 and its family members. These arguments do not get beyond establishing that the person skilled in the art **could** have combined the elements of the separate embodiments of D1 to solve the problem addressed in the opposed patent in the manner described and claimed in the patent. It falls short of the necessary step of showing that the person skilled in the art would, for plausible reasons, be led by the teaching of the prior art, to formulate that problem and solve it in the manner claimed. The general expression in claim 1 of D1 "of mechanical, electrical and/or electronic means does not provide any specific teaching as to any problem that is to be solved or by what specific combination of the various means such problem could be solved. The board does not exclude the

possibility that the claims of a prior art patent document could sometimes provide an enabling disclosure of the solution to a particular problem but it is convinced that this is not true of the present case. This aspect of the appellant's argument is essentially based on hindsight.

6. The board therefore concludes that the appellant has not shown that the CD player of claim 1 of the opposed patent is either old or obvious having regard to the cited prior art and that accordingly the ground of opposition pursuant to Article 100(a) EPC does not prejudice the maintenance of the opposed patent in unamended form.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

W. J. L. Wheeler