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D E C I S I O N
of 11 June 1999

Case Number: T 0537/97 - 3.5.1

Application Number: 92901376.1

Publication Number: 0572415

IPC: H04Q 7/00

Language of the proceedings: EN

Title of invention:

Multiple format signalling protocol for a selective call receiver

Applicant:

Motorola, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

Decision re appeals - remittal (yes)"

Decisions cited:

G 0010/93

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0537/97 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 11 June 1999

Appellant: Motorola, Inc.
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Representative: Gibson, Sarah Jane
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 January 1997
refusing European patent application
No. 92 901 376.1 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. R. K. Zimmermann
V. Di Cerbo

Summary of Facts and Submissions

I. The appeal concerns European patent application No. 92 901 376.1 The examining division refused the application which was based on a main request and an auxiliary request, the main request claiming protection for a selective call receiver (claim 1) and for a method for use, in a selective call receiver, for presenting information including at least first and second messages in at least first and second formats (claim 11).

II. With respect to these claims, the reason given for the refusal was lack of inventive step in view of prior art document US-A-4849750 (document D2). According to the examining division, document D2 disclosed a paging system using a signalling format which, in addition to the pager address and the message, included special characters encoding a command transmitted to the pager and informing the pager about the type of message to be received.

The document did not explicitly disclose to include two or more of such commands or messages into a single information packet. However, since each message was preceded by a particular command and this command was encoded independently from the pager address, such a feature would be implicitly disclosed in document D2. In view of this prior art, adding one or more commands corresponding to one or more type of messages would be self-evident to a person skilled in the art who had set himself the objective of accommodating two or more data types in a single signalling format.

III. The decision of refusal was posted on 27 January 1997. With the request to reverse the decision, the appellant filed a notice of appeal, together with a statement of grounds, on 27 March 1997 and paid the appeal fee on the same day.

In a communication the Board raised the objection of lack of novelty in view of special End-Of-Page commands described in document D2 which inform the pager on the type of toner alert to be produced. In oral proceedings held before the Board on 11 June 1999, the decision on the appeal was announced on the basis of the following requests.

IV. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or the auxiliary request as submitted at the oral proceedings before the Board. The independent claims according to these requests read as follows:

Main request:

"1. A selective call receiver (11) comprising:
receiver means (13) for receiving a signal, the signal comprising:
an address identifying the selective call receiver and
an information packet, characterized in that:
the information packet associated with the address
comprises a first message transmitted to the selective
call receiver in a first information format, a second
message also transmitted to the selective call receiver
in a second information format, and a control character
wherein the first message and the second message do not
include an alert tone, and

presentation means (17) for presenting the first message transmitted in the first information format in a first output mode in response to receiving and decoding the address, and further for presenting the second message transmitted in the second information format in a second output mode in response to further receiving and decoding the control character."

"10. A method for use in a selective call receiver, for presenting information including at least first and second messages in at least first and second formats comprising the steps of: receiving a signal having a single address for identifying a selective call receiver, characterised by the steps of: receiving the signal having a control character, an information packet associated with the address comprising a first message having a first information format and a second message having a second information format wherein the first message and the second message do not include an alert tone; and presenting the first message in the first information format encoded from the information packet in a first output mode in response to the address and the second message encoded in the second information format from the information packet in a second output mode in response to the control character."

Auxiliary request:

"1. A selective call receiver (11) comprising: receiver means (13) for receiving a signal, the signal comprising: an address identifying the selective call receiver and an information packet, characterized in that:

the information packet associated with the address comprises a first message transmitted to the selective call receiver in a first information format, a second message also transmitted to the selective call receiver in a second information format, a third message also transmitted to the selective call receiver in an information format, a first control character, and a second control character; and presentation means (17) for presenting the first message transmitted in the first information format a first output mode in response to receiving and decoding the address, further for presenting the second message transmitted in second information format in a second output mode in response to further receiving and decoding the first control character, and further for presenting the third message transmitted in the information format in an output mode in response to further receiving and decoding the second control character."

"10. A method for use in a selective call receiver, for presenting information including at least first, second and third messages in at least first and second formats comprising the steps of: receiving a signal having a single address for identifying a selective call receiver, characterised by the steps of: receiving the signal having a first control character, an information packet associated with the address comprising a first message having a first information format, a second message having a second information format, a third message having an information format and a second control character; and presenting the first message in the first information format encoded from the information packet in a first

output mode in response to the address, the second message encoded in the second information format from the information packet in a second output mode in response to the control character, and the third message encoded in the information format in response to the second control character."

- V. The appellant argued that the prior art did not give any hint to include more than one message into a uniquely addressed information packet. On the contrary, adding such a second message would be a novel and inventive feature. Document D2 would rather lead the skilled person into a different direction since according to this document the message was always preceded by a special control character.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC and is thus admissible.

2. With its main request, the appellant amended the independent claims by introducing the negative feature that "the first message and the second message do not include an alert tone". Although this feature is not explicitly disclosed, the application as originally filed clearly distinguishes between messages presented in visual or audible mode on an output device 17 and alerts produced by an alert device 16 for informing the user that a message is to be presented on output device 17. The description, therefore, clearly distinguishes between alert and message. Therefore, adding the

negative feature to the claims has the effect to bring the terminology into compliance with the description and does thus not add any subject-matter to the application.

The further amendments have *prima facie* either the character of rephrasing and clarifying the claims or of limitations which seem to have a basis in the examples of the description. In view of the decision to be taken, however, the Board refrains from giving a final opinion about the question whether the claims as amended actually fulfil the requirements of Article 123(2) EPC.

3. Regarding novelty and inventive step, it is to be noted that document D2 is the only prior art document which has been cited by the examining division.

Document D2 discloses a paging protocol which allows to transmit messages of varying data type. The paging protocol defines a signal structure including a unique address, a message for example of numeric or alphanumeric type and two or more control characters which according to the data type of the message encode a command for controlling the output mode of the pager. The paging signal, according to all embodiments described in document D2, includes only one (non-alert type) message per page transmitted.

Therefore, in the terms of the present claims, document D2 discloses a signal which comprises, within an information packet, an address, a "second message" in a second information format and a control character, whereby said second message is to be presented in a

second output mode in response to (further) receiving and decoding the control character. Although not explicitly said so in claim 1, the examples given in the description make clear that the control character indicates the data type of the message.

The essential difference between claim 1 of the main request and document D2 is that according to claim 1 the information packet additionally comprises a "first message" in a first information format which is to be presented in a first output mode in response to receiving and decoding the address. This implies that the receiver must also be informed about the data type of this further message, either by preset or by transmitting a corresponding control information to the receiver; claim 1 includes both possibilities.

Regarding the technical problem objectively solved by the invention on the basis of this difference, it is first to be noted that the present description itself indicates that the object of the invention is to provide a selective call receiver signalling format having a single address and accommodating two or more data types. The decision under appeal apparently refers to this statement by defining the accommodation of two or more data types in a single signalling format as the "objective" which the skilled person sets to achieve.

However, the accommodation of two or more data types in a uniquely addressed information packet is at least to an important extent already part of the solution as defined for example in claim 1 of the main request and, therefore, is not an admissible formulation of the technical problem.

A more general definition of the technical problem might refer to the functionality of the paging system allowing the transmission of messages having potentially different data types. However, such a result is already provided by the paging protocol of document D2. Any further considerations concerning other technical effects or advantages which might be achieved for example by the accommodation of a plurality of messages in a single uniquely addressed information packet do not appear on the file, nor have such type of arguments been submitted by the appellant in the course of the appeal procedure. Therefore, the Board is of the opinion that, on the basis of the facts and evidence on file, the technical problem objectively solved with regard to the closest prior art is merely to find an alternative to the paging system disclosed in document D2, an alternative which must preserve the functionality of the prior art system.

Evidently there are many possible alternatives to transmit signals of different data type to a pager; major technical difficulties are not expected to arise in finding such alternatives. Nevertheless, on the basis of document D2 and the general technical knowledge, the Board sees no reason why the person skilled in the art would take a signalling format as claimed into closer consideration.

Even if document D2 describes that the information packet should additionally encode the type of alert tone to be produced on the pager, this information is closely coupled to the End-Of-Page command so that the skilled person would be hindered to apply this concept outside of the End-Of-Page command to a non-alert type

of signal.

The reasons given in the appealed decision explain why a signalling format as claimed would be evident, if the skilled person sets as an objective the accommodation of two or more data types in a single signalling format. However, the crucial question whether such an objective is known or at least evident in view of the prior art is not addressed in the decision under appeal.

It has to be concluded, therefore, that in view of the present requests document D2 and the general technical knowledge are not a sound and sufficient basis for refusing the application.

4. Nevertheless, the Board has serious doubts whether this positive result could be confirmed when the pertinent prior art is taken in full consideration. In fact, the combination of several data types in a single information packet is known in other paging systems, for example, from document US-A-4959644, a document which is cited in the international search report but which has not yet been introduced by the examining division. Furthermore, the Board considers it highly probable that, even from the appellant's firm, paging systems have become known where data messages and voice messages are combined in a composite paging signal under a unique address. In particular for the Chinese language, paging formats have been proposed allowing to encode, in a radio message, alphanumeric characters and graphical images. Before arriving at a final decision, such prior art has to be taken into account in assessing novelty and inventive step; possibly after an

additional search has been carried out for producing the necessary documentary evidence.

As stated in the decision G 10/93 of the Enlarged Board (OJ 1995, 172, see points 4 f.), a board of appeal, although having the power, should not carry out a full examination of an application even if it considers necessary to introduce new grounds (or facts or evidence) in ex parte proceedings since this is the task of the examining division.

Under the present circumstances the Board considers it appropriate to remit the application to the examining division for further prosecution on the basis of the present requests. It should be noted that the Board did not finally decide on the allowability of the amendments or on the patentability of any of the subject-matter to which the claims according to the present requests relate; the application has to be fully examined as to the requirements of the EPC.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the first instance for further examination on the basis of the appellant's requests.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg