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**Datasheet for the decision
of 15 September 2006**

Case Number: T 0770/04 - 3.5.03

Application Number: 00309805.0

Publication Number: 1102500

IPC: H04Q 7/22

Language of the proceedings: EN

Title of invention:

Method and apparatus for a wireless telecommunications system
that provides location-based action services

Applicant:

LUCENT TECHNOLOGIES INC.

Opponent:

-

Headword:

Location-based action services/LUCENT

Relevant legal provisions:

EPC Art. 56, 113(1), 116(1), 158
EPC R. 68(1)

Keyword:

"Inventive step (no)"

Decisions cited:

G 0010/93, T 1059/04

Catchword:

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Case Number: T 0770/04 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 15 September 2006

Appellant: LUCENT TECHNOLOGIES INC.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 21 April 2004
refusing European application No. 00309805.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: A. Ritzka
R. Moufang

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dated 21 April 2004, refusing European patent application No. 00 309 805.0 for the reason that the subject-matter of each of the independent claims did not involve an inventive step having regard to the disclosure of:

D1: US 5 461 390 A

and the common general knowledge in the art.

II. Notice of appeal was filed on 29 May 2004 and the appeal fee paid. The statement of grounds of appeal was filed on 3 June 2004. The appellant requested that the appealed decision be cancelled in its entirety and that a patent be granted. With the written grounds of appeal a new set of claims was filed.

The board issued an invitation to oral proceedings accompanied by a communication. In the communication the board commented that the appellant had not specified the documents on which the request for grant was based, but it was assumed that grant on the basis of the set of claims filed with the written grounds of appeal and the description and drawings in the version on which the appealed decision was based was requested; the appellant was invited to clarify the request.

The board expressed the preliminary view that the subject-matter of independent claims 1, 22, 25 and 48 *inter alia* did not involve an inventive step having regard to the disclosure of D1.

III. With a letter submitted 8 August 2006, in response to the communication, the appellant maintained the request that a patent be granted on the basis of the set of claims filed with the written grounds of appeal and filed sets of claims of first and second auxiliary requests. It was argued that the subject-matter of the independent claims of each of the requests involved an inventive step having regard to the disclosure of D1.

IV. In the letter of 8 August 2006 the appellant also announced that it would not attend the oral proceedings set for 15 September 2006 and requested that the oral proceedings be cancelled and the procedure continued in writing. The board informed the appellant that the oral proceedings would take place as scheduled on 15 September 2006.

V. Oral proceedings took place as scheduled on 15 September 2006. Neither the appellant nor its representative attended the hearing. After deliberation on the basis of the submissions and requests of 8 August 2006 the chairman announced the board's decision.

VI. Claim 1 according to the main request reads as follows:

"An apparatus comprising: a memory (302), adapted to store information identifying a wireless communication device (201) that is with a user and position information of a remote location stored in association with the information identifying the wireless communication device (201), CHARACTERIZED BY:

a controller (301), adapted to receive information indicating position of the wireless communication device (201);

the controller being adapted to output a control signal to a second controller (310) at the remote location instructing the second controller to initiate an action at the remote location, upon received information indicating that the position of the wireless communication device (201) has satisfied a geographic relationship with the remote location, the control signal instructing the second controller which controls a plurality of devices, to initiate action customized by the user, using at least one of the plurality of devices at the remote location."

Claim 22 according to the main request reads as follows:

"An apparatus comprising: a memory (302), adapted to store information identifying a wireless communication device (201) that is with a user and position information of a remote location stored in association with the information identifying the wireless communication device (201); CHARACTERIZED BY: a controller (301), adapted to output a control signal to a second controller (310) at the remote location instructing the second controller which controls a plurality of devices to initiate action customized by the user, using at least one of the plurality of devices at the remote location upon determining that a position of the wireless communication device has satisfied a geographic relationship with the remote location."

Claims 25 and 48 of the main request are independent claims respectively directed to a system and a method and are based on the apparatus which is the subject of claims 1 and 22.

Claims 1, 22, 25 and 48 according to the first auxiliary request differ from the respective claims of the main request in specifying that the action initiated by the second controller is configured to benefit the user in a pre-defined manner and that the remote location is at least one of the user's home and the user's office.

Claims 1, 22, 25 and 48 according to the second auxiliary request add to the respective claims of the first auxiliary request that the plurality of devices include at least one appliance.

Reasons for the Decision

1. *Oral proceedings*
 - 1.1 As pointed out by this board in a different composition in decision T 1059/04 (unpublished), the function of a board of appeal is to reach a decision on the issues presented to it, not to act as an alternative examining division (cf. G 10/93, OJ EPO 1995 172, in particular point 4).
 - 1.2 According to Article 116(1) EPC, oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at request of any party to the proceedings. Oral

proceedings are considered as an effective way to discuss cases mature for decision, because the appellant is given the opportunity to present its concluding comments on the outstanding issues (Article 113(1) EPC). A decision can be made at the end of oral proceedings based on the requests discussed during oral proceedings (Rule 68(1) EPC).

- 1.3 The need for procedural economy dictates that the board should reach its decision as quickly as possible while giving the appellant a fair chance to argue its case. In the present appeal the holding of oral proceedings was considered by the board to meet both of these requirements. The appellant gave no reasons to support the request to cancel the oral proceedings scheduled by the board and to continue the procedure in writing. The board considered that, despite the appellant's announced intention not to attend, the twin requirements of fairness and procedural economy were still best served by holding the oral proceedings as scheduled. The request to cancel oral proceedings and to continue in writing was therefore refused.

2. *Main request*

2.1 Claim interpretation

The independent claims each refer to the controller being adapted to output a control signal to a second controller at the remote location instructing the second controller to initiate an action customized by the user. The board notes that the second controller at the remote location is not part of the claimed apparatus of claims 1 and 22.

Moreover, the independent claims each refer explicitly to an action "customized by a user". The control signal outputted by the controller causes the second controller to initiate the action. The board notes that the initiation of the action is a result of the cooperation of the controller and the second controller. However, the kind of action initiated is unspecified, and being "customized by the user" does not imply any specific technical limitation and does not serve to define technical interaction between these components. Rather, it relates to the content of the unspecified action. Indeed, the apparatus of claims 1 and 22 is directed only to the memory and the one controller, the operation of which is defined in the claims with reference to the second controller and the signals received, sent and exchanged among the controllers. Since the technical features of the apparatus of claims 1 and 22 do not depend on by whom the action is customized or by whom the action is initiated, the board considers that being "customized by the user" has no limitative effect on the claimed subject-matter.

The language of claim 1 requires information as to whether the position of the wireless communications device has satisfied a geographic relationship with the remote location, but does not exclude that this information is provided by a further, unspecified device and passed to the controller, although it appears more probable that this is effected by the controller, since the controller is adapted to receive information indicating the position of the wireless communications device. Even if the determination were to take place beyond the controller and thereafter be

passed on to it, the controller is nevertheless provided with information that the geographical condition is met. No technical distinction can be seen.

2.2 Inventive Step

The board's comments on inventive step are based on the interpretation of the claims discussed at point 2.1 above.

D1 relates to the field of remotely monitoring the locations of individuals, for example warning a victim and the police about the location of a stalker. It discloses a database system 16 connected to a wireless communication system 10, see figure 1 and column 3, lines 40 to 42. The database system comprises a processor 18 and a storage medium 20, see figure 1 and column 3, lines 42 to 43. The database system constitutes, in the language of the present claims, an apparatus comprising a memory in form of the storage medium and a controller in form of the processor.

The database system keeps a database record containing location information about a locator device, which constitutes a wireless communication device. The record contains *inter alia* information identifying a subject associated with the locator device and location coordinates defining the subject's approved location, see column 2, lines 36 to 39; column 3, line 65 to column 4, line 2 and column 6, lines 4 to 19. Thus, the storage medium, i.e. the memory is adapted to store information identifying the locator device, that is with a subject, i.e. a user, and position information of the approved location, i.e. a remote location,

stored in association with the information identifying the wireless communication device.

The database processor retrieves a record for a subject associated with a locator device and causes a polling message to be sent through the mobile telephone switching office 14 via cell sites to the locator device 22, see column 3, lines 43 to 48. The locator device determines its spatial coordinates from a global positioning system and responds to the polling message with a response message which includes the spatial coordinates and which is forwarded to the database processor, see column 3, lines 57 to 64. Thus, the processor, i.e. the controller, is adapted to receive information indicating the position of the locator, i.e. the wireless communication device.

The database processor retrieves location information from the database record and compares the location coordinates sent from the locator device with approved coordinates stored in the database record, see column 3, line 65 to column 4, line 4, i.e. the processor determines whether the locator device has satisfied a geographic relationship with the subject's approved location.

If the subject is not in an approved location, *inter alia* the victim may be alerted by the database processor establishing a data and/or voice connection through the mobile telephone switching office and a cell site to a locator device associated with the victim and informing the victim with an audible/visual or other signal that the stalker is nearby, see column 4, lines 16 to 19 and 41 to 46. It would be

obvious to the person skilled in the art that in the context of a cellular system a suitable locator device for the victim would be a mobile phone, the use of which implies the provision of a controller in the locator device, i.e. a second controller in the language of claim 1. The second controller is instructed by the data and /or voice connection established by the data processor, i.e. by a control signal outputted by the controller. The generation of an audible/visual or other signal at the locator device associated with the victim is a specific action which if the locator device is a mobile phone would be understood by the skilled person as being customizable. Since mobile phones could at the claimed priority date provide a variety of outputs, e.g. audible, visual and vibratory, as customised by the user, a plurality of devices can be controlled.

As stated above, only minor differences, which do not involve an inventive step, can be found between the disclosure of D1 and the claimed subject-matter.

Thus, the subject-matter of claim 1 does not comply with Article 56 EPC. The arguments apply *mutatis mutandis* to independent claim 22 also. Thus, the main request is not allowable.

3. *First auxiliary request*

3.1 Claim interpretation

Independent claims 1 and 22 according to the first auxiliary request add to the respective claims of the main request that the action initiated by the second

controller is "configured to benefit the user in a pre-defined manner" and that the remote location is "at least one of the user's home and the user's office". The board interprets the action "configured to benefit the user in a pre-defined manner" with reference to the description column 6, lines 15 to 18 as an action to be taken on behalf of the user which will be performed under specified and recorded geographic conditions and which represents desired services. A different interpretation would give rise to objections under Articles 84 and 123(2) EPC.

The fact that an action is "configured to benefit the user in a pre-defined manner" is in the board's view not limitative since it does not affect technical features of the claimed subject-matter. Similarly, the limitation of the remote location to one of the user's home and the user's office will affect the content of the information stored in the memory, but does not imply any further technical limitation. Thus, neither of these features serve to limit the claimed subject-matter with respect to the claims of the main request.

3.2 Article 123(2) EPC

The claims of the first auxiliary request as interpreted at point 3.1 above comply with Article 123(2) EPC.

3.3 Inventive step

Referring to the interpretation of the claims discussed at point 3.1 above, the comments on inventive step presented in point 2.2 apply.

Thus, the subject-matter of claim 1 according to the first auxiliary request does not involve an inventive step having regard to the disclosure of D1. The arguments apply *mutatis mutandis* to independent claim 22 also. Consequently, the first auxiliary request has to be refused.

4. *Second auxiliary request*

4.1 Claim interpretation

Independent claims 1 and 22 according to the second auxiliary request add to the respective claims of the first auxiliary request that the plurality of devices includes "at least one appliance".

Reference is directed to the interpretation of the independent claims according to the first auxiliary request at point 3.1 as regards the common features.

In the board's view the reference to "at least one appliance" has no limitative effect on the scope of the claims. The claimed subject-matter relates to the remote control of the devices controlled by the second controller. This remote control is determined by the memory, the two controllers and their interaction using various signals. The nature of the devices controlled by the second controller at the remote location does not alter the interaction of the memory and the two controllers. In particular, it has no technical effect on the apparatus of claims 1 and 22.

4.2 Article 123(2) EPC

The claims of the second auxiliary request in the interpretation given at point 5.1 above comply with Article 123(2) EPC.

4.3 Inventive step

Referring to the comments on the interpretation of the claims discussed in point 4.1 above and on claim 1 of the main request as to inventive step in point 2.2 above, the board concludes that the subject-matter of claim 1 according to the second auxiliary request does not involve an inventive step having regard to the disclosure of D1. The arguments apply *mutatis mutandis* to independent claim 22 also. Consequently, the second auxiliary request has to be refused.

5. There being no other requests, it follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland