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**Datasheet for the decision
of 30 November 2010**

Case Number: T 1628/08 - 3.5.03

Application Number: 98810968.2

Publication Number: 0989714

IPC: H04M 1/56

Language of the proceedings: EN

Title of invention:

Method for the managing of pieces of information and stored data in a telephone apparatus of the electronic type

Patentee:

Naxos Finance SA

Opponent:

Managing telephone number data/NAXOS

Headword:

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Relevant legal provisions:

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

Relevant legal provisions (EPC 1973):

-

Keyword:

"Added subject-matter - no"

"Remittal to first instance - yes"

Decisions cited:

T 0063/86, T 2287/08

Catchword:

-



Case Number: T 1628/08 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 30 November 2010

Appellant: Naxos Finance SA
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 4 March 2008
refusing European patent application
No. 98810968.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: A. J. Madenach
M-B. Tardo-Dino

Summary of Facts and Submissions

I. The present appeal is against the decision of the examining division to refuse application No. 98810968.2 on the ground that the amended application contained subject-matter which extended beyond the content of the application as filed (Article 123(2) EPC).

In the course of the examination the examining division also raised objections of lack of inventive step (Article 56 EPC), citing in this respect *inter alia*:

D1: EP 0 462 488 A

II. The appellant requested that the decision of the examining division be cancelled and a patent be granted on the basis of the documents filed during the oral proceedings of 13 February 2008 before the examining division. As an auxiliary measure oral proceedings were requested.

III. In a communication of 16 August 2010 pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal, accompanying a summons to oral proceedings, the board gave its preliminary opinion.

IV. With letter of 29 October 2010 the appellant submitted a new set of requests and claims consisting of a main request with claims 1-5, a request titled "main claim 1a" with claims 1-5 and first to third auxiliary requests each with claims 1-5, and amended description page 4 (application as originally filed).

V. Oral proceedings took place on 30 November 2010.

During the oral proceedings, the appellant filed a new description page 2 (application as published) and withdrew all requests apart from the second auxiliary request.

At the end of the oral proceedings, the chairman announced the decision of the board.

VI. Independent claim 1 according to the sole request reads as follows:

"Method for managing pieces of information and data relating to telephone numbers, organized in telephone number lists, said telephone number lists are stored in a mobile phone, said method is characterized by:

a) automatic storing of telephone numbers of incoming and outgoing telephone calls under control of a microprocessor in a first telephone number list or in second telephone number list, the first telephone number list being accessible to any user during operation of the telephone under the control of said microprocessor, the telephone number chosen by the user or the telephone number corresponding to the incoming call, is stored in a temporary register; there it is verified, whether the temporarily stored telephone number during the preceding phase, is comprised in a further list of telephone numbers, said further list is code-protected and said further list of code-protected telephone numbers is previously defined by the user; in the affirmative case the code-protected telephone number is stored in said second telephone number list, corresponding to a personal secret access code; in the negative case, the

not code-protected telephone number is stored in the first telephone number list of the outgoing or incoming calls;

b) limiting the user's access to only the telephone numbers in the first telephone number list, until the user of the mobile phone inputs said personal secret access code, after which the user has also access to telephone numbers in the first telephone number list and to telephone numbers in the second telephone number list;

c) wherein the telephone numbers both of the first and the second telephone number list are stored in the mobile phone and wherein telephone numbers according to the second telephone number list are telephone numbers that are not stored in the first telephone number list;

d) said second telephone number list can be accessed and displayed only after inputting the said personal secret access code previously defined and associated to said second telephone number list;

e) refusing the calls coming from protected telephone numbers, avoiding, if this is the case, the relevant bell ringing, whenever the apparatus is operated in the public mode, thus whenever the user of the mobile phone has not yet inputted the personal secret access code."

Reasons for the decision:

1. Added subject-matter, Article 123(2) EPC

1.1 The examining division came to the conclusion that the feature "is comprised in a further list of code-protected numbers" of claim 1 considered in its decision could not be directly and unambiguously derived from the originally filed application since there was no basis

for the presence of a third list. The examining division appears to have interpreted the original disclosure as meaning that the list of code-protected numbers was identical to the second list.

1.2 According to present claim 1, the first list is accessible to any user, the second list "corresponds" to a personal secret access code, and there is a further list of code-protected telephone numbers.

1.3 Different lists are defined for example in original claim 2, which distinguishes between at least two lists, one public and one private. According to original claim 2, procedures are provided for the memorisation of "all the not code protected telephone numbers" in the public list.

According to paragraph [0062] of the published application "the memory of the telephone apparatus, provided for containing the list of the telephone numbers ... is divided into at least two areas: a public area, which may be accessed, without any formality, by all the users, ..., and one or more private areas, which may be accessed and viewed only after the inputting of one or more secret codes ...".

Thus, the description requires (at least) a first list (in the public area) which is accessible to all users and a second list (in the private area) which requires the entering of a secret code to be accessible.

1.4 Paragraphs [0017]-[0019] of the published application relate to the automatic memorisation function of telephone numbers. Although these paragraphs do not

state that a secret code was previously inputted by the user, the fact that they deal with storing of code-protected numbers implies that such a code was previously inputted.

According to paragraph [0018] of the published application it is verified whether the temporarily stored number "is comprised in the list of the code protected numbers". If so, according to paragraph [0019] of the published application, the "number is stored in the private list corresponding to such a secret code". If not, the "not code-protected number is stored in the public list".

This can be understood, *prima facie*, as meaning that there is indeed an original disclosure for three lists, i.e. the list of code protected numbers used for verification, the private list of received code-protected numbers, and the public list.

The board agrees that confusion is caused by the fact that automatic memorisation as described in paragraphs [0017]-[0019] of the published application refers to the list of code protected numbers, the private list corresponding to such a secret code, and the public list without these items ever having been mentioned previously. This cannot be logically correct.

- 1.5 The argument of the examining division was that not all of these definite articles are a mistake. "The private list corresponding to such a secret code" was understood as being the same as the list of code protected numbers. Thus, it could be argued that the list of code protected numbers is a list which is only accessible after

inputting a private code, as is the private list. There is no indication of two different secret codes. Indeed, it appears to be the same secret code ("such a secret code"). The list of code protected numbers and the private list contain the same elements, i.e. the code-protected telephone numbers, see first phrase of paragraph [0019]. Thus, the examining division took the view that the two lists are identical and that there is no original disclosure for three lists.

- 1.6 The board agrees that the description of the application in suit is confusing and could be interpreted in this manner. However, in the board's view, such an interpretation does not take account of the description when read as a whole.

Thus it is clear from column 1, lines 4-6 and lines 16-21 of the published application that the invention relates to a so called "call-log" in which details including the telephone numbers of incoming and outgoing calls are memorised. According to the invention, the "call-log" is memorised in such a way that it is divided into a public area, which may be accessed by all users, and at least one private area, which may be accessed only after the inputting of a secret code previously defined. The two areas are understood to correspond to the public and private lists as defined in paragraph [0019] of the published application or, equivalently, to the first and second lists as claimed. Furthermore, a criterion is applied (paragraph [0018]) to decide whether a given telephone number is part of the public (first) or private (second) list. This criterion is whether the number of an incoming or outgoing call is comprised in the list of code-protected numbers. As the

numbers (and further details) of incoming and outgoing calls are memorised in the first (public) or second (private) list depending on this criterion, the board takes the view that the skilled person would interpret this as meaning that the list of code-protected numbers is different from the second (private) list. The list of code-protected numbers is a list previously defined by the user (column 7, line 54 - column 8, line 2) whereas the second (private) list is a list modified each time an incoming or outgoing call corresponds to one of the numbers.

Thus, the board concludes that the skilled person would interpret the description as directly and unambiguously disclosing the provision of first and second lists of telephone numbers, which constitute the public and private part of a call log, and a further list of telephone numbers, which serve as a criterion for deciding whether the number (and possibly more details) of an incoming or outgoing call are stored in the first or second list.

1.7 Feature e of claim 1 of the sole request derives from column 6, lines 3-6 of the published application.

1.8 The board is furthermore satisfied that the further amendments introduced into claim 1 according to the sole request as compared to claim 1 of the request underlying the decision of the examining division are also based on the original disclosure: the term "telephone number list" is used e.g. in original claim 1; the feature that the list of code-protected telephone numbers is previously defined by the user follows from column 7, line 56 - column 8, line 2.

1.9 Claim 1 of the sole request thus fulfils the requirements of Article 123(2) EPC.

2. Clarity, Article 84 EPC

The board is satisfied that claim 1 of the sole request, although containing a number of infelicities of language, defines the matter for which protection is sought in an adequately clear and concise way.

3. Inventive step, Article 56 EPC:

3.1 The board notes that the examining division based its decision exclusively on the ground that the amended application contained subject-matter which extended beyond the content of the application as filed (Article 123(2) EPC). In a communication of 19 November 2007, the examining division raised an objection of lack of inventive step in relation to the subject-matter of a claim 1 having a substantially broader scope than claim 1 according to the present sole request.

The board has nevertheless considered the arguments of the examining division as far as they apply to present claim 1.

3.2 The examining division considered during the examination procedure that D1 represents the closest prior art. The board agrees.

D1 relates to capturing and storing call activity at a telephone set, including storing telephone numbers (column 1, lines 1-8), i.e. maintaining a "call log".

Optionally, this can be done under the control of a microprocessor which can be part of the telephone set (column 3, lines 11-20) as can be a display used for displaying the telephone numbers (column 3, lines 26-28).

To preserve confidentiality of certain information, access may involve the use of a password (column 7, line 54 - column 8, line 10). Following column 1, lines 3-8, information and data in the sense of D1 relates "to telephone set activity to provide a call status activity log ... and for displaying ... telephone numbers". Thus, the skilled person would understand that D1 manages information and data in the form of a call log.

The subject-matter of present claim 1 essentially differs from the teaching of D1 in that it comprises three lists, i.e. a first telephone number list accessible to any user, a second telephone number list corresponding to a personal secret access code, and a further list which is code-protected and comprises code-protected telephone numbers previously defined by the user, and in refusing calls from code protected numbers, when in public mode (feature e).

D1 only discloses a single list comprising telephone numbers.

- 3.3 The examining division stated in their communication of 19 November 2007 that privacy did not per se have technical character and that the technical problem to be solved could be regarded as how to modify the method of D1 to allow users to be identified via a secret code which allows them to view a private and public list.

3.4 The board observes that the present claim 1 does not refer to "public" and "private" lists. Instead, the formulations "first telephone number list ... accessible to any user" and "second telephone number list, corresponding to a personal secret access code" are used. These features imply technical means added to a telephone number list corresponding to a secret access code which could e.g. be in the form of a query added to each item of the list as to whether the secret code has previously been entered.

The problem solved by the above identified differing features may be seen as allowing several users to use the same phone and still preserve the confidentiality of their call logs in such a way that maximum privacy is conserved (column 2, lines 6-14 and column 8, lines 40-44 of the published application).

3.5 According to D1 "... embodiments of the present invention may incorporate selection criteria for capturing and/or displaying information so as to preserve certain confidential information. Such selection criteria can be developed in a manner which is well known to those of ordinary skill in the art ..." (column 9, line 56 - column 10, line 3).

"Certain confidential information" could be understood as comprising certain confidential telephone numbers and thus as suggesting a list of telephone numbers which would require code-protection. If this were the case the "selection criteria" would be understood by the skilled person as comprising a list of such telephone numbers as a reference to allow the apparatus of D1 to decide which

of the incoming and outgoing calls involve one of the certain confidential telephone numbers.

D1 does not, however, contain any disclosure pointing to feature e of claim 1 of the sole request, i.e. "refusing the calls coming from protected telephone numbers, avoiding, if this is the case, the relevant bell ringing, whenever the apparatus is operated in the public mode, thus whenever the user of the mobile phone has not yet inputted the personal secret access code". The board accordingly concludes that the arguments of the examining division as regards inventive step do not apply to the present claim 1.

4. Remittal to the first instance, Article 111(1) EPC

4.1 According to Article 111(1) EPC a "Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution".

In the present case, there is no formal decision of the examining division on the question of novelty and inventive step. Moreover, as noted above, the objection of lack of inventive step raised in the communication of 19 November 2007, concerned a claim 1 of a broader scope which in particular did not include feature e of present claim 1. This feature corresponds, albeit using a different wording, to original dependent claim 5, but the dependent claims were only dealt with in general terms in the above mentioned communication.

The amendments to claim 1, in particular regarding feature e, must thus be considered substantial amendments.

According to established case law, in a case where substantial amendments to the claims which require substantial further examination, are proposed on appeal, the case should be remitted to the Examining Division (e.g. T 63/86, OJ 1988, 224 and T 2287/08 not published in the OJ).

- 4.2 For these reasons, the board decides to remit the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of the claims of the sole request maintained during the Oral Proceedings (auxiliary request 2 filed on 29 October 2010).

The Registrar

The Chairman

G. Rauh

A. S. Clelland