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**Datasheet for the decision
of 5 July 2011**

Case Number: T 1807/08 - 3.5.03

Application Number: 05023162.0

Publication Number: 1677497

IPC: H04M 1/2745

Language of the proceedings: EN

Title of invention:

Mobile terminal and method for associating photos with telephone numbers in a mobile terminal

Patentee:

LG Electronics Inc.

Opponent:

-

Headword:

Mobile terminal/LG

Relevant legal provisions:

EPC Art. 56

Relevant legal provisions (EPC 1973):

-

Keyword:

"Inventive step (yes)"

Decisions cited:

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Catchword:

-

Case Number: T 1807/08 - 3.5.03

**DECISION
of the Technical Board of Appeal 3.5.03
of 5 July 2011**

Appellant: LG Electronics Inc.
20, Yoido-dong
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Seoul 150-721 (KR)

Representative: Beyer, Andreas
Wuesthoff & Wuesthoff
Patent- und Rechtsanwälte
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 March 2008
refusing European patent application
No. 05023162.0 pursuant to Article 97(2)
EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: T. Snell
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. This decision makes reference to the following documents from the examining proceedings:
- D1: WO-A-2004/093432
D2: EP-A-1469374
D3: EP-A-0930770
- II. The appeal is against the decision of the examining division refusing European patent application No. 05023162.0, with publication number EP-A-1677497. The decision was based, *inter alia*, on the ground that the subject-matter of independent claims 1 and 14 of "auxiliary request II" (which is the only request relevant to the board's decision) did not meet the requirement of inventive step pursuant to Articles 52(1) and 56 EPC with respect to the disclosure of document D2.
- III. In the notice of appeal the appellant requested that "the decision of the first instance be set aside in its entirety".
- IV. With the statement of grounds of appeal the appellant filed new claims, said to correspond to the claims of auxiliary request II refused by the examining division.
- Oral proceedings were conditionally requested.
- V. In a communication accompanying a summons to oral proceedings, the board raised issues *inter alia* concerning the clarity of the independent claims. The board indicated that if the clarity objections were overcome, it would consider whether it were in a position to decide on the case without oral proceedings.
- VI. Together with a reply to the board's communication dated 4 May 2011, the appellant filed amended claims of a main and an auxiliary request.
- VII. The appellant was notified by a communication dated 28 June 2011 that the oral proceedings were cancelled.
- VIII. According to the written submissions, the appellant requests the grant of a patent on the basis of the claims of a main request, or alternatively an auxiliary request, both filed with the letter dated 4 May 2011. The request includes pages 1 to 3, 3a and 10 of description as filed on 30 January 2008 and pages 4 to 9 as originally filed, as well as figures 1, 2, 3A and 3B as originally filed.
- IX. Claims 1 and 14 of the appellant's **main request** read as follows:
- "1. A method for contacting a person using a mobile terminal comprising the steps of:

- displaying one of a plurality of photos included in a photo database (110), and
 - selecting a contact operation while the photo is displayed,
- characterized by the steps of:
- determining whether the photo database includes information that associates the photo with a person whose personal information is included in a contact list database (130) so as to designate the photo as a representative photo,
 - automatically performing a contact function so as to contact the person in accordance with the selected contact operation, if the photo is a representative photo, and
 - opening a contact list feature so as to display a contact list from which a person may be selected, if the photo is not a representative photo.

14. A mobile terminal comprising:

- a contact list database (130) which includes personal information associated with at least one person; and
- a photo database (110) which includes a plurality of photos stored in a memory of the mobile terminal and which further includes information that associates at least one photo with a person whose personal information is included in the contact list database (130) so as to designate the at least one photo as a representative photo, characterised in that the mobile terminal is configured, upon displaying a photo included in the photo database (110) and upon selection of a contact operation by a user, to determine whether the photo is a representative photo, to automatically perform a contact function so as to contact the person in accordance with the selected contact operation, if the photo is a representative photo and to open a contact list feature so as to display a contact list from which a person may be selected, if the photo is not a representative photo."

X. In view of the board's decision, it is not necessary to reproduce the claims of the auxiliary request.

Reasons for the decision

1. *Articles 123(2) and 84 - main request*

1.1 Claim 1 is based on claim 10 as originally filed together with paragraphs [0043] - [0046] of the description as originally filed (referring to the published application EP-A-1677497). Claim 14 (which is an independent apparatus claim corresponding to method claim 1) is based on claim 23 as originally filed together with the above-mentioned passage of the description.

Dependent claims 2 to 13 and 15 to 20 correspond to claims 11 to 22 and 24 to 29 as originally filed.

All claims therefore comply with Article 123(2) EPC.

1.2 The board considers that the claims are clear within the meaning of Article 84 EPC.

2. *Inventive step - main request*

2.1 The general problem underlying the invention as set out in the application as filed is the desire to call a person whose photo is currently displayed on the viewer of a mobile phone (cf. paragraph 0005 of the published description). A known solution as described in the application is to exit the photo viewing application and either manually enter the telephone number or search for it by opening a phone book application.

2.2 In broad terms the invention solves this problem by associating photos with personal information included in a contact list database (eg an address or phone book), so that, having determined if the photo has such an association (such a photo is called a "representative photo"), the person can be contacted automatically, eg by automatically placing a telephone call. If there is no such association, a contact list is opened enabling the number to be searched for in the normal way.

2.3 The board regards document D2 as representing the closest prior art.

Document D2 discloses a mobile phone having database in which photos have an association with personal information (cf. col. 8, lines 6-11). When such a photo is displayed and an "off-hook" key pressed, the person is called automatically (cf. col. 4, lines 29-34).

2.4 Hence, using the wording of claim 1, D2 discloses a method for contacting a person using a mobile terminal comprising the steps of:

- displaying one of a plurality of photos included in a photo database, and
- selecting a contact operation while the photo is displayed.

2.5 The subject-matter of claim 1 differs from the disclosure of D2 in the following features:

- determining whether the photo database includes information that associates the photo with a person whose personal information is included in a contact list database so as to designate the photo as a representative photo,

- automatically performing a contact function so as to contact the person in accordance with the selected contact operation, if the photo is a representative photo, and
 - opening a contact list feature so as to display a contact list from which a person may be selected, if the photo is not a representative photo.
- 2.6 These features provide the technical effect of enabling calling to be started from a photo viewing mode which displays photos both with an association with a personal information in the contact list database ("representative photo") as well as photos that are not, eg the normal photo viewing mode of the mobile phone. In accordance with D2, calling is only possible from a menu displaying a photo and other personal information, ie all photos are representative photos.
- 2.7 The problem to be solved by the present invention starting out from D2 is regarded as being to provide an alternative method of calling a person using a mobile phone which includes a photo database.
- 2.8 As mentioned above, with the mobile phone of D2 it is only possible to initiate a call when viewing a photo already designated as a representative photo. As all viewed photos are representative photos, there would be no reason for the skilled person to modify the mobile phone of D2 by including the steps required by claim 1 of (a) "determining whether the photo database includes information that associates the photo with a person whose personal information is included in a contact list database so as to designate the photo as a representative photo" and (b) "opening a contact list feature, if the photo is not a representative photo". The board concludes that their inclusion in the method of D2 is not obvious. As a consequence, the board disagrees with the view of the examining division expressed in the impugned decision either that feature (a) is implicit in the method of D2, or concerns an obvious alternative (cf. point 15 of the section "II. Reasons for the decision"), or that the inclusion of feature (b) does not require the exercise of inventive activity (cf. point 14 of the "Reasons for the Decision").
- 2.9 Documents D1 and D3 concern methods for associating photos with personal data in an address book of a mobile phone. Neither of these documents deal explicitly with calling a person whose picture is displayed. Implicitly, this is only possible as with document D2 if the photo has already been registered in the address book as a representative photo. Hence, there can also be no reason starting out from either D1 or D3 to include the step of "determining whether the photo database includes information that associates the photo with a person whose personal information is included in a contact list database so as to designate the photo as a representative photo".

- 2.10 The board concludes that the subject-matter of claim 1 involves an inventive step (Articles 52(1) and 56 EPC).
- 2.11 The same reasoning applies, *mutatis mutandis*, to independent claim 14.
- 2.12 Claims 2 to 13 and 15 to 20 are dependent on either claim 1 or claim 14 and therefore also meet the requirement of an inventive step (Articles 52(1) and 56 EPC).

3. *Auxiliary request*

As the claims of the main request are allowable, there is no need to consider the auxiliary request.

4. *Adaptation of the description*

The description appears to require adaptation to correspond to the invention now claimed, which is based on the embodiment claimed in claim 10 as originally filed. This matter is however considered best dealt with by the examining division.

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 with the order to grant a patent in accordance with claims 1 to 20 of the main request filed with the letter dated 4 May 2011 and a description to be adapted.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland