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**Datasheet for the decision
of 24 January 2014**

Case Number: T 2139/08 - 3.4.01

Application Number: 04252995.8

Publication Number: 1480157

IPC: G06K9/00, G06F3/033, G06F15/02

Language of the proceedings: EN

Title of invention:
Apparatus and method of input and finger print recognition on
a handheld electronic device

Applicant:
BlackBerry Limited

Headword:

Relevant legal provisions:
EPC 1973 Art. 54, 56, 84
EPC Art. 123(2)
EPC 1973 R. 27(1) (e)

Keyword:
Amendments - added subject-matter (no)
Novelty
Inventive step

Decisions cited:
T 0667/08, T 0545/92

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2139/08 - 3.4.01

**D E C I S I O N
of Technical Board of Appeal 3.4.01
of 24 January 2014**

Appellant: BlackBerry Limited
(Applicant) 2200 University Avenue East
Waterloo, ON N2K 0A7 (CA)

Representative: Fennell, Gareth Charles
Kilburn & Strode LLP
20 Red Lion Street
London WC1R 4PJ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 8 April 2008
refusing European patent application No.
04252995.8 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: G. Assi
Members: P. Fontenay
M. Vogel

Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division to refuse European patent application No. 04 252 995.8. The decision was dispatched on 8 April 2008.

II. In its decision, the examining division held that the main request and first and second auxiliary requests then on file did not meet the requirements of Article 56 EPC 1973 with regard to inventive step.

Moreover, the examining division indicated by way of *obiter dictum* that all the requests did not comply with the requirements of Article 84 EPC 1973 and that the first and second auxiliary requests contravened Article 123(2) EPC.

III. The appellant (applicant) lodged an appeal against this decision on 13 June 2008. The appeal fee was paid on 16 June 2008.

In the written statement setting out the grounds of appeal, filed on 11 August 2008, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of various sets of claims according to a main request or first or second auxiliary requests filed with letter dated 14 February 2008 or according to third or fourth auxiliary requests filed with the statement of grounds.

The main request and first and second auxiliary requests correspond to the requests underlying the decision under appeal.

IV. By summons of 31 July 2013 the appellant was summoned to oral proceedings due to take place on 18 December 2013.

V. In a communication dated 9 September 2013 pursuant to Article 15(1) RPBA, the Board expressed its provisional opinion with regard to the appellant's requests.

In particular, the Board drew the attention of the appellant to various shortcomings in the wording of the claims according to all the requests with regard to the requirement of clarity under Article 84 EPC 1973. Concerning the issues of novelty and inventive step of the independent claims of the main request, it was acknowledged that the arguments put forward by the appellant in the statement of grounds appeared to be convincing.

VI. In a letter dated 18 November 2013, the appellant filed two new requests, dubbed "*Request A*" and "*Request B*", which were to be considered as new main request and first auxiliary request, respectively. The appellant requested that these two requests be considered before all of the requests filed with the grounds of appeal.

VII. In a phone conversation on 10 December 2013, the attention of the appellant was drawn to the fact that the claims of Request A, filed by letter of 18 November 2013, were considered to meet the requirements of novelty and inventive step with regard to the state of the art on file.

However, Request A contained two independent claims in the same category and was thus considered to infringe Rule 43(2) EPC (Rule 29(2) EPC 1973) since none of the exceptions referred to in this rule appeared to apply.

A possibility of amending the claims so as to meet this objection was suggested.

VIII. With letter dated 13 December 2013, the appellant requested the grant of a patent based upon the following documents:

- description page 1 submitted on 15 June 2007;
- description pages 2 to 4 enclosed with the letter of 13 December 2013;
- description pages 5 to 16 as originally filed;
- figures 1 to 5 as originally filed; and
- claims 1 to 12 enclosed with the letter of 13 December 2013.

All previous requests were withdrawn.

IX. The Oral proceedings appointed for 18 December 2013 were cancelled by order of the Chairman of the Board on 16 December 2013.

X. Claim 1 of the appellant's request reads:

"1. A method of input and fingerprint recognition at an electronic handheld device, the method comprising the steps of:

providing a touch surface (215,315,415) having a touch resolution portion and a fingerprint portion (220,320,420) distinct from the touch resolution portion, the touch resolution portion and the fingerprint portion being integral to said touch surface, the touch resolution portion having a touch resolution for detecting a touch input on said touch surface; and

selectively operating the fingerprint portion in one of a fingerprint mode for sensing a fingerprint on

said touch surface and a touch input mode for detecting the touch input on said touch surface."

Claim 5 of the appellant's request reads:

"5. An apparatus for input and fingerprint recognition for use with a handheld electronic device, the apparatus comprising:

a touch surface (215,315,415) having a touch resolution portion and a fingerprint portion (220,320,420) distinct from the touch resolution portion, the touch resolution portion and the fingerprint portion being integral to said touch surface, the touch resolution portion having a touch resolution for detecting a touch input on said touch surface; and

a data processor coupled to the touch surface and being configured to selectively operate the fingerprint portion in one of a fingerprint mode for sensing a fingerprint on said touch surface and a touch input mode for detecting the touch input on said touch surface."

Claim 6 of the appellant's request reads:

"6. A handheld electronic device with the apparatus for input and fingerprint recognition according to claim 5."

Claims 2 to 4 and 7 to 12 depend respectively on claims 1 and 6.

Reasons for the Decision

1. *Applicable law*

This decision is issued after the entry into force of the EPC 2000 on 13 December 2007, whereas the application was filed before this date. Reference is thus made to the relevant transitional provisions for the amended and new provisions of the EPC, from which it may be derived which Articles and Rules of the EPC 1973 are still applicable to the present application and which Articles and Rules of the EPC 2000 are to apply. When Articles or Rules of the former version of the EPC are cited, their citations are followed by the indication "1973" (cf. EPC, Citation practice).

2. *Admissibility of the appeal*

The appeal complies with the requirements of Articles 106 to 108 EPC and Rule 99 EPC. The appeal is, thus, admissible.

3. *Article 123(2) EPC*

3.1 Claim 1 finds its basis in original independent claim 9. Amended claim 1 further recites that the touch resolution portion and the fingerprint portion are integral to the touch surface. A basis for this amendment is to be found, for example, in paragraph [0005] of the published application or in original claim 1.

3.2 Claim 5 derives from original independent claim 13 as to "*an apparatus for input and fingerprint recognition on a handheld electronic device*". Claim 5 has been further amended by specifying that the touch resolution portion and the fingerprint portion are integral to the touch surface as disclosed in paragraph [0005] of the published application and by specifying that the

claimed apparatus is "*for use with a handheld electronic device*".

The Board is satisfied that the generalisation resulting from the fact that the handheld device per se is no more part of the claimed subject-matter is allowable. It is stressed, in this respect, that the first embodiment of the apparatus, in the form of a peripheral (cf. Figures 2A to 2F and original claim 1), implies that the possibility of the claimed apparatus to constitute a separate part or entity derives directly and unambiguously from the original application (cf. decision T 545/92, not published).

- 3.3 Claims 2 to 4 derive, respectively, from original claims 10 to 13. Claim 6 relates to the combination of an handheld device with the apparatus for input and fingerprint recognition as disclosed in the second and third embodiments of the invention. Claims 7 and 8 derive, respectively, from original claims 14 and 16.

Claim 9 finds its basis in the description of the first embodiment of the invention (cf. paragraphs [0028] to [0034], Figures 2A to 2F; original claim 1). Although not explicitly recited, the fact that the data processor is disposed within the housing derives from original paragraph [0030] in the published application. Contrary to the view expressed by the examining division, it is stressed that a claimed feature does not need to be mentioned explicitly in the application as filed in order to be allowable under Article 123(2) EPC as long as the amendment results directly and unambiguously from said original application documents considered in their entirety (cf. decision T 667/08, not published).

Claims 10 and 11 derive from original claims 5 and 3, respectively. Claim 12 finds its basis in original claim 19.

3.4 The description has been amended so as to acknowledge the prior art and to reflect the amendments carried out with regard to the new claims.

3.5 The conditions of Article 123(2) EPC are, therefore, met by the appellant's request.

4. *Article 84 EPC 1973*

4.1 The examination division observed in its decision that method claim 1 recited features of an apparatus and was therefore unclear contrary to Article 84 EPC 1973.

The Board, however, notes that the subject-matter of claim 1 refers to a method which is defined, in essence, by the two clearly identifiable steps of providing a touch surface and of selectively operating the fingerprint portion. The fact that the touch surface to be provided is defined in terms of structure neither affects the category to which the claim belongs nor creates any confusion as to the extent of protection. There is no doubt, in this respect, that the extent of protection will be affected by the structural limitations regarding the touch surface recited in the claim's wording.

4.2 The Board, moreover, rejects the view of the examining division mentioned as *obiter dictum* in the contested decision according to which the features of claim 3 are essential for operating the claimed apparatus. It is, namely, established jurisprudence of the boards of appeal that claimed definitions must be read in an

attempt to make technical sense, thus implying, under the circumstances, that the reference to a fingerprint resolution portion and touch resolution portion indeed implies the existence of sensing surfaces adapted for each recited purpose.

4.3 The Board is also not convinced by the examining division 's view according to which the application failed to teach at least one way of carrying out the invention (Rule 27(1) (e) EPC 1973). As put forward by the appellant, the teaching of paragraph [0042] appears to provide at least some basic information as to a possible implementation of the claimed invention. It is considered, in this respect, that a reduction to practise relying on this basic teaching would not require any special skills extending beyond what may be expected from the skilled person. The requirements of Rule 27(1) (e) EPC 1973 are therefore met.

4.4 Consequently, the application meets the requirements of Article 84 EPC 1973 as to clarity and support by the description.

5. *Novelty (Article 54 EPC 1973)*

Reference is made in this decision to the following documents:

D1: WO-A-01/59558;
D4: US-B-6 401 551;
D5: US-B-6 360 004.

None of the documents on file discloses an apparatus which would be adapted to be used with a handheld device which comprises a touch surface as defined in independent claim 5 of the appellant's request. More

concretely, none of these documents discloses a touch resolution portion and a fingerprint portion, distinct from the touch resolution portion, with both portions being integral to a touch surface.

In this respect, the Board notes that the touch pad mode and the fingerprint recognition mode referred to in document D1 solely differ from each other in the manner the electrodes of the various cells constitutive of the touch pad are controlled.

While it is acknowledged that the mere reference to "*distinct portions*" in the claim's wording allows a broad interpretation of the claimed subject-matter and would also apply to the case of one portion completely overlapping the other one, it nevertheless implies that the two portions be somehow distinguishable, whether structurally or functionally. There is, however, no indication to be found in D1 that certain areas would be activated according to a fingerprint recognition mode while other portions, distinguishable from the first ones, would be controlled according to a touch mode. It is therefore impossible in the absence of any structural differences between various areas of the touch pad, or any functional differences as to the manner various areas of the touch pad would possibly be controlled, to identify distinct portions as actually required by the claim's wording.

Similarly, document D5 discloses a fingerprint sensor which acts not only as a fingerprint sensor but also as a position sensor. There is, however, no suggestion that any specific areas of the sensor would be dedicated to one or the other mode.

Document D4 focuses on the structure of a fingerprint reading device. The possibility of activating said reading device according to different modes is not addressed in document D4 which appears, thus, even less relevant for the issue of novelty.

The known apparatuses, insofar as they are indeed adapted to the recited facilities, disclose sensors for which the entirety of the sensing area may act, alternatively, as a fingerprint sensor or a position determining sensor (touch sensor), contrary to the apparatus of claim 5 which is thus new within the meaning of Article 54(1), (2) EPC 1973.

In view of the foregoing, the method of input and fingerprint recognition of independent claim 1, which explicitly refers to the provision of a touch surface with two distinct resolution portions, is also new.

6. *Inventive step (Article 56 EPC 1973)*

6.1 Since document D1 discloses an apparatus for input and fingerprint recognition, this apparatus being adapted for use with handheld devices, it qualifies as the closest prior art. The same finding would apply to the disclosure of document D5. As a matter of fact, both documents suggest to use the disclosed units in a fingerprint recognition mode or, alternatively, as a position sensor for detecting a position of contact of the finger with the sensor.

6.2 The apparatus defined in claim 5, differs from these known devices, in that the same touch surface includes two distinct portions.

Faced with the problem of making the touchpad of document D1, or D5, more cost effective (see statement of grounds of appeal, point 5.2.5.2), the skilled person would consider documents relating to touch pads of a similar construction adapted for use in fingerprint reading systems. Since document D4 directly addresses the question of manufacturing costs, its teaching would have undoubtedly been considered by the skilled person (cf. D4, column 1, lines 35-38; column 2, lines 11-16; column 4, lines 27-44; column 5, lines 19-25).

6.3 However, document D4 does not hint at the claimed solution. The fact that the fingerprint sensor of D4 may be provided in superposition on the display area, or a part of it, is in this respect not sufficient. Nowhere in document D4 is it namely suggested to provide distinct portions of one and the same sensing area (touch surface) with different functionalities.

None of the other available prior art suggests to adapt the touch surface of a handheld device by providing such a surface with two distinct areas wherein the fingerprint area may be controlled according to various resolution modes.

For these reasons, the subject-matter of claim 5 involves an inventive step in the sense of Article 56 EPC 1973. The same finding applies to the method of claim 1, since it explicitly includes the step of providing a touch surface with distinct touch resolution portions.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division with the order to grant a patent on the basis of:
 - description page 1 submitted by letter of 15 June 2007;
 - description pages 2 to 4 submitted by letter of 13 December 2013;
 - description page 5 to 16 as originally filed;
 - figures 1 to 5 as originally filed; and
 - claims 1 to 12 submitted by letter of 13 December 2013.

The Registrar:

The Chairman:



R. Schumacher

G. Assi

Decision electronically authenticated