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**Datasheet for the decision  
of 17 April 2014**

**Case Number:** T 0562/10 - 3.5.03

**Application Number:** 06021187.7

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**Language of the proceedings:** EN

**Title of invention:**  
Mobile phone

**Applicant:**  
DRNC HOLDINGS, INC.

**Headword:**  
Mobile phone/DRNC HOLDINGS

**Relevant legal provisions:**  
EPC Art. 52(1), 56, 113(1)  
EPC R. 103(1)(a)

**Keyword:**  
Inventive step (all requests) - (no)  
Reimbursement of appeal fee - (no)  
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**Decisions cited:**  
T 0641/00

**Catchword:**



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Case Number: T 0562/10 - 3.5.03

**D E C I S I O N  
of Technical Board of Appeal 3.5.03  
of 17 April 2014**

**Appellant:** DRNC HOLDINGS, INC.  
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**Representative:** Johansson, Magnus  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 3 November 2009  
refusing European patent application No.  
06021187.7 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** F. van der Voort  
**Members:** A. Madenach  
M.-B. Tardo-Dino

## **Summary of Facts and Submissions**

- I. The present appeal arises from the decision of the examining division refusing European patent application No. 06021187.7 on the ground that the subject-matter of claims 1 to 7 of a main request and claims 1 to 6 of first, second and third auxiliary requests did not involve an inventive step (Articles 52(1) and 56 EPC) having regard to the disclosure of document D2 and common general knowledge.

A further document

D1: EP 1004957 A1

which was cited in the European search report, referred to in the examination proceedings, and acknowledged on amended page 2 of the description of the present application as submitted on 16 January 2008, is referred to in the present decision.

- II. In the statement of grounds of appeal the appellant requested that the decision be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, the claims of the first or the second auxiliary request, all in the form on which the decision of the examining division was based, or on the basis of the claims of an amended second auxiliary request as submitted with the statement of grounds of appeal, or on the basis of the claims of a third or a fourth auxiliary request, which were identical to the respective claims of the second and the third auxiliary requests on which the decision of the examining division was based. Oral proceedings were requested in the event that the main request was not considered allowable. Further, a refund of the

- appeal fee was requested on the basis of alleged substantial procedural violations by the examining division.
- III. The board summoned the appellant to oral proceedings and sent a communication according to Article 15(1) RPBA, in which its preliminary opinion on various issues was expressed.
- IV. With a reply dated 13 March 2014 to the summons the appellant submitted a set of claims 1 to 9 of a main request, sets of claims 1 to 8 of a first, a second and a third auxiliary request, and a set of claims 1 to 7 of a fourth auxiliary request. It requested that the decision of the examining division be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, on the basis of the claims of one of the auxiliary requests.
- V. In the course of the oral proceedings which took place on 17 April 2014, the appellant confirmed its previous requests, *i.e.* that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, in the alternative, on the basis of one of the first to fourth auxiliary requests, all as submitted with the letter dated 13 March 2014. The appellant further requested that the appeal fee be reimbursed.
- VI. Claim 1 of the main request reads as follows:
- "A method for controlling a display comprising the steps of:
- operating a first operating portion (14) in either of two opposite directions;

displaying a soft key function indication (63), predetermined information and a pointer on a display unit (15);

controlling said display unit so as to shift said pointer to a desirable position within said predetermined information on a screen of said display unit in response to said step of operating said first operating portion and displaying a mark (71, 72) indicative of a direction to which said pointer can be shifted and in which said predetermined information exists, and only displaying said mark if said predetermined information exists in said direction, said mark being displayed adjacent to said soft key function indication (63) along a shift direction of said first operating portion."

According to claim 1 of the first auxiliary request the two opposite directions are defined as "being upwards towards a top of said display or downwards towards a bottom of said display". Further, the claim comprises the following additional features:

"operating a second operating portion (18, 19) to shift said pointer in a direction perpendicular to said upward or downward direction, said perpendicular directions being leftwards or rightwards, a display of a higher hierarchy being located leftwards and a display of a lower hierarchy being located rightwards, wherein:

said controlling step comprises controlling said display unit so as to display a mark (73, 74) indicative of a direction to which said pointer can be shifted by said second operating portion and in which

said predetermined information exists, adjacent to said soft key function indication (63) along a shift direction of said second operating portion, and only displaying said mark if said predetermined information exists in said direction."

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that it comprises the further step of:

"determining whether said predetermined information exists in each direction",

and within the controlling step the further step of:

"determining whether said displays of a higher or lower hierarchy exist",

and in that in the last paragraph "in which said predetermined information exists" and "if said predetermined information" are replaced by "in which said higher or lower hierarchy exists" and "if said display of a higher or lower hierarchy exists", respectively.

Claim 1 of the third auxiliary request is directed to "A method for controlling a display in a portable device for performing at least one of: sending and receiving calls; sending and receiving emails; Internet browsing; and reproducing audio data" with the method steps as recited in claim 1 of the first auxiliary request, except that in the penultimate paragraph "a display" is twice replaced by "information".

Claim 1 of the fourth auxiliary request is directed to "A method for controlling a display of a portable

telephone" with the method steps as recited in claim 1 of the first auxiliary request, except that in the penultimate paragraph "a display" is twice replaced by "information".

### **Reasons for the Decision**

1. *Alleged procedural violations: reimbursement of the appeal fee and remittal*

1.1 According to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the present case, for the reasons set out below (see points 2 to 4), these requirements are not met, since the appeal is not found allowable.

Further, according to Article 11 RPBA, a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. For the reasons set out below, no fundamental deficiencies are apparent in the first instance proceedings which would have called for a remittal to the first instance.

1.2 The appellant alleged that two substantial procedural violations had occurred during the examination proceedings.

1.3 The first of the alleged substantial procedural violations or deficiencies is a contravention of Article 113(1) EPC. The appellant argued that the raising of a new objection by the first examiner during

a telephone conversation with the representative on 23 September 2009, *i.e.* three weeks before the oral proceedings, the introduction of a new document on the last working day before the oral proceedings, and the raising of a further new objection during the oral proceedings, *i.e.* that the claimed invention represented only an administrative procedure for selecting how to display a function and was therefore not inventive, resulted in the violation of the applicant's right to be heard.

The board notes, however, that the new objection raised during the telephone conversation was eventually dropped and, hence, was not decisive for the outcome of the decision. It cannot therefore give rise to a fundamental deficiency.

With respect to the further new objection raised during the oral proceedings, the board notes that a similar objection was already raised in the examining division's communication of 24 April 2009, in which it was stated that the feature in question did not involve any technical consideration and that therefore the skilled person (starting out from the disclosure of D2) would have arrived at the claimed invention without exercising inventive skill. The alleged new objection can thus at best be considered as a minor modification of the argument. This cannot give rise to a fundamental deficiency.

As regards the introduction of the new document, the board notes that the decision under appeal is based on D2. In the decision, after explaining why the subject-matter of claim 1 does not involve an inventive step, the examining division states as an aside that "The same consideration can be made starting with the common



general knowledge, *i.e.* windows manager under the operative system Windows available since 1992", the latter being documented by the newly introduced document. The reasons for the decision are therefore not based on this document. The late citation of this document cannot, therefore, be considered to have given rise to a fundamental deficiency.

- 1.4 The second alleged substantial procedural violation is a contravention of the applicant's legitimate expectations which arose after the first examiner informed the representative in a telephone interview on 25 September 2009 that the first auxiliary request with some minor amendments would be considered allowable, whereas in the oral proceedings a correspondingly worded request (*i.e.* the third auxiliary request) was not allowed.

The board notes that the telephone interview took place with the first examiner. It is, however, the examining division as whole which decides on the allowability of a request. The first examiner cannot make a commitment for the examining division as a whole. Further, it is an accepted principle that neither the first examiner nor the examining division is bound by suggestions made, for example, over the phone. The board does not therefore see any procedural violation here either: the fact that the examining division, after a discussion during the oral proceedings, came to a different conclusion from the opinion expressed by the first examiner during a telephone call was not excluded.

- 1.5 For the reasons given above, the request that the appeal fee be reimbursed is rejected (Rule 103(1)(a) EPC). Further, there is no reason to remit the case to the examining division (Article 11 RPBA).

2. *Claim 1 of the main request and the first auxiliary request: inventive step (Articles 52(1) and 56 EPC)*

2.1 The subject-matter of claim 1 of the main and first auxiliary requests relates to a method for controlling a display. D1, which the board considers to constitute the closest prior art, relates to a portable terminal, e.g. a mobile telephone, having a display (the abstract and paragraph [0001]). D1 describes, with reference to Figure 3, the main operations of the mobile telephone (paragraphs [0031]-[0035]). Part of the main operations is the execution of the directory processing (paragraph [0033]), which is described in further detail and with reference to Figure 5 in paragraphs [0044]-[0049].

In detail and with reference to Figure 5, which shows the resulting displays, the directory processing comprises, using the language of claim 1 of the first auxiliary request, the steps of operating a first operating portion (the auxiliary soft keys 4A and 4B taken together); displaying a soft key function display area (2A) (which the board understands to be identical to the claimed soft key function indication), predetermined information (*i.e.* the Japanese characters shown on the display of Figure 5B), and a pointer (*i.e.* the inversion  $C_{B1}$  as shown on the display of Figure 5B) on a display unit (2); controlling said display unit so as to shift said pointer to a desirable position within said predetermined information on a screen of said display unit in response to said step of operating said first operating portion (paragraph [0046]) and displaying a mark ( $I_{B11}$ ,  $I_{B12}$ ) indicative of a direction to which said pointer can be shifted and in which said predetermined information exists, said mark being displayed within said soft key function indication

along a shift direction of said first operating portion. The directory processing further comprises a step of operating a second operating portion (the main soft key 3) to shift the pointer in a direction perpendicular to the direction along which the pointer can be shifted by the first operating portion (paragraph [0046]). By operating the second operating portion in the downward direction, the displayed mode is shifted to the next mode with a corresponding screen as shown in Figure 5C (*loc. cit.*). This screen corresponds to the claimed display of a lower hierarchy. The controlling step furthermore comprises controlling the display unit so as to display a further mark (I<sub>B10</sub>) within the soft key function indication and indicative of the direction to which the pointer can be shifted by said second operating portion and in which said predetermined information exists along a shift direction of the second operating portion.

The method of claim 1 of the first auxiliary request differs therefore from the method known from D1 by the following features:

- operating the first operating portion is in either of two opposite directions, the two directions being upwards towards a top of said display or downwards towards the bottom of the display
  - the pointer is shifted by the second operating portion leftwards or rightwards;
  - only displaying the marks if said predetermined information exists in the respective directions;
  - the marks are displayed adjacent said soft key function indication (underlining by the board);
- and

- a display of higher hierarchy is located in the direction opposite to the direction in which a display of lower hierarchy is located.

2.2 The first two features relate to the direction in which the pointer can be shifted by operating the operating portions. Compared to the method of D1, the first and second operating portions as operated according to the claimed method are interchanged with a consequential effect on the pointer movement: the displays of lower or higher hierarchy are reached by moving the pointer sideways, whereas movements of the pointer over the display are upwards and downwards. The claimed method corresponds thus to pointer movements on the display which are, in their functionality, rotated by 90° as compared to the known method. The problem to be solved by these features can be seen in the adaption of the known method in such a way that the content, which, contrary to the content shown in the example of D1 (Figure 5B), has a large vertical extension, is better handled on a given display. Considering the freely programmable nature of the **soft** keys of D1, in order to handle a pointer for browsing information with a predominantly vertical extension, it would have been obvious to the skilled person to likewise interchange the functionality of the operating portions with respect to the pointer movements with the effect that the main soft key 3 of D1 would be used for moving the pointer upwards and downwards and the auxiliary soft keys 4A and 4B would be used for reaching displays of lower and higher hierarchy. These features cannot, therefore, contribute to an inventive step.

2.3 With respect to the third feature, *i.e.* the display of marks only if predetermined information exists in the direction of the mark, it is not necessary to decide

whether or not this feature is of a technical nature or solves a technical problem or not, since it was in any case obvious to the skilled person for the following reasons. Considering the relevant display shown in Figure 5B of D1, neither the Figure itself nor the related description at paragraph [0046] gives any indication whether predetermined information exists to the left or upwards or downwards of the display. There is, therefore, no explicit teaching whether the marks I<sub>B10</sub>, I<sub>B11</sub> or I<sub>B12</sub> would disappear if no predetermined information existed in the direction indicated by the marks. However, D1 explicitly discloses in other examples that no marks (icons) are shown when the corresponding soft key is not active in the current mode. Reference is made, e.g., to Figures 5C and 5D (modes B2 and B3), in which no icon corresponding to the inactive soft key 4A is shown. From this, and in the absence of any specific indication as to the extent of the predetermined information beyond the display of Figure 5B, it is obvious to the skilled person to consider displaying the marks I<sub>B10</sub>, I<sub>B11</sub> or I<sub>B12</sub> only if predetermined information exists in the direction indicated by the marks in order to be consistent with the way the relation between icons and soft keys is displayed in other display modes of the same operation (*i.e.* the directory processing) or of other operations. Hence, this feature does not contribute to an inventive step.

- 2.4 The fourth feature, *i.e.* the display of the marks adjacent to, instead of within, the soft key function indication, is a design alternative. The board cannot see, nor was it argued by the appellant, that this feature would solve a technical problem. It is therefore, by analogy with the reasoning set out in

T 641/00 (OJ 2003, 352), disregarded for the analysis of an inventive step.

2.5 The fifth feature, *i.e.* the location of a display of a higher hierarchy in a direction opposite to the display of lower hierarchy, solves the problem of providing an escape route from the soft key mode B1 shown in Figure 5B of D1 back to the initial mode B0 shown in Figure 5A. This problem is immediately evident to the skilled person since the display shown in Figure 5B provides no explicit escape possibility, unlike the two other display modes of the directory processing (Figures 5C and 5D) where an escape back to the initial mode shown in Figure 5A is achieved by pressing the "CLEAR" button. The claimed solution to this problem is obvious to the skilled person, since a user would intuitively try to operate the operating portion 3 in a direction opposite to the downward direction which led to the display of lower hierarchy, in an attempt to move from the given display (Figure 5B in this case) to a display of higher hierarchy (Figure 5A in this case). Hence, this feature does not contribute to an inventive step either.

2.6 Since none of the above features contributes to an inventive step and since no contribution to inventive step can be seen in combining these features, the subject-matter of claim 1 of the first auxiliary request does not meet the requirements of Articles 52(1) and 56 EPC.

2.7 The features of claim 1 of the main request are all comprised in claim 1 of the first auxiliary request. Since the above reasoning applies, *mutatis mutandis*, it follows that the subject-matter claim 1 of the main

request does not satisfy the requirements of Articles 52(1) and 56 EPC either.

2.8 Hence, the main request is not allowable.

3. *Claim 1 of the second, third and fourth auxiliary requests: inventive step (Article 52(1) and 56 EPC)*

3.1 Claim 1 of the second auxiliary request (see point VI above) comprises the features of determining whether the predetermined information in each direction exists and whether the displays of a higher and lower hierarchy exist.

These features are, however, already implied by the condition "only displaying said mark **if** said predetermined information exists in said direction" (emphasis by the board) in claim 1 of the first auxiliary request, since this condition presupposes a determining step. The above additional features therefore do not add new features to claim 1 of the second auxiliary request. Further, the replacement in the last paragraph of the term "predetermined information" by "higher or lower hierarchy" is merely a clarification which does not add a further feature either.

It follows that the subject-matter of claim 1 of the second auxiliary request does not meet the requirements of Articles 52(1) and 56 EPC for the same reasons as given above in relation to the subject-matter of claim 1 of the first auxiliary request. Hence, the second auxiliary request is not allowable.

3.2 Claim 1 of the third auxiliary request seeks protection for, *inter alia*, a method for controlling a display in

a portable device for performing sending and receiving telephone calls, and claim 1 of the fourth auxiliary request is directed to a method for controlling a display of a portable telephone, whilst in both claims the remaining features are identical to those of claim 1 of the first auxiliary request.

Since D1 relates to a mobile telephone (paragraph [0001]), the subject-matter of claim 1 of the third and fourth auxiliary requests does not meet the requirements of Articles 52(1) and 56 EPC for the same reasons as given above in relation to the subject-matter of claim 1 of the first auxiliary request. Hence, the third and fourth auxiliary requests are not allowable.

4. Since none of the appellant's requests is allowable, the appeal must be dismissed.

### **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The request for reimbursement of the appeal fee is rejected.



The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated