

**Internal distribution code:**

- (A) [ - ] Publication in OJ  
(B) [ - ] To Chairmen and Members  
(C) [ - ] To Chairmen  
(D) [ X ] No distribution

**Datasheet for the decision  
of 10 October 2016**

**Case Number:** T 0543/14 - 3.5.05

**Application Number:** 09170697.8

**Publication Number:** 2194452

**IPC:** G06F3/048

**Language of the proceedings:** EN

**Title of invention:**

Portable electronic device with interface reconfiguration mode

**Applicant:**

Apple Inc.

**Headword:**

Touch interface reconfiguration/APPLE

**Relevant legal provisions:**

EPC Art. 52(2)(c), 56  
EPC R. 61

**Keyword:**

Inventive step - mixture of technical and non-technical  
features  
Remittal to the department of first instance

**Decisions cited:**

G 0003/08, T 1173/97, T 1143/06, T 0528/07, T 1411/08,  
T 1896/09, T 1900/09, T 0852/10, T 0781/10, T 0887/12

**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 0543/14 - 3.5.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.05**  
**of 10 October 2016**

**Appellant:** Apple Inc.  
(Applicant) 1 Infinite Loop  
Cupertino, CA 95014 (US)

**Representative:** Barnfather, Karl Jon  
Withers & Rogers LLP  
4 More London Riverside  
London SE1 2AU (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 23 October 2013  
refusing European patent application  
No. 09170697.8 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chair** A. Ritzka  
**Members:** P. Cretaine  
G. Weiss

## **Summary of Facts and Submissions**

- I. This appeal is against the decision of the examining division, posted on 23 October 2013, refusing European patent application No. 09170697.8 on the grounds of lack of inventive step (Article 56 EPC) having regard to the "notoriously known" prior art.
  
- II. Notice of appeal was received on 4 November 2013 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 26 February 2014. The appellant requested that the decision be set aside and that a patent be granted based on a main request or a first auxiliary request, both filed with the statement setting out the grounds of appeal. The claims of the main request were identical to the claims on which the refusal decision was based. Oral proceedings were further requested as an auxiliary measure. In addition, the appellant requested reimbursement of the appeal fee on the grounds of an alleged procedural violation due to improper consideration of the claimed "mixed invention" and to failure to conduct a prior-art search.
  
- III. A summons to oral proceedings was issued on 29 July 2016. In an annex to this summons, the board gave its preliminary opinion on the appeal pursuant to Article 15(1) RPBA.

The board agreed with the appellant that the claims according to the main request required a prior-art search. The board further expressed doubts about the admissibility of the first auxiliary request. As to the request for reimbursement of the appeal fee, the board stated that, in its view, no procedural violation had

occurred in the examination process and that the appeal fee should not be reimbursed.

The board further indicated that it would be in a position to remit the case to the department of first instance for further prosecution, including a search, on the basis of the main request, provided the appellant withdrew its other requests.

- IV. With a letter of reply dated 10 August 2016, the appellant withdrew the first auxiliary request and the request for reimbursement of the appeal fee. The request for oral proceedings was also withdrawn, provided the board remitted the case to the department of first instance for further prosecution.
- V. By communication dated 21 September 2016, the board informed the appellant that the oral proceedings appointed for 29 November 2016 had been cancelled.
- VI. Independent claim 1 according to the main (sole) request reads as follows:

"A portable electronic device, comprising:  
a touch-sensitive display;  
one or more processors;  
memory; and  
one or more programs, wherein the one or more programs are stored in the memory and configured to be executed by the one or more processors, the programs including:  
instructions for displaying a first plurality of application icons in a first region on the touch-sensitive display in a normal mode of operation, wherein in the normal mode of operation a tapping gesture on a respective application icon at a first

location on the touch-sensitive display activates a corresponding application;

instructions for detecting a first predefined user action comprising a finger contact on the respective application icon at the first location held for more than a predefined time period;

instructions for, in response to detecting the first finger contact on the respective application icon at the first location held for more than the predefined time period, initiating a predefined user interface reconfiguration mode, distinct from the normal mode of operation, that allows a user to reposition one or more displayed application icons;

instructions for generating, when the reconfiguration mode has been initiated, an indication to the user that the reconfiguration mode has been initiated and that the positions of one or more application icons in the first plurality of application icons may be reconfigured by the user;

instructions for detecting movement of the first finger contact from the first position on the touch-sensitive display to a second position on the touch-sensitive display while in the interface reconfiguration mode;

instructions for, in response to detecting movement of the first finger contact from the first position on the touch-sensitive display to the second position on the touch-sensitive display while in the interface reconfiguration mode, moving the respective application icon to the second position on the touch-sensitive display;

instructions for detecting a second predefined user action, separate from the first predefined user action, after moving the first application icon to the second position on the touch-sensitive display; and

instructions for, in response to detecting the second predefined user action:

fixing a position of the respective application icon at the second position, and terminating the user interface reconfiguration mode."

The main request further comprises independent claims for a corresponding method (claim 8) and a corresponding computer program (claim 15).

## **Reasons for the Decision**

### 1. Admissibility

The appeal complies with Articles 106 to 108 EPC (see Facts and Submissions, point II) and is therefore admissible.

### 2. Main request

#### 2.1 Technical features of claim 1

The extended European search report issued on 28 April 2010 cited as "L" document the following text: "The contribution to the prior art (a generally known -and defined in the application itself- portable device with a touch-sensitive display) does not as such go beyond a program for a computer or a presentation of information (i.e. reconfiguring a user interface by positioning icons)". No search has been carried out for further pertinent prior art. The examining division then refused the main request on the grounds that the subject-matter of claim 1 lacked inventive step (Article 56 EPC), having regard to the prior art as notoriously known. In that respect, the examining division considered that the features of claim 1 which

were not notorious were related to computer programs as such (Article 52(2)(c) EPC).

The board however agrees with the appellant that the technical effects provided by the "instructions" features of the portable electronic device defined in present claim 1 go beyond the normal physical interactions between programs and computers. Therefore these features, and their technical effects, should be taken into account for the assessment of inventive step, in accordance with the case law of the boards of appeal (see G 3/08 and T 1173/97).

More precisely, in the board's judgement, the following features present in substance in claim 1 are not related to computer programs as such but rather to a user's gestural interactions with the portable electronic device and the subsequent specific response of the device, and therefore have a technical character (see T 1143/06, T 1896/09, T 1900/09, and T 0852/10):

- instructions for, in the normal mode of operation, activating an application by tapping on an icon at a first location on the touch-sensitive display,
- instructions for detecting a first predefined user action comprising a finger contact on the application icon at the first location held for more than a predefined time period,
- instructions for, in response to detecting the first finger contact on the application icon at the first location held for more than the predefined time period, initiating a predefined user interface reconfiguration mode, distinct from the normal mode of operation, that allows a user to reposition one or more displayed application icons,



- instructions for detecting movement of the first finger contact from the first position on the touch-sensitive display to a second position on the touch-sensitive display while in the interface reconfiguration mode,
- instructions for, in response to detecting movement of the first finger contact from the first position on the touch-sensitive display to the second position on the touch-sensitive display while in the interface reconfiguration mode, moving the application icon to the second position on the touch-sensitive display,
- instructions for detecting a second predefined user action, separate from the first predefined user action, after moving the first application icon to the second position on the touch-sensitive display,
- instructions for, in response to detecting the second predefined user action, fixing a position of the application icon at the second position, and terminating the user interface reconfiguration mode.

Further, in the board's judgement, the following feature is not related to the presentation of information as such but rather to providing an indication of the technical state of the device, namely if the device is in the normal or reconfiguration mode:

- instructions for generating, when the reconfiguration mode has been initiated, an indication to the user that the reconfiguration mode has been initiated and that the positions of one or more application icons in the first plurality of application icons may be reconfigured by the user.

Since providing a visual indication of technical conditions of a machine is a technical feature, according to the case law of the boards of appeal (see

T 528/07, T 781/10 and T 887/12), this feature too has a technical character.

## 2.2 Unsearched features

The board therefore agrees with the appellant that, in the present case, the afore-mentioned "instructions" features (see point 2.1 above) are technical features which go beyond mere common general knowledge and cannot be considered to have been "notorious" at the priority date of the present application in 2005. According to the jurisprudence of the boards of appeal, technical features of a claim which are not considered as "notorious" should be searched before the claims are definitively assessed with respect to inventive step (see T 1411/08).

3. Thus, the board judges that a search for relevant prior art has to be performed with respect to the features identified in point 2.1 above (Rule 61 EPC).

## 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, including a search, on the basis of the main request.

The Registrar:

The Chair:



L. Malécot-Grob

A. Ritzka

Decision electronically authenticated