BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS　**BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE**　**CHAMBRES DE RECOURS DE L'OFFICE EUROPÉEN DES BREVETS**

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

Datasheet for the decision
of 11 October 2021

Case Number:	T 0140/18 - 3.5.03
Application Number:	09743287.6
Publication Number:	2274901
IPC:	H04M3/487, H04M3/42
Language of the proceedings:	EN

Title of invention:
Systems and methods for mobile wireless advertising platform

Applicant:
Singhal, Tara Chand

Headword:
Mobile wireless advertising platform/SINGHAL

Relevant legal provisions:
EPC Art. 56, 84, 113(1), 116, 123(2)
RPBA 2020 Art. 12(8)

Keyword:
Decision requested according to the state of the file - implicit withdrawal of conditional request for oral proceedings
Added subject-matter - main request (yes)
Clarity - main request (no)
Inventive step - auxiliary requests (no): claim construction - scope of claim not implicitly limited by referring to the description

Decisions cited:
T 0881/01, T 0223/05, T 1646/12, T 2764/19

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 11 October 2021

Appellant: Singhal, Tara Chand
(Applicant)   P.O. Box 5075
                    Torrance, CA 90510-5075 (US)

Representative: Viering, Jentschura & Partner mbB
                    Patent- und Rechtsanwälte
                    Am Brauhaus 8
                    01099 Dresden (DE)

Decision under appeal: Decision of the Examining Division of the
                          European Patent Office posted on 14 July 2017
                          refusing European patent application
                          No. 09743287.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chair   K. Bengi-Akyürek
Members: T. Snell
               R. Romandini

Summary of Facts and Submissions

I.   This case concerns the appeal of the applicant
        (henceforth, "appellant") against the decision of the
        examining division refusing the European patent
        application.

II.   The following documents are mentioned in the board's
        decision:

        D1:   US 2007/0136761 A1
        D3:   US 2001/0022788 A1.

III.   The appellant requests that the decision under appeal
        be set aside and that a patent be granted on the basis
        of the claims of either the **main request** or one of the
        1st to 4th auxiliary requests all as filed with the
        statement of grounds of appeal.

        The main request and the 1st and 2nd auxiliary requests
        are re-filed versions of the requests decided on by the
        examining division, whereas the 3rd and 4th auxiliary
        requests are filed for the first time in these appeal
        proceedings.

IV.   In the statement of grounds of appeal, the appellant
        conditionally requested oral proceedings. Subsequently,
        in response to a communication of the board pursuant to
        Rule 100(2) EPC containing the board's negative
        preliminary opinion, the appellant requested that a
        decision be issued "on the state of the file" (cf. the
        submission dated 13 September 2021, point 1.2).

V.   Claim 1 of the **main request** reads as follows:

"A wireless mobile advertising system working in
conjunction with a wireless communication network, that
delivers commercial messages to a wireless device user,
the advertising system having a message server and a
handheld wireless mobile device, wherein the mobile
device comprising:

a. an inbound wireless data function with a storage
function in the mobile wireless device that receive and
store from the commercial message server a message file
that has a one or more of, audio, text, image, and
flash animation formatted commercial messages wherein
the messages in the file have been customized to a
device user demographics that is pre-stored in the
message server;

b. a message exposure function, for visually and/or
aurally annunciating a message, detects onset of a
device function, wherein the device function includes
categories of functions including communication
function, camera function, and music function, puts on
hold the device function for a brief period of time,
wherein the brief period of time is less than or equal
to 3.5 seconds to avoid viewer irritability, and
exposes a selected message from the message file to the
device user during the hold period by visually
annunciating the message on a display screen and/or
aurally via a speaker of the device, wherein the hold
for the brief period of time of one or more of the
enumerated device functions provides assurance that a
device user has exposure of the selected message from
the message file, wherein the message file having been
received from the message server over the wireless
communication network, wherein a message provider with
a message provider interface over a global computer
network having entered messages in the message server."

VI.   Claim 1 of respectively the **1st, 2nd and 3rd auxiliary requests** reads as follows:

"A wireless mobile advertising system working in conjunction with a wireless communication network, that delivers commercial messages to a wireless device user, the advertising system having a message server and a handheld wireless mobile device, wherein the mobile device comprising:

a. an inbound wireless data function with a storage function in the mobile wireless device that receive and store from the commercial message server a message file that has a one or more of, audio, text, image, and flash animation formatted commercial messages, wherein a part of each commercial message is a preprogrammed criterion code;

b. a message exposure function that detects onset of a device function, wherein the device function includes categories of functions including communication function, camera function, and music function, puts on hold the device function for a brief period of time and displays and/or plays a selected message from the message file to the device user, wherein the message is selected according to the preprogrammed criterion code, during the hold period."

VII.   Claim 1 of the **4th auxiliary request** differs from claim 1 of the 1st, 2nd and 3rd auxiliary requests in that the following wording is added to the end of feature "a.":

", wherein the preprogrammed criterion code identifies algorithms used to expose the message to a user of the mobile wireless device",

and in that the following wording is added to the end
of feature "b.":

", wherein the message is exposed to the user according
to the preprogrammed criterion code".

Reasons for the Decision

1.   Procedural matters

In the statement of grounds of appeal, the appellant
conditionally requested oral proceedings (Article 116
EPC) but subsequently requested a decision "based on
the state of the file", i.e. that a decision be taken
based on the case presented by the appellant hitherto
in written proceedings. It follows logically that the
appellant no longer wishes to present arguments to the
board orally. The conditional request for oral
proceedings is therefore treated as having been
withdrawn. Consequently, the decision can be handed
down in writing in compliance with Article 113(1) EPC
(Article 12(8) RPBA 2020).

*2.   **Main request** – claim 1 – added subject-matter
           (Article 123(2) EPC) and clarity (Article 84 EPC)*

2.1   The board agrees with the examining division that the
           following sub-feature of feature b of present claim 1
           is not directly and unambiguously derivable from the
           application as filed (cf. point 16 of the impugned
           decision):

               "... a message exposure function ... puts on hold
               the device function for a *brief period of time*,
               wherein the brief period of time *is less than or*

equal to 3.5 seconds to avoid viewer
irritability...".

2.2   In this respect, neither the term "brief" (in the
        context of time), nor the condition "less than or equal
        to 3.5 seconds", nor any mentioning of "viewer
        irritability" occur in the application documents as
        filed.

2.3   The appellant refers in section 3.1.1 of the statement
        of grounds of appeal to the passages of the original
        description on page 18, lines 11 to 13 and page 24,
        lines 11 to 21 as well as to Fig. 2A for support.
        However, none of these passages, explicitly or
        implicitly, discloses any of the aspects mentioned in
        point 2.2 above.

        In this respect, on page 18, "a few seconds or even
        sub-second duration" is mentioned. On page 24, "longer
        than 3 to 9 seconds" is mentioned, and in Fig. 2A,
        examples are given of "5, 7 and 3 seconds". Even if
        these examples, for the sake of argument, were held to
        provide support for the general term "brief", there is
        no support for the specific value of "3.5 seconds", nor
        any mention of a period related to "viewer
        irritability".

        Claim 1 therefore does not comply with Article 123(2)
        EPC. It is further not clear what technical limitation,
        if any, is implied by the term "... to avoid viewer
        irritability", also resulting in a lack of clarity
        (Article 84 EPC).

2.4   Consequently, claim 1 of the main request does not
        comply with Articles 123(2) and 84 EPC.

3.   ***1st, 2nd and 3rd auxiliary requests*** *– claim 1 –*
        inventive step (Articles 52(1) and 56 EPC)

3.1   Claim 1 of each of these auxiliary requests is
        identical and comprises the following limiting features
        (board's labelling A to J):

        A: A wireless mobile advertising system working in
             conjunction with a wireless communication network,
             that delivers commercial messages to a wireless
             device user,

        B: the advertising system having a message server and
             a handheld wireless mobile device, wherein the
             mobile device comprises:

        C: an inbound wireless data function with a storage
             function in the mobile wireless device that receive
             and store from the commercial message server a
             message file that has a one or more of, audio,
             text, image, and flash animation formatted
             commercial messages,

        D: wherein a part of each commercial message is a
             preprogrammed criterion code;

        E: a message exposure function that detects onset of a
             device function,

        F: wherein the device function includes categories of
             functions including communication function, camera
             function, and music function,

        G: puts on hold the device function for a brief period
             of time and

H: displays and/or plays a selected message from the
     message file to the device user,

I: wherein the message is selected according to the
     preprogrammed criterion code,

J: during the hold period."

3.2   The closest prior-art document is held to be **D1.**

        In particular, D1 discloses features A to C, E, F and
        H:

        A: cf. D1, paragraph [0055].
        B: cf. D1, paragraphs [0040] and [0041].
        C, H: cf. D1, paragraphs [0049] and [0053].
        E, F: cf. D1, paragraph [0049], 3rd sentence.

3.3   The distinguishing features with respect to D1 are
        therefore **features D, G, I and J.**

        Features D and I concern a "criterion code" transmitted
        with the commercial message on the basis of which the
        message is selected for display or play. **Features G and
        J** concern the holding of a device function for a brief
        period of time whilst the message is displayed or
        played.

3.4   The technical effect of features D and I is to provide
        information to the mobile device enabling the
        commercial message to be correctly processed. The
        technical effect of features G and J is that "a message
        can be played to the user without disrupting other
        device functions that are being executed" (cf. the
        impugned decision, point 14.3). These effects are
        independent of one another insofar as there is no

requirement in claim 1 that the criterion code
influences the holding period and thus there is no
synergy. The respective pairs of distinguishing
features D/I and G/J can therefore be assessed
independently using the **"partial problems"** approach.

3.5   Re **features D and I:**

3.5.1   A "preprogrammed criterion code" as mentioned in
        features D and I is interpreted here as embracing any
        preprogrammed information (i.e. programmed before being
        received by the mobile device) used by the mobile
        device to select a message from the message file for
        display or play.

3.5.2   The appellant argued that the "criterion code" should
        be interpreted more narrowly. In this respect, the
        appellant submits the following:

        "*The criterion code may be used to identify
        different approaches or algorithms that may be used
        to expose different formats and types of messages
        to the user by the mobile device. The criterion
        code may be considered as a "header" of the message
        which is not part of the content and is not
        displayed to a user. The criterion code is used in
        connection with software of the mobile device. The
        software of the mobile device implements algorithms
        (which are already present in the software of the
        mobile device and does not have to be downloaded as
        part of a content of a message) according to the
        criterion code and selects the messages based on
        the criterion code. Thus, the criterion code is
        part of a high level control function*" (cf. the
        statement of grounds of appeal, page 13,
        section 3.2.3, 3rd paragraph).

However, claim 1 does not specify that the "criterion code" must have any of these properties going beyond preprogrammed information used by the mobile device to select a message from the message file for display or play.

3.5.3   In the reply to the board's communication under Rule 100(2) EPC dated 13 September 2021 (cf. page 2, last two paragraphs), the appellant further submitted that claims were to be interpreted in the light of the description and "*cannot be read in isolation, devoid of meaning and context of the claim elements and claim terms as in the specification ... Therefore a claim term or a phrase cannot be read out of the context in which it is used in the claim and the specification, and then compared to or equated to terms that may be found elsewhere in the prior art out of context ..., because terms devoid of the context in which they are used in the invention become a veritable jungle of meaningless ideas. A classic example of context is the term 'virus', which may mean both a pathogen and a computer harming malware (a piece of code)*".

3.5.4   In accordance with case law, a claim should be interpreted on its own merits, but by giving its wording the broadest technically sensible meaning by the skilled person within the context of the application (see e.g. T 223/05, Reasons 3.5; T 2764/19, Reasons 3.1.1).

In the present case, the board's broad interpretation of "criterion code" makes technical sense in the context of the application, and the board sees no parallel at all with the appellant's "virus" example.

It is furthermore well-established case law that, for the purposes of judging novelty and inventive step, the scope of a claim resulting from its literal wording cannot be altered by reading into it further limiting features which appear only in the description. This would amount to *amending* the claims, and not to *interpreting* them (cf. T 1646/12, Reasons 2.1). It would also deprive the claims from their intended function (cf. e.g. T 881/01, Reasons 2.1), which is to define the *subject-matter* for which protection is sought (Article 84 EPC).

3.5.5   As stated above, the technical effect of **features D and I** is to provide information to the mobile device enabling the commercial message to be correctly processed.

3.5.6   In this respect, in accordance with **D1**, content application 412 of the mobile device may configure received content to be automatically displayed or audibly played when certain events take place (cf. paragraph [0049]). Two of the many examples given are a "ring tone" that is played on reception of an incoming call (cf. paragraph [0051], last two sentences) and displaying "advertisement content" (i.e. commercial content) when the mobile device is flipped open (cf. page 6, left-hand column, lines 9-12). However, it is not stated in D1 *how* the content application 412 knows how to configure which message to display or play when a particular event occurs.

3.5.7   Starting out from D1, the objective technical problem associated with features D and I can therefore be seen as *how to enable the content application to correctly process the received messages stored in the mobile*

device in order to display or play a commercial message when a particular event occurs.

3.5.8   A way to solve this problem at least hinted at by D1 is to include a script with the content (cf. page 4, right-hand column, 4th line from bottom to page 5, left-hand column, line 4), i.e. instruction logic indicating how the content should be used. Thus, referring to the examples mentioned above, the skilled person would be led to include with the message a script containing instructions resulting in a ring tone being played on an incoming call or displaying an advertisement message on flipping open the display. Such a script would then fall within the scope of a "criterion code" within the meaning of present claim 1.

3.5.9   The appellant argues that the "script" suggested in D1 is part of the content and does not provide any control function on a higher level, e.g. it is not part of a header and is not involved in delivery or selecting a message.

However, claim 1 does not specify that the "criterion code" may *not* be part of the content or define that it should provide control on "a higher level" (whatever that means). Furthermore, following the board's argumentation above (cf. point 3.5.8), the script would contain information used by the mobile device when "exposing" the message. Thus, the script would indeed be involved in delivering and selecting a message. Consequently, the appellant's argument is not convincing.

3.5.10   The board concludes that **features D and I** do not contribute to inventive step.

3.6   Re **features G and J**:

          The appellant has not argued at all that this pair of
          features contributes to inventive step. The board
          therefore has no reason to re-consider the assessment
          of the examining division that this aspect is obvious
          in the light of the combination of documents **D1** and **D3**
          (cf. points 14.1 to 14.4 of the impugned decision).

3.7   Consequently, the subject-matter of claim 1 of
          respectively the 1st, 2nd and 3rd auxiliary requests
          does not involve an inventive step (Articles 52(1) and
          56 EPC).

4.   ***4th auxiliary request*** *– claim 1 – inventive step*

4.1   Claim 1 of the 4th auxiliary request differs from
          claim 1 of the 2nd auxiliary request in that it
          includes the features that

          K: the preprogrammed criterion code identifies
              <u>algorithms</u> used to expose the message to a user of
              the mobile wireless device;

          L: the message is exposed to the user <u>according to</u> the
              preprogrammed criterion code.

4.2   These additional features make no difference to the
          assessment of inventive step since it is obvious that
          if a script were received instructing how a message is
          to be "exposed" (cf. point 3.5.9 above), then the
          content application of D1 would operate in conjunction
          with the script enabling the instruction to be carried
          out. In so doing, "algorithms" in the mobile device
          would need to be identified and invoked, e.g. those

software routines involved with reproducing audio
and/or activating a display.

5.   *The appellant's response to the board's communication*
        pursuant to Rule 100(2) EPC

5.1   In the submission dated 13 September 2021, the
        appellant made comments with respect to claim
        interpretation, the technical character of the
        invention and inventive step, without directing these
        arguments specifically to the claims of any request.

5.2   As regards claim interpretation, this matter has been
        discussed above (cf. points 3.5.1 to 3.5.5).
        Furthermore, the technical character of the claimed
        subject-matter within the meaning of Article 52 EPC, at
        least as regards the subject-matter of claim 1 of the
        1st to 4th auxiliary requests, has been assumed. There
        is therefore no need to comment on this matter.

5.3   With respect to inventive step, the appellant
        identifies four features, labelled **features A. to D.**,
        in respect of claims directed to the "message server"
        and three (different) **features A. to C.** (NB: these
        features should not be confused with those identified
        by the board's feature labelling set out in point 3.1
        above) in respect of claims directed to the "handheld
        mobile device" as being allegedly "not taught by any
        prior art singly and/or in combination" (cf. pages 5
        and 6 of the above submission).

5.4   The board however points out that **features A., B. and
        D.** allegedly comprised in the "message server" are not
        included in claim 1 respectively of the 1st to 4th
        auxiliary requests and therefore not relevant to
        inventive step. As regards **feature C.** of the "message

server" and **features A. to C.** of the "handheld mobile
device", these features have been taken into account in
the above discussion of inventive step (cf. point 3.5
above, "Re features D and I").

6.   As there is no allowable request, the appeal must be
        dismissed.

Order

For these reasons it is decided that:

        The appeal is dismissed.

The Registrar: The Chair:

B. Brückner   K. Bengi-Akyürek

Decision electronically authenticated