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**Datasheet for the decision  
of 12 March 2021**

**Case Number:** T 0981/18 - 3.5.05

**Application Number:** 07841749.0

**Publication Number:** 2080087

**IPC:** G06F3/048

**Language of the proceedings:** EN

**Title of invention:**

PORTABLE ELECTRONIC DEVICE FOR INSTANT MESSAGING

**Applicant:**

Apple Inc.

**Headword:**

Touch input for scrolling through conversations of messages on a handheld portable device

**Relevant legal provisions:**

EPC Art. 56

**Keyword:**

Inventive step - (no) - effect not made credible within the whole scope of claim

**Decisions cited:**

T 1143/06



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0981/18 - 3.5.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.05**  
**of 12 March 2021**

**Appellant:** Apple Inc.  
(Applicant) One Apple Park Way  
Cupertino CA 95014 (US)

**Representative:** Barton, Russell  
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 19 October 2017  
refusing European patent application No.  
07841749.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chair** A. Ritzka  
**Members:** P. Tabery  
E. Mille

## Summary of Facts and Submissions

- I. The appeal is directed against the decision of the examining division dated 19 October 2017 refusing European patent application No. 07841749.0.
- II. The examining division referred to, *inter alia*, the following documents:
- D7** WO 2006/020305 A2 (APPLE COMPUTER [US];  
HOTELLING STEVE [US]; STRICKON JOSHUA A [US];  
HUP) 23 February 2006 (2006-02-23)
- D9** US 2006/128404 A1 (KLASSEN GERHARD D [CA] ET  
AL) 15 June 2006 (2006-06-15)
- III. The examining division decided that the application did not fulfil the requirements of Article 56 EPC (main and first auxiliary requests) and Article 123(2) EPC (second auxiliary request).
- IV. In its statement setting out the grounds of appeal, the appellant (applicant) requested that a patent be granted on the basis of the claims of a main request or one of a first and a second auxiliary request, all submitted with the statement setting out the grounds of appeal. The claims of the main request and the first auxiliary request were identical to those of the main request and the first auxiliary request underlying the impugned decision.
- V. The board issued a summons to oral proceedings and in an annex set out its provisional opinion on the case (Article 15(1) RPBA 2020).

The board concurred with the findings of the examining division that the **main request** and the **first auxiliary request** did not meet the requirements of Article 56 EPC.

The board noted that the **second auxiliary request** was an amended request and that it thus had to be discussed whether it was to be admitted into the proceedings pursuant to Article 12(4) RPBA 2007. The board indicated that it also had doubts as to inventive step.

- VI. In a reply dated 12 February 2021, the appellant provided further arguments regarding the pending requests.
- VII. Oral proceedings were held on 12 March 2021. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or the first auxiliary request. The appellant withdrew the second auxiliary request.
- VIII. **Claim 1** of the **main request** comprises the following features (as labelled by the board):
- A computer-implemented method, comprising:
- (i) at a portable electronic device with a touch screen display displaying a list of instant message conversations on the touch screen display, a respective instant message conversation including a respective set of instant messages exchanged between a user of the device and a respective other person;
  - (ii) while displaying the list of instant message conversations, detecting a first scrolling gesture comprising a substantial vertical movement of the first

user contact with the touch screen display;

(iii) responding to the first scrolling gesture by scrolling the list of instant message conversations in accordance with a direction of the first scrolling gesture, wherein the first scrolling gesture is independent of a horizontal position of the first user contact with the touch screen display;

(iv) detecting a selection gesture on a particular instant message conversation in the list of instant message conversations;

(v) responding to the selection gesture by replacing display of the list of instant message conversations with display of the particular message conversation, the particular instant message conversation including a set of instant message exchanged between the user of the device and a single other person in a chronological order;

(vi) while displaying instant message in the particular instant message conversation, detecting a second scrolling gesture comprising a substantially vertical movement of a second user contact with the touch screen display, wherein the detecting of the second scrolling gesture is independent of a horizontal position of the second user contact with the touch screen display; and

(vii) responding to the second scrolling gesture by scrolling the display of instant messages in the particular instant message conversation in accordance with a direction of the second scrolling gesture.

Independent **claims 11 and 12** are directed to a corresponding portable electronic device and a corresponding computer program product, respectively.

IX. **Claim 1 of the first auxiliary request** comprises, in addition to the features of **claim 1** of the **main**

**request**, the features of **claim 2** of the **main request** , i.e., that "*[displayed] messages sent by the user to the other person [are] aligned to a first side of the touch screen display and messages sent by the other person to the user [are] aligned to an opposite side of the touch screen display*".

## **Reasons for the Decision**

1. The present application concerns touch input for scrolling through conversations of messages on a handheld portable device.

2. Main request

The main request is identical to the main request considered in the impugned decision.

2.1 Interpretation of the claims

The formulation "*a set of instant message*" (see line 17 of claim 1) is interpreted by the board as relating to "*a set of instant messages*".

Similarly, the feature "*while displaying instant message in the particular instant message conversation*" is interpreted as "*while displaying the set of instant messages in the particular instant message conversation*".

2.2 Novelty (Article 54(1) EPC)

**D9** discloses the following features of **claim 1** (the references in parentheses are to that document; strike-through is used to mark features it does not disclose,

while alternative features disclosed in it are underlined):

A computer-implemented method, comprising:

(i) at a portable electronic device with a touch screen display (see [0129] and Figure 7) displaying a list of instant message conversations on the touch screen display, a respective instant message conversation including a respective set of instant messages exchanged between a user of the device and a respective other person (see [0037]-[0042], [0056], [0075], and Figure 1; [0057]-[0059] and Figure 2);

(ii) while displaying the list of instant message conversations, detecting a first scrolling gesture command (see [0040], [0047]; see note below) ~~comprising a substantial vertical movement of the first user contact with the touch screen display;~~

(iii) responding to the first scrolling gesture command by scrolling the list of instant message conversations in accordance with a direction of the first scrolling gesture command (see [0040], [0047]; see note below), ~~wherein the first scrolling gesture is independent of a horizontal position of the first user contact with the touch screen display;~~

(iv) detecting a selection gesture on a particular instant message conversation in the list of instant message conversations (see [0046]-[0047] and Figure 2, step '2-3');

(v) responding to the selection gesture by replacing display of the list of instant message conversations with display of the particular message conversation

(see Figure 3; that the "conversation history UI" is shown on the entire display is implied by "in the event the display is not large enough", see [0047]; it is thereby implied that the list of conversations is replaced), the particular instant message conversation including a set of instant message exchanged between the user of the device and a single other person in a chronological order (see [0044]);

(vi) while displaying instant message in the particular instant message conversation ("scrollably displayed in the conversation history UI display", see [0047]), detecting a second scrolling ~~gesture command~~ ("by scrolling a track wheel or pressing hotkeys ..., the display scrolls the conversation history to this particular message field.", see [0080]) ~~comprising a substantially vertical movement of a second user contact with the touch screen display, wherein the detecting of the second scrolling gesture is independent of a horizontal position of the second user contact with the touch screen display; and~~

(vii) responding to the second scrolling ~~gesture command~~ by scrolling the display of instant messages in the particular instant message conversation in accordance with a direction of the second scrolling ~~gesture command~~ ("by scrolling a track wheel or pressing hotkeys ..., the display scrolls the conversation history to this particular message field.", see [0080]).

The board notes that, although **D9** does not explicitly disclose also scrolling the "message list application UI" containing a list of conversations or "threads", it does disclose this implicitly. It is immediately apparent that text messages can be scrolled not only



within a single conversation ("*scrollably displayed*", see [0047]) but also where "*text message [are] representing text message threads*" (see [0040]).

Hence, the differences between the subject-matter of **claim 1** and that of document **D9** reside in that:

- *gestures are used for scrolling,*
- *the gestures comprise a substantial vertical movement of the first user contact with the touch screen display, and*
- *the detecting of the scrolling gestures is independent of a horizontal position of the second user contact with the touch screen display.*

The subject-matter of **claim 1** of the **main request** is therefore novel over what is known from **D9**.

### 2.3 Inventive step (Article 56 EPC)

The distinguishing features achieve the technical effect of *replacing a track wheel input for scrolling by an input received from a touch sensitive screen.*

The objective technical problem may thus be formulated as *how to replace a track wheel input for scrolling by an input received from a touch sensitive screen.*

**D9** teaches (see [0129]) that, "*although the input panel 98 and the display screen 99 are shown as separate items, it is to be clearly understood that in some embodiments of the invention the display screen can be used for receiving user inputs and therefore also forms at least part of the input panel 98*". In particular,

the display screen may be a touch screen (see [0129]). Since **D9** envisages (see [0080]) that "[scrolling] the conversation history" is performed by "scrolling a track wheel", the skilled person following the teaching of **D9** would have encountered the above formulated objective technical problem. To solve this problem, the skilled person would have considered **D7**, which discloses using a touch sensitive screen as user input device.

**D7** discloses the distinguishing features as follows:

- gestures are used for scrolling (*implied by: "when the user slides their ... fingers 576 over the touch screen 520, vertical scrolling ... is implemented", see page 33, lines 16-22, and Figure 23B*),
- the gestures comprise a substantial vertical movement of the first user contact with the touch screen display (*"The direction of scrolling may follow the same direction as finger movement", see page 33, lines 16-22, and Figure 23B*), and
- the detecting of the scrolling gestures is independent of a horizontal position of the second user contact with the touch screen display (*Figure 23B shows that the gesture is performed above list 680 of media items 681, but not above any designated sub-area or button*)

The skilled person would have recognised that **D7** provides a solution to the objective problem at issue and would thus have applied its teaching to what is known from **D9**. This way, the skilled person would have arrived at the claimed subject-matter without employing any inventive skills.

The board thus concludes that the subject-matter of **claim 1** of the **main request** is not inventive over what is known from **D9** in combination with the teaching of **D7**.

Similar considerations apply to the further independent **claims 11 and 12** of the **main request**.

- 2.4 The appellant disputes that **D9** *"suggests or discloses a 'selection gesture' to change between message and group lists as claimed"*.

The board notes that, for feature (iv) of claim 1, paragraph [0047] of **D9** has been cited (see above), which discloses that *"the thread is selected, and a thread open function invoked through the user interface"*, wherein the user interface may be a *"touch sensitive screen input"*, see paragraph [0046]. The opened thread / conversation is depicted in Figure 3, which has been cited above for feature (v) of claim 1. Since the gesture is not further specified in the claim, the board finds that these passages of **D9** do indeed disclose the contested feature.

- 2.5 Regarding the issue of inventive step, the appellant argues that the distinguishing features identified by the examining division *"have the technical effect that the interactions [for a particular message to be on the display] are efficient and effective"* and that *"the invention concerns the provision of interactions that enable efficient and effective navigation to a particular instant message through such a portable screen."*

The board notes that the objective technical problem should be based on objectively established facts, in particular those appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the appellant was actually aware at the time the application was filed. Based on the distinguishing features identified by the board, (see point 2.2 above and the disclosure in [0129] of **D9**), the objective technical problem identified by the board is more specific than that formulated by the appellant.

Furthermore, the appellant argues that, starting from **D9**, the skilled person would have understood "*that the vertical bar is draggable up or down by a user by touching the bar*". Considering the small size of the screen disclosed in **D9**, a stylus had to be used for touch screen input, and this was common technology at the priority date of the application. On this basis, the skilled person would have arrived at a different solution from that which is claimed.

The board finds this line of argument unconvincing. Firstly, the board notes that **D9** does not envisage that the user scrolls by directly touching the vertical bar. Secondly, **D7** discloses a touch screen operable by a user's fingertip rather than a stylus. Therefore, the skilled person would have readily recognised that the vertical bar would need to be enlarged in order to allow for fingertip operation. Considering the small size of the screen shown in Figure 7 of **D9**, an enlarged scroll bar would occupy a significant portion of the screen. This readily apparent disadvantage would have deterred the skilled person from considering what the appellant presents as the most obvious solution.

The appellant argues that document **D7** taught that the scrolling gesture was **not** independent of *"a horizontal position of the first user contact with the touch screen display"*.

The board agrees with the appellant to the extent that **D7** teaches that the scrolling gesture needs to be performed above list 680 of media items 681 (see Figure 23B). When applying this teaching to what is known from **D9**, the skilled person would have understood that the gesture may be performed anywhere above the list of conversations (or the list of messages). Since **D9** shows that the list of conversations (like the list of messages) is displayed over the full width of the screen, the skilled person would necessarily have arrived at the feature in question without employing any inventive skills.

The appellant furthermore argues that the selecting gesture shown in **D9** was not independent of the scrolling gesture: when scrolling with a track wheel, one conversation was selected after another. This was incompatible with scrolling by means of touch gesture operation as disclosed in **D7**, where the selected conversation was unaffected by the scroll gesture. Due to this discrepancy between the teachings of **D9** and **D7**, combining their teachings would require further modifications that would not have been obvious to the skilled person.

The board is also unconvinced by this argument since it is merely the highlight (or focus) that changes when the user is scrolling with the track wheel. Only when the *"open thread function"* (see paragraph [0047] of **D9**) is invoked is the selection in the sense of the claimed method performed. Therefore, this alleged

incompatibility between the teachings of these documents does not in fact exist.

The appellant further argues that **D9** concerned mobile phones with small screens, whereas **D7** taught a solution for large screens.

The board notes, firstly, that **D7** mentions that the method it discloses is also applicable to devices such as "*a cell phone*". Secondly, it would have been apparent to the skilled person that gestures such as scrolling could also be performed on a small screen, such as that shown in **D9**. Therefore, contrary to what the appellant alleges, there is no incompatibility between the teachings of these documents. Last but not least, the board notes that **claim 1** of the **main request** is in any case not limited to devices having a small screen. Consequently, this argument also fails to convince for this reason.

2.6 In view of the above, the **main request** is not allowable.

3. First auxiliary request

The first auxiliary request is identical to the first auxiliary request considered in the impugned decision.

3.1 Amendments

**Claim 1** of the **first auxiliary request** comprises the features of **claims 1 and 2** of the **main request**.

3.2 Novelty (Article 54(1) EPC)

The amended feature that "*messages sent by the user to the other person aligned to a first side of the touch screen display and messages sent by the other person to the user aligned to an opposite side of the touch screen display*" is not disclosed in **D9**. The subject-matter of claim 1 thus differs from what is known from **D9** in that it has the distinguishing features identified with respect to **claim 1** of the **main request** and the amended feature, recited above.

The subject-matter of **claim 1** of the **first auxiliary request** is therefore novel over what is known from **D9**.

### 3.3 Inventive step (Article 56 EPC)

The amended feature relates to a presentation of information, which is generally excluded from patentability (Article 52(3) EPC). However, if a presentation of information can be shown to produce a technical effect it is, by virtue of Article 52(3) EPC, not excluded from patentability (see decision T 1143/06).

The board is not convinced that the amended feature credibly achieves the claimed technical effect of *expediting scrolling to a particular message*. But even if that were the case, the board considers that this technical effect would not be achieved over the full breadth of the claim. Therefore, the amended feature cannot provide the basis for an inventive step. Since the distinguishing features identified with respect to claim 1 of the main request were found to be obvious, the subject-matter of **claim 1** according to the **first auxiliary request** is not inventive for the same reasons.

3.4 The appellant emphasises that, by arranging the messages from/to a particular contact on opposite sides, the user would only need to review and navigate through the messages aligned on one side of the display. This allowed the user to disregard the messages on the other side, reducing the cognitive burden. Hence, the technical effect of *expediting scrolling to a particular message* was credibly achieved.

The board is not convinced by this argument, which appears to be based on the presentation of messages as depicted in Figure 6A of the present application. However, the amended feature includes further ways of presenting messages which differ significantly from the clean separation of sent and received messages on either half of the display shown in that figure. Due to the broad scope of its possible interpretation, the amended feature does not exclude the case that longer messages are presented using the full width of the screen. In such a situation, the number of messages the user needs to review when scrolling is essentially unaffected by the claimed alignment. As a consequence, the technical effect alleged by the appellant cannot be obtained over the full breadth of the claim.

The appellant contends that displaying messages "*aligned*" to one side was different from displaying them "*justified*": when messages were displayed "*aligned to a first side of the touch screen display*", there would necessarily remain a gap on the opposite side as words were wrapped to the next line. This would give rise to the technical effect stated above.

The board considers that, even if the gaps caused by word wrapping are taken into account, messages could



still fill the width of the display to such an extent that the user would anyway need to review all messages. Therefore, the board likewise finds this argument unconvincing.

3.5 In view of the above, the **first auxiliary request** is not allowable.

4. Consequently, the appeal is not allowable.

## Order

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

The appeal is dismissed.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated