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**Datasheet for the decision
of 9 May 2023**

Case Number: T 0965/20 - 3.5.07

Application Number: 13717925.5

Publication Number: 2834740

IPC: G06F11/07, H04L12/24

Language of the proceedings: EN

Title of invention:

System, method, apparatus, and computer program product for providing mobile device support services

Applicant:

Assurant, Inc.

Relevant legal provisions:

EPC Art. 84
RPBA 2020 Art. 13(2)

Keyword:

Claims - clarity - new main request (no)
Amendment after summons - exceptional circumstances - new request filed during the oral proceedings (no)

Decisions cited:

T 2214/15, T 2486/16, T 1790/17



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Case Number: T 0965/20 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 9 May 2023

Appellant: Assurant, Inc.
(Applicant) 28 Liberty Street
New York, NY 10005 (US)

Representative: Black, Diego
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 October 2019
refusing European patent application
No. 13717925.5 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair P. San-Bento Furtado
Members: M. Jaedicke
E. Mille

Summary of Facts and Submissions

- I. The appellant (applicant) appealed against the examining division's decision refusing European patent application No. 13717925.5. That application was filed as international application PCT/US2013/035272 (published as WO 2013/152190 A1).
- II. The documents cited in the contested decision included: D1 US 2006/0212771 A1, published on 21 September 2006
- III. The examining division refused the application on the grounds that the subject-matter of claim 1 of the main request and of each of the first to third auxiliary requests lacked inventive step over the prior art disclosed in document D1. The examining division also decided that claim 1 of all auxiliary requests was unclear and that claim 1 of the fourth and fifth auxiliary requests infringed Article 123(2) EPC.
- IV. In its statement of grounds of appeal, the appellant maintained and resubmitted the requests considered in the contested decision and set out why - in its opinion - the contested decision was erroneous. It requested that the decision under appeal be set aside and a patent be granted on the basis of the main request or one of the first to fifth auxiliary requests. The appellant alleged that its right to be heard had been violated, because its arguments had been ignored in the decision under appeal.
- V. In a communication under Article 15(1) RPBA 2020 accompanying the summons to oral proceedings, the board expressed, among other things, its provisional opinion that all requests infringed Article 123(2) EPC, that

the subject-matter of claim 1 of the main request and of each of the auxiliary requests lacked inventive step in view of document D1, and that claim 1 of the auxiliary requests was unclear.

- VI. By letter of 6 April 2023, the appellant submitted a new main request as well as new first and second auxiliary requests. It withdrew, on the express condition that the three newly submitted requests be admitted into the appeal proceedings, the main request and the first to fifth auxiliary requests resubmitted with its statement of grounds of appeal.
- VII. Oral proceedings were held as scheduled. The board admitted the three newly submitted requests and the appellant was heard on relevant issues. In the course of the oral proceedings, the appellant withdrew the new first and second auxiliary requests filed with its letter of 6 April 2023 and filed a further claim request labelled "NEW REQUEST", which the board decided not to admit. At the end of the oral proceedings, the Chair announced the board's decision to dismiss the appeal.
- VIII. The appellant's final requests were that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims of the new main request submitted with its letter dated 6 April 2023.
- IX. Claim 1 of the new main request reads as follows:
"An apparatus comprising at least one processor and at least one memory having program code instructions embodied therein, the at least one memory and program code instructions being configured to, with the at least one processor, direct the apparatus to at least:
receive device status data from a mobile device;

determine an application profile for the mobile device based at least in part on the device status data from the mobile device, the application profile comprising:

- (i) applications installed on the mobile device;
- (ii) configuration settings for the applications installed on the mobile device;

- (iii) processor or memory usage of the applications installed on the mobile device;

- (iv) crash logs of the applications installed on the mobile device; and

- (v) execution or usage data of the applications installed on the mobile device,

receive device status data from a plurality of other mobile devices;

aggregate the device status data from the plurality of other mobile devices;

determine one or more fault profiles for the plurality of other mobile devices based on the aggregated device status data from the plurality of other mobile devices, the one or more fault profiles comprising:

- (i) applications installed on the plurality of other mobile devices;

- (ii) device settings of the plurality of other mobile devices;

- (iii) usage characteristics of the one or more applications installed on the plurality of other mobile devices; and

- (iv) statistical information that is a probability that a particular device configuration would give rise to one or more particular faults;

determine one or more potential faults for the mobile device based at least in part on:

- (i) a comparison between the device status data from the mobile device and one or more fault profiles

of the one or more fault profiles for the plurality of other mobile devices, or

(ii) a comparison between the application profile for the mobile device and one or more fault profiles of the one or more fault profiles for the plurality of other mobile devices,

wherein the one or more potential faults comprise a predicted fault that has a non-zero probability of affecting the mobile device in the future;

cause information regarding the one or more potential faults for the mobile device to be provided and presented on the mobile device, wherein the one or more potential faults comprises two or more conflicting applications;

determine, based at least in part on the one or more potential faults, one or more solutions to the one or more potential faults for the mobile device; and

automatically perform the one or more solutions to the one or more potential faults for the mobile device, wherein the apparatus is configured to:

receive the device status data from the mobile device via a first network connection; and

receive device status data from at least one of the other mobile devices via a second network connection that is not the first network connection."

X. Claim 1 of the "NEW REQUEST" reads as follows:

"An apparatus comprising at least one processor and at least one memory having program code instructions embodied therein, the at least one memory and program code instructions being configured to, with the at least one processor, direct the apparatus to at least:

receive device status data from a mobile device;

determine an application profile for the mobile device based on the device status data from the mobile device, the application profile comprising:

- (i) applications installed on the mobile device;
 - (ii) configuration settings for the applications installed on the mobile device;
 - (iii) processor or memory usage of the applications installed on the mobile device;
 - (iv) crash logs of the applications installed on the mobile device; and
 - (v) execution or usage data of the applications installed on the mobile device,
- receive device status data from a plurality of other mobile devices;
- aggregate the device status data from the plurality of other mobile devices;
- determine one or more fault profiles for the plurality of other mobile devices based on the aggregated device status data from the plurality of other mobile devices, the one or more fault profiles comprising:
- (i) applications installed on the plurality of other mobile devices;
 - (ii) device settings of the plurality of other mobile devices;
 - (iii) usage characteristics of the applications installed on the plurality of other mobile devices; and
 - (iv) statistical information that is a probability that a particular device configuration would give rise to one or more particular faults;
- determine a potential fault for the mobile device based at least in part on:
- (i) a comparison between the device status data from the mobile device and one or more fault profiles of the one or more fault profiles for the plurality of other mobile devices, or
 - (ii) a comparison between the application profile for the mobile device and one or more fault profiles of

the one or more fault profiles for the plurality of other mobile devices,

wherein the potential fault comprise [sic] a predicted fault that has a non-zero probability of affecting the mobile device in the future;

cause information regarding the potential fault for the mobile device to be provided and presented on the mobile device;

determine, based at least in part on the potential fault, a solution to the potential fault for the mobile device; and

cause the solution to be automatically performed."

XI. The appellant's arguments relevant to the present decision are discussed in detail below.

Reasons for the Decision

1. *The invention*

According to the background provided in paragraph [0004] of the description as filed, one of the problems related to mobile computing devices is that users can load too many, problematic or malicious applications on a device and turn the previously working device into a device that appears to be failing. Furthermore, users may install a combination of applications that are not compatible with each other such that device performance may be severely impacted.

The patent application relates to the provision of mobile device support services by diagnosing problems and providing solutions to non-hardware and hardware issues affecting mobile device performance (description, paragraph [0006]). Mobile device support may include remote monitoring and/or diagnostics for

mobile devices. Proactive device monitoring gives mobile device users advance notice of and solutions to potential problems identified on their mobile devices.

New main request

2. *Admissibility*

Since the set of claims of the new main request represented a direct response to fresh objections raised in the board's preliminary opinion and these circumstances constitute exceptional circumstances under Article 13(2) RPBA 2020, the board admitted the new main request into the appeal proceedings.

3. *Clarity*

- 3.1 In the oral proceedings, the board informed the appellant of its preliminary opinion that the scope of claim 1 of the new main request was unclear (Article 84 EPC). The board explained that claim 1 was directed to an apparatus other than the mobile device referred to in claim 1, since the claimed apparatus was configured to receive device status data from that mobile device. According to claim 1 the apparatus was configured to determine one or more potential faults affecting the mobile device, wherein the one or more potential faults involved two or more conflicting applications. Furthermore, claim 1 of the new main request included the feature that the claimed apparatus is configured to "automatically perform the one or more solutions to the one or more potential faults for the mobile device". Consequently, the apparatus seemed to be configured to automatically perform a solution on the mobile device, for example to automatically resolve the potential fault involving conflicting applications

installed on the mobile device. It followed that it was not clear whether the claim was directed only to the apparatus or to a system comprising the apparatus and the mobile device on which the solution was automatically performed.

3.2 The appellant argued that automatically performing a solution did not preclude an instruction being sent to the mobile device. The description disclosed, in paragraph [0070], several different solutions including a mobile application operating under the control of a mobile application controller prompting a user with an identified solution via the user interface and providing the user with the option to implement the solution. This breadth of the claimed invention was also supported by paragraph [0049]. The appellant also proposed to amend the claim based on originally filed claim 45, should the board be minded to accept a new claim request.

3.3 The board is not convinced by the appellant's arguments since the scope of claim 1 also encompasses configuring the apparatus to perform a solution fully automatically on the mobile device, such as removing an application installed on the mobile device. The board notes that paragraph [0070] of the description discloses the automatic removal of identified malware from the mobile device as a possible solution. Consequently, claim 1 specifies that the apparatus is configured to perform a solution on a mobile device other than the apparatus, which renders the scope of claim 1 unclear (Article 84 EPC).

"NEW REQUEST"

4. *Admissibility under Article 13(2) RPBA 2020*

4.1 Under Article 13(2) RPBA 2020 any amendment to a party's appeal case made after notification of a summons to oral proceedings is not, in principle, to be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

4.2 The "NEW REQUEST" was filed at a late stage in the oral proceedings. The appellant requested that the "NEW REQUEST" replace the new main request if the board admitted the "NEW REQUEST" into the appeal proceedings.

4.3 Since the "NEW REQUEST" was filed after oral proceedings had been arranged, Article 13(2) RPBA 2020 is applicable.

4.4 In the oral proceedings, the appellant argued that, regarding the criterion of exceptional circumstances under Article 13(2) RPBA 2020, it was required - according to decision T 2486/16, Reasons 6.5.6 - to provide "cogent reasons", meaning that it is not only required to identify the circumstances invoked and explain why they are to be regarded as "exceptional", but it also should explain why these circumstances had the direct result of preventing the party from filing its requests at an earlier stage.

The appellant identified as exceptional circumstances in the current case the fact that new arguments and objections had been raised in the oral proceedings and that the "NEW REQUEST" was filed in response to those arguments and related discussions. The appellant

referred to decision T 1790/17, Reasons 7, according to which amendments resulting from discussions at the oral proceedings before the board should be possible since, otherwise, oral proceedings would be pointless. The board responsible for the cited decision admitted a request that was filed as a direct reaction following the exchange of arguments in the oral proceedings and addressing the objections and concerns held by the board, as this was justified by exceptional circumstances. In view of the cited decision, the appellant argued that it could also rely, in the current case, on the discussions at the oral proceedings as exceptional circumstances under Article 13(2) RPBA 2020. Moreover, since the "NEW REQUEST" represented a direct reaction to the exchange of arguments at the oral proceedings, the appellant could not have filed this request at an earlier stage in the proceedings.

Moreover, the appellant argued that the further requirements for admitting an amendment to an appellant's case as set out in the RPBA 2020 were satisfied. The "NEW REQUEST" comprised only a single claim. Consequently, discussing this request was procedurally efficient. The request was suitable to address the issues raised by the board and overcame, *prima facie*, the objections raised in the proceedings by the board and in the contested decision.

- 4.5 The board considers that the circumstances of the current case are different from those underlying the cited decision T 1790/17. The board understands that, in the case underlying the cited decision, the appellant filed a new request comprising amendments resulting from discussions in the oral proceedings which clarified objections for lack of technical

character already raised in the board's communication. Furthermore, the request was considered to overcome the board's objections and concerns (see reasons 7. and minutes of the oral proceedings before the board in case T 1790/17).

By contrast, the board considers that the "NEW REQUEST" in the current case does not amount to a reaction to a clarification of objections that the board had raised in its summons, but rather a reaction to a new clarity objection raised in the oral proceedings against the new main request. This new clarity objection, which concerned the clarity of the scope of claim 1 (see above, point 3.1), was caused, however, by amendments submitted for the first time in the new main request, which was filed in reply to the board's communication and in advance of the oral proceedings. It is to be expected - and is thus foreseeable - that newly filed requests which are filed in response to the board's summons may give rise to new objections, in particular under Articles 123(2) and 84 EPC.

Consequently, the objection under Article 84 EPC raised by the board is not to be regarded as an exceptional circumstance, but as a normal and expected course of action in oral proceedings before a board. This is supported by the established case law, according to which exceptional circumstances within the meaning of Article 13(2) RPBA 2020 generally concern new or unforeseen developments in the appeal proceedings themselves whereas the normal course of events does not justify late submissions (see, for example, decision T 2214/15, Reasons 5.4. and the Case Law of the Boards of Appeal of the EPO, 10th edition 2022, V.A.4.5.4.a)).

- 4.6 Consequently, the board does not admit the "NEW REQUEST" into the appeal proceedings under Article 13(2) RPBA 2020.
5. The board considers that a further reason for not admitting the "NEW REQUEST" under Article 13(2) RPBA 2020 is that it gives rise, *prima facie*, to objections under Article 84 EPC. This is against the admissibility criteria set out in Article 13(1) RPBA 2020, on which the board may rely (see decision T 2486/16, Reasons 6.4.1). The feature "cause the solution to be automatically performed" of claim 1 seems vague and unclear. When questioned by the board in the oral proceedings, the appellant argued that the wording of this feature does not encompass performing a solution such as instructing the user to return the device to a sales outlet or service centre for repair or replacement (see paragraph [0068] of the description). However, the wording of the feature under discussion does not appear to be limited to sending a request to the mobile device affected by a potential fault in order to automatically perform a solution, for example. Consequently, the board had, *prima facie*, doubts about the clarity of claim 1 of the "NEW REQUEST".

Alleged procedural violation and reimbursement of the appeal fee

6. The appellant argued (see statement of grounds of appeal, section 4.2) that the first-instance proceedings did not comply with Article 113(1) EPC in that there was no indication in the decision under appeal that the applicant's arguments had been considered. Instead, the reasons provided in the contested decision had been essentially reproduced from

the annex to the summons and did not make reference to the appellant's extensive arguments put forward in its letter of 22 August 2019 except for the following general statement in point 19: "The formulation of the feature analysis of D1 and the reasoning underlying the objections for the different requests addresses the arguments submitted by the applicant in the letter of 22.08.2019."

7. Under Rule 103(1)(a) EPC, the appeal fee is to be reimbursed if the appeal is allowable and if such reimbursement is equitable by reason of a substantial procedural violation. The boards may, even in the absence of a corresponding request (as is the case here), examine this issue on their own motion pursuant to Article 114(1) EPC (see Case Law of the Boards of Appeal of the EPO, 10th edition 2022, V.A.11.2).

8. Rule 103(1)(a) EPC stipulates as a precondition for reimbursement that the appeal must be allowable. According to the established case law (see Case Law of the Boards of Appeal of the EPO, 10th edition 2022, V.A.11.5), this means that the appeal must be allowable at least in part. Since the current appeal is not allowable, not even in part, there is no need to examine whether reimbursement of the appeal fee under Rule 103(1)(a) EPC is equitable by reason of the alleged substantial procedural violation.

Conclusion

9. Since the sole request both maintained by the appellant and admitted into the appeal proceedings by the board cannot form the basis for the grant of a patent, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



S. Lichtenvort

P. San-Bento Furtado

Decision electronically authenticated