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Case Number: T 0478/06 - 3.5.01

Application Number: 98308084.7

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IPC: G06F 17/60, G01C 21/00, G08G 1/00

Language of the proceedings: EN

Title of invention:
Geo-enabled personal information manager

Applicant:
LUCENT TECHNOLOGIES INC.

Opponent:
-

Headword:
Geo-enabled personal information manager/LUCENT TECHNOLOGIES

Relevant legal provisions:
-

Relevant legal provisions (EPC 1973):
EPC Art. 56

Keyword:
"Inventive step - automated data entry (obvious)"
"Inventive step - location of control button - (no technical contribution)"
"Inventive step - prompting the user (no technical contribution)"

Decisions cited:
-

Catchword:

-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0478/06 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 30 June 2009

Appellant: LUCENT TECHNOLOGIES INC.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 3 November 2005 refusing European patent application No. 98308084.7 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: S. Steinbrener
Members: W. Chandler
P. Schmitz

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division to refuse the European patent application No. 98308084.7 on the grounds that claim 3 of the main request did not involve an inventive step (Article 56 EPC 1973) and that claims 1 and 3 of the auxiliary request contained added subject-matter (Article 123(2) EPC 1973).

II. In the statement setting out the grounds of appeal, the appellant maintained the previous main request and filed a new first and second auxiliary request with slightly amended claims.

III. In a communication, the Board considered that apparatus claim 3 (and also method claim 1) of all requests did not involve an inventive step, over the combination of WO-A-96/00373 (D1) and the skilled person’s common general knowledge.

IV. In a response, the appellant filed a new sole request with method claim 1 amended essentially to include a second aspect of the invention taken from the description, and provided arguments to support inventive step. The appellant also made an auxiliary request for oral proceedings.

V. In the communication accompanying the summons to oral proceedings, the Board summarised the issues to be discussed and tended to consider that the subject-matter of new claim 1 still lacked an inventive step.

VI. In a response, the appellant filed further arguments in favour of inventive step and filed an auxiliary request with claims 1 and 2 of the main request combined, the latter having been filed for the first time with the main request.

VII. At the oral proceedings before the Board, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 5 of the main request filed with letter dated 30 May 2008, or claims 1 to 4 of the auxiliary request filed with letter dated 12 May 2009.

VIII. Claim 1 of the main request reads as follows:

"A method of providing access to geographic information in a computer system, the method comprising the steps of:

displaying at least a portion of a record in a display screen of a personal information manager program running on a computer of the system, wherein the record includes a location identifier and a button accessible by a user command and for requesting map information associated with said location identifier without requiring the user to re-enter previously stored information; and

automatically generating, in response to a user command on said button, a request from the personal information manager program for retrieval of said map information associated with said location identifier,

displaying, in response to the retrieval of said map information, said map information and prompting the user to indicate if directions are required to or from said location identifier."

Claim 1 of the auxiliary request adds to the end of claim 1 of the main request:

"wherein at least a further button accessible by a user command and for requesting at least a further geographic information associated with said location identifier is displayed together with the suitable representation for requesting the map information, wherein said at least one further geographic information includes at least one of direction, weather and yellow pages."

IX. The appellant argued essentially as follows:

D1 disclosed a navigation system that was an independent product that could run on computers, PDAs etc. It showed how the early versions of navigation programs worked and used proprietary commands. The user always had to enter all the required information and got a single result, such as the requested route.

The invention solved the problem of providing an efficient or convenient mechanism for obtaining additional geographical information relating to personal information stored in a personal information manager (PIM). This was the problem mentioned at paragraph [0003] of the published application.

Dl did not give any hint, nor any technical details regarding searching for geographic information associated with addresses in a personal information manager program.

To get map data for a contact, the skilled person would have realised that the address would have to be found in the PIM and put into the navigation program. Apart from writing it down the skilled person might have considered using a copy-paste operation (first solution).

At the priority date of 1997, car navigation and route planning systems were proprietary products distinct from computer systems and PIM programs so that the skilled person would not necessarily have linked them. The skilled person in the field of PDAs would have realised that PDA manufacturers were not willing to open up their systems and would have asked the navigation specialist to modify the navigation system. Thus, even if the skilled person would have considered using a link from one program to another, he would rather have modified the independent navigation program to pull in the address (second solution).

Even if the skilled person would have modified the PDA and provided a button according to the invention, it would have linked to an origin or destination address of a navigation system such as that in D1 (third and fourth solutions). These solutions did not require any modification to the navigation system of D1. However, they did not result in “map information” as claimed.

To arrive at the claim, the problem would have had to be changed to include the element of providing map information. The skilled person would have had to provide a new query type for map information. However, even this would have led to interim solutions (fifth and sixth solutions) where further data input was

required. These would not have been the claimed automatic generation of map information.

There was also no motivation to prompt the user to indicate if directions were required to or from said location identifier which would require yet another reformulation of the problem. However, even if the skilled person would have considered providing direction information, the most obvious solution would have been to provide a “jump back” button in the map information that enabled the user to go back to the navigation program query page to request the information (seventh, eighth and ninth solutions).

The skilled person therefore had multiple possibilities to modify the disclosure of D1 in order to find a solution to the problem. All solutions differed substantially from the invention defined in new claim 1. They were more closely related to the disclosure of D1.

Even if any of these functions taken alone were considered to be obvious to the skilled person in the light of the common general knowledge and normal programming practices, they combined in the present technical context to yield a fast, easy to handle and efficient searching and retrieval tool, which went beyond the mere aggregation of normal design options.

The failure of others to develop this solution, despite long exposure to conventional personal information manager programs, constituted strong evidence of inventive step.

The invention in the auxiliary request additionally solved the problem of simplifying the entry of two or more types of information. This went even further than the main request by imagining what other types of information the user might want.

Reasons for the Decision

1. The appeal complies with the requirements referred to in Rule 65(1) EPC 1973 and is therefore admissible.

Application

2. The application concerns the problem of providing automatic retrieval of geographic information, such as map, direction, weather or yellow pages information, from the Internet or another source, associated with records that have already been stored in a personal information manager (PIM) program, such as an address book, contact manager, or organiser. Conventionally, the user had to re-enter an address from the PIM program into an on-line geographic information service or another software product. This was inefficient, and a source of inconvenience and annoyance for the user (see published application paragraph [0003]).

3. The solution to this problem is essentially to provide a button in the display of the PIM program for requesting map information associated with an address from a data record in the PIM (Figure 3 of application). Thus, if the user wants a map associated with the address of the contact, the user need only click on button 60. An address is automatically extracted from the displayed record and used to retrieve map

information from a web site on the Internet, such as mapsonus.com, without any further intervention. A second aspect of the invention, claimed for the first time in appeal, is prompting the user, when the map information is displayed, to indicate if direction indications are required (column 9, lines 4 to 8). The auxiliary request adds the idea of providing a further button for requesting additional geographic information, e.g. direction, weather or yellow pages (Figure 3 of application).

Main request

4. The examining division found apparatus claim 3 (without the second aspect) obvious starting from the prior art of a standard computer. Specifically, the examining division split the claim into a hardware part, considered to be disclosed by a standard computer, a software part, considered to consist of standard software techniques, and an application part. The application part related to managing personal information, a location identifier and geographic information. This part was considered to have no technical character and thus not contribute to inventive step. Thus the technical problem was considered to be how to implement the application part on a computer. It was considered obvious to use a standard computer and standard software to do this.

5. Although the Board agrees with the general idea behind this approach, namely that non-technical aspects do not contribute to inventive step, and indeed agrees with the examining division’s conclusion, the Board finds the analysis rather perfunctory. In the Board’s view,

it lacks an explanation of why certain aspects do not have technical character and why their implementation using the standard software techniques is obvious. It is probably not the case, for example, that the implementation of all imaginable “application parts” with software techniques would be obvious.

6. Firstly, the Board considers that the reasoning could have been bolstered by a more precise analysis of the non-technical aspects. Generally, any aspects that are based on the subjective interests, personal preferences and (business/commercial) activities or circumstances of the user are non-technical in nature. Thus the Board agrees that managing, i.e. using depending on wishes, personal and geographical information is non-technical. Also, the choice of where to provide a control button is a matter of user preference, and/or the commercial circumstances such as which program is available to be modified. The same goes for the second aspect of prompting the user, when the map information is displayed, to indicate if directions are required. In the Board’s view this is technically no different from the basic function of offering directions, differing at most by a presentation of information in the form of a question, and by the point in time that the directions are offered, which is a matter of user preference, neither being a technical consideration. Finally, the information content itself is, of course, also non-technical and cannot play a role for inventive step.

7. Secondly, the Board considers that there is more concrete prior art available to cover the technical aspects than a standard computer, namely the PIM programs mentioned in paragraph [0002] of the

application or the personal digital assistant (PDA) mentioned in D1 at page 8, line 19. Moreover, both the application and D1 disclose these programs in combination with retrieving geographic information from remote services at paragraph [0003] and page 8, lines 15 to 22, respectively.

8. It is common ground that method claim 1 differs from this prior art by the above-mentioned features of:

i) automatically generating, in response to a user command on a button in the PIM program, a request from the personal information manager program for retrieval of map information associated with a location identifier (in the PIM program), and
ii) when the map information is displayed, prompting the user to indicate if directions are required to or from said location identifier.

9. The Board considers that when using a conventional PIM, the user would inevitably encounter the situation where map information for a contact is desired. It would, of course, be possible to enter the address manually, but it would be obvious to the skilled person that this task should be automated if it turns out to be cumbersome under the prevailing (non-technical) circumstances, e.g. for a sales representative visiting clients. Thus, the Board judges that an obvious technical problem facing the skilled person, which does not contain any inventive elements, would be to automate the retrieval of geographical information relating to personal information stored in the PIM. This is the problem suggested by the appellant and stated in the application (see point 2, above).

10. It is self-evident that this problem can be solved by providing some sort of control button that causes the required information to be retrieved. In appeal, there was much discussion of whether this button would be in the PIM program pushing data to a navigation program, as claimed, or in a navigation program that accessed the geographical information pulling data from the PIM program. The appellant considered it would be the latter because in D1 it was the navigation program that provided the geographic information and this operated independently from the rest of the system.

11. However, in the end, as mentioned above, the Board comes to the conclusion that in the present case, the choice of where to put the control button is a purely non-technical consideration, such as the user's preferences (e.g. with respect to the privacy of data stored in the PIM), or the commercial circumstances of which program is available to be modified. It has no technical effect on the final outcome of displaying the map information, even if it does imply a particular technical implementation. However, apart from not being claimed in detail, the skilled person would envisage no difficulties in this implementation since the use of a button, e.g. on an HTML form, to send a command to a remote service was well known at the priority date.

12. Most of the appellant's arguments on this point (and others) aim to show that D1 would lead the skilled person to solutions other than the claimed one. However, the above finding that the motivation for arriving at these solutions is non-technical renders most of these arguments moot. Thus these arguments can at best be

used to attempt to show that the skilled person would not consider the claimed implementation of these ideas. However, as mentioned above (and below) in the relevant paragraphs, either the claim does not specify any details of the implementation, or the skilled person would consider it as known or as an obvious matter of routine design. In this respect, the Board also considers that the appellant's arguments rely too closely on the exact disclosure of D1 and do not adequately take into account the skilled person's knowledge and routine design capabilities.

13. For example, the appellant argued that even if the PIM were provided with a control button, the result would not be "map information" as claimed but only route information from an origin to a destination as disclosed in D1. However, the information that is provided depends on the non-technical consideration of what the user wants, and as mentioned earlier, map information of a contact is one possibility. Moreover, D1 discloses at page 6, line 36 to page 7, line 4 and page 41, lines 3 to 8 that different types of information from the map database may be requested, so that there is no technical obstacle in implementing this. Similarly, in the Board's view it follows from the discussion of retrieving map information by manually entering addresses into on-line geographic information services in the opening part of the application, that this was known at the priority date.

14. The appellant argued that at the priority date of 1997, car navigation and route planning systems were proprietary products distinct from computer systems and PIM programs so that the skilled person would not

necessarily link them. Again the Board considers that this concerns a non-technical business aspect, but that the skilled person would in fact have no technical reason for not doing so. The same goes for the alleged navigation system manufacturers' fear of "opening up" their interfaces, which incidentally might be reciprocal fear of the user if the PIM program were to allow a navigation program to access the users' data records.

15. Considering the prompting feature (difference ii), the appellant argued that it was not possible to arrive at this solution without changing the technical problem inadmissibly by including elements of the solution. However, the Board considers that this feature still falls under the problem of automatically retrieving geographical information, in this case including route information. Furthermore, as mentioned earlier, this idea concerns non-technical considerations of a preference and a presentation of the direction information that cannot contribute to inventive step. Only the implementation of this function could contribute. However, this is not specified.

16. Accordingly, the Board judges that claim 1 of the main request does not involve an inventive step (Article 56 EPC 1973).

Auxiliary request

17. Claim 1 of the auxiliary request adds to claim 1 of the main request that at least one further button is provided for accessing direction, weather or yellow pages information. In the Board's view, providing a

button for direction information is obvious for the same reason as the feature of prompting the user to indicate whether direction information is required. It is a consequence of the non-technical consideration of the preference of when to offer the known functionality of providing direction information. Even if the provision of buttons for the other types of information were not merely claimed as alternatives, the Board considers that they would also be obvious for the same reasons as providing a button for the map information, being all dependent on user preference and/or commercial circumstances.

18. Accordingly, the Board judges that claim 1 of the auxiliary request does not involve an inventive step (Article 56 EPC 1973).

19. There being no other requests, it follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek S. Steinbrener