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**Datasheet for the decision
of 04 May 2010**

Case Number: T 0511/07 - 3.5.03

Application Number: 00916968.1

Publication Number: 1166533

IPC: H04M 1/725

Language of the proceedings: EN

Title of invention:

Mobile communication terminal handling messages including graphics

Applicant:

Nokia Corporation

Opponent:

-

Headword:

Mobile communication terminal/NOKIA

Relevant legal provisions:

EPC Art. 84, 113(1)

RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):

EPC R. 68(2)

Keyword:

"Substantial procedural violation (no)"
"Admissibility of the sole request (no)"
"Absence of appellant at oral proceedings"

Decisions cited:

T 1134/06

Catchword:

-



Case Number: T 0511/07 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 4 May 2010

Appellant: Nokia Corporation
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Representative: Brax, Matti Juhani
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 October 2006
refusing European patent application
No. 00916968.1 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: F. van der Voort
Members: T. Snell
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division refusing European patent application No. 00916968.1 with publication number EP 1 166 533 A. The decision was issued in the form of a so-called "decision according to the state of the file" and made reference to two communications dated 19.05.2004 and 16.03.2006.
- II. In the notice of appeal the appellant requested that the decision be set aside and a patent be granted.
- III. In the subsequently filed statement of grounds, the appellant filed comments under the heading "Procedural Aspects". These comments, on the basis of which the appellant requested that the decision under appeal be set aside, can be summarised as follows:
 - (a) In the second Article 96(2) communication the examining division introduced new prior art as a result of a secondary search, some of which was not clearly pre-published.
 - (b) The applicant's right to be heard was not respected as it did not have the chance to comment on the newly cited prior art. In particular, the examining division gave the impression that its mind was already made up to refuse the application regardless of arguments brought forward by the applicant or whether oral proceedings were held. Hence the applicant opted to request a decision according to the state of the file in order to obtain an appealable decision.

(c) The decision is unclear as regards the reasons for lack of inventive step. It is not clear whether the decision is based on a combination of D4 and D5 only, or whether also in combination with D1. The term "asserted inventive contribution", which is unknown from the EPC, the Guidelines for Examination, or the case law [of the Boards of Appeal] further confuses the situation. Further, the problem-solution approach has not been applied. Finally, document D6 is referred to without indicating its relevance.

IV. In a communication accompanying a summons to oral proceedings the board gave a preliminary opinion that no violation of the right to be heard could be identified. In addition, the board indicated that it was not convinced that the decision as a whole was unreasoned. Considering the publication dates of D4-D6, the board noted that this matter was raised for the first time in these appeal proceedings and that it did not see D4 and D6 as decisive for the outcome of the appeal. Further, the board raised, *inter alia*, an objection that the subject-matter of the independent claims lacked an inventive step having regard to D1 combined with the document

D7: CA 2 193 764 A (introduced by the board, Article 114(1) EPC),

or alternatively on the basis of D7 combined with D5.

- The board drew attention to Article 13 RPBA regarding the need to examine the admissibility of amended claims filed in response to the summons, if any.
- V. In response to the board's communication, the appellant filed new claims on which the further proceedings were to be based. Four additional documents were cited, numbered D8-D11, along with brief comments referring to certain paragraphs of the board's communication. The appellant stated that "Further details concerning the reasons for find [sic] these documents will be provided during the oral proceedings".
- VI. In a fax letter dated 28 April 2010, the appellant indicated that it would not attend the oral proceedings.
- VII. Oral proceedings were held on 04 May 2010 in the absence of the appellant. The board understood from the appellant's written submissions that the appellant requested that the decision be set aside and a patent be granted on the basis of claims 1-11 as filed with the letter of response to the summons to oral proceedings and received by fax on 20 June 2009. After deliberation, the board's decision was announced at the end of the oral proceedings.
- VIII. Claim 1 of the appellant's request reads as follows:
- "A method for handling messages transmitted between mobile communication terminals via a wireless network and handled in accordance with the SMS text message carrying concept, comprising the step of:

generating a compound message including a text part and at least one graphical icon part (110;112;113;114;115);

said compound message generation includes the step of:

reading of a user inputted text part (111) and converting the inputted text into the SMS text message carrying concept message text format;

characterized by the steps of:

inserting a graphical part (114,115) into the message text, said graphical part includes a record for each of said at least one graphical icon part in a graphical format;

adding information in the message defining the position where said at least one graphical icon part is inserted into the text part; and

transmission of the message via the wireless network (117)."

Independent claim 2 reads as follows:

"A mobile communication terminal (1) for handling messages in accordance with the SMS text message carrying concept and having a controller (18), a transceiver (19) for communicating with a wireless communication network, and a user interface (2,3,5,6,10) through which the user operates the terminal, said user interface includes: a display (3),

and said mobile communication terminal further comprises:

a message editor application configured to generate (31) a compound message including a text part and at least one graphical icon part;

said controller (18) being configured to generate a message for being transmitted via said transceiver (19) in accordance with the SMS text message carrying concept, and said controller (18) being configured to include in the message:

a text part in a predefined message text character format,

characterized by said controller (18) being configured to include:

a graphical part including a record for each of said at least one graphical icon part in a graphical format, and

information in the message defining the position where said at least one graphical icon part is inserted into the text part."

Independent claim 11 reads as follows:

"A message in accordance with the SMS text message carrying concept for use in the communication terminal as claimed in claim 2, said message having a format in accordance with the SMS text message carrying concept that includes:

a text part in a predefined message text character format;

at least one graphical icon part;

characterized by a graphical part including a record for each of said at least one graphical icon part in a graphical format; and

information in the message defining the position where said at least one graphical icon part is inserted in the text part."

Reasons for the Decision

1. *Absence of the appellant at oral proceedings*

1.1 The board considered it expedient to hold oral proceedings in accordance with Article 116(1) EPC for reasons of procedural economy. Having verified that the appellant was duly summoned the board decided to continue the oral proceedings in the absence of the appellant (Rule 115(2) EPC and Article 15(3) RPBA).

1.2 In the communication accompanying the summons the appellant was informed that if amended claims were submitted, it would be necessary at the oral proceedings to discuss their admissibility giving due regard, *inter alia*, to the criteria set out in Article 13(1) and (3) RPBA. It was also mentioned that compliance with, *inter alia*, Article 84 EPC would have to be examined. The appellant could therefore have

expected that the matters of admissibility and clarity would be discussed, and could have presented comments on these matters, either in writing, or, if it had chosen to attend, at the oral proceedings. Hence, the right to be heard on these issues has been respected and, for the reasons set out below, the board was in a position to issue a decision which complies with Article 113(1) EPC.

2. *Procedural aspects raised in the statement of grounds*

2.1 These procedural aspects are set out in paragraph III of the "Summary of Facts and Submissions" above. The board has considered whether these comments, although raised in connection with a different request to that currently on file (and, moreover, not in connection with a request for reimbursement of the appeal fee, cf. Rule 67 EPC 1973), identify a substantial procedural violation committed by the examining division that would justify in itself remittal of the case to the first instance.

2.2 Re (a): The appellant apparently disputes the publication dates of documents D4, D5 and D6. However, the board considers that the publication date of a document forms part of the factual framework of substantive examination. Hence, an error of publication date, even if it had occurred, would be an error of fact and not of procedure. Nevertheless, the appellant appears to argue that the examining division did not follow the correct procedure by not investigating properly the dates of publication. In respect of Internet citations, (cf. OJ 8-9/2009, p.456 ff., eg 3.3), as with other citations, it may be necessary that

an examiner provide proof of a publication date, *inter alia*, if the applicant gives reasons for questioning the date of publication. However, in the present case, the appellant challenged the publication dates for the first time in these appeal proceedings. As regards D5, the appellant comments that it is impossible to judge without further investigation whether the original version of this document corresponds to that downloaded [from the Internet] by the examining division. However, in the board's view, document D5 is not an Internet citation per se whose content might be open to doubt but is merely a downloaded version of a printed document with a high probability of authenticity (cf. T 1134/06, not published in OJ, paragraph 4.2 of the Reasons for the decision). Given the date on the document of 1993, the board sees no reason why the examining division needed to further verify that the document was available to the public at the priority date of the present application. In the case of document D4, the appellant has plausibly argued in the statement of grounds that its content may have been published after the priority date of the application, despite the earlier date on the document. Nevertheless, the applicant did not question the publication date of D4 during the examination procedure, but, following its introduction, merely requested a decision on the state of the file. Under these circumstances the board concludes that the examining division, from a procedural point of view, was reasonably entitled to base its decision on this document. As regards D6, although the board agrees that the examining division should not have assumed that the content of this document was available to the public before the priority date, it is mentioned more as an aside and

does not form part of the main argument with respect to inventive step, which relies on documents D1, D4 and D5. Thus the publication date of D6, in a procedural sense, can be regarded as moot.

The board adds that, in the absence of an admissible set of claims (see below), there is no need for the board to investigate further the publication dates of the aforementioned documents.

2.3 Re (b): The second point raised by the appellant is that it was denied the right to be heard (cf. Article 113(1) EPC).

2.3.1 In accordance with Article 113(1) EPC, the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to comment.

In this respect, the board notes that the applicant, aware of the objections raised by the examining division in its second communication dated 16 March 2006, requested a decision on the state of the file. In so doing, the applicant chose voluntarily to forgo the opportunity to respond to the examining division's objections either in writing or by maintaining its request for oral proceedings, including those objections based on the documents newly cited in the examining division's second communication. Under these circumstances, the present decision according to the state of the file is based on grounds or evidence on which the applicant has had an opportunity to comment and therefore complies with Article 113(1) EPC.

2.3.2 The board infers from the appellant's remarks that the applicant regarded it as futile to present comments either in writing or orally because the examining division had already made up its mind to refuse the application.

The board however can find no evidence to support this point of view. Although the examining division stated that a refusal was "to be expected" and that oral proceedings would be held "before refusing the application", in the board's view this was to be seen only as an indication of the examining division's current assessment of the case and a confirmation that oral proceedings would be held before any final decision was taken, and does not imply that the application would be refused in any event. The examining division accordingly invited the applicant to file new claims and arguments in support (cf. point 5 of the examining division's second communication).

Hence the board finds the appellant's argument unconvincing.

2.4 Re (c): The appellant has argued implicitly that the decision is not reasoned.

2.4.1 In accordance with Rule 68(2) EPC 1973 all decisions issued by the EPO must be reasoned, ie the decision should contain a logical chain of argumentation explaining why the decision has been taken. In the present case, the appellant appears to argue mainly that the decision is incomprehensible because it is not clear whether claim 1 is attacked on the basis of D4 and D5 only, or in combination with D1.

- 2.4.2 However, in the board's view, the two communications referred to in the impugned "decision according to the state of the file", seen in the context of the appellant's reply dated 07 September 2004, form a logical and comprehensible argument.
- 2.4.3 In this respect, in the communication of 19 May 2004, the examining division argues that the subject-matter of claim 1 lacks novelty with respect to the disclosure of D1. In the applicant's reply dated 07 September 2004, it is argued that certain features of claim 1 are missing from D1. In the second communication dated 16 March 2006, the examining division cited documents D4 and D5 as disclosing the missing features and argued that the subject-matter of claim 1 lacked an inventive step. Reading the two communications referred to in the impugned decision and the appellant's reply in the correct sequence, it is clear to the board that the inventive step argument starts out from the disclosure of D1 and is based on combining it with the disclosures of D4 and D5. The board finds this to be a logical chain of argumentation, and the decision is thus reasoned within the meaning of Rule 68(2) EPC 1973.
- 2.4.4 The appellant argues that the problem-solution approach has not been used. However, in accordance with the Guidelines, C-IV, 9.8 (June 2005 edition), "the examiner should normally apply the so-called "**problem-and-solution approach**" (board's underlining). Thus the use of the problem-solution approach was not obligatory to meet the requirements of a reasoned decision. The appellant also makes comments to the effect that it is not indicated where certain features are disclosed in

the cited documents. However, the board notes that in the first communication at point 4 and in the second communication at point 3, specific passages of D1, D4 and D5 are referred to by the examining division. In the present case the board considers these references to be sufficient in order to be able to understand the reasoning of the examining division. Further, the board sees no objection to the use of the term "asserted inventive contribution", which appears to be merely an alternative expression for "alleged inventive contribution". Finally, as already stated above, the mentioning of D6 in the communication dated 16 March 2006 appears to be intended more as an aside and does not form part of the main argument based on D1, D4 and D5. Hence, its citing in this manner by the examining division without a detailed explanation does not mean that the decision is not reasoned.

2.5 In consequence, the board concludes that no substantial procedural violation was committed that would require the board to remit the case to the examining division.

3. *Admissibility of the request filed with the letter dated 20 June 2009*

3.1 The new request was filed once oral proceedings before the board had been arranged.

In accordance with Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), "Any amendment to a party's case after it has filed its grounds of appeal ... may be admitted and considered at the Board's discretion".

In accordance with Article 13(3) RPBA, "Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board ... cannot reasonably be expected to deal with without adjournment of the oral proceedings".

- 3.2 A commonly-used criterion of the boards of appeal in deciding whether to admit an amended request, particularly at a late stage of the proceedings, is whether or not the claims of the request are clearly allowable. This criterion is the one adopted by the board in the present case.
- 3.3 Claim 1 of the appellant's request includes the newly-added phrase "handled in accordance with the SMS text message carrying concept". In the board's view, the term "SMS text message carrying concept" is not a standard term used in the art, and it is not clear to the board to what extent the term "SMS text message carrying concept" limits the scope of the claim. In this respect, it is not clear whether the claim should be limited to SMS text messaging, or should embrace conceptually similar text messaging systems which include one or more of the features of SMS text messaging. Moreover, it is not clear whether or not the term "carrying concept" is intended to limit the claim with respect to the manner only in which the messages are transmitted across the network, without placing any restriction on the nature of the messages themselves. Claim 1 therefore does not appear to comply with Article 84 EPC and is consequently "not clearly allowable". The same objection applies, *mutatis mutandis*, to independent claims 2 and 11.

3.4 The board in exercising its discretion under Article 13(1) RPBA has also decided to take into account that the request filed with the letter dated 20 June 2009 lacks any proper substantiation, ie the appellant has not set out in writing, or presented orally, the reasons why the decision under appeal should be set aside on the basis of the new request. Given the board's negative preliminary opinion with respect to the previous set of claims as regards inventive step, it could have been expected that the appellant would have explained why the subject-matter of the claims of the new request involved an inventive step, since this does not appear to be self-evident from the formulation of the claims alone. The appellant's case for setting aside the impugned decision could have been put either in writing in the letter accompanying the new request dated 20 June 2009 or at the very latest at the oral proceedings, or rely on comments provided in the statement of grounds. However, there are no comments in the statement of grounds relevant to the issue of inventive step, at least in respect of the board's argument based on a combination of documents D1 and D7, and the appellant did not appear at the oral proceedings. Its only comment in the letter dated 20 June 2009 which might be seen as concerning the issue of inventive step states merely that "The objective problem to be solved needed to be redefined in view of the amendments to the claims. This amendment has been reflected in the introductory portion of the description." This statement however provides no reasons why the claimed solution involves an inventive step. In the letter dated 20 June 2009, it is further stated that "Document D10 is filed in response to item 12.5 of the summons." Although item 12.5 of the summons

concerns inventive step, the relevance of document D10 is not explained by the appellant, it being merely indicated that "Further details concerning the reasons for find [sic] these documents [NB: D8-D11] will be provided during the oral proceedings." Hence the appellant's request is devoid of any substantive arguments in support of it.

- 3.5 The appellant argued that the request should be admitted as it was filed in response to arguments raised by the board for the first time and did not involve complex new subject-matter. However, these points are not relevant to the issues discussed in points 3.3 and 3.4 above.
- 3.6 For the above reasons, the board decided not to admit the appellant's request dated 20 June 2009.
4. As there is no admissible request, it follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

F. van der Voort