BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN 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 4 February 2011

Case Number: T 1995/07 - 3.5.06

Application Number: 05106171.1

Publication Number: 1742139

IPC: G06F 1/16

Language of the proceedings: EN

Title of invention:
Carrying case for a handheld device and methods thereof

Applicant:
RESEARCH IN MOTION LIMITED

Headword:
Loss protection for handheld device/RESEARCH IN MOTION

Relevant legal provisions:
-

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

Keyword:
Inventive step - yes

Decisions cited:
-

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1995/07 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 4 February 2011

Appellant: RESEARCH IN MOTION LIMITED
295 Phillip Street
Waterloo, Ontario N2L 3W8 (CA)

Representative: Moore, Barry
Hanna Moore & Curley
13 Lower Lad Lane
Dublin 2 (IE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 30 July 2007 refusing European patent application No. 05106171.1 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: D. H. Rees
Members: M. Müller
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division to refuse the European patent application no. 05106171.1 which was pronounced in oral proceedings on 10 July 2007 and transmitted with letter of 30 July 2007.

II. The examining division made reference *inter alia* to the following documents

D1: US 2004/070499 A1
D2: US 6 133 830 A
D4: US 5 635 959 A
D5: US 6 674 358 B1

and found the claimed invention to lack an inventive step in view of D5 in combination with D4.

III. Notice of appeal was filed on 28 September 2007 and the fee paid on the same day. A statement setting out the of grounds of appeal was filed on 30 November 2007. The appellant requested that the decision be set aside and a patent be granted based on the main request or the auxiliary request on which the appealed decision was based.

The board notes that on 6 March 2006 an amended description page was filed which was numbered "2" but referred to as new page "1a". It is evident from the content of that page and that of later amendments to pages 1a and 1b that the numbering "1a" was intended and that no amended page 2 is on file.

The appellant's requests are therefore based on the following documents:

claims, nos.
1-7 as filed electronically on 7 July 2006 (main request) or 8 June 2007 (auxiliary request)
description, pages
1, 11 as filed electronically on 6 March 2006
1a as filed electronically on 7 July 2006 (main request) or 8 June 2007 (auxiliary request)
1b as filed electronically on 7 July 2006
3-10 as originally filed
drawings
1/5-5/5 as originally filed

The appellant argued in particular that the reasoning in the decision was tainted by hindsight and did not establish that the skilled person would (as opposed to could) have arrived at the claimed invention without exercising an inventive step.

IV. Claim 1 according to the main request reads as follows:

"A method for alerting a user of a handheld device (100) of a possible risk of losing the handheld device (100), the method comprising:

determining that said handheld device (100) is not secured to a carrying case (200) of said handheld device (100) and that at least a predefined or programmable amount of time has passed since a last activation of said handheld device (100); and

consequently, transmitting a signal from said handheld device (100) to said carrying case (200) over a wireless communication link to cause said carrying

case (200) to activate one or more of its user interface elements (260,262,264) in order to alert said user of said risk."

Claim 3 according to the main request reads:

"A handheld device (100) comprising:

a wireless communication interface (142) through which said handheld device (100) is able to communicate with a carrying case (200);

means for determining whether said handheld device (100) is secured to said carrying case (200);

a processor (110);

a memory (112);

a power source (154) to provide power to said processor (110), said memory (112) and said communication interface (142); and

means for determining whether at least a predefined or programmable amount of time has passed since a last activation of said handheld device (100), which signifies, in conjunction with said handheld device (100) not being secured to said carrying case (200), that there is a possible risk of a user losing said handheld device (100),

wherein said memory (112) is arranged to store executable code means (150) that, when executed by said processor (110), is arranged to control said wireless communication interface (142) to transmit a signal to said carrying case (200) to cause said carrying case (200) to alert a user of said handheld device (100) to said risk."

In view of the outcome of this decision, the claims of the auxiliary request are irrelevant.

Reasons for the Decision

1. The appeal is admissible as complying with the admissibility requirements (see points I and III).

2. The examining division has not raised any concern under Article 84 or 123 (2) EPC 1973, neither in the refusal nor in the preceding examination procedure. Especially with regard to the main request the board has no reasons to raise any such objections of its own.

3. The board agrees that document D5 is the most suitable document to assess novelty and inventive step of the invention.

3.1 As to claim 1: Document D5 concerns an handheld electronic device which is normally held in a carrying case, called a holster, and discloses a method for alerting the user that the device is at risk of being lost (fig. 1 and abstract). According to this method, it is determined that the device is not secured to the holster (*loc. cit.* and fig. 2, item 16) and consequently, an interface element of the holster is activated to alert the user of this risk (by way of an audible or vibrating alert; col. 2, lines 45-48).

The alert can be silenced or defeated in situations where the user intentionally removes the device from the holster in order to use it. To achieve this, D5 discloses that the user may have to activate the device (see *e.g.* col. 4, lines 6-19), in which case a signal is transmitted from the device to the holster over a wireless communication link.

3.2 As regards claim 1 of the main request, D5 does not disclose the features that:

(a) it is determined whether at least a predetermined or programmable amount of time has passed since a last activation of the device; and that

(b) a signal is transmitted from the device to the holster case in order to trigger the alert rather than to silence or defeat it.

3.3 As to claim 3: Document D5 also discloses a handheld electronic device which is equipped to communicate with its holster through a wireless communication interface (cf. *e.g.* D5, figs. 1 and 2; items 10, 12 and 28). The device can be a computer, PDA, or cellular phone, and then evidently contains a processor, a memory and a power source (cf. D5, col. 2, lines 11-13; col. 4, lines 42-48). According to the main embodiment in D5, the detector used to determine whether the device is secured to the holster is contained in the holster (fig. 2, item 16). D5 also discloses the option that the detector may be contained in the device but only if the entire alert functionality is duplicated in the device (col. 4 lines 48-50).

3.4 As regards claim 3, therefore, D5 does not disclose that the device is set to perform the functions a) and b) defined above, and, in addition, that

(c) it is the device which determines whether it is secured in the holster but the holster which alerts the user.

4. The board agrees with the appellant that the central difference between D5 and the invention is that risk of loss is determined in different situations.

4.1 D5 is concerned with the risk of inadvertent removal or theft. When the user removes the device from its holster to use it, and indicates so by defeating or silencing the alert, it is the user's responsibility to put the device back. The implicit assumption in D5 apparently is that the user can be relied on. According to D5, the alert will not and cannot be reactivated unless the device is placed back in the holster (col. 3, lines 65-67; col. 4, lines 40-41).

4.2 The invention, in contrast, is specifically concerned with the risk that the user might *forget* to put the device back into the carrying case and then lose it.

4.3 The appellant proposes that the objective technical problem solved by the invention is "how, once the electronic device has been removed from its holster and activated by a user, to alert the user that the device is at risk of being lost" (grounds of appeal, p. 5, 3rd par. from bottom).

4.4 This formulation limits the situations of interest to those in which the user has already activated the device. As D5 discusses the risk of loss only in one particular situation (inadvertent removal or theft), it is, in the board's view, already a part of the invention to appreciate in which further situations there is a risk of loss which should be taken care of. Thus, the objective technical problem proposed by the appellant contains an element of the solution as

claimed and hence is, in itself, a result of an *ex post facto* analysis.

4.5 In order to avoid this, the board considers that the objective technical problem which features a) and b) solve in view of D5 which should be considered is, more generally, to *further reduce the risk that the device may be lost*.

4.6 In this context it appears to be of no particular importance whether the detector is integrated into the holster or the electronic device, provided that the alert remains in the holster. Since D5 explicitly suggests that the alert circuitry may be shared or entirely contained within the electronic device (col. 4, lines 42-45), the board believes that feature c) alone constitutes an obvious variation of D5 and thus is insufficient to establish an inventive step of claim 3 over D5.

5. In order to solve the given technical problem, the skilled person would, in the board's view, have to determine in which situations the device is at risk of being lost.

5.1 As already indicated, the discussion in D5 is limited to inadvertent removal or theft and there is no hint to other scenarios in which it might be worthwhile trying to reduce the risk of loss. *A priori*, it seems that the device could be lost virtually any time: After the device is removed from the holster and the alert is defeated or silenced, but before the device is activated; after the device is activated, used and deactivated, but before it is put back in the holster;

or under various circumstances between activation and deactivation. It is also possible that the device is lost together with its holster, *i.e.* before the device is removed from the holster.

5.2 The board concludes that D5 does not contain any explicit or implicit prompt that would suggest features a) and b). The board further holds that feature a) is not a self-evident criterion for assessing whether a device is at risk of being lost. In fact, the available prior art suggests some substantially different criteria that could be used, *e.g.* the presence or absence of a user's hand near the device (see *e.g.* D1, pars. 32-33) or the distance between the device and its holster (see *e.g.* D2, col. 1, lines 40-42).

5.3 The board considers it to be common knowledge that off-the-shelf cell phones have had, since before the priority date of the application under appeal, screen savers, keypad locks or device locks that would be activated when the cell phone had been idle for a certain time.

While these mechanisms may comprise features similar to feature a), in the board's view none of them directly provides or suggests a solution to the objective technical problem at stake.

A keypad lock may be activated to avoid that buttons are accidentally pressed, for instance if the phone is carried in a pocket. In a pocket, however, the phone would normally not appear to be at risk of being lost. A device lock may be activated to avoid that a phone is

used by a non-authorized person. This is useful whenever third parties may have access to the phone, for instance because it is left on the desk in an open-plan office, but appears unrelated to a risk of loss.

The board therefore concludes that the mentioned common knowledge would not have incited the skilled person to solve the objective technical problem in the claimed manner.

5.4 Document D4 discloses a computer operated with a cordless pen and a pen holding case equipped to determine whether it contains a pen or not. When it is detected that the pen is not stored in place, and no input was made at the computer with either the keyboard or the pen during a predetermined period of time, it is determined that the pen must be forgotten to be replaced and a warning is given (D4, col. 6, lines 37-58).

The system of D4 does not force the user to put the pen back after every use of the *pen*. As the appellant points out, this may mean that the pen may have been mislaid for a considerable period of time before the user is alerted. The board agrees with the examining division that this is done so as not to disturb the user while typing text when the pen is placed close to the computer. In the typical scenario, as the board sees it, D4 assumes that the risk of losing the pen is small while the computer is in use, but when the user is about to finish work and walk away from the computer, the user should be forced to put the pen in its proper place. D4 does therefore not *disclose* a scenario in which imminent loss of an item is

determined when this item has not been used for a certain period of time.

5.5 The decision argues that D4 provides a solution to the problem of how to alert the user that he might forget to return the handheld device in its storage position (point 2.4, 1st par.). To an extent, the board agrees with this statement; especially feature a) is disclosed in D4 when the computer of D4 is considered as the device being activated.

5.6 However, the board also has to decide whether the skilled person, presented with D4, would *appreciate* that it contained a teaching which could solve a problem with the system disclosed in D5 and whether, if so, that teaching would be applied in such a way as to fall within claim 1 of the present application.

In the board's judgement the answer is no. There are a number of significant differences between the systems in D5 and D4. In D4 the component which does the carrying is not simply a holster, it is the major part of the system, the "word processor". The carried element, on the other hand, is passive; there is no suggestion anywhere in D4 that it generates any signals, and in fact it would appear that what is referred to in D4 as a "cordless pen" is simply what is known in the context of PDAs (Personal Digital Assistants) as a "stylus" - a piece of plastic useful for indicating a position on a touch screen. Its "activation" could only be recognised by events occurring in the word processor. In D5 the carried element is assumed to have significant electronics, including a wireless transmitter. In these

circumstances it is doubtful whether the skilled person, without the benefit of hindsight, would recognise the teaching of D4 as being relevant to the system of D5.

Should the skilled person nonetheless decide to adapt the teaching of D4 to D5, it would still be necessary to make two further steps before arriving at the claimed invention. Firstly, the irrelevance of the keyboard activity in D4 would have to be recognized, and secondly the function of the transmitted signal in D5 would have to be inverted - it would have to be changed from suppressing an alarm to causing an alarm.

All in all the board considers that while it is possible to extract a relevant teaching from D4, this is only apparent in the knowledge of the claimed invention. The board agrees with the appellant that it is the result of *ex post facto* argumentation.

6. The board thus concludes that the subject matter of the claims according to the main request is based on an inventive step over D5 in combination with the available prior art, especially D4, and common knowledge, in accordance with Article 56 EPC 1973.

7. The board notes that the description has not yet been adapted to the present claims. In particular, the condition for alerting the user which is now required by the independent claims and thus obligatory for the invention is disclosed in the description as a mere example for such a condition (cf. descr., pars. 15 and 23). The description as it presently stands is

therefore not consistent with the claims of the main request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The application is remitted to the department of first instance with the order to grant a patent based on the main request, with the description yet to be adapted.

The Registrar: The Chairman:

B. Atienza Vivancos D. H. Rees