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**Datasheet for the decision  
of 1 April 2011**

**Case Number:** T 0962/08 - 3.5.03

**Application Number:** 05102553.4

**Publication Number:** 1708525

**IPC:** H04Q 7/38

**Language of the proceedings:** EN

**Title of invention:**

Roaming Profiles for Wireless Devices

**Applicant:**

Research In Motion Limited

**Headword:**

Roaming profile/RESEARCH IN MOTION

**Relevant legal provisions:**

EPC Art. 56

**Relevant legal provisions (EPC 1973):**

-

**Keyword:**

"Inventive step (all requests) - no"

**Decisions cited:**

-

**Catchword:**

-



Case Number: T 0962/08 - 3.5.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.03  
of 1 April 2011

**Appellant:** Research In Motion Limited  
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Waterloo, Ontario N2L 3W8 (CA)

**Representative:** Patel, Binesh  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 7 January 2008  
refusing European patent application  
No. 05102553.4 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** B. Noll  
R. Moufang

## Summary of Facts and Submissions

I. This appeal is against the decision of the examining division to refuse European patent application No. 05102553.4 on the ground that the subject-matter of the independent claims of each of a main and two auxiliary requests lacked an inventive step (Article 56 EPC) having regard, inter alia, to the following documents:

D1: US 2004/0054923 A1

D2: US 2002/0025821 A1

A third auxiliary request was not admitted into the procedure by the examining division pursuant to Rule 137(3) EPC.

II. With the statement of grounds of appeal it was requested that the decision under appeal be set aside and a patent be granted on the basis of one of the main or first or second auxiliary requests on which the decision under appeal was taken, or a third auxiliary request not admitted into the procedure by the examining division.

III. In a communication dated 4 June 2010 the board gave a preliminary opinion on the claimed subject-matter, inter alia on inventive step (Article 56 EPC) as regards claim 1 of the main and the three auxiliary requests.

IV. Together with a reply to the board's communication, received on 4 October 2010, the appellant filed an amended set of claims according to a third auxiliary

request. It was requested that the impugned decision be set aside and that the case be remitted to the department of first instance for further prosecution. Oral proceedings were conditionally requested.

V. In a communication accompanying a summons to oral proceedings the board drew attention to the points to be discussed at the oral proceedings, in particular inventive step (Article 56 EPC) as regards claim 1 of each request.

VI. With a letter filed on 27 January 2011 the appellant informed the board that it would not be attending the oral proceedings scheduled for 1 April 2011 and requested that a decision be issued on the file as it stands.

VII. Oral proceedings were held on 1 April 2011 in the absence of the appellant. After deliberation, the board's decision was announced.

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

A method in a provisioning system (100) for provisioning a wireless device (210) based upon a current network of operation for a wireless network (210) [sic], the current network having one or more predefined services provisioned for use by the wireless device on the current network, the method comprising: receiving information from the wireless device (210) for identifying the current network of operation for the wireless device; identifying the one or more predefined services that are provisioned for use by the wireless device (210) on

the current network based upon the information from the wireless device; and,  
transmitting to the wireless device (210) provisioning information for the one or more predefined services to enable the wireless device (210) to be programmed with the one or more predefined services.

Claim 1 of the first auxiliary request differs from claim 1 of the main request by omitting the word "predefined" and in that the last feature reads "transmitting to the wireless device (210) provisioning information comprising configuration settings for all of the one or more services to be enabled for that device based on the current network".

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request by adding "in order to enable the wireless device (210) to be programmed based on said configuration settings" to the last feature.

Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request by the provisioning system being "used by one or more service providers for controlling access to services by their respective subscribers", by the additional feature of "providing capabilities for management of one or more roaming profiles for said wireless device (210) by said one or more service providers" and in that the last feature reads "notifying the wireless device (210) of the roaming profile which is to be used including sending a service profile to the wireless device (210) containing configuration settings for all of the one or

more services to be enabled for that device based on the current network".

## **Reasons for the decision**

### 1. *Procedural matters*

From the appellant's submissions the board understands that the appellant requests that the decision under appeal be set aside and a patent be granted on the basis of the claims filed on 1 November 2007 as main, first and second auxiliary requests, or on the basis of the claims filed on 4 October 2010 as a third auxiliary request.

The present decision is based on the objection as to lack of inventive step (Article 56 EPC) which had been raised in the board's communications. The appellant made use of its opportunity to present its comments on this objection by submitting arguments in support of the present claims. Under these circumstances, the board was in a position to give a decision in accordance with Article 113(1) EPC.

### 2. *The invention*

The invention relates to service provisioning for a "roaming" wireless device such as a mobile telephone which is temporarily operating in a mobile network other than the "home" network in which the telephone is registered. The application identifies a need for customizing user services in dependence on the network in which the wireless device is presently operated, for

either providing the subscriber with additional services when roaming or blocking such services for which the subscriber would be charged at an excessively high rate when using them in a network other than the home network.

3. *The prior art*

D2 relates to a mobile telephone system for providing to a subscriber services dependent on the network in which the user's telephone is registered. Thus, D2 is in the same technical field as the application and is therefore considered by the board as the single most relevant prior art document for an assessment of inventive step.

D2 suggests that various services (e.g. call forwarding or voice mail, cf. paragraph [0003]) may be provided to a mobile telephone and that a subset of these services will be available to the subscriber dependent on which network the mobile telephone is currently registered to. The network-dependent sets of services are referred to as "service markers" (paragraph [0024]). Upon registering a telephone in a visited telephone network, network identity information of the visited network is received at the home location register of the subscriber (paragraphs [0030-0031]). An appropriate service marker to be currently used by the mobile telephone is identified, based on the network identity information, and transmitted to the visitor location register of the visited network. The service marker is used at the visited network to specify the services available to the roaming subscriber during the time the

mobile telephone is registered with the visited network (paragraph [0036]).

4. *Claim 1 of the main request - inventive step (Article 56 EPC)*

4.1 The method according to claim 1 of the main request differs from that of D2 in that provisioning information is transmitted to the wireless device whereas in D2 the provisioning information is transmitted as a service marker to the visitor location register of the visited network. It is acknowledged by the appellant that this is the difference between the claimed invention and D2 (cf. page 2 of the appellant's letter received on 4 October 2010).

4.2 In the board's view the person skilled in the art would recognize that in D2 the visitor location register acts as an "intelligent agent" which controls access to services by a subscriber temporarily visiting the network. The skilled person would further recognize that, in order to enable a wireless device to benefit from a service which needs a special adaptation of the wireless device itself, provisioning information also has to be transferred to the wireless device. The claim does not specify where this information is derived from. Thus, the person skilled in the art, starting out from D2, would appreciate that the system must transfer provisioning information to the wireless device too since the device needs the provisioning information in order to determine which services can be set up. Thus, the skilled person implementing the teaching of D2 would arrive at the method of claim 1 without the exercise of inventive skill.



4.3 The appellant argued that the D2 system envisaged a network-specific architecture which would necessitate an update of infrastructure elements of the visited network, in order to provide communication between the device's home location register and the device itself. In contrast, the invention did not modify the infrastructure of the visited communication network but enabled a single central resource to serve as a provisioning unit which did not require to communicate with infrastructure elements of the visited network but rather provided direct interaction of the provisioning system and the wireless device.

The claimed method is not however limited to any particular structure of a network; the provisioning system is described in the application merely in terms of its function rather than by structural elements. Even if, for the sake of argument, the provisioning system was understood as a separate structural resource arranged outside of the communication network, the skilled person would be aware of the possibility of such an implementation from paragraph [0004] of D2, according to which it was known before the filing date of D2, albeit with known disadvantages, to implement a provisioning system as an "intelligent agent" outside of, and independent from, the network structure. For this reason the appellant's arguments as to inventive step of the method of claim 1 of the main request are not considered convincing.

4.4 In conclusion, the method according to claim 1 does not involve an inventive step (Article 56 EPC).

5. *Claim 1 of the first auxiliary request - inventive step (Article 56 EPC)*

Regarding claim 1 of the first auxiliary request, the appellant argued that "D2 does not envision any services that would benefit from special adaptation or programming at the wireless device", and that the skilled person is not taught by D2 to provide configuration settings to the device for all services.

In the board's view, whether or not all services at the wireless device require special adaptation to the visited network will depend on the nature of each service. The skilled person would appreciate that the system must transfer provisioning information for each service for which an adaptation is necessary. Thus, the skilled person implementing the teaching of D2 for each service of the wireless device, would be led to the method of claim 1 of the first auxiliary request without the exercise of inventive skill (Article 56 EPC).

6. *Claim 1 of the second auxiliary request - inventive step (Article 56 EPC)*

The additional feature of claim 1 of the second auxiliary request does not serve to restrict the scope of the claim further since it is implicit and indeed self-evident that the configuration settings for a particular service are for modifying the programming of the wireless device. Accordingly, the method of claim 1 of the second auxiliary request lacks an inventive step for the same reasons as for claim 1 of the first auxiliary request (Article 56 EPC).

7. *Claim 1 of the third auxiliary request - inventive step (Article 56 EPC)*

The additional features in claim 1 of the third auxiliary request, in essence the provisioning system being used by one or more service providers, and providing capabilities for management of roaming profiles by the service providers, have in the board's view no clear limitative effect on the scope of claim 1.

This was communicated to the appellant in the communication accompanying the summons but the appellant did not comment on this.

The additional features are not therefore considered as contributing to an inventive step of the claimed method. The board therefore considers that the method according to claim 1 of the third auxiliary request lacks an inventive step for the same reasons as for claim 1 of the first auxiliary request (Article 56 EPC).

8. *The request for remittal*

The appellant requested remittal to the department of first instance for further prosecution and argued that the board, in finding that D1 was not prejudicial to inventive step and having based its objections against inventive step solely on D2, had introduced a new ground of objection; the appellant should be allowed to have its case heard in two instances with respect to the new ground.

It is however the established jurisprudence of the boards of appeal that an appellant has no absolute

right to have each individual issue considered by two instances, Article 111(1) EPC leaving it to the discretion of the board whether to exercise any power within the competence of the department of first instance or to remit the case to that department.

In the present case D2 was discussed in the course of substantive examination, so that the appellant had an opportunity to comment on the objection of lack of inventive step with respect to D2 before two instances. The fact that the board's objection of lack of inventive step is solely based on D2 whereas it was not in the impugned decision is not an appropriate reason to remit the case.

9. There is accordingly no request on file on the basis of which the appeal could be allowed and the appeal must therefore be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland