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**Datasheet for the decision
of 23 February 2011**

Case Number: T 0174/09 - 3.5.03

Application Number: 99300339.1

Publication Number: 0930761

IPC: H04M 1/274

Language of the proceedings: EN

Title of invention:

Telephone with adaptive speed dial method

Applicant:

LUCENT TECHNOLOGIES INC.

Opponent:

-

Headword:

Adaptive speed dial/LUCENT

Relevant legal provisions:

EPC Art. 54, 56

Relevant legal provisions (EPC 1973):

Keyword:

"Novelty (main request - no)"

"Inventive step (auxiliary requests - no)"

Decisions cited:

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Catchword:

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Case Number: T 0174/09 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 23 February 2011

Appellant: LUCENT TECHNOLOGIES, INC.
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Murray Hill NJ 07974-0636 (US)

Representative: Williams, David John
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 July 2008
refusing European application No. 99300339.1
pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: B. Noll
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division posted on 18 July 2008 to refuse European patent application No. 99300339.1 on the ground that the subject-matter of claims 1, 3-9 and 13-15 of a sole request lacked novelty (Article 54(2) EPC) having regard to the prior art document

D2: EP 0709996 A2.

II. With the statement of grounds of appeal received on 28 November 2008 the appellant filed sets of claims of a main and three auxiliary requests and stated that they reserved the right for oral proceedings.

III. In a communication accompanying a summons to oral proceedings the board gave a preliminary opinion on the case, in particular as to novelty (Article 54(2) EPC) and inventive step (Article 56 EPC) of the subject-matter of claim 1 of each request.

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

"A telephone, consisting of:
a speed dial memory (107); and
a speed dial updating unit (109) adapted to automatically update the speed dial memory (107) based on calling history;
wherein the speed dial updating unit (109) includes an outgoing telephone number memory (111) adapted to store outgoing telephone numbers associated with outgoing calls, and a score keeping unit (113) adapted to maintain a count of the number of calls to each

outgoing telephone number; CHARACTERISED BY:
wherein the speed dial updating unit (109) includes a
threshold unit (125) adapted to set a threshold, such
that the score keeping unit (113) maintains a count of
the number of calls since the threshold for each
outgoing telephone number; and
wherein the threshold is based on at least one of a
measure of time and a number of calls."

Claim 1 of each auxiliary request differs from claim 1
of the main request only by its last feature, which
reads as follows:

"wherein the threshold is based on both a measure of
time and a count of a number of calls" (first auxiliary
request),

"wherein the threshold is based on a measure of time
during which the score keeping unit (113) records a
count of a number of calls" (second auxiliary request),
and

"wherein the threshold is based on the amount of call
time for each outgoing telephone number" (third
auxiliary request).

V. With a letter filed on 10 February 2011 the appellant
stated that the request for oral proceedings was
cancelled and requested a decision on the file as it
currently stands.

VI. The oral proceedings took place as appointed on
23 February 2011 in the absence of the appellant. At
the end of the oral proceedings the board's decision
was announced.

Reasons for the decision

1. *Claim 1 of the main request - novelty (Article 54(2) EPC)*

It is common ground that the telephone disclosed in D2 includes a speed dial memory and a speed dial updating unit according to the features in the pre-characterizing portion of claim 1, and that the D2 telephone sets a threshold in time (e.g. 28 days, cf. column 5, lines 32 to 40) for which the number of calls for each dialled number is calculated; this calculated number of calls serves to sort the dialled number into an abbreviated dialling list (cf. column 6, lines 1 to 7).

The appellant argues that the telephone according to claim 1 is distinguished from D2 by a threshold unit 125, and that, although the function of a threshold may be known from D2, it "is improper for a functional feature of the prior art to be cited against the novelty of a feature of an apparatus claim".

The threshold unit is described in the present application, starting at paragraph [0021] of the published application, only in terms of its function. Although figure 1 shows the threshold unit as a separate block within the speed dial updating unit 109, this representation is not understood by the board as showing an actual structural element of the threshold unit; rather, the board understands block 109 in figure 1 as representing a processor properly programmed to carry out the functions of updating the speed dial list in the memory and setting the threshold used in the

updating process. Hence, in the board's view there is no disclosure in the application of a specific threshold unit structure.

These objections were set out in the board's communication and the appellant did not comment. Since the threshold unit is defined in the application only by its function rather than by any structural feature, and since the same function is disclosed in the cited prior art, the board considers that this feature does not distinguish over the corresponding feature in D2. Thus, the telephone according to claim 1 lacks novelty (Article 54(2) EPC) having regard to D2.

2. *Claim 1 of the auxiliary requests - inventive step (Article 56 EPC)*

The telephone set of claim 1 of each auxiliary request is distinguished from claim 1 of the main request by the criterion according to which the threshold for sorting out less useful telephone numbers from the speed dial memory is set. In the board's view any criterion as to whether a called telephone number is considered as a candidate for the speed dial memory is of a subjective nature and is therefore a non-technical decision at the free disposal of the skilled person. The skilled person would as a matter of course consider the criteria given in the last feature of claim 1 of each auxiliary request as obvious possibilities for modifying the threshold of the telephone set of D2 without the exercise of inventive skill. Thus, claim 1 of each auxiliary requests lacks an inventive step (Article 56 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland