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**Datasheet for the decision  
of 3 July 2014**

**Case Number:** T 2333/09 - 3.5.05

**Application Number:** 06253027.4

**Publication Number:** 1818769

**IPC:** G06F3/033

**Language of the proceedings:** EN

**Title of invention:**

Method and arrangement for providing a primary actions menu on a handheld communication device

**Applicant:**

BlackBerry Limited

**Headword:**

Providing a primary actions menu/BLACKBERRY

**Relevant legal provisions:**

EPC Art. 56

RPBA Art. 13(1), 13(3)

**Keyword:**

Inventive step (no -  
main request, first to fifth auxiliary requests)  
Request not admitted (sixth auxiliary request)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
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Case Number: T 2333/09 - 3.5.05

**D E C I S I O N  
of Technical Board of Appeal 3.5.05  
of 3 July 2014**

**Appellant:** BlackBerry Limited  
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**Representative:** Roberts, Gwilym Vaughan  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 16 July 2009  
refusing European patent application No.  
06253027.4 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chair** A. Ritzka  
**Members:** P. Corcoran  
G. Weiss

## Summary of Facts and Submissions

- I. The decision under appeal is the decision to refuse the present application which was delivered during oral proceedings held on 1 July 2009 with written reasons being dispatched on 16 July 2009.
- II. The impugned decision was taken with respect to a main request comprising 39 claims and two auxiliary requests each comprising 37 claims, all of said requests having been submitted with the letter of 29 May 2009.
- III. Said decision refers to the following prior art documents:
- D1: EP 1 521 168 A2;
  - D4: "Dell Axim X50 Owners Manual" (DELL) September 2004, retrieved on 11 March 2008, from the URL <http://support.dell.com/support/edocs/systems/aximx50/en/om/N6966bk1.pdf> [XP007904314];
  - D4a: "Dell stellt neue PDA-Topklasse vor" (HEISE), 12 December 2004, retrieved on 11 March 2008 from the URL [http://www.heise.de/newsticker/suche/ergebnis?rm=result;q=AXIM%20X50;url=/newsticker/meldung/52069/;words=Axim%20x50%20X50\\*](http://www.heise.de/newsticker/suche/ergebnis?rm=result;q=AXIM%20X50;url=/newsticker/meldung/52069/;words=Axim%20x50%20X50*) [XP007904313];
  - D5: US 2005/190083 A1;
  - D6: US 2004/165924 A1;
  - D7: US 2006/007129 A1;
  - D8: US 2002/142738 A1;
  - D9: R. Cowart; B. Knittel, "Special Edition Using Microsoft Windows® 2000 Professional", 24 February 2000, ISBN: 978-0-7897-2125-9 [XP001167394];
  - D10: US 6 664 991 B1.
- IV. Claim 1 of the main request submitted with the letter of 29 May 2009 reads as follows:

"A method for displaying an abbreviated menu on the screen of a handheld electronic device (300a, 300b), said method comprising:

displaying a cursor-navigable page on a screen of a handheld electronic device (300a, 300b);

initiating an ambiguous request by a user for display of menu items corresponding to the displayed page, wherein said ambiguous request is a request made while a cursor is positioned at a location on the page that is not visually signified for menu display actuation;

in response to the ambiguous request, displaying a short menu (624) having a first list of menu items which is a subset of a second list of menu items of an extended menu (622) which lists all available menu items associated with the displayed page, said first list of menu items having been assessed a higher probability for being user-selected than at least some items of the second list of menu items not included in said first list of menu items;

initiating a request by a user for display of the extended menu (622); and

in response to the request, displaying the extended menu (622)."

V. Claim 1 of the first auxiliary request submitted with the letter of 29 May 2009 reads as follows:

"A method for displaying an abbreviated menu on the screen of a handheld electronic device (300a, 300b), said method comprising:

displaying a cursor-navigable page on a screen of a handheld electronic device (300a, 300b);

initiating an ambiguous request by a user for display of menu items corresponding to the displayed page, wherein said ambiguous request is a request made while a cursor is positioned at a location on the page

that is not visually signified for menu display actuation;

in response to the ambiguous request, displaying a short menu (624) having a first list of menu items which is a subset of a second list of menu items of an extended menu (622) which lists all available menu items associated with the displayed page, said first list of menu items having been assessed a higher probability for being user-selected than at least some items of the second list of menu items not included in said first list of menu items,

wherein the short menu (624) comprises a menu item for displaying the extended menu (622); and

displaying the extended menu (622) in response to a selection of the menu item."

VI. Claim 1 of the second auxiliary request submitted with the letter of 29 May 2009 reads as follows:

"A method for displaying an abbreviated menu on the screen of a handheld electronic device (300a, 300b), said method comprising:

displaying a cursor-navigable page on a screen of a handheld electronic device (300a, 300b);

initiating an ambiguous request by a user for display of menu items corresponding to the displayed page, wherein said ambiguous request is a request made while a cursor is positioned at a location on the page that is not visually signified for menu display actuation;

in response to the ambiguous request, displaying a short menu (624) having a first list of menu items which is a subset of a second list of menu items of an extended menu (622) which lists all available menu items associated with the displayed page, said first list of menu items having been assessed a higher probability for being user-selected than at least some

items of the second list of menu items not included in said first list of menu items,

wherein the short menu (624) comprises a menu item for displaying the extended menu (622); and

expanding the short menu (624) to display the extended menu (622) in response to a selection of the menu item."

- VII. In the decision under appeal, the examining division found that the subject-matter of claim 1 of the main request did not involve an inventive step in the light of D4 combined with the general knowledge of the skilled person as evidenced by D9. A similar finding was arrived at in respect of independent device claim 23 of the main request whereby reference was made to D5, D6, D7 and D10 as evidence that providing a keyboard to enter text was a standard design feature in the field of hand held devices. The examining division further found that substantially the same objections concerning the lack of patentability applied to the independent claims of the auxiliary requests.
- VIII. Notice of appeal was received at the EPO on 21 September 2009 with the appropriate fee being paid on the same date. A written statement setting out the grounds of appeal was received at the EPO on 17 November 2009. With said written statement the appellant submitted the following request:  
*"We maintain the Main Request and five Auxiliary Requests, which were filed with our letter of 29 May 2009".*
- IX. With respect to the main request and first and second auxiliary requests filed with the letter of 29 May 2009, complete versions of the corresponding claim sets were filed. With respect to the third,

fourth and fifth auxiliary requests, the wording of the claims of these requests was merely indicated in summary form in the letter of 29 May 2009 where it was stated that these requests were to be based respectively on the main request and the first and second auxiliary requests whereby the text of the independent claims of the first group of requests was to be changed by amending the text which formerly read "an extended menu" to read "a single extended menu".

X. Insofar as they are relevant to the present decision, the submissions of the appellant contained in the written statement setting out the grounds of appeal, may be summarised as follows:

- (i) According to the appellant, the features of the concluding part of claim 1 specifying the method steps performed in response to the ambiguous request were not disclosed in D4. As a result of these distinguishing features, two types of menu could be displayed, viz. the short menu and the extended menu as defined in claim 1 and the user could select which type of menu to use as a matter of preference.
  
- (ii) The short menu is a concise list of the items that the user is most likely to select. In many cases, the user can select the desired item with one selection from a limited number of items. The extended menu displays everything that the user can select in relation to the displayed page in one list such that the user will not have to look through a number of menus to find the desired item to select.

- (iii) The appellant submitted that the distinguishing features provided the technical effect of improved usability of the device, making it more user-friendly.
- (iv) According to the appellant, the menu system of D9 (as shown in Figure 1.3 thereof) is a hierarchical system of menus where the menus of each level after the first level are reduced so that they only contain certain items that would be in the full menu at that level in the hierarchy. The appellant submitted that this is not the same as the menu system disclosed in the present application according to which there is "an extended menu which lists all available menu items associated with the displayed page".
- (v) On this basis, the appellant submitted that a combination of D4 and D9 would not lead the skilled person to the invention according to the independent claims of the main request.
- (vi) With respect to the auxiliary requests, the appellant made substantially similar submissions to the effect that a combination of D4 and D9 would not lead the skilled person to the claimed invention according to the independent claims of said requests.

XI. In a communication accompanying a summons to oral proceedings the board gave its preliminary opinion that the appellant's requests were not allowable and, *inter alia*, made the following observations:

- (i) The board noted that it was not inclined to concur with the appellant's submissions



concerning D9 and its alleged lack of relevance to the claimed invention. In particular, the board was not inclined to concur with the appellant's submissions to the effect that the menu system disclosed in the present application was significantly different from that of D9.

- (ii) The board referred in this regard to the document D9a (US 6 121 968 B) which it introduced into the proceedings pursuant to Article 114(1) EPC as it appeared to be of potential relevance to the question of inventive step. The board noted that it could not identify any effective difference in technical terms between the "short menus"/"long menus" of D9a and the corresponding "short menus"/"extended menus" of the present application.
- (iii) Referring to [0011], [0064] and [0122] of the originally filed application, the board expressed the preliminary opinion that the term "extended menu" as used in the context of the present application included within its scope a menu of a hierarchical menu system which listed all available menu items at the applicable level of the menu hierarchy (cf. description: [0011], [0064] and [0122], "an extended menu ... corresponding to the displayed page").
- (iv) In view of the foregoing, the board was of the preliminary opinion that claim 1 of the main request lacked an inventive step in the light of D4 considered in combination with D9, or alternatively, considered in combination with D9a. Substantially similar considerations applied to claim 23 of the request.

- (v) Insofar as the amendments to the independent claims of the auxiliary requests were clear and were supported by the original disclosure, they appeared to relate to subject-matter which was known *per se* from the cited prior art or which would fall within the routine competence of the skilled person. In the given context, said amendments did not appear to provide an inventive contribution to the subject-matter of the auxiliary requests.
  
- (vi) Concerning the amendments proposed in respect of the third to fifth auxiliary requests, the board noted that the appellant had referred to Fig. 6g as providing a basis for these amendments and had submitted that said figure showed "a single extended menu" (622). The appellant had attempted to argue that the menu 622 was not part of a hierarchical menu system and that the expression "a single extended menu" was intended to express this. However, the board noted that at least some of the actions indicated on the menu 622 appear to indicate the existence of a further level of menu options. The board therefore had reservations as to whether the aforementioned amendments, insofar as they were intended to be interpreted in the manner indicated above, were supported by the original application documents.

XII. With a letter of reply dated 2 June 2014, the appellant made submissions in response to the board's communication and filed a further auxiliary request.

XIII. Insofar as they are relevant to the present decision, the written submissions made in the letter of reply dated 2 June 2014 may be summarised as follows:

- (i) Referring to the claimed "single extended menu" feature of the third to fifth auxiliary requests, the appellant submitted that the amendments relating to this feature were supported by the originally filed application. According to the appellant there was a difference between the use of ellipses "... " and the use of arrows ">" in menus inasmuch as ellipses were used to indicate either that the text associated with that menu item had been truncated or that actioning that menu item would cause a dialogue box to open whereas actioning a menu item having an arrow would cause a submenu to open. The appellant further stated that although the "new" menu item of menu 622 had an arrow, a new message would not be associated with the displayed page and the menu 622 was therefore a "single extended menu" which listed all available menu items associated with the displayed page.
- (ii) With respect to the aforementioned third to fifth auxiliary requests, the appellant disputed that a person skilled in the art would combine D4 with either D9 or D9a, and submitted that if he were to do so, then he would simply implement the hierarchical menu system of D9 or D9a on the device of D4 and so would not arrive at the claimed subject matter.
- (iii) With respect to the sixth auxiliary request, the appellant submitted that claim 1 thereof had been amended to recite "the handheld electronic device

(300a, 300b) transmitting information for the short menu (624) to, or receiving the information from, a central location that is separate from the handheld electronic device (300a, 300b) via a communication system". A basis for this amendment could be found, for example, in paragraph [0101] of the originally filed application. Claim 23 had been amended in line with claim 1.

- (iv) With respect to the question of inventive step, the argumentation set out in relation to the previously filed requests was considered to apply equally to the sixth auxiliary request. Referring to paragraph [0101] of the originally filed application, it was further submitted that the claimed approach allowed the user to access the information for the short menu on multiple devices. This allowed the user to experience, on different devices, identical short menus for which the items have a high probability of being selected - thereby improving the efficiency of user interactions with the devices.
  
- (v) According to the appellant, there was no hint or suggestion in any of D4, D9 or D9a of transmitting any menu information between a handheld electronic device and a central location and the concept of transmitting menu information was one that would be alien to the skilled person. On this basis, it was submitted that the person skilled in the art would not obviously make the modifications to the closest prior art that would be required in order to arrive at the claimed subject matter.

- XIV. With a letter of reply dated 1 July 2014, the appellant's representative informed the board to the effect that he would not be attending the hearing on 3 July 2014.
- XV. Oral proceedings were held as scheduled on 3 July 2014. Nobody appeared on behalf of the appellant.
- XVI. The appellant has requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the claims according to the main request or, alternatively, the first to fifth auxiliary requests, all requests filed with the letter dated 17 November 2009 or on the basis of the claims according to the sixth auxiliary request filed with the letter dated 2 June 2014.
- XVII. The claims of the appellant's main request filed with the letter dated 17 November 2009 are the same as those of the corresponding request filed with the letter of 29 May 2009 (cf. item IV. above).
- XVIII. The claims of the appellant's first and second auxiliary requests filed with the letter dated 17 November 2009 are likewise the same as those of the corresponding requests filed with the letter of 29 May 2009 (cf. items V. and VI. above).
- XIX. The third, fourth and fifth auxiliary requests submitted with the letter dated 17 November 2009 are based on the amendments to the main request and the first and second auxiliary requests indicated in the letter of 29 May 2009 which specifies that the text of the independent claims of the latter group of requests is to be amended by replacing the expression "an

extended menu" with "a single extended menu" (cf. Facts and Submissions, item IX. above).

XX. Claim 1 of the sixth auxiliary request reads as follows:

"A method for displaying an abbreviated menu on the screen of a handheld electronic device (300a, 300b), said method comprising:

displaying a cursor-navigable page on a screen of a handheld electronic device (300a, 300b);

initiating an ambiguous request by a user for display of menu items corresponding to the displayed page, wherein said ambiguous request is a request made while a cursor is positioned at a location on the page that is not visually signified for menu display actuation;

in response to the ambiguous request, displaying a short menu (624) having a first list of menu items which is a subset of a second list of menu items of an extended menu (622) which lists all available menu items associated with the displayed page, said first list of menu items having been assessed a higher probability for being user-selected than at least some items of the second list of menu items not included in said first list of menu items;

initiating a request by a user for display of the extended menu (622);

in response to the request, displaying the extended menu (622);

and the handheld electronic device (300a, 300b) transmitting information for the short menu (624) to, or receiving the information from, a central location that is separate from the handheld electronic device (300a, 300b) via a communication system."

XXI. During the oral proceedings held on 3 July 2014, following deliberation on the appellant's written submissions, the chair announced the board's decision.

### **Reasons for the Decision**

1. The appeal is admissible. The appeal is not allowable for the reasons which follow.

#### *Procedural matters*

2. *Non-attendance at oral proceedings*

2.1 In the present case, the board decided that it was appropriate to proceed by holding the oral proceedings as scheduled in the absence of the appellant (cf. Rule 115(2) EPC) particularly in view of the fact that the appellant had not withdrawn its precautionary request for oral proceedings but had merely notified the board to the effect that it would not be represented at the proceedings.

2.2 The appellant could reasonably have expected that during the oral proceedings the board would consider the objections and issues raised in the communication annexed to the summons to oral proceedings which form the basis for the present decision. In deciding not to attend the proceedings, the appellant effectively chose not to avail of the opportunity to present its observations and counter-arguments orally but instead to rely on its written case (cf. Article 15(3) RPBA).

2.3 The appellant's written case corresponds to that presented in the written statement setting out the

grounds of appeal and the letter dated 2 June 2014 (cf. (cf. Facts and Submissions, items X and XIII and above).

- 2.4 The board was in a position to announce a decision at the conclusion of the oral proceedings as foreseen by Article 15(6) RPBA. The reasons on which this decision was based do not constitute a departure from grounds or evidence previously put forward which would require that the appellant be given a further opportunity to comment.

*Main request*

3. *Interpretation of claim 1*

- 3.1 According to [0011] of the originally filed description, the term "extended menu" as used in the the present application denotes a menu which "lists all available menu items" at a particular level of the menu hierarchy whereas the term "short menu" denotes "a dynamic menu that is built by the user by selecting menu items from the corresponding extended menu to include in the short menu".

- 3.2 According to [0064] of the originally filed description, it is envisaged to implement the present invention in the context of "application programs ... that support hierarchical menus" and to enable application developers "to design hierarchical menus, both extended and short menus, in a typical manner". Likewise, [0120] of the originally filed description states that Fig. 8 illustrates an exemplary method for implementing a hierarchical menu with ambiguous selection on a computer device such as a PDA or other similar device having a small display screen.



3.3 The board therefore judges that the term "extended menu" as used in the context of the present application includes within its scope a menu of a hierarchical menu system which lists all available menu items at the applicable level of the menu hierarchy (cf. originally filed description: [0011] and [0122], "an extended menu ... corresponding to the displayed page").

3.4 For the purpose of assessing inventive step, the subject-matter of claim 1 of the main request is to be interpreted in the light of the preceding observations.

4. *Observations re D9 and D9a*

4.1 The appellant submits that there is no disclosure in D9, of an extended menu which lists all available menu items as defined in the claimed invention and that there is, likewise, no disclosure of a short menu defined in terms of such an extended menu.

4.2 The board, however, is not convinced by the appellant's submissions to the effect that the menu system disclosed in the present application is substantially different from that disclosed in D9.

4.3 The board further refers in this regard to the document D9a (US 6 121 968 B) which was introduced into the present proceedings pursuant to Article 114(1) EPC. D9a is a US patent specification which appears to relate to the adaptive menu system disclosed in D9 and which discloses subject-matter in this regard which is substantially similar to that disclosed in D9, albeit in more detail. In view of the more detailed level of disclosure relating to so-called "adaptive menus" provided in D9a, the board considers it more

appropriate to rely on that document for the purposes of the present decision.

4.4 Similar to document D9, D9a discloses drop-down menus provided by a computer program which are provided in two states, viz. a "short menu" state and a "long menu" state. When a user opens a desired menu, the menu will initially take the form of a short menu of executable commands which are a subset of the total number of executable commands available under the selected menu. The short menu may be dynamically expanded into a long menu which will contain the complete set of executable commands available under the selected menu (cf. in particular D9a: Abstract; col.2 l.9 - col.3 l.63; col.7 l.39 - col.12 l.14; Figs. 2A-2D and 3).

4.5 The board cannot identify any effective difference in technical terms between the "short menus"/"long menus" of D9a and the corresponding "short menus"/"extended menus" of the present application. It is further noted in this regard that the appellant made no effective counter-submissions to the observations relating to D9a made by the board in its communication.

5. *Inventive step*

5.1 The board is not convinced by the appellant's assertions to the effect that the skilled person would not have combined the disclosures D4 and D9a.

5.2 D4 discloses a handheld electronic device (cf. D4: Chapter 1) which is provided with an operating system, i.e. Microsoft Windows Mobile 2003 (cf. D4: Chapter 2) which provides a conventional windows-based Graphical User Interface (GUI) environment comprising "pop-up menus" (cf. D4: p.41 and p.48).

- 5.3 D9a relates to the provision of menus in the form of adaptive menus for a conventional windows-based GUI environment (cf. for example, D9a: Figs. 2A to 2D). From D9a it may be inferred that the adaptive menus disclosed therein improve the usability of the system *inter alia* by reducing cluttering and providing menus which more accurately reflect the particular needs and utilization behaviour of the user (cf. D9a: col.1 l. 27-46 and col.1 l.62 - col.2 l.3).
- 5.4 The appellant asserted that the skilled person would not have attempted a combination of the teachings of D4 and D9a but failed to advance any convincing reasons in support of the assertion. The board cannot identify any plausible reason as to why the skilled person would have been deterred from deploying the teaching of D9a concerning adaptive menus in the particular context of the conventional windows-based GUI environment of the handheld device of D4 with a view to improving the usability of the system.
- 5.5 The board judges that deploying the teaching of D9a concerning adaptive menus in the conventional windows-based GUI environment of the handheld device of D4 would lead to a method for displaying an abbreviated menu on the screen of a handheld electronic device substantially as defined in claim 1 according to which a menu would be initially displayed in the form of a "short menu" which could be followed the subsequent display of an "extended menu" in response to an appropriate user input in the form of an "expansion action" (cf. D9a: col.2 l.34 to 53).
6. In view of the foregoing, the board concludes that claim 1 of the main request lacks an inventive step in

the light of D4 considered in combination with D9a. A similar finding applies to claim 23 of the request.

*First and second auxiliary requests*

7. *Differences with respect to the main request*

7.1 Claim 1 of the first auxiliary request and claim 1 of the second auxiliary request differ from claim 1 of the main request with respect to the wording used to define the concluding features of the claim.

7.2 The concluding features of claim 1 of the main request are worded as follows:

*"initiating a request by a user for display of the extended menu (622); and  
in response to the request, displaying the extended menu (622)."*

7.3 The concluding features of claim 1 of the first auxiliary request are worded as follows:

*"wherein the short menu (624) comprises a menu item for displaying the extended menu (622); and  
displaying the extended menu (622) in response to a selection of the menu item."*

7.4 The concluding features of claim 1 of the second auxiliary request read as follows:

*"wherein the short menu (624) comprises a menu item for displaying the extended menu (622); and  
expanding the short menu (624) to display the extended menu (622) in response to a selection of the menu item."*

7.5 Claim 1 of the main request merely specifies in general terms the display of an extended menu in response to a

"request" by a user. Claim 1 of the first auxiliary request additionally specifies the means by which the request to display the extended menu is submitted, i.e. by providing a menu item for displaying the extended menu and by displaying the extended menu in response to the selection of said menu item.

7.6 Claim 1 of the second auxiliary request seeks protection for substantially the same subject-matter as claim 1 of the first auxiliary request and differs only in terms of the wording used to define the display of the extended menu, i.e. by "expanding the short menu".

8. *Inventive step*

8.1 D9a discloses the provision of a menu item for displaying the extended menu and the display of the extended menu in response to a selection of said menu (cf. D9a: col.2 l.44-47; col.11 l.31-42; Fig. 2D).

8.2 The board therefore judges that the additional features of claim 1 of the first auxiliary request concerning the means by which the request to display the extended menu is submitted (cf. 7.5 above) are known *per se* from D9a and consequently do not provide an inventive contribution to the claimed subject-matter.

8.3 With respect to claim 1 of the second auxiliary request, the use of the wording to the effect that the extended menu is displayed by "expanding the short menu" is not considered to imply any significant technical difference in respect of the claimed subject-matter. It is further noted in this regard, that D9a discloses the display of the extended menu in terms of an "expansion" of the short menu (cf. D9a; col.2 l. 34-53). Hence, the additional features of claim 1 of

the second auxiliary request are also judged not to provide an inventive contribution.

9. In view of the foregoing, the above finding in respect of the main request concerning a lack of inventive step (cf. 6. above) also applies to the corresponding claims of the first and second auxiliary requests.

*Third, fourth and fifth auxiliary requests*

10. *Differences with respect to the preceding requests*

10.1 According to the letter of 29 May 2009, the third, fourth and fifth auxiliary requests are to be based respectively on the main request and the first and second auxiliary requests whereby the text of the independent claims of the first group of requests is to be changed by amending the text which formerly read "an extended menu" to read "a single extended menu".

10.2 Taking account of the appellant's submissions in the written statement setting out the grounds of appeal, insofar as the board has been able to understand the intended effect of the proposed specification of "a single extended menu", this is to define an extended menu which is not part of a hierarchical menu system, i.e. it is intended to denote that there is only a sole extended menu without any further sub-menus.

11. *Article 123(2) EPC*

11.1 The appellant has submitted that the feature of a "single extended menu" according to the amendments proposed in respect of the third to fifth auxiliary requests denotes a menu which is not part of a hierarchical menu system but rather a sole menu which

- lists all available menu items associated with the displayed page.
- 11.2 The board has reservations as to whether such an interpretation of this feature is supported by the originally filed application documents.
- 11.3 According to the originally filed description (cf. [0011]), the term "extended menu" as used in the context of the present application denotes a menu which "lists all available menu items at that particular level" (emphasis added), i.e. at the particular level of the menu hierarchy, whereas the term "short menu" denotes "a dynamic menu that is built by the user by selecting menu items from the corresponding extended menu to include in the short menu".
- 11.4 According to [0064] of the originally filed description, it is envisaged to implement the present invention in the context of "application programs ... that support hierarchical menus" (emphasis added) and to enable application developers "to design hierarchical menus, both extended and short menus, in a typical manner" (emphasis added). Likewise, [0120] of the description states that Fig. 8 illustrates an exemplary method for implementing a hierarchical menu on a computer device such as a PDA or other similar device having a small display screen.
- 11.5 The appellant referred to Fig. 6g as providing a basis for the aforementioned interpretation of the proposed amendments and submitted that said figure showed "a single extended menu" (622) which was not part of a hierarchical menu system. According to the appellant ellipses were used to indicate either that the text associated with that menu item had been truncated or

that actioning that item would cause a dialogue box rather than a submenu to open. The appellant further argued that although the "new" menu item of menu 622 had an arrow, a new message would not be associated with the displayed page and that menu 622 was therefore a "single extended menu" which did not form part of a hierarchical menu system.

- 11.6 The board is not convinced by the appellant's submissions in this regard and takes the view that the "new" item of menu 622 which has an arrow amounts to a disclosure of at least one menu item which can be used to invoke a further level of menu options associated with the displayed page.
- 11.7 Consequently, in the board's judgement, there is no clear and unambiguous disclosure of an embodiment of the invention in which the extended menu is a sole menu which is not part of a hierarchical menu system. The board therefore has reservations as to whether the proposed amendments, insofar as they are to be interpreted in the manner indicated by the appellant, are supported by the original application documents as required by Article 123(2) EPC.

12. *Inventive step*

- 12.1 Notwithstanding the aforementioned reservations concerning compliance with the requirements of Article 123(2) EPC, the board judges that, if the aforementioned "single extended menu" feature is interpreted in accordance with the appellant's submissions as denoting a sole menu which does not form part of a hierarchical menu system, said feature does not involve an inventive step.



- 12.2 Whether the extended menu is implemented as a "single extended menu" not forming part of a hierarchical menu system or as part of a hierarchical menu system comprising a parent menu and additional submenus is, in the board's judgement, a matter of design choice which lies within the routine competence of the skilled person.
- 12.3 In the absence of any identifiable disclosure in the originally filed application of an embodiment which explicitly excludes the extended menu from forming part of a hierarchical menu system, the board considers that any alleged advantages of implementing the extended menu as a sole menu which does not form part of a hierarchical menu system must be considered readily apparent to the skilled person based on his common general knowledge and routine design skills.
- 12.4 The board therefore concludes that, insofar as it might be considered compliant with the requirements of Article 123(2) EPC, the feature of a "single extended menu" which does not form part of a hierarchical menu system fails to provide a non-obvious technical contribution to the claimed subject-matter.
- 12.5 In view of the foregoing, the board judges that the third to fifth auxiliary requests are not allowable.

*Sixth auxiliary request*

13. *Observations re claim 1*

13.1 Claim 1 of the sixth auxiliary request differs from claim 1 of the main request in that it further includes the following additional feature group:

*"and the handheld electronic device (300a, 300b) transmitting information for the short menu (624) to, or receiving the information from, a central location that is separate from the handheld electronic device (300a, 300b) via a communication system."*

13.2 The additional feature group of claim 1 relates to an embodiment disclosed in [0101] of the application as originally filed according to which the information for the short menu is stored locally as well as at a central location.

13.3 According to the appellant, said additional feature group of claim 1 allows the user of the handheld electronic device to access the information for the short menu on multiple devices. This allows the user to experience, on different devices, identical short menus for which the items have a high probability of being selected - thereby improving the efficiency of user interactions with the devices.

13.4 As far as the board can determine, the subject-matter of the additional feature group of claim 1 was not present in the claims of any preceding request and it appears to have been taken from the description. Moreover, said feature group addresses a substantially new technical problem which had not been the subject of consideration during first instance proceedings and which had not been present in the formulation of the

appellant's case as initially submitted with the written statement setting out the grounds of appeal.

13.5 The board further has reservations as to whether the technical limitation implied by the expression "a central location that is separate from the handheld electronic device" as used in claim 1 is sufficiently clear to comply with the requirements of Article 84 EPC. Although it is evident from the disclosure that the handheld electronic device may be in communication with a network (cf. for example Fig. 11), there is no identifiable explanation in the description as to what the aforementioned expression is intended to denote in technical terms in the context of such a network environment.

13.6 It is additionally noted that in view of the fact that the amendments to claim 1 appear to relate to previously unclaimed subject-matter, the board has doubts as to whether said subject-matter has been included within the scope of the original search. Hence, a thorough assessment of the question of inventive step might require an additional search directed towards said previously unclaimed subject-matter.

14. *Article 13 RPBA*

14.1 According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion which shall be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Article 13(3) RPBA further states that 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.

- 14.2 Referring to the observations set forth under 13. above, it is apparent that the additional feature group of claim 1 of the sixth auxiliary request relates to previously unclaimed subject-matter and represents a significant amendment to the appellant's case filed at a relatively late stage of the proceedings.
- 14.3 In particular, the amendments to said claim raise a number of new issues which could not be discussed with the appellant during oral proceedings due to the fact that the appellant was not represented. The board concluded that, in the absence of the appellant's representative, it could not reasonably be expected to deal with these issues without an adjournment of the oral proceedings (cf. Article 13(3) RPBA).
- 14.4 In view of the foregoing, in particular having regard to the principle of procedural economy and taking into account the relatively late stage of the proceedings at which the sixth auxiliary request had been filed, the board decided to exercise its discretion not to admit said request into the proceedings (Articles 13(1) RPBA).

### *Conclusions*

15. In the absence of an allowable request the appeal must be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chair:



B. ter Heijden

A. Ritzka

Decision electronically authenticated