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**Datasheet for the decision
of 6 September 2013**

Case Number: T 0627/10 - 3.5.01

Application Number: 04103307.7

Publication Number: 1617359

IPC: G06Q 10/00, H04L 12/58,
H04M 1/725

Language of the proceedings: EN

Title of invention:
Sender-specified notification of incoming data messages

Applicant:
BlackBerry Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Amendments - added subject-matter (main and 1st to 3rd
auxiliary requests: yes / 4th auxiliary request: no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0627/10 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 6 September 2013

Appellant: BlackBerry Limited
(Applicant) 295 Phillip Street
Waterloo ON N2L 3W8 (CA)

Representative: Patel, Binesh
Barker Brettell LLP
100 Hagley Road
Edgbaston
Birmingham
B16 8QQ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 November 2009
refusing European patent application
No. 04103307.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: K. Bumés
Members: R. R. K. Zimmermann
P. Schmitz

Summary of Facts and Submissions

I. European patent application number 04103307.7 published as EP 1 617 359 A1 relates to a sender-specified notification of data messages in wireless data communications. Claim 1 as originally filed reads as follows:

"A method for controlling notification of an event to a user of a mobile device comprising:
evaluating notification data associated with an event to be notified to the user; and
notifying the user of the event in accordance with the result of the evaluation step."

II. In preparation of oral proceedings before the examining division, the applicant filed a main and an auxiliary set of claims, inter alia amending the independent claims 1 and 7, respectively 6 by introducing the feature

"evaluating (respectively, evaluate) any local notification data set at the mobile device, the local notification data set at the mobile device taking precedence over the notification data received with the received data communication, where the local notification data is present".

At the oral proceedings, which the applicant did not attend, the examining division found that the said feature was not disclosed in the application as originally filed and decided to refuse the application on grounds of Article 123(2) EPC, communicating the reasons in writing on 3 November 2011.

III. The appellant (applicant) lodged an appeal against the decision in its entirety on 5 January 2010 and filed a statement setting out the grounds of appeal including a main set and three auxiliary sets of claims on 8 March 2010. The appellant requested oral proceedings in the event that the appeal was unsuccessful. In support of the appeal, the appellant submitted that the said feature had a clear basis in the possible scenarios of delaying notification disclosed in the application as filed. The EPC did not require a literal disclosure; the teaching of the entire application was sufficient for the admissibility of amendments.

IV. In a communication of 11 June 2013 annexed to the summons to oral proceedings, the Board made certain preliminary observations on the merits of the case, which read as follows:

"3. The reasons given in the decision under appeal for added subject matter stand up to closer scrutiny. The feature that the local notification data set at the mobile device take precedence over the notification data received with the received data communication indeed lack any clear basis in the application as filed. The respective arguments provided by the appellant are not convincing. The lack of explicit disclosure of the feature in question is non-controversial. Moreover, however, the feature cannot be derived from the application as filed in a direct and unambiguous manner. The examining division was apparently right in its analysis that both, the local notification data as well as the notification parameter provided with the message, may specify a notification delay in an accumulative sense and that hence the claimed

precedence does not follow from the text passages cited from the application.

The example at page 12, line 20 ff. can easily be understood as a forced notification prevailing over a local notification parameter indicating delay of the notification. The last sentence of this paragraph may even mean that received notification parameters are not overridden by a local rule for forced notification.

The example at page 15, line 12 ff. ("Display Now") relates to the display of messages and does thus not indicate that the received notification parameter is overturned by local data 315.

Neither is the feature in question derivable from page 15, line 19 ff. which discloses the option to ignore notification delays in certain situations. The option described refers to overriding a received notification parameter providing a "courtesy delay". Other types of notification delays may remain effective. Therefore, a general precedence of local notification data (as a concept of conflict resolution) cannot be derived from the said text passage.

4. In summary, the precedence of the local notification data seems not to be in the application as filed. The limitation of the feature to cases of forced notification (2nd and 3rd auxiliary requests) does not solve the problem. All present claim requests are apparently affected by the deficiency of added subject matter. The appellant, therefore, should expect a negative decision on the appeal."

V. In a reply letter dated 17 July 2013, the appellant filed a 4th auxiliary set of claims. In the independent claims of this new request, claims 1 and 9, the feature in question (see above) is replaced by the definition

"evaluating (respectively, evaluate) a characteristic of the data communication and forcing (respectively, force) notification of the received data communication even if notification is otherwise to be delayed".

New dependent claims 7, 8, 14, and 15 have been added, defining embodiments where the characteristic indicates that the data communication is urgent and from a specified sender, respectively.

In a subsequent letter, the appellant advised the Board that it would not attend the oral proceedings.

The appellant's final requests were that the decision under appeal be set aside and that a patent be granted on the basis of the main request or auxiliary requests 1 to 3 filed with the statement setting out the grounds of appeal, or, based on auxiliary request 4 filed with letter of 17 July 2013, that the case be remitted to the examining division for further prosecution, if the Article 123(2) EPC objections were considered overcome.

VI. The Board announced the decision on the appeal in the oral proceedings held in absence of the appellant on 6 September 2013.

Reasons for the Decision

1. The admissible appeal is successful on the basis of the 4th auxiliary request filed by letter dated 17 July 2013.
2. The main request and auxiliary requests 1 to 3 infringe Article 123(2) EPC for the reasons set out in the Board's communication (see point IV above). Since the appellant has not filed any counterargument, those reasons still apply and accordingly the main request and the auxiliary requests 1 to 3 cannot be allowed.
3. Concerning the 4th auxiliary request, the Board finds that the subject matter of the amended independent claims as well as of the new dependent claims is disclosed in the application as originally filed and thus meets the requirements of Article 123(2) EPC.

The amendments are directly and unambiguously derivable from the application as filed. At page 10, line 20 ff. (also EP 1 617 359 A1, paragraph 0038, column 10, line 43 ff.), the application describes some specific embodiments of the invention as follows:

"Rules may also evaluate a characteristic of the event. For example notification may be forced when a message is urgent or from a specified sender, etc., even if notification is indicated to be otherwise delayed."

This is essentially the content of the amendments, except that the present claims do not refer to rules and events but to a method and a device, respectively, arranged to perform such an evaluation step on

"a characteristic of the data communication". It can be inferred from the application, however, that the discrepancy is just a variation of definition.

In paragraph 0038 cited above the term "event" is used substantially synonymous with data communication, e.g. the receipt of new e-mail etc.

The term "rule" is used to indicate a particular form of notification data or parameter defined by the user (see e.g. paragraphs 0038 and 45) and evaluated by the receiving mobile device upon the occurrence of an event (see e.g. figure 5 with paragraph 0048).

Therefore, a skilled person would clearly read the sentence "rules may ... evaluate a characteristic of the event" as meaning that the evaluation is actually a step of the method and a function of the mobile device, respectively, implemented for controlling the notification of an "event", i.e. a data communication in terms of the application.

4. The refusal of the application was only based on Article 123(2) EPC. This objection is overcome by auxiliary request 4. Since the examining division has not yet examined and decided upon the patentability requirements, the Board considers it appropriate to remit the case to the examining division for further prosecution (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

T. Buschek

K. Bumès