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**Datasheet for the decision
of 9 November 2012**

Case Number: T 2485/10 - 3.5.03

Application Number: 07397032.9

Publication Number: 2040497

IPC: H04W 24/00, H04W 4/00

Language of the proceedings: EN

Title of invention:
Tracking mobile communication devices

Applicant:
3 Step It Group Oy

Opponent:
-

Headword:
Tracking mobile communication devices/3 STEP IT GROUP OY

Relevant legal provisions:
EPC Art. 52(1), 54

Relevant legal provisions (EPC 1973):
-

Keyword:
"Novelty (sole request) - yes"
"Remittal - yes"

Decisions cited:
-

Catchword:
-



Case Number: T 2485/10 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 9 November 2012

Appellant: 3 Step It Group Oy
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 5 July 2010
refusing European patent application
No. 07397032.9 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: A. J. Madenach
R. Menapace

Summary of Facts and Submissions

I. The present appeal is against the decision of the examining division refusing European patent application No. 07397032.9 on the ground that, *inter alia*, claim 1 did not fulfil the requirement of novelty (Articles 52(1), 54(1) and (2) EPC) having regard to the disclosure of

D7: US 2002/0016817 A1.

II. The board understands from the notice of appeal and the grounds of appeal that the appellant's request was that the decision of the examining division be set aside and a patent be granted on the basis of the set of claims 1-20 of 20 April 2010, on which the decision of the examining division was based.

III. The board summoned the appellant to oral proceedings. In a communication accompanying the summons, the board gave its preliminary opinion.

IV. In preparation for the oral proceedings the appellant filed with letter dated 1 October 2012 amended pages 2 to 7 and 20 of a main request including amended claims 13 and 14, claims 1 to 20 of a first auxiliary request and amended pages 2 to 5 and claims 1 to 8 of a second auxiliary request.

V. Oral proceedings took place on 9 November 2012.

In the course of the oral proceedings, the appellant withdrew the main and first auxiliary requests and filed amended claims 1, 2 and 3 (part) of a revised second

auxiliary request, which became its sole request. It was requested that the decision under appeal be set aside and a patent be granted on the basis of the appellant's sole request, i.e. claim 1, 2 and claim 3 (part) as filed during the oral proceedings, and claim 3 (part) - 8 as filed as second auxiliary request on 1 October 2012.

After deliberation by the board, the chairman announced the board's decision.

VI. Independent claim 1 according to the sole request reads as follows:

"A method in a mobile telecommunication device (120) of a client, wherein the mobile telecommunication device (120) is used by a user and associated with a mobile telecommunication subscription, characterized by periodically:

producing (409) a status report comprising at least one detail about the mobile telecommunication device (120) and an identification of the subscription associated with the mobile telecommunication device (120), the at least one detail about the mobile telecommunication device comprising a combination of: information related to hardware of the mobile telecommunication device; and information related to software that is in use by the mobile telecommunication device; and

sending (411) the status report to a tracking element (110); wherein the method further comprises:

obtaining a (404) client identity associated with the client and indicating the client identity by the status report so as to facilitate correlating the status report to the client

defining (405) a reporting scheme either independently or based on contribution of the user;

following (407) the reporting scheme; and

performing the periodical producing and sending the status reports according to the reporting scheme (408, 409);

the method further comprising providing the mobile telecommunication device with a tracking application;

wherein the method is performed by the tracking application (402)."

Independent claim 3 essentially relates to the corresponding mobile telecommunication device.

Independent claim 8 essentially relates to a computer program whose code is configured to enable the mobile communication device to perform the method according to claim 1.

Reasons for the Decision

1. *Admissibility of the sole request*

- 1.1 The appellant's sole request was filed during the oral proceedings.

According to Article 12(4) RPBA, the board has the power to hold inadmissible requests which could have been presented in the first instance proceedings. According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. The discretion, in particular in the case of new amended requests, 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.

- 1.2 Claim 1 essentially comprises, in addition to the features of claim 1 considered by the examining division in the impugned decision, the steps of:

"defining (405) a reporting scheme either independently or based on contribution of the user;

following (407) the reporting scheme; and

performing the periodical producing and sending the status reports according to the reporting scheme (408, 409);

the method further comprising providing the mobile telecommunication device with a tracking application;

wherein the method is performed by the tracking application (402)."

These features derive from lines 20 to 22 of page 10 and lines 7 to 13 of page 11 of the original application.

These features comprise the complete sequence of steps required for producing and sending status reports according to a reporting scheme including the providing of the mobile telecommunication device with a tracking application. Hence, the specific combination of steps is originally disclosed and does not amount to an intermediate generalisation. The requirements of Article 123(2) EPC are therefore met.

The claim furthermore meets the requirement of clarity (Article 84 EPC).

For the reasons given at point 2 below, the sole request also overcomes the novelty objection on which the examining division's decision was based.

Considering that the refusal of the present application was only based on a novelty objection, the board decides to admit the request.

2. *Novelty (Article 52(1) and 54 EPC)*

2.1 The examining division considered D7 as the closest prior art. The board agrees.

2.2 D7 relates to a telecommunication network with a number of terminal devices or mobile radiotelephones (MS1 and MS2) and a central or service server (S) of a service

provider. The server includes a part for interrogating the hardware and software configurations of the terminal devices (see abstract and paragraphs [0024] and [0025]).

Hence, D7 relates to a telecommunication device of a client (*i.e.* the terminal devices or mobile radiotelephones) which is used by a user, and to a method of using it (see *e.g.* paragraph [0011]).

The terminal device is furthermore associated with a telecommunication subscription, as follows from paragraph [0004], last sentence.

According to D7 (see paragraph [0011]), at logon or periodically an interrogation of the current hardware and software configuration automatically occurs, and a code which identifies the current configuration is automatically transmitted. The board understands this to mean that a status report, which comprises details about the mobile telecommunication device, *i.e.* comprising a combination of information related to hardware of the mobile telecommunication device and information related to software that is in use by the mobile telecommunication device, is produced and is sent to the central server.

According to claim 1, the status report is sent to a tracking element. This is in essence what is done by the central server of D7. Hence, the central server of D7 corresponds to the tracking element of claim 1. This correspondence was, in fact, not disputed by the appellant.

Since information is sent to it and used by it, the central server (*i.e.* the tracking element in the language of claim 1) necessarily obtains the combination of information related to hardware of the mobile telecommunication device and information related to software that is in use by the mobile telecommunication device.

According to D7 a code which identifies the current hard- and software configuration of a mobile terminal is produced and transmitted at logon onto the network or periodically (paragraph [0011]). According to paragraph [0013] of D7, user rejections of downloaded offers are stored on the service server. This presupposes that the service server is informed about the user identity (meaning its subscriber or client identity) every time it is connected with the user, which, according to paragraph [0011] can occur on a regular basis.

This understanding is not contradicted by the second sentence of paragraph [0013] according to which the repeated offering of downloads which have meanwhile been realised is prevented by a configuration code in the mobile device identifying a corresponding software change in the mobile device.

The board sees in paragraph [0013] two different teachings: The first relates to user rejections of unwanted offers, the prevention of this necessitating user identification to the service server. The second relates to avoiding offers of software already installed, the prevention of which not does necessitate user identification, as has been pointed out by the appellant.

As a consequence, the board concludes that an "identification of the subscription associated with the mobile telecommunication device" is periodically produced and sent to the service server in D7, *i.e.* to the tracking element according to language of the claim.

- 2.3 The appellant disputes that D7 discloses the feature of "obtaining a (404) client identity associated with the client and indicating the client identity by the status report so as to facilitate correlating the status report to the client."

The appellant argues in this respect that the claims of the present invention imply a difference between a user, who is subscribed to a telecommunication network, and a client, who is a client of the tracking service and whose identity is indicated by the status report.

The board has difficulty in finding support for this argument in the wording of the claims. It is correct that during the obtaining step of claim 1 a "client identity" associated with the client is obtained. The client is the owner of the mobile device (first line of the claim). Further, according to the claim's producing step, a status report is produced comprising an identification of the subscription associated with the mobile device.

The question is, therefore, whether the client identity is different from the subscription identity as argued by the appellant.

First of all, the board notes that the appellant in its letter of 1 October 2012 (page 5/9, 3rd paragraph)

indicates that the term client **also** refers to a client of tracking services (emphasis by the board). This is understood in the context to mean that the term client has two meanings, the other being that of a client of the telecommunication service provider.

Turning in more detail to the interpretation of the term "client", the board notes that the application itself does not give any interpretation of the term. The board will therefore rely on what is usually understood by this term in the art of telecommunications. As the board sees it, a client is a person (physical or legal) who or which has a contract (a subscription) with a telecommunication service provider concerning services related to, in this case, a mobile terminal which is typically in the client's possession. Therefore, the term "client" would be typically be equated with a subscriber to services associated with a mobile device.

Therefore, the wording of the claims encompasses both the client identity and the identification of the subscription.

Such an interpretation is consistent with the discussion of the problems arising in the prior art, as discussed in the "Background of the Invention". The board observes that claims must be interpreted with the intention to make technical sense out of them and notes that "client identity" is a concept which was not originally part of the independent claims.

The appellant argues that if the report is sent via SMS, which normally contains the subscriber's identity, the inclusion of a similar identity in the report (see

paragraphs [0039] and [0040] of the published application document) would be superfluous.

The passages quoted by the appellant relate to a specific example in which the client and subscriber identities appear to be different. The claims are, however, more general and do not reflect this example.

2.4 D7 does not, however, show any of the features

"defining (405) a reporting scheme either independently or based on contribution of the user;

following (407) the reporting scheme; and

performing the periodical producing and sending the status reports according to the reporting scheme (408, 409);

the method further comprising providing the mobile telecommunication device with a tracking application;

wherein the method is performed by the tracking application (402)."

There is, in particular, no tracking application involved in the known method. In D7, the mobile device is merely interrogated and does not act on its own (abstract and paragraph [0011], line 10).

Hence, claim 1 is novel and fulfils the requirement of Article 54 EPC.

2.5 The further independent claims are essentially based on features corresponding to those of claim 1 and, therefore, also fulfil the requirement of Article 54 EPC.

2.6 The board considered the question of an inventive step in the light of D7 and the common general knowledge. The problem to be solved by the features recited at point 2.4 above can be considered to reside in allowing information reporting independently of an interrogation by a service server or tracking element in the language of claim 1. Assuming that it was obvious to the skilled person starting out from the network known from D7 to consider such a problem, in the board's opinion the skilled person's general knowledge would not have led them to modify the known network in such a way as to replace the interrogation unit 3 explicitly provided for the interrogation by the service server (paragraph [0025]) by a tracking application provided at the mobile telecommunication device.

The board therefore concludes that the subject-matter of claim 1 involves an inventive step having regard to the disclosure of D7 and the common general knowledge.

3. In view of the fact that the refusal was only based on a lack of novelty objection which for the reasons set out above has been overcome by amendment, the board considers it appropriate to remit the case to the first instance for further examination.

4. The board notes that independent claims 3 and 8 have not been modified in the same way as claim 1 in that a feature corresponding to "the method comprising providing the mobile telecommunication device with a

tracking application" is missing. The inclusion of such a feature might be necessary in the light of the requirements of Article 123(2) EPC (see point 1.2 above).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of the appellant's sole request.

The Registrar

The Chairman

G. Rauh

A. S. Clelland