

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 8 February 2016**

Case Number: T 0649/11 - 3.4.01

Application Number: 08152699.8

Publication Number: 1947590

IPC: G06K9/00, G06F3/033, G06F15/02

Language of the proceedings: EN

Title of invention:
Apparatus and method of input and finger print recognition on
a handheld electronic device

Applicant:
BlackBerry Limited

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 76(1), 84, 123(2)

Keyword:
Divisional application - added subject-matter (no) -
after amendment
Divisional application - double patenting (no)

Decisions cited:
G 0001/05, G 0001/06, T 0469/03, T 0877/06, T 1708/06,
T 1391/07, T 2139/08, T 2402/10

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0649/11 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 8 February 2016

Appellant: BlackBerry Limited
(Applicant) 2200 University Avenue East
Waterloo, ON N2K 0A7 (CA)

Representative: Fennell, Gareth Charles
Kilburn & Strode LLP
20 Red Lion Street
London WC1R 4PJ (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 19 October 2010
refusing European patent application No.
08152699.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Assi
Members: T. Zinke
J. Geschwind

Summary of Facts and Submissions

I. The appeal filed on 23 December 2010 lies from the decision of the examining division, posted on 19 October 2010, refusing European patent application No. 08 152 699.8 published with publication No. 1 947 590. This European patent application is a divisional application from the earlier European patent application No. 04 252 995.8, published with publication No. 1 480 157. The appeal fee was paid on 23 December 2010. The statement setting out the grounds of appeal was filed on 28 February 2011.

II. In its decision the examining division refused a procedural main request to withdraw the summons to oral proceedings, a first auxiliary request under Article 76(1) EPC in view of the term "*coplanar*" in claim 1, a second and a third auxiliary request due to lack of inventive step (Article 56 EPC) considering the teaching of document WO-A-2001/59558 (D1).

In an "*obiter dicta*" (cf. section III. of the decision) the examining division further stated that "*Even when disregarding the deficiency concerning the coplanarity aspect of claim 1 of the First Auxiliary Request, an inventive step reasoning similar with that presented for claim 1 of the Second Auxiliary Request applies. Claim 1 of the First Auxiliary Request lacks therefore inventive step (Art. 56 EPC).*"

III. With the notice of appeal the appellant (applicant) appealed this decision in its entirety.

IV. With the statement setting out the grounds of appeal the appellant requested that a patent be granted on the basis of claim sets according to a main request, a

first auxiliary request, a second auxiliary request, or a third auxiliary request, all filed together with the grounds of appeal. The claims of the main request, the first auxiliary request and the second auxiliary request corresponded to the first to third auxiliary requests as discussed in the appealed decision. The third auxiliary request was newly filed.

The appellant provided arguments with regard to Articles 76(1) and 56 EPC as well as Article 123(2) EPC.

Moreover, as a further auxiliary request, the appellant requested oral proceedings.

- V. By summons of 22 July 2015 the appellant was summonsed to oral proceedings due to take place on 12 October 2015. A communication under Article 15(1) RPBA was issued on 11 August 2015 drawing attention to the issues to be discussed during oral proceedings.

In particular, the Board raised doubts that the terms "*planar*" and "*coplanar*" as claimed according to all claim sets then on file were originally disclosed in the earlier application. The Board further commented that other issues, for example inventive step and double patenting with regard to the meanwhile granted patent EP-B-1 480 157 (cf. decision T 2139/08) based on the earlier European patent application would be discussed, if necessary.

- VI. With letter dated 21 September 2015, the appellant filed amended claim sets according to a revised main request, a revised second auxiliary request and a revised third auxiliary request. The appellant did not formally withdraw the requests filed with the grounds

of appeal and asked that the revised requests be considered in the given order before the requests filed with the grounds of appeal.

The appellant noted: *"In the enclosed requests the terms 'planar' and 'coplanar' have been deleted to address the Article 76(1) issue. No other amendments have been made."*

Further, the appellant provided arguments with regard to double patenting, novelty and inventive step for the revised requests.

- VII. In a phone conversation on 5 October 2015, the attention of the appellant was drawn to the preliminary position of the Board that the claims of the revised main request were considered to overcome the objections raised in the Board's communication of 11 August 2015. However, minor issues still had to be considered; in particular, reference signs should be included into the claims and dependent claims 4 and 5 should be corrected, since they claimed an *"apparatus"* and not an *"electronic handheld device"* as claim 3, to which they referred back.
- VIII. With letter dated 6 October 2015, the appellant filed a further revised claim set and stated: *"On the understanding that this application can be granted based on the replacement set of claims filed herewith, we withdraw the other requests on file and request grant of this application based on the replacement set of claims."*
- IX. The oral proceedings appointed for 12 October 2015 were cancelled by letter dated 12 October 2015 and faxed to the appellant's representative on 7 October 2015.

X. Claim 1 of the appellant's request reads:

"1. An apparatus for input and fingerprint recognition comprising:

a touch surface (215, 315, 415) comprising a first region and a second region, the second region (220, 320, 420) being distinct from the first region and occupying less than an entire portion of a total surface area of the touch surface (215, 315, 415); and,

a data processor coupled to the touch surface (215, 315, 415), the data processor being configured to selectively operate the touch surface (215, 315, 415) in a touch input mode or a fingerprint detection mode, in the touch input mode the data processor being configured to operate the second region (220, 320, 420) at a first resolution comparable to that of the first region to detect a touch input anywhere on the touch surface (215, 315, 415), in the fingerprint detection mode the data processor being configured to operate the second region (220, 320, 420) at a higher resolution than the first resolution to detect a fingerprint on the second region (220, 320, 420)."

Claim 4 of the appellant's request reads:

"4. A handheld electronic device comprising:

a housing;

a display screen; and

an apparatus for input and fingerprint recognition according to claim 1 or claim 2, wherein the display screen and the touch surface (215, 315, 415) are disposed within the housing, the display screen being disposed at one side of the housing, the touch surface (215, 315, 415) being disposed at another side of the housing opposite to the one side."

Claim 7 of the appellant's request reads:

"7. A method of input and fingerprint recognition comprising:

operating a touch surface (215, 315, 415) at a first resolution to detect a touch input anywhere on the touch surface (215, 315, 415), the touch surface (215, 315, 415) comprising a first region and a second region (220, 320, 420), the second region (220, 320, 420) being distinct from the first region and occupying less than an entire portion of a total surface area of the touch surface (215, 315, 415); and

operating the second region (220, 320, 420) at a higher resolution than the first resolution to detect a fingerprint on the second region (220, 320, 420)."

Claims 2 to 3, 5, 6 and 8 depend respectively on claims 1, 4 and 7.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) EPC*

The removal of the terms "*planar*" and "*coplanar*" from the wording of the claims respects Article 123(2) EPC, since the aspects of "*planarity*" or "*coplanarity*" were not mentioned in the application as filed.

3. *Article 76(1) EPC*

Since the claim wording no longer includes the terms "*planar*" and "*coplanar*", the objections as expressed in the decision with regard to Article 76(1) EPC are overcome. Hence, the Board is satisfied that Article 76(1) EPC is respected.

4. *Article 84 EPC*

The Board is satisfied that the requirements of Article 84 EPC are met.

5. *Novelty (Article 54 EPC)*

5.1 Already in its decision the examining division concluded that "*any potential difference over D1 resides in the aspect of distinctness of the first and second regions*" with regard to the then pending second auxiliary request (cf. section II.4.1).

5.2 In the decision T 2139/08 this Board in a different composition dealing with the earlier European patent application No. 04 252 995.8 also discussed the aspect of "*distinctness*" and concluded (section 5.): "*While it is acknowledged that the mere reference to 'distinct portions' in the claim's wording allows a broad interpretation of the claimed subject-matter and would also apply to the case of one portion completely overlapping the other one, it nevertheless implies that the two portions be somehow distinguishable, whether structurally or functionally. There is, however, no indication to be found in D1 that certain areas would be activated according to fingerprint recognition mode while other portions, distinguishable from the first ones, would be controlled according to a touch mode. It*

is therefore impossible in the absence of any structural differences between various areas of the touch pad, or any functional differences as to the manner various areas of the touch pad would possibly be controlled to identify distinct portions as actually required by the claim's wording."

5.3 The Board in its current composition sees no reason to deviate from this assessment. Hence, the subject-matter of claims 1, 4 and 7 is considered to be novel as compared to document D1.

6. *Inventive step (Article 56 EPC)*

6.1 The apparatus as defined in claim 1 differs from the known device according to D1 in that the same touch surface includes two distinct regions, wherein the second region occupies less than an entire portion of a total surface area of the touch surface.

6.2 Faced with the problem of making the touch pad of document D1 more cost-effective, the skilled person would consider documents relating to touch pads of a similar construction adapted for use in fingerprint reading systems.

6.3 However, none of the other available prior art documents suggest to adapt the touch surface of a handheld device by providing such a surface with two distinct regions, wherein the fingerprint region may be controlled according to different resolution modes.

6.4 For these reasons, the subject-matter of claim 1 involves an inventive step in the sense of Article 56 EPC. The same finding applies to the device of claim 4 and the method of claim 7 which explicitly includes the

step of providing a touch surface with distinct touch resolution regions.

7. *Double Patenting*

7.1 In decisions G 0001/05 (OJ EPO 2008, 271) and G 0001/06 (OJ EPO 2008, 307) (cf. respective sections 13.4) the Enlarged Board of Appeal stated *"The Board accepts that the principle of prohibition of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor. Therefore the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application claims the same subject-matter as a pending parent application or a granted parent patent."*

7.2 This requirement of *"same subject-matter"* was followed in the established case law of the technical boards of appeal regarding the question of *"double patenting"* (see e.g. T 1391/07, point 2.5 of the reasons; T 0877/06, point 5 of the reasons; T 1708/06, point 6 of the reasons; T 0469/03, point 4.2 of the reasons; T 2402/10, point 8. of the reasons).

7.3 All the claims of the granted European patent EP-B-1 480 157 include the feature that the touch resolution portion and the fingerprint resolution portion are integral to the touch surface, which is not a feature in any of the claims of the revised main request in the present divisional application.

7.4 On the other hand, all claims of the present revised main request include the feature that the second region occupies less than an entire portion of a total surface area of the touch surface, which is not a feature in any of the claims of EP-B-1 480 157.

7.5 Since EP-B-1 480 157 and the present divisional application do not "*claim the same subject-matter*", the question of double patenting does not arise.

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 with the order to grant a patent on the basis of the revised main request as filed by letter of 6 October 2015 and a description to be adapted thereto.

The Registrar:

The Chairman:



R. Schumacher

G. Assi

Decision electronically authenticated