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Datasheet for the decision
of 12 December 2014

Case Number:	T 0993/11 - 3.5.05
Application Number:	07802544.2
Publication Number:	1946503
IPC:	H04L12/58, H04Q7/22
Language of the proceedings:	EN

Title of invention:
MESSAGING SYSTEM

Applicant:
Apple Inc.

Headword:
Messaging system/APPLE

Relevant legal provisions:
EPC Art. 111(1), 123(2)
RPBA Art. 13(1)

Keyword:
Amendments - added subject-matter (yes)
Late-filed auxiliary requests -
 justification for late filing (yes)
Appeal decision -
 remittal to the department of first instance (yes)

Decisions cited:

Catchword:

Case Number: **T 0993/11 - 3.5.05**

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 12 December 2014

Appellant:
(Applicant)

Apple Inc.
1 Infinite Loop
Cupertino, CA 95014 (US)

Representative:

Barton, Russell Glen
Withers & Rogers LLP
4 More London Riverside
London, SE1 2AU (GB)

Decision under appeal:
Decision of the Examining Division of the
European Patent Office posted on 29 December
2010 refusing European patent application No.
07802544.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chair	A. Ritzka
Members:	M. Höhn
	F. Blumer

Summary of Facts and Submissions

I.   This appeal is against the decision of the examining
        division, posted on 29 December 2010, refusing European
        patent application No. 07802544.2 on the grounds of
        Article 123(2) EPC and lack of inventive step (Article
        56 EPC) with regard to prior-art publications:

        D1:   WO 01/55892 A1 and
        D3:   EP 1239395 A2.

II.   The notice of appeal was received on 28 February 2012.
        The appeal fee was paid on the same day. The statement
        setting out the grounds of appeal was received on 28
        April 2012. The appellant requested that the appealed
        decision be set aside and that a patent be granted on
        the basis of the main request or the auxiliary request,
        both filed with the statement setting out the grounds
        of appeal. Oral proceedings were requested on an
        auxiliary basis.

III.   With a communication dated 12 September 2014 the board
        summoned the appellant to oral proceedings on 12
        December 2014. In an annex to the summons the board
        expressed its preliminary opinion that both requests
        did not appear to fulfil the requirements of Article
        123(2) EPC and furthermore appeared to lack an
        inventive step (Article 56 EPC).

IV.   By letter dated 12 November 2014 the appellant
        submitted a set of claims according to a second
        auxiliary request supported by arguments in favour of
        an antecedent basis and inventive step for all requests
        on file.

V.   By letter dated 5 December 2014 the board was informed
        that the appellant would not be attending the oral
        proceedings.

VI.   The appellant requested in writing that the decision
        under appeal be set aside and that a patent be granted
        on the basis of the main request, or, subsidiarily, on
        the basis of any of the first or second auxiliary
        requests, the main request and first auxiliary request
        as filed with letter dated 28 April 2011 (the latter
        then filed as "Auxiliary Request"), or the second
        auxiliary request as filed with letter dated
        12 November 2014.

VII.   Independent claim 1 according to the main request reads
        as follows:

        "1. A method of selecting a recipient of a store-and-
        forward message on the basis of data identifying access
        to previously transmitted messages, said message being
        one of an SMS, MMS or WAP message, and comprising
        content data (501, 503) for display within a display
        area of a receiving mobile terminal and control data
        comprising data indicative of a user selectable portion
        within the display area, the method comprising:
        receiving content data (C) having one of a plurality of
        different types for use in creating a said message;
        accessing (S6.3, S6.9) tracking data corresponding to a
        previously transmitted message (M1) containing content
        data of a given type, the tracking data being
        indicative of selection of a said user selectable
        portion upon display thereof at a said receiving mobile
        terminal; and
        selecting a recipient of the message on the basis of
        the received content data and the tracking data,

wherein the control data associated with the user
selectable portion comprises instructions for the
receiving mobile terminal, said instructions causing
the receiving mobile terminal to transmit a response
store-and-forward message (M2) upon selection of the
user selectable portion by the recipient, said response
store-and-forward message being used to update tracking
data for the previously transmitted message, said
response store-and-forward message being one of SMS or
WAP message, and
wherein the tracking data is updated on the basis of
data identifying the receiving mobile terminal, said
data identifying the receiving mobile terminal having
been derived from the response store-and-forward
message (M2)."

Independent claim 1 according to the first auxiliary
request reads as follows:

"1. A method of selecting a recipient of a store-and-
forward message on the basis of data identifying access
to previously transmitted messages, said message being
an SMS message, and comprising content data (501, 503)
for display within a display area of a receiving mobile
terminal and control data comprising data indicative of
a user selectable portion within the display area, the
method comprising:
receiving content data (C) having one of a plurality of
different types for use in creating a said message;
accessing (S6.3, S6.9) tracking data corresponding to a
previously transmitted message (M1) containing content
data of a given type, the tracking data being
indicative of selection of a said user selectable
portion upon display thereof at a said receiving mobile
terminal; and

selecting a recipient of the message on the basis of
the received content data and the tracking data,
wherein the control data associated with the user
selectable portion comprises instructions for the
receiving mobile terminal, said instructions causing a
software application on the receiving mobile terminal
to transmit a response store-and-forward message (M2)
upon selection of the user selectable portion by the
recipient, said response store-and-forward message
being used to update tracking data for the previously
transmitted message, said response store-and-forward
message is an SMS message,
wherein said instructions cause the software
application to access said previously transmitted
message in order to retrieve data identifying said
content data, and thereafter generating said response
store-and-forward message comprising said retrieved
data, and
wherein the tracking data is updated on the basis of
data identifying the receiving mobile terminal, said
data identifying the receiving mobile terminal having
been derived from the response store-and-forward
message (M2)."

Independent claim 1 according to the second auxiliary
request reads as follows:

"1. A method of selecting a recipient of a store-and-
forward message on the basis of data identifying access
to previously transmitted messages, said message being
one of an SMS, MMS or WAP message, and comprising
content data (501, 503) for display within a display
area of a receiving mobile terminal and control data
comprising data indicative of a user selectable portion
within the display area, the method comprising:

receiving content data (C) having one of a plurality of
different types for use in creating a said message;
identifying (S6.1) attributes of the received content
data (C);
querying (S6.3, S6.5) a database for previously
transmitted messages having content with one or more
attributes which match the identified attributes of the
received content data;
generating (S6.7) a list of content identifiers
corresponding to said previously transmitted messages
having content with one or more attributes which match
the identified attributes of the received content data,
said list being ranked in accordance with the
correlation between the attributes of the content in
said previously transmitted messages and the identified
attributes of the received content data;
accessing (S6.9) tracking data corresponding to the
previously transmitted messages (M1) in said list
containing content data of a given type, the tracking
data being indicative of selection of a said user
selectable portion upon display thereof at a said
receiving mobile terminal; and
selecting a recipient of the message on the basis of
the received content data and the tracking data,
wherein the control data associated with the user
selectable portion comprises instructions for the
receiving mobile terminal, said instructions causing
the receiving mobile terminal to transmit a response
message (M2) upon selection of the user selectable
portion by the recipient, said response message being
used to update tracking data for the previously
transmitted message, and
wherein the tracking data is updated on the basis of
data identifying the receiving mobile terminal, said
data identifying the receiving mobile terminal having
been derived from the response message (M2)."

VIII. Oral proceedings were held on 12 December 2014. After
       due consideration of the appellant's written arguments
       the chair announced the decision.

Reasons for the Decision

1.   Admissibility

       The appeal complies with Articles 106 to 108 EPC (see
       Facts and Submissions, point II above). It is therefore
       admissible.

2.   Non-attendance at oral proceedings

       By letter dated 5 December 2014 the board was informed
       that the appellant would not be attending the oral
       proceedings. The board nonetheless considered it
       expedient to maintain the date set for oral
       proceedings. Nobody attended on behalf of the
       appellant.

       Article 15(3) RPBA stipulates that the board is not
       obliged to delay any step in the proceedings, including
       its decision, by reason only of the absence at the oral
       proceedings of any party duly summoned who may then be
       treated as relying only on its written case.

       Hence, the board was in a position to announce a
       decision at the end of the oral proceedings.

Main request

3.   Article 123(2) EPC

3.1   In the board's judgement, no antecedent basis is found
        in the application as filed for the feature "response
        store-and-forward message being one of SMS or WAP
        message" of claim 1.

3.2   While a direct and unambiguous disclosure is found that
        the messages M1 sent to a user can be store-and-forward
        messages such as SMS, MMS and WAP (see e.g. page 11,
        lines 31 and 32, or page 12, line 9 of the
        application), no such explicit disclosure is found for
        the response messages M2. Whenever it is referred to
        store-and-forward messages being one of SMS or WAP
        message, no direct reference to messages M2 is found.

        None of the passages referred to by the appellant (see
        page 2, section "Amendments" of the statement setting
        out the grounds of appeal; page 2 of the letter dated
        12 November 2014) provides for a direct and unambiguous
        disclosure for the feature objected to above as
        required under Article 123(2) EPC. In particular, the
        passage on page 7, lines 9 to 12 of the description as
        filed and Figure 1, which were referred to, disclose a
        system, i.e. an arrangement with network components,
        "suitable for delivery of WAP messages". It does not
        directly and unambiguously disclose what kind of
        messages are used for the response message M2 as
        claimed according to claim 1. Claim 1 being a method
        type claim goes beyond merely being suitable for
        delivery of WAP or SMS messages. The mere possibility
        of sending WAP or SMS messages for response messages M2
        is not considered to be a sufficient antecedent basis

for a corresponding method step as claimed in method
claim 1.

In particular, since this feature according to the
appellant's arguments is to be considered as
establishing an inventive step over the prior art on
record, such a selection among several possibilities of
a general disclosure needs to be clearly disclosed.
However, the board does not find such a direct and
unambiguous disclosure for the response message M2
being advantageous if being of a WAP or SMS type.

3.3   Claim 1 therefore does not fulfil the requirements of
        Article 123(2) EPC.

        First auxiliary request

4.   Claim 1 of this request is limited to the use of SMS
        messages and further comprises the feature of a
        software application wherein instructions cause the
        software application to access the previously
        transmitted message M1 in order to retrieve data
        identifying the content data, and thereafter generating
        the response store-and-forward message M2 comprising
        said retrieved data.

4.1   Article 123(2) EPC

        Claim 1 according to this request still comprises the
        feature the "response store-and-forward message is an
        SMS message". The objection raised in point 3 above
        therefore applies, *mutatis mutandis*, to independent
        claim 1 of this request as far as the response message
        M2 being an SMS message is concerned.

4.2   Claim 1 of this request therefore does not fulfil the
        requirements of Article 123(2) EPC either.

        Second auxiliary request

5.   Admissibility of the request

5.1   This request was filed in reaction to the board's
        objections raised in the annex to the summons for oral
        proceedings in order to overcome those objections.
        While the decision under appeal was already based on
        objections under Articles 123(2) and 56 EPC, it has to
        be noted that, regarding its objection for lack of an
        inventive step, the board did not concur with the
        decision under appeal that D1 discloses response
        messages in form of an email (see point 5.3 in the
        annex to the summons and point 2.5 on page 5 of the
        decision under appeal). Thus, the objection based on
        Article 56 EPC raised by the board was a different line
        of argumentation to which the appellant could react for
        the first time in response to the annex to the summons
        for oral proceedings.

5.2   Although it was late-filed, the board therefore admits
        this request into the proceedings in accordance with
        Article 13(1) RPBA.

6.   Article 123(2) EPC

6.1   Claims 1 and 14 according to this request no longer
        comprise the feature that the response store-and-
        forward message is a WAP or an SMS message. The
        objection raised in point 3 above is therefore overcome
        by the amendments to independent claims 1 and 14 of
        this request as far as the response message M2 is
        concerned.

6.2   The added features concerning the specification of the
       mechanism for categorising by attributes are considered
       to be originally disclosed in Figure 6 and on page 13,
       lines 1 to 22 as filed (see reference to steps S6.1,
       S6.3, S6.5, S6.7 and S6.9).

6.3   Claims 1 and 14 of this request therefore fulfil the
       requirements of Article 123(2) EPC.

7.   Remittal

7.1   According to Article 111(1) EPC the board may exercise
       any power within the competence of the examining
       division (which was responsible for the decision under
       appeal) or remit the case to that department for
       further prosecution. It is thus at the board's
       discretion whether it examines and decides the case or
       whether it remits the case to the first instance.

7.2   Since the features added by amendment were not claimed
       before, but were taken from the description of the
       present application, the appellant has created a fresh
       case in the appeal proceedings. The board cannot know
       whether the features added by amendment were covered by
       the search for prior art carried out in the first
       instance proceedings. In the light of the uncertainty
       whether the prior art on file is complete for assessing
       novelty and inventive step, the board therefore
       considers that in the present case remittal of the case
       to the department of first instance (Article 111(1)
       EPC) on the basis of the second auxiliary request is
       the more appropriate course of action.

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 on the basis of claims 1-27 submitted as Second Auxiliary Request with letter dated 12 November 2014.

The Registrar: The Chair:

K. Götz-Wein   A. Ritzka

Decision electronically authenticated