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**Datasheet for the decision
of 14 January 2015**

Case Number: T 1399/11 - 3.5.03

Application Number: 06021759.3

Publication Number: 1814288

IPC: H04M1/2745, H04M1/725

Language of the proceedings: EN

Title of invention:

Transmission of database records between mobile communication terminals

Applicant:

LG Electronics Inc.

Headword:

Transmission of database records/LG

Relevant legal provisions:

EPC Art. 84

Keyword:

Clarity (all requests) - no

Decisions cited:

T 0728/98

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1399/11 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 14 January 2015

Appellant: LG Electronics Inc.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 1 February 2011
refusing European patent application No.
06021759.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman F. van der Voort
Members: T. Snell
R. Cramer

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division refusing European patent application No. 06021759.3 (publication No. EP 1 814 288 A1).

The refusal was based on the ground of lack of novelty pursuant to Article 52(1) EPC in combination with Article 54 EPC.

- II. The applicant filed a notice of appeal against the above decision. New sets of claims of a main request and an auxiliary request were subsequently filed with the statement of grounds of appeal.

Oral proceedings were conditionally requested.

- III. In a communication accompanying a summons to oral proceedings, the board raised matters concerned with Articles 123(2) and 84 EPC. In addition, the board gave a preliminary opinion that the subject-matter of claims 1 and 2 of both requests did not involve an inventive step (Articles 52(1) and 56 EPC).

- IV. In response to the board's communication, the appellant filed new claims of a main request and of auxiliary requests 1 and 2.

- V. Oral proceedings took place on 14 January 2015

During the oral proceedings the appellant filed a new main request ("2nd version") to replace the main request on file.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis

of the claims of the main request as filed during the oral proceedings, or on the basis of the claims of either auxiliary request 1 or auxiliary request 2, both requests as filed with the letter dated 12 December 2014.

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

VI. Claim 1 of the **main request** reads as follows:

"A method for use in a system comprising a first mobile communication terminal and a second mobile communication terminal, the method being for sharing a phone number stored in the first mobile communication terminal to the second mobile communication terminal, the method comprising:

- providing (S302), by the first mobile communication terminal, a message window for inputting a composed Short Message Service, SMS, message to be transmitted to the second mobile communication terminal;
- inputting (S314), by the first mobile communication terminal, a search condition for searching a phone number to be transmitted, the search condition comprising a search string;
- retrieving (S316), by the first mobile communication terminal, at least one phone number from a database in the first mobile communication terminal matching the search condition;
- selecting (S318), by the first mobile communication terminal, one of the phone numbers from the retrieved at least one phone number by way of interacting, by the user, with a provided menu to select the retrieved phone number being a phone number corresponding to a specific third mobile communication terminal;
- including (S320), by the first mobile communication

terminal, the selected phone number corresponding to the specific third mobile communication terminal, by way of interacting with the user interface of the first mobile communication terminal, in a portion of the message associated with the sender's phone number of the composed SMS message, wherein the portion of the message associated with the sender's phone number, instead of including the sending terminal's identification number, includes the phone number corresponding to the specific third mobile communication terminal;

- transmitting (S322), by the first mobile communication terminal, the composed SMS message to the second mobile communication terminal,

- receiving, by the second mobile communication terminal, the transmitted SMS message including the phone number corresponding to the specific third mobile communication terminal in the portion of the message associated with the sender's phone number in the received SMS message; and

- i) selecting and storing, by the second mobile communication terminal, the phone number corresponding to the specific third mobile communication terminal in a memory of the second mobile communication terminal or
ii) replying, by the second mobile communication terminal, to the third mobile communication terminal."

VII. Claim 1 of auxiliary request 1 reads as follows:

"A method for transmitting a phone number stored in a first mobile communication terminal to a second mobile communication terminal, the method comprising:

- providing (S302) a message window for inputting a composed message to be transmitted to the second mobile communication terminal;

- inputting (S314) a search condition for searching a

phone number to be transmitted, the search condition comprising a search string;

- retrieving (S316) at least one phone number from a database in the first mobile communication terminal matching the search condition;
- selecting (S318) one of the phone numbers from the retrieved at least one phone number by way of interacting, by the user, with a provided menu to select the retrieved phone number being a phone number corresponding to a specific third mobile communication terminal;
- displaying (S320) the selected phone number corresponding to the specific third mobile communication terminal by way of interacting with the user interface of the first mobile communication terminal such that the selected phone number is included [*sic*] the message sender information section of the composed message; and
- transmitting (S322) the composed message to the second mobile communication terminal, wherein the selected phone number is included in the message sender information section of the transmitted message such that the second mobile communication terminal retrieves the phone number corresponding to the specific third mobile communication terminal from the message sender information section in the received message upon receiving the message from the first mobile communication terminal".

VIII. Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 in that the following feature is added to the end of the claim:

", wherein the second terminal is enabled to directly make a phone call to the retrieved phone number or to

store the phone number without having to key in the phone number".

Reasons for the Decision

1. *Main request - claim 1 - clarity (Article 84 EPC)*

1.1 Claim 1 includes the following feature:

"including (S320), by the first mobile communication terminal, the selected phone number corresponding to the specific third mobile communication terminal, by way of interacting with the user interface of the first mobile communication terminal, in a portion of the message associated with the sender's phone number of the composed SMS message, wherein the portion of the message associated with the sender's phone number, instead of including the sending terminal's identification number, includes the phone number corresponding to the specific third mobile communication terminal" (board's underlining).

1.2 In the board's view, this feature is unclear for the following reasons.

1.3 Firstly, the board notes that this feature of the claim is concerned with a mobile-originated SMS message, i.e. a message composed and transmitted from a mobile terminal. The board is of the view that a mobile-originated SMS message does not ordinarily include a field reserved for the sender's phone number. In accordance with the understanding of the board, the sender's phone number is added to the header of the SMS message by the network. Consequently, only a mobile-terminated SMS message includes a field reserved for the sender's phone number. At the oral proceedings, the

appellant did not challenge the board's understanding of the way SMS messages are formatted for transmission. It follows that the term "a portion of the message associated with the sender's phone number" cannot refer to a standard field included in a mobile-originated SMS message, e.g. part of the header.

1.4 Consequently, it is unclear what portion of the SMS message is being referred to. In particular, in the board's view, it is ambiguous whether or not the expression "a portion of the message associated with the sender's phone number of the composed SMS message", together with the wording "wherein the portion of the message associated with the sender's phone number, instead of including the sending terminal's identification number, includes the phone number corresponding to the specific third mobile communication terminal", embraces a portion of text included in the main body of the SMS (consider, e.g., a text message composed by the user including, instead of the wording "My number is xxxx", the wording "Steve Dean's number is yyyy").

1.5 The board notes further that the appellant's arguments in support of novelty and inventive step require an interpretation of the wording "a portion of the message associated with the sender's phone number of the composed SMS message" as not embracing a text portion within the main body of the message (cf. e.g. page 10 of the letter dated 12 December 2014, lines 15-29). It follows that this feature is essential for delimiting the invention over the prior art. Although the appellant argued at the oral proceedings that the skilled person would not ordinarily understand the claim as currently worded to embrace using the main body of the SMS message, the board takes the view that

a broader interpretation cannot be fairly excluded. Consequently, the matter for which protection is sought cannot be unequivocally determined.

1.6 The board thereby follows T 728/98 (OJ EPO 2001, 319), in which the following was observed with regard to the requirement of clarity: "Article 84 in combination with Rule 29(1) EPC [1973, cf. Rule 43(1) EPC] stipulates the requirements that the claims shall be clear and define the matter for which protection is sought in terms of the technical features of the invention. Those requirements serve the purpose of ensuring that the public is not left in any doubt as to which subject-matter is covered by a particular claim and which is not. From this principle of legal certainty, in the Board's judgement, it follows that a claim cannot be considered clear in the sense of Article 84 EPC if it does not unambiguously allow this distinction to be made (see decisions G 2/88, OJ EPO 1990, 93, point 2.5 of the reasons; T 337/95, OJ EPO 1996, 628, points 2.2 to 2.5 of the reasons). A claim comprising an unclear technical feature, hence, entails doubts as to the subject-matter covered by that claim. This applies all the more if the unclear feature is essential with respect to the invention in the sense that it is designed for delimiting the subject-matter claimed from the prior art, thereby giving rise to uncertainty as to whether or not the subject-matter claimed is anticipated. Thus, it is for the reason of lack of legal certainty, that such a claim is not accepted to be clear in the sense of Article 84 EPC." (cf. point 3.1 of the reasons).

1.7 The board thus concludes that claim 1 of the main request is not clear within the meaning of Article 84 EPC. The main request is therefore not allowable.

2. *Auxiliary request 1 - claim 1 - clarity (Article 84 EPC)*
- 2.1 Claim 1 of auxiliary requests 1 and 2 respectively includes the feature "wherein the selected phone number is included in the message sender information section of the transmitted message", i.e., inter alia, the term "a portion of the message associated with the sender's phone number" used in claim 1 of the main request has been replaced by "the message sender information section of the transmitted message".
- 2.2 The board notes that the claimed limitations here are even more vague, since claim 1 of auxiliary request 1 embraces any kind of message, instead of being limited to SMS. Analogous to the unclear expression used in claim 1 of the main request, the board notes that the term "message sender information section" does not have an unequivocally clear meaning in the art, all the more so in view of the range of message types embraced by the claim. In particular, in the board's view, it is not clearly excluded that the "message sender information section" could be a portion of the text body of the message. It therefore follows that the same considerations apply as given in connection with claim 1 of the main request.
- 2.3 The appellant did not offer any specific arguments in respect of the clarity of claim 1 of auxiliary request 1.
- 2.4 The board concludes that claim 1 of auxiliary request 1 is not clear (Article 84 EPC). Auxiliary request 1 is therefore not allowable either.

3. *Auxiliary request 2 - claim 1 - clarity*

Claim 1 of auxiliary request 2 includes the same expression "message sender information section" as used in claim 1 of auxiliary request 1. Consequently, the considerations set out above with respect to clarity apply, *mutatis mutandis* (Article 84 EPC). The appellant did not argue otherwise.

Auxiliary request 2 is therefore not allowable either.

4. *Conclusion*

As there is no allowable request, it follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Magliano

F. van der Voort

Decision electronically authenticated