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**Datasheet for the decision  
of 10 January 2017**

**Case Number:** T 2478/12 - 3.5.03

**Application Number:** 08705751.9

**Publication Number:** 2106652

**IPC:** H04M1/247, G06F3/048

**Language of the proceedings:** EN

**Title of invention:**

PORTABLE ELECTRONIC DEVICE, METHOD, AND GRAPHICAL USER  
INTERFACE FOR DISPLAYING ELECTRONIC LISTS AND DOCUMENTS

**Applicant:**

APPLE INC.

**Headword:**

Scrolling method for touch-screen device/APPLE

**Relevant legal provisions:**

EPC Art. 56

**Keyword:**

Inventive step - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 2478/12 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 10 January 2017**

**Appellant:** APPLE INC.  
(Applicant) 1 Infinite Loop  
Cupertino, CA 95014 (US)

**Representative:** Gillard, Matthew Paul  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 13 July 2012 refusing European patent application No. 08705751.9 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** F. van der Voort  
**Members:** T. Snell  
S. Fernández de Córdoba

## **Summary of Facts and Submissions**

I. This appeal is against the decision of the examining division refusing European patent application No. 08705751.9, with international publication number WO 2008/086319 A.

The refusal was based on the ground that the subject-matter of claim 1 of both a main request and an auxiliary request lacked an inventive step.

Claim 1 of the auxiliary request, which is the claim most relevant to these appeal proceedings, was refused by the examining division having regard to disclosures of the following three documents:

D2: US 6 181 316 B1;  
D4: US 2004/0021676 A1; and  
D7: WO 2006/045530 A2

The board's decision also refers to the following document cited during the examination procedure:

D3: US 6 570 594 B1

II. The appellant filed an appeal against the above decision. Claims of respectively a main request and three auxiliary requests were filed with the statement of grounds of appeal.

III. In a communication accompanying a summons to oral proceedings, the board raised issues concerned with clarity, added-subject matter and inventive step, the latter in particular having regard to documents D3 and D4.

IV. Together with a letter of response, the appellant submitted a main request and five auxiliary requests to replace the requests on file.

V. Oral proceedings were held on 10 January 2017.

Following a discussion of the issues, the appellant submitted a sole new request to replace all previous requests.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims 1 to 15 of the sole request filed during the oral proceedings.

At the end of the oral proceedings, the chairman announced the board's decision.

VI. Claim 1 reads as follows:

"A method (2300), comprising:

at a portable multifunction device (100) with a touch screen display (112):

displaying (2302) a portion of a content piece on the touch screen display (112), wherein the displayed portion of the content piece has a vertical position in the content piece;

detecting (2304) an object contacting the touch screen display (112) on the displayed portion of the content piece;

in response to detecting the object on the displayed portion of the content piece, displaying (2306) a

vertical bar overlaying the displayed portion of the content piece, wherein the vertical bar has a vertical position overlaying the displayed portion of the content piece that corresponds to the vertical position in the content piece of the displayed portion of the content piece;

detecting (2308) a movement of the object on the displayed portion of the content piece;

in response to detecting the movement:

scrolling (2310) the content piece displayed on the touch screen display (112) so that a new portion of the content piece is displayed, and

moving (2310) the vertical position of the vertical bar to a new position so that the new position corresponds to the vertical position in the content piece of the displayed new portion of the content piece; and,

after a predetermined condition is met, ceasing (2312) to display the vertical bar while continuing to display the displayed portion of the content piece, wherein the displayed portion of the content piece has a vertical extent that is less than a vertical extent of the content piece and the content piece is a list of items or is an electronic document;

wherein the method further comprises:

after scrolling to a top of the content piece, in response to continuing to detect downward movement of the object that attempts to scroll the content piece beyond the top of the content piece, revealing a

background beyond the top of the content piece and starting to reduce the length of the vertical bar."

## **Reasons for the Decision**

### *1. Amendments*

1.1 Present claim 1 differs from claim 1 of the auxiliary request filed during the examination procedure in incorporating amendments to the effect that, firstly, in the fourth paragraph the wording "contacting the touch screen display (112)" has been inserted, secondly in the fifth paragraph the term "on top of" has twice been replaced by the term "overlying", and, thirdly, the expression "reducing the length of the vertical bar" has been replaced by "starting to reduce the length of the vertical bar".

1.2 The feature "contacting the touch screen display (112)" is disclosed, inter alia, in paragraph [0066] of the description (referring to the published application, WO 2008/086319 A). Hence this amendment complies with Article 123(2) EPC.

1.3 It is unambiguously disclosed in the application as filed that the vertical bar may overlay the displayed portion of the content piece, cf. e.g. Figs. 5, 6A and 6B. Consequently, the second amendment complies with Article 123(2) EPC.

1.4 The wording "starting to reduce the length of the vertical bar" is based on the description, paragraph [00283]. Consequently, this amendment also complies with Article 123(2) EPC.

### *2. Claim 1 - inventive step*

- 2.1 The present invention relates to touch-screen operated mobile devices in which scrolling through a displayed content, e.g. a document, is performed by having an object (usually a finger) make contact with the screen and moving (swiping) the object across the screen.
- 2.2 D4 discloses such a device. In D4 (cf. the abstract), as is common when text documents are displayed on computer devices, a vertical scroll bar is provided on the right-hand edge of the document indicating to the user the position of the displayed part in the overall document. The length of the vertical bar represents the size of the displayed portion in relation to the entire document.
- 2.3 The technical problem to be solved with respect to D4 can be seen as how to provide enhanced operation of the device with regard to scrolling through a displayed content piece.
- 2.4 In accordance with claim 1, this solution is in essence solved by:
- (i) in response to detecting the object on the displayed portion of the content piece, displaying the vertical [scroll] bar overlaying the displayed portion of the content piece;
  - (ii) after a predetermined condition is met (e.g. when the device ceases to detect the object), ceasing to display the vertical bar while continuing to display the displayed portion of the content piece; and
  - (iii) after scrolling to a top of the content piece, in response to continuing to detect downward movement of



the object that attempts to scroll the content piece beyond the top of the content piece, revealing a background beyond the top of the content piece and starting to reduce the length of the vertical bar.

2.5 For the purposes of this decision, it is assumed for the sake of argument that the skilled person would incorporate features (i) and (ii) without requiring inventive skill by combining D4 with document D3 (which the board considers to be even more relevant than D2 cited by the examining division although both documents are essentially similar in the context of the present discussion). D3 discloses a computer user interface operated by a control device, inter alia a mouse or glide pad, for controlling a cursor (cf. col. 4, lines 31-39), in which a vertical scroll bar is displayed overlaying a text document only when the cursor is in the vicinity of the scroll bar, i.e. when the user is interested in scrolling (cf. e.g. D3, claim 1, 2nd clause and col. 5, lines 31-39). As regards the applicability of this concept to touch-screen devices, the board notes that D3 states that it is also applicable to personal digital assistants (PDA), although there are no further details (cf. col. 3, lines 53-56). However, in general, PDAs at the priority date of the application had touch-screens operated for example by using a stylus. Although the appellant disputed that the incorporation of these features in the device of D4 would have been obvious, this point is moot in view of the board's assessment of distinguishing feature (iii).

2.6 With respect to distinguishing feature (iii), the examining division (cf. point 4 of the impugned decision) identified a separate problem to be solved ("to indicate to the user that the top of the list has

been reached") whose solution had no combined technical effect with the remaining distinguishing features of the claim (i.e. features (i) and (ii)). This aspect could therefore be considered separately.

2.7 The board does not agree with this approach. Considering that being able to reduce the length of the vertical bar is at least dependent on whether or not the vertical bar is displayed, it is clear that a technical interaction is present between features (i), (ii) and (iii). Further, all distinguishing features contribute to enhancing the scrolling experience of the user by controlling a common element, namely the vertical bar. Finally, all distinguishing features are related by the fact that they each involve detection of the "object" contacting and moving across the screen to perform scrolling operations (generally, a finger). A "partial problems" approach can only be applied in the case of problems independently solved by different sets of distinguishing features (cf. the Guidelines for Examination, G-VII, 5.2, last paragraph). This approach is therefore not appropriate in the present case.

2.8 Furthermore, the specific problem identified by the examining division in isolation ("to indicate to the user that the top of the list has been reached") includes a pointer to the solution, and therefore incorporates hindsight. In the present case, the question to be answered with regard to inventive step is rather whether the skilled person would objectively be motivated to combine D4 with features of D3 (or D2, cf. point 2.5 above) and D7, which was referred to by the examining division in connection with feature (iii) (cf. point 2.4 above) in such a way as to arrive obviously at the method as claimed in claim 1, in order

to provide enhanced operation of the device with regard to scrolling through a displayed content piece.

2.9 D7 discloses a display apparatus with means for navigating through a displayed list of items or a document (in this latter case, an item may consist of individual elements such as lines, paragraphs or words, cf. page 2, lines 15-17). In order to indicate when the end of the list is reached, one or more items are temporarily displaced (cf. e.g. the abstract). It is to be noted however that the examples shown in D7 consist of relatively simple lists, none of which include a scroll bar (cf. Figs. 2-5). The board points out that a scroll bar as used in D4 and D3 (or D2) already indicates that the end of a document has been reached when the vertical bar, or "thumb" (cf. D3, col. 3, lines 29-32) arrives at the top or bottom of the displayed document. Therefore, the skilled person would have no compelling motivation to look for further ways of indicating that the end of a document has been reached, such as by seeking to incorporate features of D7. The board considers that the incorporation of these features is not obvious but requires the benefit of hindsight.

2.10 In this light, it is moot to speculate whether the combination of D4 and D3 (or D2), if further combined with one of the various embodiments suggested in D7, might result in either background being revealed or the vertical bar beginning to be reduced in length, as argued by the examining division (cf. page 9 of the impugned decision, last paragraph to page 10, line 2), since, even if that were the case, the combination of D4, D3 (or D2) and D7 would still not be obvious. That notwithstanding, in the board's judgement, the examining division's contention that the vertical bar

would implicitly be reduced in length if a document having a scroll bar were to be displaced in the manner disclosed in D7, page 2, lines 10-14, in any case is based on conjecture.

- 2.11 The board concludes that the subject-matter of claim 1 involves an inventive step having regard to the documents D4, D3 (or D2, cf. point 2.5 above) and D7 (Articles 52(1) and 56 EPC).

3. *Conclusion*

For the above reasons, the decision under appeal is to be set aside. Since the board has only examined claim 1 in the light of the documents D2, D3, D4 and D7, the case is remitted to the examining division for examination of the remaining claims and, if need be, for consideration of the claims in the light of other prior art documents.

**Order**

**For these reasons it is decided that:**

- The decision under appeal is set aside.
- The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 15 of the sole request filed during oral proceedings.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated