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**Datasheet for the decision  
of 14 August 2018**

**Case Number:** T 0336/13 - 3.5.04

**Application Number:** 07784380.3

**Publication Number:** 2036324

**IPC:** H04N1/00

**Language of the proceedings:** EN

**Title of invention:**  
UNIVERSAL MOBILE PRINT AGENT

**Applicant:**  
Qualcomm Incorporated

**Headword:**

**Relevant legal provisions:**  
EPC Art. 123(2), 111(1), 112a(2)(c)  
EPC 1973 Art. 113  
EPC R. 106  
RPBA Art. 13

**Keyword:**

Amendments - main request - added subject-matter (yes)  
Late-filed first auxiliary request - admitted (no)  
Remittal to the department of first instance of the first  
auxiliary request (no)

**Decisions cited:**

R 0009/11, R 0010/11, R 0001/13

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0336/13 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 14 August 2018**

**Appellant:** Qualcomm Incorporated  
(Applicant) 5775 Morehouse Drive  
San Diego, CA 92121 (US)

**Representative:** Heselberger, Johannes  
Bardehle Pagenberg Partnerschaft mbB  
Patentanwälte, Rechtsanwälte  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 1 October 2012  
refusing European patent application  
No. 07784380.3 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** C. Kunzelmann  
**Members:** B. Willems  
G. Decker

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the examining division dated 1 October 2012 refusing European patent application No. 07784380.3 pursuant to Article 97(2) EPC. The application was published as international application WO 2007/146858 A2.
  
- II. The documents cited in the decision under appeal included the following:  
  
D1: "Nokia N70", User's Manual, 18 August 2005, URL: [http://nds1.nokia.com/phones/files/guides/Nokia\\_N70\\_1\\_UG\\_en.pdf](http://nds1.nokia.com/phones/files/guides/Nokia_N70_1_UG_en.pdf), XP002466582; and  
  
D4: US 2004/125401 A1.
  
- III. The application was refused on the grounds that the subject-matter of claim 1 of the then main request lacked novelty over the disclosure of document D4 (Article 54 EPC), the subject-matter of claim 1 of the first auxiliary request extended beyond the disclosure of the application as filed (Article 123(2) EPC) and the subject-matter of claim 1 of the second auxiliary request lacked inventive step over the disclosure of D1 combined with the common general knowledge of a person skilled in the art (Article 56 EPC).
  
- IV. The applicant filed an appeal requesting that the examining division's decision be set aside. With the statement of grounds of appeal, the now appellant requested that a patent be granted on the basis of the claims of a sole request submitted with that statement. The appellant indicated a basis for the amendments in the application as filed and provided arguments as to

why the subject-matter of claim 1 met the requirements of Articles 54 and 56 EPC 1973.

- V. The board issued a summons to oral proceedings. In a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ 2007, 536), annexed to the summons, the board gave its provisional opinion that the subject-matter of claims 1 and 4 extended beyond the disclosure of the application as filed (Article 123(2) EPC), introduced document D5 (JP2005159958 A) and a translation of document D5, D5T, into the proceedings and informed the appellant that it should be prepared to discuss novelty and inventive step in view of the documents cited in the decision under appeal and document D5.
- VI. With the reply dated 2 July 2018, the appellant filed amended claims according to auxiliary requests A, B and C and requested that a patent be granted on the basis of the claims of the main request submitted with the statement of grounds of appeal, or alternatively on the basis of the claims of one of auxiliary requests A, B or C. It also suggested remitting the case to the examining division in accordance with Article 111(1) EPC if any request needed to be discussed with respect to novelty and inventive step, in particular in view of document D5/D5T or the technical field of Bluetooth discovery. The appellant submitted arguments as to why the amended claims met the requirements of Articles 54, 56 EPC 1973 and 123(2) EPC.
- VII. Oral proceedings before the board were held on 14 August 2018.

During the oral proceedings, the appellant withdrew auxiliary requests A, B and C filed with the letter

dated 2 July 2018 and filed claims according to a first auxiliary request.

The appellant confirmed its final requests as follows:

"It is **requested:**

*to reverse the decision of the examining division regarding EP 07784380.3 dated October 1, 2012 and to grant a patent based on*

*the claims as filed on January 28, 2013 with the grounds of appeal;*

*or auxiliarily based on the claims as filed during the oral proceedings dated August 14, 2018;*

*and/or auxiliarily remit the proceedings back to the examining division based on the claims as filed during the oral proceedings dated August 14, 2018."*

The appellant raised "an objection with regards to the right to be heard in the sense of Art. 113 EPC and in view of Rule 106 EPC [...] on the matter of the auxiliary request 1".

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

VIII. Claim 1 of the main request reads as follows:

"A method carried out by a mobile device for interfacing with an output device in order to provide a print output, the method comprising:

initializing a print output from the mobile device;

initiating position location of the mobile device;

selecting an output device based, at least in part, on the location of the mobile device;

enabling a direct connection without using an intermediate device to the selected output device via a wireless transceiver within the mobile device;

connecting to the selected output device via the wireless transceiver using Near Field Communication;  
and

communicating at least one image stored within the mobile device to the selected output device via the connection using a unified and coordinated interface on the mobile device that manages information and data between the mobile device and the output device via a print application residing on the mobile device."

IX. Claim 1 of the first auxiliary request reads as follows:

"A method carried out by a mobile device for interfacing with an output device in order to provide a print output, the method comprising:

initializing a print output from the mobile device, by a user;

initiating position location of the mobile device, wherein the position location is based at least in part on GPS or provided by a cellular communication system;

selecting a remote output device based, at least in part, on the location of the mobile device, by the user;

accessing the remote output device directly; and

communicating at least one image stored within the mobile device to the selected remote output device via a connection using a unified and coordinated interface on the mobile device that manages information and data between the mobile device and the output device via a print application residing on the mobile device."

- X. The examining division's objections, where relevant to the present decision, may be summarised as follows:

Claim 1 of the then first auxiliary request specified initiating the position location of the mobile device, selecting an output device based on said position and communicating at least one image to the selected output device using a direct connection, without using an intermediate device. This combination of features was not directly and unambiguously derivable from the application as filed (see decision under appeal, page 5).

- XI. The appellant's arguments, where relevant to the present decision, may be summarised as follows:

(a) Support for claim 1 of the main request could be found in at least paragraphs [0025], [0078], [0081] and [0121] (see statement of grounds of appeal, point 4.2, page 4). In particular, paragraphs [0078] and [0121] mentioned Near Field Communication (NFC).

(b) It was apparent from paragraph [0038] that the terms "remote" and "direct" referred to different characteristics of the connection (see reply dated 2 July 2018, page 6, fourth to seventh paragraph).



In general, the links disclosed in the application could be categorised according to three criteria: remote or local, wired or wireless and direct or indirect. According to paragraph [0025] a "direct" connection from a mobile device to a "local" output device could be established without using an intermediate device. It was evident from paragraphs [0026] and [0063] that the interface dealt with all possible output scenarios, including local wireless connections (see statement of grounds of appeal, page 5, second full paragraph).

(c) The embodiment described in paragraphs [0097] to [0102] provided a basis for the combination of *"selecting an output device based, at least in part, on the location of the mobile device"* and *"enabling a direct connection without using an intermediate device to the selected output device via a wireless transceiver within the mobile device"*. According to these paragraphs and paragraphs [0043], [0044] and [0118], a remote output device might be selected based on location information and the mobile device brought to the location of the remote output device to establish a direct wireless connection between the mobile device and the remote output device (see the reply dated 2 July 2018, page 3, first paragraph, to page 6, first paragraph).

(d) Paragraphs [0118] and [0119] set out a timeline for the claimed features. After using the position location of the mobile device to identify and locate output devices at retailers, the user could select a specific output device. The location information could be used to travel to the output device at the retailer and to establish an NFC

connection with the selected, now "local", output device (see statement of grounds of appeal, page 5, third full paragraph and the paragraph bridging pages 5 and 6, and reply dated 2 July 2018, page 7).

- (e) Paragraphs [0043] and [0044] disclosed that the mobile device could use its position to obtain a list of nearby service providers. The user might examine the list to determine which service provider offers printing, and travel to the service provider to generate a local output at the printer. The phrase "local output" also occurred in paragraph [0078] which disclosed that "*Near Field Communication [...] can be used where near field [sic] [...] communications is used as a wireless link to a local device*". Therefore, paragraph [0044] clearly pointed to using NFC as an option to generate an output at the local printer.
- (f) In the communication under Article 15(1) RPBA, the board did not consider the disclosure in paragraphs [0043] and [0044] in its assessment of added subject-matter. The disclosure in these paragraphs was first discussed during the oral proceedings. Following the board's conclusion that they did not provide a basis for the claimed subject-matter, the appellant had to be given an opportunity to react by filing amended claims. These claims could not have been filed at an earlier stage in the proceedings.

Claim 1 of the auxiliary request filed during the oral proceedings "*only slightly deviate[d]*" from claim 1 of the main request forming the basis for the appealed decision. Therefore, it was not too

complex to examine novelty and inventive step over the available prior art (see written objection submitted by the appellant during the oral proceedings).

Therefore, the board should have exercised its discretion under Article 13(1) RPBA and admitted the auxiliary request into the proceedings.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Added subject-matter - main request (Article 123(2) EPC)*
  - 2.1 It is established case law that the mandatory prohibition on extension laid down in Article 123(2) EPC means that an amendment can only be made within the limits of what a person skilled in the art would derive directly and unambiguously from the description, claims and drawings of the application as filed (see the Case Law of the Boards of Appeal of the European Patent Office, 8th edition 2016, II.E.1.2.1).
  - 2.2 Claim 1 of the main request specifies:  
  
*"selecting an output device based, at least in part, on the location of the mobile device;*  
  
*enabling a direct connection without using an intermediate device to the selected output device via a wireless transceiver within the mobile device;*  
*connecting to the selected output device via the wireless transceiver using Near Field Communication".*

- 2.3 The board agrees with the examining division that the application as filed does not provide a basis for the combination of features quoted in point 2.2 above (see point X above).
- 2.4 The passages listed in points XI(a) and (b) above disclose a direct connection with a local output device. However, none of these passages mentions the "position location" of the mobile device.
- 2.5 The board has not been convinced that paragraphs [0097] to [0102] directly and unambiguously disclose remotely detecting an output device, bringing the mobile device to the location of the remote output and then establishing a direct wireless connection (see point XI(c) above).

Paragraphs [0097] to [0102] concern the option of remote output, which may comprise determining the position of the mobile device ("Location Based Service (LBS)"). In contrast, paragraphs [0090] to [0096] disclose the "alternative option" (emphasis added) of outputting to a local output device, without retrieving the location of the mobile device. The remote output option is illustrated in the "YES" branch following decision block 520 of Figure 5, and the local output option is illustrated in the "NO" branch following decision block 520 of Figure 5.

Paragraph [0097] discloses that if remote output is desired, the mobile device determines whether "LBS output devices are desired". Paragraph [0098] describes the case that "LBS output devices are not desired". However, if LBS is desired, according to paragraph [0099] the mobile device initiates position location, for example with GPS. The mobile device then

determines which LBS devices are available, queries a database for output devices that are within a predetermined proximity (see paragraph [0100]) and presents the LBS devices (and optionally non-LBS devices as well) to the user (see paragraph [0101]). The user can then select an output device (see paragraph [0102]).

It is apparent from Figure 5 that the location information is retrieved if remote output and LBS are selected.

Paragraph [0118] discloses "*position location [...] to identify and locate nearby retailers [...] and] utilize an over-the-air interface to route selected images to a retailer identified using a global positioning satellite (GPS) system or A-GPS*". Combining the disclosure of paragraphs [0097] to [0102] with the disclosure of paragraph [0118], the mobile device would determine which LBS devices are available and use over-the-air (OTA) to route the images to an LBS device in the proximity.

- 2.6 The board has not been persuaded that according to paragraphs [0118] and [0119] output devices may be discovered and selected based on the location information, the user may use the location information to travel to the retailer with the selected output device and then establish there an NFC connection between the mobile device and the output device (see point XI(d) above).

The board finds that, even in the "retail" scenario described in paragraphs [0118] to [0121], there are two mutually exclusive options: remote output using a location position system or local output.

Paragraph [0118] clearly distinguishes between two scenarios: a user at *"a retail location [...] may use a Bluetooth wireless connection to print at a photo kiosk"* (first sentence) or else initiating *"position location [...] to identify and locate nearby retailers [...] and] utilize an over-the-air interface to route selected images to a retailer identified using a global positioning satellite (GPS) system or A-GPS"* (second and third sentence).

The first scenario does not entail locating the mobile device using GPS. The second scenario uses GPS and an over-the-air (OTA) interface to *"route selected images"*. According to paragraph [0071], the *"modem OTA processing module [...] is used to communicate information to an output device via the communication system, such as a cellular telephone system"*. Hence, the OTA link constitutes a remote wireless connection and GPS is used to route images transmitted via this connection.

Paragraph [0119] uses GPS and an OTA link to have *"prints waiting at a local retail outlet"*. In this paragraph, the term *"local"* is used to refer to nearby shops or kiosks for picking up prints rather than to specify the connection for transmitting the images.

2.7 Paragraph [0044] discloses that the user may travel to the service provider to generate a *"local output at the printer"*. Contrary to the appellant's assertion (see point XI(e) above), this wording is not repeated in paragraph [0078], which instead mentions a *"wireless link to a local device"*. Moreover, paragraph [0044] is to be read in conjunction with paragraph [0043], which discloses that the user initiates remote printing. The board is not persuaded that after initiating remote

printing the user would travel to the service provider to set up a wireless connection to a local printer. It makes more sense that "local" refers to the output being generated at the location of the service provider (see also point 2.6 above) and that, after initiating remote printing and travelling to the service provider, the user then enters a command to start printing the images which have been transmitted to the printer in the meantime. Therefore, the board concludes that paragraphs [0043] and [0044] do not point directly and unambiguously to connecting the mobile device to the printer via an NFC connection.

- 2.8 In view of the above, the board finds that claim 1 of the main request does not meet the requirements of Article 123(2) EPC.
3. *First auxiliary request - admission into the appeal proceedings (Article 13(1) RPBA)*
- 3.1 Under Article 13(1) RPBA any amendment to a party's submissions after it has filed its statement of grounds of appeal may be admitted and considered at the board's discretion. The discretion is to 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.
- 3.2 The first auxiliary request was filed for the first time during the oral proceedings before the board (see point VII above). Hence, it was filed at a very late stage of the appeal proceedings.
- 3.3 The filing of the request cannot be seen as a response to a new objection only raised during the oral proceedings.

In the decision under appeal, the examining division objected that the combination of *"initiating position location of the mobile device, selecting an output device based on said position and communicating at least one image to the selected output device using a direct connection, without using an intermediate device"* could not be directly and unambiguously derived from the application as filed (see decision, page 5).

The board's communication, in particular section 4, contained a preliminary opinion agreeing with this objection. The board extensively commented on all passages indicated by the appellant in the statement of grounds of appeal. Only in response to the board's communication did the appellant further indicate paragraphs [0043] and [0044] as a possible basis.

During the discussion of paragraphs [0043] and [0044] at the oral proceedings, the board merely rebutted the appellant's arguments based on these paragraphs. However, the "explicit view taken by the board" that the subject-matter of claim 1 of the main request was not directly and unambiguously derivable from the application as filed had been clearly expressed in the preliminary opinion. Therefore, the discussion during the oral proceedings cannot be regarded as having caused the submission of the first auxiliary request (see point XI(f) above) and cannot be taken as a justification for submitting the first auxiliary request at this very late stage.

- 3.4 What is more, a comparison of claim 1 of the first auxiliary request with claim 1 of the main request on file shows that the amendments made to claim 1 of the first auxiliary request go beyond deleting the features *"enabling a direct connection [...] connecting to the*



*selected output device [...] using Near Field Communication*" from claim 1 of the main request. Further, the board does not share the appellant's view that claim 1 of the first auxiliary request "only slightly deviate[d]" from claim 1 of the main request forming the basis for the decision (see point XI(f) above). Unlike claim 1 of the current and previous main request, claim 1 of the present first auxiliary request specifically refers to a remote output device (rather than an output device in general) and specifies "*accessing the remote output device directly*".

At first glance, the adjective "remote" contradicts the adverb "directly".

In its analysis of claim 1 of the main request in the decision under appeal, the examining division referred to paragraphs [0038] and [0039] for interpreting the phrase "direct connection". Paragraph [0038] discloses that the "*mobile device 110 can utilize the communication system 140 to connect to a remote printer [...] and] can access a remote printer directly or [...] indirectly*". Paragraph [0038] does not give a definition of "directly" or "indirectly", but seems to suggest that the presence of an intermediate communication system does not preclude the possibility that the remote printer is directly accessed. The examining division interpreted "enabling a direct connection" accordingly, i.e. images may be sent via a server to the printer (see decision under appeal, page 4, first paragraph). In contrast, the appellant referred to paragraph [0025] and submitted that a direct connection is a connection without an intermediate device (see point XI(b) above). These contradictory definitions of "direct" cast doubts on the meaning of directly accessing an output device.

Moreover, it is not apparent how the mobile device can access a remote printer without using any intermediate communication system.

Thus, the phrase "*accessing the remote output device directly*" gives rise to new complex questions with regard to technical issues. The board would have to address these questions before it could assess novelty and inventive step and "*decide about the substantive matter*" (see point XI(f) above).

3.5 Moreover, all the claims submitted in the appeal proceedings prior to the oral proceedings comprised a feature of a Near Field Communication (NFC) connection to the selected output device. This implies a very small distance (roughly a few centimeters) between the mobile device and the selected output device. In the statement of grounds of appeal as well as in the letter of reply to the board's communication, this feature was referred to in support of patentability of the claimed subject-matter. In contrast, the claims of the auxiliary request explicitly refer to a remote output device. Thus, the submissions during the written appeal proceedings based on the NFC connection are no longer relevant for the combination of features of claim 1 of the auxiliary request, so that large parts of the written appeal proceedings are essentially meaningless for the assessment of the auxiliary request. Admitting the auxiliary request would essentially result in the board having to examine a second, alternative appeal. This would not be in the interest of procedural economy.

3.6 In view of the above, the board exercised its discretion referred to in Article 13(1) RPBA and

decided not to admit this claim request into the proceedings.

4. *Remittal of the case on the basis of the first auxiliary request to the department of first instance (Article 111(1) EPC 1973)*

Since the first auxiliary request was not admitted into the proceedings, this request for remittal serves no purpose and therefore need not be considered by the board.

5. *Objection to a fundamental violation of the appellant's right to be heard (Article 113 EPC 1973, Rule 106, Article 112a(2)(c) EPC)*

- 5.1 During the oral proceedings before the board, the appellant raised in writing an "*objection regarding the right to be heard according to Art. 113 EPC, in view of Rule 106 EPC*". As stated in its first two paragraphs, it related to the appellant's requests for admission of the first auxiliary request into the proceedings and for remittal of the case to the department of first instance on the basis of that request.

- 5.2 After the appellant had filed its first auxiliary request during the oral proceedings, the question whether it could be admitted into the appeal proceedings was discussed. During the discussion, the board pointed out that it had discretion under Article 13 RPBA not to admit the first auxiliary request into the appeal proceedings and that, when exercising its discretion, it would consider, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy (Article 13(1) RPBA) and

whether the board could be expected to deal with the new subject-matter without adjourning the oral proceedings (Article 13(3) RPBA). Before the board took its decision on the grounds set out in points 3.3 to 3.6 above, the appellant was given an opportunity to present its comments on these grounds.

- 5.3 Consequently, after the board's announcement that it had exercised its discretion under Article 13(1) RPBA and had decided not to admit the first auxiliary request into the appeal proceedings, the appellant did not, in either its written reasons or those presented orally, submit that it had not had an opportunity to comment on the grounds underlying the board's decision.
- 5.4 Rather, the appellant asserted in its written reasons and orally that the board had violated its right to be heard by not admitting the first auxiliary request into the appeal proceedings. According to the appellant, it needed to have an opportunity to react to the board's objection under Article 123(2) EPC regarding the claims of the main request by filing new claims which overcame the objection. This opportunity had been taken away by the board's negative decision on the admission of the first auxiliary request.
- 5.5 The board notes that the appellant was indeed given the opportunity to file a new request, an opportunity which it actually took by filing its first auxiliary request. This, however, is to be distinguished from the subsequent question of whether the board actually admits the late-filed request into the proceedings.
- 5.6 According to Articles 114(2) EPC and 13 RPBA, the boards have discretionary powers when it comes to admitting late-filed requests. This issue pertains to

the merits of the decision and is part of substantive law (see R 1/13, Reason 16.3). Only an arbitrary or manifestly unlawful exercise of discretion amounts to a fundamental violation of the right to be heard pursuant to Article 113 EPC 1973 (see R 9/11, Reasons 3.2.1, 3.2.3; R 10/11, Reasons 5.2).

- 5.7 The board discussed with the appellant the grounds that might be relevant for the exercise of its discretion (see point 5.2 above) and relied on them for its decision as elaborated under points 3.3 to 3.6 above. The arguments underlying the decision not to admit the first auxiliary request are within the scope of Article 13(1) RPBA. In consequence, there was no arbitrary or manifestly unlawful exercise of discretion which would amount to a fundamental violation of the appellant's right to be heard. The board dismissed the appellant's objection under Rule 106 EPC, Article 112a(2) (c) EPC accordingly.
6. Since none of the appellant's requests is allowable, the appeal is to be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

C. Kunzelmann

Decision electronically authenticated