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**Datasheet for the decision
of 17 October 2014**

Case Number: T 2249/13 - 3.5.01

Application Number: 10186066.6

Publication Number: 2315176

IPC: G06Q40/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for displaying market depth and other information on a mobile phone, handheld device, or computer system

Applicant:

Trade Capture, OTC Corp.

Headword:

Mobile device/TRADE CAPTURE

Relevant legal provisions:

EPC Art. 56, 111(1), 112(1)(a), 113(1), 125

EPC R. 4(1), 63(1), 63(2)

RPBA Art. 8(3), 11, 13(1)

Keyword:

Inventive step - (no)

Diverging auxiliary requests 6 to 11 - (not admitted)

Refund of search fee upon no-search declaration - (no)

Remittal to the department of first instance - (no)

Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

J 0005/81, J 0014/87, T 0026/88, T 0641/00, T 0520/01,
T 0240/04, T 1784/06, T 0506/08, T 1411/08, T 2459/12

Catchword:



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Case Number: T 2249/13 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 17 October 2014

Appellant: Trade Capture, OTC Corp.
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Stamford, CT 06901 (US)

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 17 June 2013
refusing European patent application No.
10186066.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman S. Wibergh
Members: K. Bumès
D. Prietzel-Funk

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 10186066.6 entitled "*Method and apparatus for displaying market depth and other information on a mobile phone, handheld device, or a computer system*".
- II. Neither the search division nor the examining division cited any prior art document.
- a) A European Search Report and Search Opinion were communicated to the appellant in February 2011, the report centring on the following declaration (referred to as the "no-search declaration" by the Board):

"The claimed subject-matter substantially refers to rules and schemes in the sense of Article 52 (2) EPC, i.e. the dissemination, transmission, and display of business/trading data. Technical character only arises because a general purpose computing system, i.e. a mobile communication device comprising a transmitter, receiver, processor, display screen, interactive GUI, is claimed in order to automate said rules and schemes. The technical features of a general purpose computing system are considered to have been so well known at the time of priority of the present application that no written evidence is necessary to prove this (see also Official Journal 2007/11, pg. 592-593)."

No invitation according to Rule 63(1) EPC (as in force from 1 April 2010) had been sent by the

search division before issuing the above declaration.

- b) The examining division set out from a notorious general-purpose computing system and considered the claimed mobile communication device to lack any inventive step (Articles 52(1) and 56 EPC) as it only used the generic computing system to automate business requirements.

III. The decision under appeal was pronounced at the end of oral proceedings which the examining division held in the absence of interpreters although the appellant's representative had informed the examining division that he intended to use (speak and hear) the German language and had requested simultaneous translation. The examining division saw no good reason to depart from the language of the proceedings (English) but offered to clarify its comments in German where necessary while declining to act officially as interpreters (reference to Guidelines for Examination in the EPO, E-IV 1).

IV. In the statement setting out the grounds of appeal, the appellant requested that the refusal decision be set aside and a patent be granted based on the original claims 1 to 42 (main request), or based on an amended set of claims 1 to 42 refiled with the statement setting out the grounds of appeal (auxiliary request, now first auxiliary request).

Claim 1 according to the main request reads:

"1. A mobile communication device comprising:
a transmitter configured to transmit data,
messages, and commands;

a receiver configured to receive data transmissions and information, including via one or more live data feeds;

one or more input devices for receiving user inputs;

a display screen; and

a processor executing software that causes said communication device to generate and display a first interactive graphical user interface (GUI) on said display screen,

said first interactive GUI simultaneously displaying live market data and information received via at least one of said live data feeds in the form of:

a dynamic market window displaying user-selected multimedia content,

live market statistics, and

at least one execution icon that when selected, invokes said communicating [sic] device to generate and transmit a transaction execution command."

The first auxiliary request appends the following feature to claim 1 of the main request:

"based on live market data and information displayed via said first interactive GUI."

- V. The statement setting out the grounds of appeal alleged two substantial procedural violations by the examining division and, therefore, included a request that the case be remitted to the department of first instance, in particular to a differently composed examining division.

Further, a refund of the European search fee was requested.

VI. The arguments submitted with the grounds of appeal can be summarised as follows.

- a) The refusal was only based on a presumption of what the closest prior art might be. On the other hand, the claimed subject-matter was distinguished not only by steps of a business process. Technical features of claim 1 went beyond the use of a notorious general-purpose computer. Technical problems resided in retrieving, displaying, and/or interacting with critical market data in an improved manner in order to be independent of stationary communication devices.

According to decision T 1411/08, an examining division should ensure that a search was performed before an application was refused for lack of inventive step. This requirement was considered to apply to the present application which comprised not only notorious technical features.

- b) Rule 4(1) EPC unambiguously allowed a party to both speak and hear an official language chosen by the party and announced in good time. The examining division had no discretion to refuse interpretation in such a situation. By refusing to provide interpretation, the examining division also infringed the appellant's right to be heard according to Article 113(1) EPC which reflects the principle of procedural fairness. Discussing the invention in a common language serves procedural economy and prevents misunderstandings. By dismissing the appellant's request for interpretation, the examining division accepted the possibility of a misdirected discussion. The dismissal limited the appellant's right to present

its arguments in a desired manner in accordance with procedural regulations of the EPC. Despite a specific complaint by the appellant, the examining division was not willing to conform to those provisions, which suggested that the division was biased at least with respect to the language issue.

- VII. The Board summoned the appellant to oral proceedings, as requested on an auxiliary basis, and set out its preliminary opinion on the substantive and procedural issues raised in the statement setting out the grounds of appeal.
- a) The Board voiced doubts about the presence of a non-obvious technical contribution over a notorious smart phone comprising an interactive graphical user interface (touch screen). Those doubts were reinforced by the apparent reliance of the application on common general knowledge; the technical implementation of desired functions (such as "live data feeds") seemed to be left to the skilled reader. The cognitive meaning of information received, displayed and transmitted did not appear to have any technical implication for the functioning of the communication device and its interactive graphical user interface (GUI).
 - b) As the request for remittal was based *inter alia* on the search division's no-search declaration, the Board first noted that it was not competent to revise acts of the search division (Article 106(1) EPC).

Regarding the examining division's reliance on a general-purpose computer system, the Board tended to accept such prior art as notorious, i.e. no documentary evidence had to be adduced by the examining division in this respect (T 1411/08, points 4.1, 4.2). In particular, the examining division was not required to prove the pre-existence of features (such as technical details of live data feeds) which the application itself failed to disclose.

- c) The examining division had apparently infringed Rule 4(1)(5) EPC by declining to provide official interpretation when the appellant's representative had filed a timely request to speak and hear an official language other than the language of the proceedings.

On the other hand, that procedural violation did not appear to have substantially affected the appellant's right to be heard (Article 113(1) EPC). The appellant did not set out any actual communication problem caused by the lack of official interpretation but addressed only hypothetical problems that might occur in general if the right to exchange arguments in a desired language was restricted.

- d) Therefore, the Board tended not to remit the case to the department of first instance but to exercise its power within the competence of the examining division (Article 111(1) EPC).
- e) Regarding the request for a refund of the European search fee in the absence of any cited document, the Board noted that it could only apply the EPC

and associated provisions as they stood. The Rules Relating to Fees did not provide for a refund of the search fee in case of a no-search declaration under Rule 63 EPC.

The Board added that it was not competent to decide on claims for compensation in respect of a loss or damage allegedly caused by the EPO in the course of patent grant proceedings (J 14/87, OJ EPO 1988, 295).

Therefore, the request for a refund of the search fee appeared inadmissible.

VIII. In response to the summons, the appellant filed second to eleventh auxiliary requests and expanded its argumentation.

- a) The second auxiliary request appends original claim 3 to claim 1 of the main request:

“the mobile communication device further comprising a filter means that filters the live market data and information displayed by said first interactive GUI according to a user-selected commodity / trading period combination, said filter means comprising means for invoking the communication device to subscribe or unsubscribe to one or more of said live data feeds, said live data feeds simultaneously providing live market data and information from one or more different sources.”

- b) The third auxiliary request appends original claim 3 to claim 1 of the first auxiliary request.

- c) The fourth auxiliary request appends a combination of original claims 3 and 37 to claim 1 of the main request, that combination reading:

"the mobile communication device further comprising a filter means that filters the live market data and information displayed by said first interactive GUI according to a user-selected commodity / trading period combination, said filter means comprising means for invoking the communication device to subscribe or unsubscribe to one or more of said live data feeds, said live data feeds simultaneously providing live market data and information aggregated from two or more sources, said sources comprising a combination of financial exchange systems and data source computer devices, said first interactive GUI simultaneously displaying said aggregated data and information."

- d) The fifth auxiliary request appends the aforementioned combination of original claims 3 and 37 to claim 1 of the first auxiliary request.
- e) The sixth auxiliary request appends a combination of original claims 3 and 28 to claim 1 of the main request, that combination reading:

"the mobile communication device further comprising a filter means that filters the live market data and information displayed by said first interactive GUI according to a user-selected commodity / trading period combination, said filter means comprising means for invoking the communication device to subscribe or unsubscribe to one or more of said live data feeds, said live

data feeds simultaneously providing live market data and information from one or more different sources, further comprising memory storing pre-set user preferences.”

f) The seventh auxiliary request appends the aforementioned combination of original claims 3 and 28 to claim 1 of the first auxiliary request.

g) The eighth auxiliary request appends original claim 29 to claim 1 of the sixth auxiliary request:

“and further comprising a global positioning means, wherein at least one of the pre-set user preferences imposes trading rules and limits according to the geographic location of said mobile communication device.”

h) The ninth auxiliary request appends original claim 29 to claim 1 of the seventh auxiliary request.

i) The tenth auxiliary request appends original claim 31 to claim 1 of the eighth auxiliary request:

“wherein at least one of the pre-set user preferences automatically links said mobile communication device to one or more additional communication devices, such that updates, settings, and transactions executed on said mobile communication device are automatically reflected on said additional communication devices, and vice versa.”

- j) The eleventh auxiliary request appends original claim 31 to claim 1 of the ninth auxiliary request.

IX. In the response to the summons, the appellant disputed that a smart phone for receiving live data feeds was well-known at the priority dates of the application. Real-time transmission, updated in "milliseconds" (paragraph 0137 of the published application, EP-A1-2 315 176), was a significant feature of the application and was much more sophisticated than conventional, less time-critical data transmissions.

Setting out from a conventional communication device, there was no hint for the skilled person to provide live data feeds for improving the retrieving, displaying and/or interacting with critical market data, based on multimedia contents and live data, in order to be independent from stationary communication devices.

The auxiliary requests covered specific embodiments optimising the communication scheme with respect to efficiency and security.

Regarding the request for remittal to the department of first instance, the appellant reiterated that a search should have been performed and prior art documents should have been cited before refusing the application for lack of inventive step.

Regarding the request for a refund of the European search fee, the appellant pointed out that the search division had failed to invite the appellant to file a statement indicating the subject-matter to be searched

and, thus, had contravened Rule 63(1) EPC. Consequently, Rule 63(2) EPC was not applicable, i.e. the no-search declaration of the search division could not be considered as a European search report. In the absence of a European search report, the European search fee constituted an unjust enrichment of the European Patent Office and, thus, should be reimbursed according to a principle of law (*condictio ob rem*) generally recognised in the Contracting States (Article 125 EPC).

- X. Oral proceedings before the Board took place as scheduled and were held in the German language as requested by the appellant. The appellant maintained all requests that had been presented in writing, modifying only the request for a refund of the European search fee to the effect that the fee should be reimbursed at least partly.

In addition, the appellant formulated five questions which were said to concern points of law of fundamental importance and therefore should be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC if the Board did not envisage remitting the application to the examining division for a supplementary search to be carried out. The five questions read as follows (Board's translation of a German text submitted during the oral proceedings and attached to the minutes):

(A) Is Article 113 EPC infringed if a search is refused according to the *Notice from the European Patent Office dated 1 October 2007 concerning business methods* (OJ EPO 2007, 592/593, section "EPC") --- applicable to claims relating to no more than such methods and comprising technical means whose notoriety mentioned in the *Notice* cannot be determined objectively ---, with

the result that no document defining the prior art is made available and the applicant is effectively prevented from commenting on the difference between the subject-matter of the application and the objectively existing prior art?

(B) Is Article 125 EPC infringed by the discriminating handling of claims relating to no more than business methods in comparison with claims relating to other matters barred from patent protection (non-exhaustive list of Article 52(2)(c) EPC) or in comparison with claims the subject-matter of which is generally accessible to patent protection under Article 52(1) EPC but has the same undefined quality of technical features as the one referenced in the *Notice "concerning business methods"* (OJ EPO 2007, 592/593, section "EPC")?

(C) Is Article 113 EPC generally infringed if a search is refused by analogous reliance on the *Notice from the European Patent Office dated 1 October 2007 concerning business methods* (OJ EPO 2007, 592/593, section "EPC") --- applicable to claims comprising technical means whose notoriety mentioned in the *Notice* cannot be determined objectively ---, with the result that no document defining the prior art is made available and the applicant is effectively prevented from commenting on the difference between the subject-matter of the application and the objectively existing prior art?

(D) If the Board finds that any of points A to C entails an infringement [of Article 113 EPC or Article 125 EPC, respectively], is it necessary to remit the application to the examining division in order to avert the effects of the infringement?

(E) Is it possible and necessary, even in the absence of a specific provision on reimbursement, to reimburse a fee for which the EPO has not performed the corresponding administrative service, in particular where the administrative service has been omitted on the basis of a standard neither accessible nor predictable to the applicant?

XI. The appellant's argumentation at the oral proceedings centred on the substantive and procedural importance of a search and the failure of the European Patent Office to cite any prior art document. In this respect, the procedure was said to be flawed from the beginning. The appellant doubted the legitimacy of the *Notice from the European Patent Office dated 1 October 2007 concerning business methods* (OJ EPO 2007, 592) which announced a no-search policy for claims pertaining to business methods. Such a discrimination was not justified; in other fields (such as gaming machines), searches were provided even on minor technical features. If a technical feature was really well-known, it should be straightforward for the EPO to provide a pertinent document.

Some prior art document was necessary to conduct the problem-solution analysis which was the standard test for inventive step at the EPO. The presence of a specific prior art document also enabled an applicant to amend the claims based on an objective surplus of the application, or to withdraw the application (instead of requesting examination and paying the associated fee) if no promising surplus existed.

The term "notoriety" in the *Notice* was indefinite and, thus, allowed search and examining divisions a sweeping

use while leaving applicants without defence in the absence of any objective prior art.

In any event, the *Notice* concerning business "methods" was not applicable to the claims of the present application which related to "devices". The claims included explicit technical features (such as live data feeds) that were not well-known for mobile communication devices at the priority dates of the application, and the description supported those features (by reference to data compression, paragraph 0156 of the published application). In addition, the GUI icon arranged to send a transaction execution command implied another technical aspect as a plurality of data items (regardless of their meaning) had to be assembled automatically for transmission. Therefore, a search should have been carried out, at the latest by the examining division before refusing the application (T 1411/08, T 698/11). Even features not described in detail by the application should be searched as such features might turn out to be prior art.

For those reasons, the appellant requested that the case be remitted to the examining division, preferably in a different composition, for a supplementary search and consequential examination procedure to be conducted.

Having noted the Board's preliminary criticism of the examining division's refusal to hold the first-instance oral proceedings in German, the appellant did not pursue that part of its argumentation.

However, if the Board was not minded to remit the case, the questions of law submitted by the appellant should be referred to the Enlarged Board of Appeal.

Reasons for the Decision

1. The application, which was published as
A1: EP-A1-2 315 176,
relates to "methods and apparatus for providing real-time market data, including full depth of market information, and trading functionality to users via mobile communication devices and/or computer systems" (A1, paragraph 0001). Paragraph 0002 states that the commodity futures trading industry has not yet offered an adequate solution to the problems associated with mobile electronic trading, despite the rapid growth in the capabilities of mobile devices ("such as the iPod®, iPhone®, Blackberry®, etc"). Existing mobile trading solutions are said to suffer from a number of deficiencies, in particular a lack of real-time data streams and up-to-date quotes as would be needed for effective trading (paragraph 0003). While participants of the commodity futures market require and demand that market depth information be provided in real-time (paragraph 0004), typical mobile devices do not have the connectivity (e.g. data rate), screen display space, or functional capabilities needed by traders to effectively and efficiently receive and display real-time data, and execute transaction commands in real-time (paragraph 0005). Paragraphs 0006 to 0008 reiterate the need for solutions that enable real-time trading.

The application seeks to address that need by frequently stating that "live data" is fed to the mobile communication device (paragraphs 0010...0016, 0018, 0021, 0024, 0030...0032, 0037, 0049, 0051, 0052, 0056...0060, 0062, 0066...0224; original claims 1, 3, 5, 8, 11, 17, 19, 24, 36, 37, 39; Figure 9). Paragraph

0137 defines that live price updates measured in "milliseconds" may be displayed. According to paragraph 0156, an optimised communication scheme may compress the size of the data stream(s) between a server system and a communication device.

Main request

Article 56 EPC - Inventive step

2. The Board sets out from close prior art represented by a mobile communication device in the form of a notorious smart phone comprising an interactive graphical user interface (touch screen), as acknowledged in the application (A1, column 1, lines 26 to 31).
3. In the light of Article 52(1)(2)(3) EPC, Article 56 EPC requires a non-obvious technical contribution (see e.g. T 641/00-*Two identities/COMVIK*, Headnote 1, OJ EPO 2003, 352; T 1784/06-*Classification method/COMPTEL*).
4. The cognitive meaning of information received, displayed and transmitted (multimedia content, market data, transaction execution command) does not have any non-obvious technical implication for the functioning of the communication device and its interactive graphical user interface (GUI). The appellant has argued that a "transaction execution command" implies an automatic (i.e. technical) compilation of a plurality of data items as a "transaction" presupposes information on at least two trading partners, the commodity to be traded, an accepted price and the like. However, the underlying technical operation is carried out by any conventional smartphone used for an online shopping transaction. (If that operation was non-

- obvious, the application would have to disclose it in enabling detail.)
5. The use of an icon as a means for inputting a command is another notorious GUI feature. Similarly, displaying various types of information simultaneously in one window ("dynamic market window") is anticipated by GUIs of conventional smart phones which display internal and external data and metadata.
 6. The appellant's central argument with respect to inventive step was that the claimed communication device was arranged to receive live data feeds, i.e. real-time transmissions updated in "milliseconds" (A1, paragraph 0137), which were significantly more sophisticated than conventional, slower data transmissions. Prior mobile devices were unable to connect to multiple feeds (statement of grounds of appeal, bottom of page 4). Setting out from a conventional communication device, there was no hint for the skilled person to provide live data feeds for improving the mobile retrieval, display and/or interaction with critical market data.
 7. The Board first notes that updating a transmission is primarily an operation of the transmitting device (e.g. a server) and may not require any modification of the receiving device (i.e. of the mobile communication device claimed). Once a conventional communication channel to a conventional communication device has been established, transmitted data may be updated by the sender as frequently as desired.
 8. Moreover, while the application frequently mentions live data feeds, it does so essentially in the form of catchwords or *desiderata* without explaining any non-

obvious technical background of such feeds. The appellant relied on a single feature in the description (A1, paragraph 0156: data compression) to show that the application provided some technical detail enabling live data feeds. However, that feature represents common general knowledge in data processing (zip files, for example), and it is up to the skilled person to weigh up its well-known advantage (reduced data volume) and disadvantages (compressing/decompressing steps). While a compressed data volume can be transmitted more quickly, the compression and decompression steps may eat up the time saving. This (conventional) compromise is confirmed by the application which states that data compression is used to "optimize" communications (A1, paragraph 0156) rather than to maximise the updating speed. In other words, no non-obvious approach is disclosed for providing the desired real-time market information.

9. As far as multiple real-time feeds to a mobile communication device are concerned, the Board again notes that this is not necessarily a feature of the claimed receiving device as the desired data may be aggregated by a sending server (A1, paragraphs 00010, 0012 etc), the server not being part of claim 1.

Moreover, no non-obvious technical implementation of multiple real-time feeds to a mobile communication device is detailed in the application. The Board accepts that such an implementation was available to the skilled person but pre-existing knowledge cannot be an inventive contribution.

10. The Board finally notes its disagreement with the argument that the skilled person had no obvious reason to enhance a mobile device by live data feeds. Real-

time transmissions were demanded by market participants (A1, paragraph 0004), i.e. this user demand is the obvious task addressed by the skilled technical person.

11. Therefore, the Board judges that the mobile communication device according to claim 1 of the main request does not involve an inventive step.

First Auxiliary Request

12. According to the first auxiliary request, the transaction execution command is generated and transmitted "based on live market data and information displayed via said first interactive GUI".
13. The additional feature relates to an interactive use of the data received and displayed by the mobile communication device. Conventional online shopping on a smartphone may not require a high updating frequency but ordering is based on the reliable currentness of information received and displayed. As mentioned before, the updating frequency is obviously driven by the needs of participants who want to make informed decisions even in a volatile market, and the application fails to disclose any non-obvious implementation of a live or real-time updating mechanism, notably in the claimed communication device (situated on the receiving end).

Therefore, the first auxiliary request does not add any inventive aspect.

Second Auxiliary Request

14. The second auxiliary request appends original claim 3 to claim 1 of the main request, i.e. claim 1 refers

additionally to a filter which allows a user to select (and deselect) a live data feed to be received and to filter the information received and displayed.

15. Those functions do not rely on non-obvious technical features of a smartphone (otherwise the features would have to be disclosed in enabling detail). It is normal for a smartphone to be connected to a selected data source, in particular to a server of a selected provider, over the Internet. Filtering information according to some user input encompasses a usual search function or display preference in the receiving device.

Therefore, the second auxiliary request does not add any inventive aspect.

Third Auxiliary Request

16. The third auxiliary request combines the amendments made by the first and second auxiliary requests.
17. The Board does not see any non-obvious working interrelationship between the features added by the first and second auxiliary requests. The appellant's argument that a high degree of overall automation is achieved does not overcome that assessment as conventional smartphones are designed to integrate communicating and computing functions; the commercial meaning of the data cannot make any inventive difference.

Fourth Auxiliary Request

18. The fourth auxiliary request appends a combination of original claims 3 and 37 to claim 1 of the main request, i.e. it additionally specifies essentially

that the live data feeds provide live market data and information "aggregated from two or more sources", said sources comprising "financial exchange systems and data source computer devices".

19. The additional features define how data items are aggregated before they are transmitted to the mobile communication device, i.e. they are not features of the communication device.

Therefore, the negative assessment of the mobile communication device cannot be overcome by the amendments according to the fourth auxiliary request.

Fifth Auxiliary Request

20. The fifth auxiliary request appends the aforementioned combination of original claims 3 and 37 to claim 1 of the first auxiliary request.

Therefore, the same objection applies: As the additional features are not features of the mobile communication device, its negative assessment with respect to inventive step cannot be overcome by those features.

Sixth Auxiliary Request

21. The sixth auxiliary request appends a combination of original claims 3 and 28 to claim 1 of the main request. While auxiliary requests 4 and 5 incorporate original claim 37, the subject-matter of auxiliary request 6 shifts to original claim 28 which specifies that the mobile communication device comprises "memory storing pre-set user preferences".

22. The Board considers that the aforementioned shift of subject-matter introduces a divergence into the tree of requests at a late stage of the procedure. Divergent requests ("claim hopping") are generally questionable at the appeal stage (T 240/04-*Sensormatrix/PHILIPS*, point 16) and even more so when filed at a late stage. According to Article 13(1) RPBA, the Board has a discretion not to admit amendments made after the party has filed its grounds of appeal, considering *inter alia* the complexity of the amended subject-matter, the state of the proceedings and the need for procedural economy.

While a memory storing pre-set user preferences might not raise the complexity of the technical discussion, it is evident that such a basic feature would not raise the prospects of success of claim 1.

Therefore, with a view to procedural economy, the Board decided not to admit the sixth auxiliary request in the appeal procedure.

Seventh to Eleventh Auxiliary Requests

23. The seventh to eleventh auxiliary requests all belong to the aforementioned divergent branch of the request tree (based on original claim 28). Therefore, the Board decided not to admit any of those late requests into the appeal procedure (Article 13(1) RPBA).

Request for a (partial) refund of the fee for a European search

24. The appellant considers that the EPO has enriched itself unfairly by receiving the search fee without performing a search. According to the appellant, the no-search declaration of the search division cannot be

deemed to be a European search report under Rule 63(2) EPC as the search division ignored Rule 63(1) EPC by failing to invite the appellant to file a statement indicating the subject-matter to be searched.

Even in the absence of a specific reimbursement provision in the EPC, the search fee should be reimbursed (partly) according to a pertinent principle of law (*condictio ob rem*) generally recognised in the Contracting States (Article 125 EPC).

Article 9 of the Rules Relating to Fees is said to reflect the principle of fairness as it grants a refund of the search fee if the European patent application is withdrawn or refused or deemed to be withdrawn at a time when the Office has not yet begun to draw up a search report. By way of analogy, the same principle should apply to cases where the EPO has deliberately chosen not to conduct a search, in particular where the choice is based on an unjustified discrimination of subject-matter according to the *Notice from the European Patent Office dated 1 October 2007 concerning business methods* (OJ EPO 2007, 592) which announced a no-search policy for claims pertaining to business methods. In similar fields (such as gaming machines), searches are provided even on minor technical features. In any event, the *Notice* concerning business "methods" is not applicable to the claims of the present application which relate to "devices" comprising technical features. Hence, there has never been any justification for omitting a search.

25. The Board points out that it applies the EPC and associated provisions as they stand. The Rules Relating to Fees do not provide for a refund of the search fee in case of a no-search declaration under Rule 63 EPC.

Rule 63(2) EPC states that such a no-search declaration shall be considered as the European search report.

26. The fact that the search division did not comply with Rule 63(1) EPC (failure to communicate with the appellant) does not alter the legal situation. The search division's actions are not open for review by the Board (Article 106(1) EPC) and, for the same reason, the search division's reliance on the *Notice from the European Patent Office dated 1 October 2007 concerning business methods* is neither.

27. The appellant referred also to Article 125 EPC to postulate a right to a (partial) reimbursement of the search fee when no prior art search has been carried out. Article 125 EPC reads:
"In the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognised in the Contracting States."

What the appellant claims here is to apply an allegedly pertinent principle of law in the Contracting States, namely the law of unfair enrichment. However, the law of unfair enrichment is provided by substantial law, not procedural law. Thus, Article 125 EPC does not provide any basis for the appellant's claim to reimburse the search fee.

28. For the sake of completeness, the Board wishes to express its awareness of the appellant's fundamental right to judicial review but that does not mean that such a review has to be provided by the Boards of Appeal in all types of disputes between an appellant and the European Patent Office or Organisation.

In particular, the Board is not competent to decide on claims for compensation in respect of a loss or damage allegedly caused by the EPO in the course of patent grant proceedings, see e.g. J 14/87 (OJ EPO 1988, 295, point 13, referring to Article 9 EPC "*Liability*").

29. Therefore, the Board considers that the request for a (partial) refund of the search fee is inadmissible.

Request for remittal to the department of first instance

30. According to the appellant, the case should be remitted to the department of first instance because the principle of a fair procedure was violated by not carrying out a search although a search could and should have been carried out in view of technical features of the claimed subject-matter going beyond steps of a business process.

Case law (T 1411/08) required the examining division to ensure that a search was performed before refusing an application for lack of inventive step. This requirement was considered to apply to the present application comprising not only notorious technical features. Instead of supplementing a search, the examining division based the refusal on a mere presumption of what the closest prior art might be.

31. According to Article 106(1) EPC, the Board is not competent to revise acts (such as a no-search declaration) of the search division. Therefore, the Board has to focus on the legitimacy of the examining division's approach not to supplement any prior art document. As set out above, the Board is satisfied that the substantive (problem/solution) discussion in

particular on original claim 1 (current main request) and amended claim 1 (first auxiliary request = former main request refused by the examining division) can start from notorious prior art within the definition of T 1411/08 (points 4.1, 4.2), i.e. prior art for which the examining division was not obliged to provide documentary evidence. It may be added that the application itself (A1, paragraph 0002) acknowledges the pre-existence of pertinent mobile communication devices (smartphones).

Setting out from such close prior art, a skilled person's obvious considerations lead to mobile communication devices according to the various versions of claim 1. The examining division is not required to consider hypothetical (undisclosed or unclaimed) alternative features for the sake of supplementing a search on such features.

Hence, the Board is convinced that the examining division did not violate the procedure when it based its refusal decision on notorious prior art and common general knowledge.

32. Therefore, the Board does not remit the case to the department of first instance (Article 11 RPBA) but exercises its power within the substantive competence of the examining division (Article 111(1) EPC). The Board comprising technically qualified members is in a position to judge the technical content of the claims without remitting the case.

Request for referral of questions to the Enlarged Board of Appeal

33. The appellant requests that the questions of law labelled A to E be referred to the Enlarged Board of Appeal, under Article 112(1)(a) EPC to clarify important points of law, if the Board is not minded to remit the case.

Questions A and C suggest that an applicant's right to be heard (Article 113(1) EPC) might be infringed if no search is carried out with respect to claims relating to business methods or devices, respectively.

Question B suggests that the EPO discriminates unfairly against claims relating to business methods and, thus, might infringe principles of procedural law generally recognised in the Contracting States, contrary to the requirement of Article 125 EPC.

If any such infringement is determined, question D suggests that there might be an absolute requirement for the Board of Appeal to remit the case in order to avert any effect of the infringement.

Finally, question E suggests that a Board of Appeal may have the power and obligation to reimburse at least part of an administrative fee, even in the absence of a direct reimbursement provision in the EPC, by virtue of a generally recognised procedural principle if the corresponding administrative act [such as a search] has not been performed by the European Patent Office.

34. According to Article 112(1)(a) EPC, the Board shall refer a question to the Enlarged Board of Appeal (EBA) if it considers that a decision of the EBA is required

for the purposes of that Article, i.e. for clarifying a point of law of fundamental importance or for ensuring uniform application of the law (Article 112(1) EPC).

However, the Board also notes that it may only refer a question to the EBA if an answer is required to enable the Board to decide on the specific appeal before it (see Case Law of the Boards of Appeal of the European Patent Office, 7th edition 2013, chapter IV.E.9.1.2(a), referring to T 520/01, for example).

If a question can be answered by reference to the EPC without leaving the Board in any doubt, the question does not have to be referred to the EBA (J 5/81, point 11, OJ EPO 1982, 155).

The Board further notes that a question of law is not considered to be of fundamental importance if the problem under consideration is likely to arise rarely in the future (T 2459/12, point 6, referring to T 26/88).

35. In the present case, the questions A to E have been proposed for referral "if the Board does not remit the case". In that context, questions A to C aim at a finding that the non-provision of prior art documents by the search and examining divisions constitutes a substantial violation or fundamental deficiency of the first-instance proceedings so that a remittal to the examining division may be occasioned (question D).

As set out above, the Board does not identify any substantial procedural violation by the examining division. At the same time, the Board is not competent to revise acts (including a potential procedural violation) of the search division or to remit a case to

it (Article 106(1) EPC). On the other hand, the Technical Board of Appeal is able to exercise its power within the competence of the examining division (Article 111(1) EPC), in particular to apply the inventive-step criterion to the claimed communication device and to take a corresponding decision on the substance of the present case.

Thus, the Board sees clear and complete reasons, without seeking guidance from the EBA, for not remitting the case to the department of first instance.

It would be inappropriate, also in terms of procedural economy and legal certainty for third parties, to refer questions to the EBA just for potentially opening a new procedural avenue for remitting a case which can be decided on its substance right away.

An additional procedural loop having no impact on the substantive outcome is considered inappropriate also for the following general reason: The number of no-search declarations issued by the search divisions of the European Patent Office has dropped to an insignificant level. Therefore, the issue of missing prior art citations is likely to arise rarely in the future and, thus, lacks the fundamental importance required for a referral to the EBA under Article 112(1) (a) EPC.

36. Question D presupposes that the Board refers to the EBA at least one of questions A, B and C. As the Board sees no necessity to refer questions A to C to the EBA, there is no point in referring question D.
37. The Board notes that question E is formulated in an abstract manner generalising a specific issue of the

present case: Question E relates to a reimbursement of any fee for which the EPO has not performed the corresponding administrative service, whereas the appellant is specifically seeking a (partial) refund of the search fee in view of a no-search declaration. However, an academic interest in obtaining a general answer to general question E does not justify a referral of the question.

Even if question E was restricted to the specific reimbursement issue of the present case, the Board would add that it has a clear and complete answer to it, i.e. the Board has sufficient arguments (as set out above) to regard a request for a (partial) refund of the European search fee as inadmissible if the request is based on a no-search declaration. That finding and argumentation are also consistent with earlier decisions of the Board in similar cases (e.g. T 506/08-*Online-Auktion/VW*).

38. For completeness, as Article 112(1)(a) EPC also provides for referrals to ensure uniform application of the law, the Board finally notes that it is not aware of any divergence from decisions of other Boards on the issues discussed above in relation to questions A to E.
39. Therefore, the Board does not refer any of the proposed questions to the Enlarged Board of Appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

On behalf of the Chairman
(according to Art. 8(3) RPBA):



T. Buschek

K. Bumes

Decision electronically authenticated