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Datasheet for the decision of 29 March 2017

Case Number: T 1273/14 - 3.5.05

Application Number: 12194315.3

Publication Number: 2565767

IPC: G06F3/048, G06F3/0486

Language of the proceedings: EN

Title of invention:
Portable multifunction device with interface reconfiguration mode

Applicant:
Apple Inc.

Headword:
Icon reconfiguration II/APPLE

Relevant legal provisions:
EPC Art. 76(1), 111(1)

Keyword:
Added subject-matter - (no, after amendment)
Remittal to the first instance for further prosecution - (yes)

Decisions cited:
T 1271/14

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Case Number: T 1273/14 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 29 March 2017

Appellant: (Applicant)	Apple Inc. 1 Infinite Loop Cupertino, CA 95014 (US)
Representative:	Barnfather, Karl Jon Withers & Rogers LLP 4 More London Riverside London SE1 2AU (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 13 January 2014 refusing European patent application No. 12194315.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair	A. Ritzka
Members:	K. Bengi-Akyuerek
	G. Weiss

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division to refuse the present European patent application, divided from its parent application EP 09700333.9, on the sole ground that the omission of the feature "varying positions of one or more icons in the first set of the first plurality of icons about respective average positions" in the independent claims added subject-matter to the parent application as originally filed (Article 76(1) EPC). The present application is related to divisional application No. 12194312.0 underlying appeal case T 1271/14.

II. With the statement setting out the grounds of appeal, the appellant filed amended sets of claims according to a main request and an auxiliary request. It requested that the decision of the examining division be set aside and that a patent be granted on the basis of either of those claim requests.

III. In an annex to the summons to oral proceedings pursuant to Article 15(1) RPBA, the board gave its preliminary opinion on the appeal. In particular, it confirmed the examining division's objections under Article 76(1) EPC and raised further objections under Article 84 EPC. The board also informed the appellant that it was minded to remit the case to the examining division for further prosecution if those objections were overcome.

IV. With a letter of reply, the appellant re-filed the claims of the main request and the auxiliary request on file as main request and first auxiliary request, and filed amended claims according to second and third auxiliary requests. It also advanced counter-arguments

to the board's communication under Article 15(1) RPBA.

V. In a further letter of 22 March 2017, i.e. shortly after the oral proceedings held in parallel case T 1271/14, the appellant filed a new set of claims as a fourth auxiliary request, and stated the following:

"Conditional, on the attached request being allowable, we withdraw all other requests, including the request for oral proceedings."

VI. The board informed the appellant that the oral proceedings appointed for 29 March 2017 had been cancelled.

VII. Claim 1 of the **fourth auxiliary request** reads as follows:

"A computing device (100), comprising:
a touch screen display (112);
one or more processors (120);
memory (102); and
one or more programs, wherein the one or more programs are stored in the memory (102) and configured to be executed by the one or more processors (120), the one or more programs including instructions for:
displaying a first set of icons in a first area (802) on the touch screen display (112); and
entering a reconfiguration mode in response to detecting a finger contact (1114) on one of the first set of icons for greater than a predetermined time; characterized by,
while in the reconfiguration mode, providing an animated effect to one or more of the icons of the first set of icons, and in response to detecting a finger gesture on a first icon (149-3) in the first set

of icons, moving the first icon (149-3) in the first set of icons from a location among the first set of icons in the first area (802) to a location in a second set in an otherwise empty first area (802), wherein the first icon is the only icon in the second set, and wherein the first set of icons and the second set of icons are distinct sets of icons that are separately displayed in the first area, such that the first and second set of icons are not concurrently displayed."

The further independent claims 4 and 7 are directed to a corresponding method and a computer-readable storage medium.

Reasons for the Decision

1. FOURTH AUXILIARY REQUEST

This claim request differs from the set of claims underlying the appealed decision essentially in that present independent claims 1, 4 and 7 now specify that (emphasis added by the board)

A) while in the reconfiguration mode, an animated effect to one or more of the icons of the first set of icons is provided;
B) the first and second sets of icons are distinct sets of icons that are separately displayed in the first area, such that the first and second sets are not concurrently displayed,

while new dependent claims 3, 6 and 9 further specify that

C) the first and second sets are not concurrently displayed except during a transition of the replacement of the first set of icons with the second set of icons.

1.1 *Basis for the amendments*

1.1.1 The amendment relating to feature A), i.e. the provision of visual feedback to the user regarding the actual initialisation of the icon reconfiguration mode, is supported e.g. by page 48, lines 26-27 ("*... The varying of the positions of the one or more icons may include animating the one or more icons ...*") and page 52, lines 30-31 ("*The animated effects during the interface reconfiguration mode, such as the varying position(s) of one or more of the icons ...*") of the original parent application as well as by page 47, lines 24-25 and page 51, lines 27-28 of the present divisional application as filed.

1.1.2 The amendment relating to feature B) finds its basis in page 44, line 31 to page 45, line 1 and page 54, lines 2-5 of the original parent application as well as in page 43, lines 29-30 and page 52, line 31 to page 53, line 2 of the present divisional application as filed. This amendment now clarifies that the first and second sets of icons are not displayed at the same time, implying that the display of the first set is to be replaced by the display of the second one (see board's communication under Article 15(1) RPBA, point 2.1.4).

1.1.3 Lastly, the amendment relating to feature C) is based on page 45, lines 1-2 and page 54, lines 4-5 of the original parent application as well as on page 43, lines 30-31 and page 53, lines 1-2 of the present

divisional application as filed.

1.1.4 Hence, the board is satisfied that the above amendments comply with Articles 76(1) and 123(2) EPC.

1.2 *Clarity (Article 84 EPC)*

Following the amendment relating to feature B), the board is also satisfied that the exact meaning of the expression "separately displayed" is now clearly defined and that therefore present independent claims 1, 4 and 7 fulfil the requirements of Article 84 EPC.

2. *Remittal of the case for further prosecution*

2.1 Given that the sole ground for refusal, i.e. added subject-matter under Article 76(1) EPC, no longer applies (see point 1.1.1 above), the decision under appeal has to be set aside.

2.2 However, the compliance of the present application with the requirements of Article 52 EPC, in particular novelty and inventive step, was neither discussed nor decided in the decision under appeal. Point 2.1 of the European search opinion of 16 January 2013, referred to by the appellant, included only a cursory and hypothetical statement in that regard:

> *"The applicant should be aware that if he enters the examination phase of the present application, the examining division is likely to be identical to the division for EP 09 700 333.9. Therefore, he should expect that the outcome of the examination would be the same. In particular, he is warned that the application would be refused pursuant to Article 97(2) EPC if he does not amend the claims*

to overcome the objection made ... If this objection is overcome by amending the claims, the examining division is likely to issue a communication pursuant to Rule 71(3) EPC."

But at no stage in the examination proceedings was a complete assessment of novelty and inventive step carried out for the claimed subject-matter.

2.3 Thus, the board does not consider itself in a position to assess the correctness of any conclusion of the examining division as regards novelty and inventive step, nor to pass final judgment on that issue for the very first time in these appeal proceedings. Rather, the board has decided, in the exercise of its discretion under Article 111(1) EPC, to remit the case to the examination division for further prosecution, on the basis of the claims of the present fourth auxiliary request.

3. Given that the fourth auxiliary request is now allowable under Articles 76(1), 123(2) and 84 EPC, and that the board is remitting the case to the department of first instance for further prosecution based on that claim request, there are no requests to be considered any further (see point V above).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 9 of the fourth auxiliary request submitted with the letter of 22 March 2017.

The Registrar: The Chair:

S. Fabiani A. Ritzka

Decision electronically authenticated