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**Datasheet for the decision
of 10 September 2021**

Case Number: T 0619/17 - 3.5.07

Application Number: 12764470.6

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G06F9/445, G06F3/0484,
H04M1/725, H04W4/00, G06F17/30,
G06F9/54

Language of the proceedings: EN

Title of invention:
Information processing device and method, and program

Applicant:
FeliCa Networks, Inc.

Headword:
Information processing device/FELICA NETWORKS

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 13(2)

Keyword:
Amendment after summons - exceptional circumstances (yes) -
all requests (admitted)
Inventive step - all requests (no)

Decisions cited:

T 1543/06, T 0064/16



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Case Number: T 0619/17 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 10 September 2021

Appellant: FeliCa Networks, Inc.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 12 October 2016
refusing European patent application
No. 12764470.6 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair J. Geschwind
Members: R. de Man
M. Jaedicke

Summary of Facts and Submissions

I. The appellant (applicant) appealed against the decision of the examining division refusing European patent application No. 12764470.6, published as international application WO 2012/132375.

II. The contested decision cited, *inter alia*, the following documents:

D1: "Nexus One User's Guide", 15 October 2010,
retrieved from: <http://support.t-mobile.com/servlet/JiveServlet/previewBody/1938-102-1-2590/User+manual+-+Google+Nexus+One.pdf>;

D4: US 2010/0076833 A1, 25 March 2010.

The examining division decided that the subject-matter of independent claims 1, 9 and 10 of the main request and of auxiliary request I lacked inventive step over a well-known "general purpose mobile terminal device in communication with a general purpose network server" as disclosed in documents D1 and D4.

The subject-matter of claims 1, 9 and 10 of auxiliary request II extended beyond the content of the application as filed and also lacked inventive step in view of documents D1 and D4.

III. With its statement of grounds of appeal, the appellant maintained the requests considered in the contested decision and filed new auxiliary requests III and IV.

IV. In a communication annexed to the summons to oral proceedings, the board expressed the view that the

subject-matter of all requests lacked inventive step over the prior art acknowledged in the description. It also raised a number of clarity objections and expressed the intention not to admit auxiliary requests III and IV into the appeal proceedings.

- V. With a letter dated 10 August 2021, the appellant replaced its requests with an amended main request and amended auxiliary requests I and II, which were based on the previous main request and auxiliary requests I and III, respectively.
- VI. Oral proceedings were held on 10 September 2021. At the end of the oral proceedings, the Chair announced the board's decision.
- VII. The appellant's final requests were that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, of one of auxiliary requests I and II.
- VIII. Claim 1 of the main request reads as follows:

"A device (100) comprising
an integrated circuit (151), a memory (138), a display unit (157), and a processor (131); wherein
the processor (131) is configured to carry out
controlling acquisition of first information (156) from the memory (138)
controlling acquisition of second information (181) from a server (102) that is external to the device (100),
generating updated first information; and
controlling display on the display unit (157)
based on the updated first information and the second information; and

the integrated circuit (151) is configured to register a part of a plurality of services previously not registered in the integrated circuit (151); and wherein

the first information (156) is about a service not registered in the integrated circuit (151) and a service registered in the integrated circuit (151);

the second information (181) is about a service registered in the integrated circuit (151); and

the updated first information indicates only a service not registered in the integrated circuit (151)."

IX. Claim 1 of auxiliary request I differs from claim 1 of the main request in that the text "in a part of a memory area of the integrated circuit (151)" was inserted after "previously not registered in the integrated circuit (151)".

X. Claim 1 of auxiliary request II reads as follows:

"An integrated circuit chip-mounted information processing device (100) comprising:

an integrated circuit chip (151), a memory (138), a display unit (157), and a processor (131); wherein an open platform is installed on the information processing device (100)

the processor (131) is configured to carry out controlling acquisition of first information (156) from the memory (138)

controlling acquisition of second information (181) from a server (102) that is external to the device (100),

generating updated first information; and

controlling display on the display unit (157) based on the updated first information and the second information; and

the integrated circuit chip (151) is configured to register a part of a plurality of services previously not registered in the integrated circuit chip (151) in a part of a memory area of the integrated circuit chip (151); and wherein

the first information (156) is about a service not registered in the integrated circuit chip (151) and a service registered in the integrated circuit chip (151);

the second information (181) is about a service registered in the integrated circuit chip (151);

the updated first information indicates only a service not registered in the integrated circuit chip (151);

the first information is information related to a bookmark for registering a service; and

the second information is information for allowing a user to use a registered service."

XI. The appellant's arguments, where relevant to the decision, are discussed in detail below.

Reasons for the Decision

1. *The application*

1.1 The application relates to "IC chip-mounted information processing devices". Such a processing device, typically a mobile phone, includes an IC chip having a memory area in which services can be "freely registered and deleted" and needs to be able to display the

services currently registered in the memory area to the user (paragraph [0006] of the published application).

- 1.2 If a "platform unique to a communication carrier" is installed on the device, the device includes "an application required for using the services", which displays the catalogue of service information. To allow the user to introduce a service not registered in the IC chip, a download link is displayed in the service catalogue "as a so-called bookmark" (paragraph [0007]).
- 1.3 Paragraphs [0008] and [0010] then mention "IC chip-mounted information processing devices of recent years on which an open platform is installed" and state that, since such a device does not require "an application required for using a service" to be installed, the above-mentioned "bookmarks" cannot be displayed on it. Instead, a user wishing to register a service needs to access a web site or application market to find and install the desired service.

Main request

2. *Admission into the appeal proceedings - Article 13(2) RPBA 2020*

The main request corresponds to the main request considered in the decision under appeal with amendments addressing a clarity objection raised for the first time in the board's communication. Since these amendments are therefore justified by exceptional circumstances within the meaning of Article 13(2) RPBA 2020, the board admits the main request into the appeal proceedings.

3. *Inventive step*

3.1 The description, in paragraphs [0017] to [0024], describes a known "IC-chip mounted information processing device such as a mobile telephone, or the like, on which a platform unique to a communication carrier is installed" as mentioned earlier in paragraph [0007] of the background section of the application.

3.2 According to paragraph [0008] of the description, at the priority date "IC chip-mounted processing devices on which an open platform is installed" had been in existence for years. Such a device is described in more detail in Figure 2 and paragraphs [0025] to [0028] of the description in the form of a mobile terminal device 20.

In the board's view, this known device is a suitable starting point for assessing inventive step.

3.3 This prior-art device includes a "menu display application" (see paragraph [0026]), which implies the presence of a memory, a display unit and a processor. It also includes an integrated circuit ("IC chip") in which services can be registered (paragraph [0027]) and which is thus "configured to register a part of a plurality of services previously not registered in the integrated circuit".

The subject-matter of claim 1 therefore differs from this prior art in that the processor is adapted to:

- acquire first information "about a service not registered in the integrated circuit and a service registered in the integrated circuit" from the memory;

- acquire second information "about a service registered in the integrated circuit" from an external server;
- generate updated first information indicating "only a service not registered in the integrated circuit"; and
- control "display on the display unit" on the basis of the updated first information and the second information.

3.4 These features reflect commonplace operations in the context of a mobile device: information is retrieved from a memory, information is retrieved from a server, information is processed to produce other information, and information is displayed. Considered individually, these features are therefore obvious.

3.5 Moreover, the combination of these features achieves no effect other than the display to the user of certain non-technical cognitive information and is therefore obvious as well. In particular, the fact that the displayed information is defined merely as being "about" services registered or not registered in the integrated circuit cannot contribute to any technical effect.

3.6 In its statement of grounds of appeal, the appellant argued that the claimed subject-matter allowed the simultaneous display of unregistered and registered service on open platforms, which had not been possible before. This made it unnecessary for a user of an open platform to search for unregistered services and allowed "faster and less energy consuming overview and access to various services".

However, any presentation of information to a user saves the user search time (and also saves the energy that would have been consumed by the search operations that were made redundant) if the information happens to be what the user is looking for. In such a context, this effect is inherent to the presentation of information and is therefore not a technical effect for the purpose of assessing inventive step (see e.g. decisions T 1543/06, Reasons 2.7 and 2.8; T 64/16, Reasons 4.13).

Moreover, the board does not agree with the appellant that the displayed information allows the user to access services. The claimed information "indicating only a service not registered in the integrated circuit" and "about a service registered in the integrated circuit" can essentially be any kind of information and need not in any way "allow access". In any event, displaying hyperlinks is well-known in the art and, in the context of the claim, achieves only its known expected advantages.

3.7 In its submissions in preparation for the oral proceedings and at the oral proceedings, the appellant argued that it was not "carrying out displaying" that rendered the distinguishing features technical but the fact that, by implementing these features, the device gained an additional functionality. As followed from in paragraph [0029] of the description, the prior-art device had not been capable of displaying both registered services and bookmarks. To display bookmarks, a change to the underlying functionality of the device was necessary, as specified in the claim.

However, the distinguishing features can be implemented by programming the prior-art device, which already

includes the required hardware components such as a memory, a display unit and a processor, in a straightforward manner. It is true that the device gains functionality as a result, but since the added functionality does not contribute to the solution of a technical problem, the distinguishing features do not represent an inventive contribution to the prior art (see points 3.5 and 3.6 above).

- 3.8 Hence, the subject-matter of claim 1 lacks inventive step (Article 56 EPC).

Auxiliary request I

4. Claim 1 of auxiliary request I adds to claim 1 of the main request that services are registered "in a part of a memory area of the integrated circuit".

5. *Admission into the appeal proceedings - Article 13(2) RPBA 2020*

Auxiliary request I corresponds to auxiliary request I considered in the decision under appeal with amendments addressing a clarity objection raised for the first time in the board's communication. Since these amendments are therefore justified by exceptional circumstances within the meaning of Article 13(2) RPBA 2020, the board admits the auxiliary request I into the appeal proceedings.

6. *Inventive step*

- 6.1 According to paragraph [0027] of the published application, the IC chip of the prior-art "IC chip-mounted processing devices on which an open platform is installed" includes a memory area with a predetermined

area in which a service is registered. The amendment therefore does not further distinguish the claimed subject-matter from the prior art.

- 6.2 Hence, the subject-matter of claim 1 of auxiliary request I lacks inventive step, too (Article 56 EPC).

Auxiliary request II

7. Claim 1 of auxiliary request II adds the following features to claim 1 of auxiliary request I:

- (a) the device is "an integrated circuit chip-mounted information processing device";
- (b) an open platform is installed on the device;
- (c) the first information relates to "a bookmark for registering a service";
- (d) the second information is "information for allowing a user to use a registered service".

8. *Admission into the appeal proceedings - Article 13(2) RPBA 2020*

- 8.1 Auxiliary request II corresponds to auxiliary request III filed with the statement of grounds of appeal with amendments addressing a clarity objection raised for the first time in the board's communication.

- 8.2 In its communication, the board expressed the intention not to admit the then pending auxiliary request III into the appeal proceedings under Article 12(4) RPBA 2007. The appellant had not explained why the request had not been filed in the first-instance proceedings. And although it had argued that the amendments only clarified the claims, it had also submitted that feature (b) restricted the technical

field of the invention and that the cited prior art did not refer to information processing devices using open platforms at all. In response, the appellant argued that the present auxiliary request II should be seen as a reaction to the board's new inventive-step objection.

8.3 Since the board's inventive-step objection is indeed based on different prior art than the "general purpose mobile terminal device in communication with a general purpose network server" considered in the decision under appeal, the board accepts that the filing of auxiliary request II is justified by exceptional circumstances and therefore admits the request into the appeal proceedings.

9. *Inventive step*

9.1 The prior-art "IC chip-mounted processing devices on which an open platform is installed" acknowledged in the description of the application discloses features (a) and (b).

9.2 According to paragraph [0007] of the application, a prior-art device "on which a platform unique to a communication carrier is installed" included an application that displayed "information of a link for downloading the application ... as a so-called bookmark" for a service not registered in the IC chip, which allowed the user to "introduce" a service not registered in the IC chip.

Hence, displaying "bookmark" links for downloading/registering a service in an IC chip was known from devices "on which a platform unique to a communication carrier is installed". These links helped a user find

and download/register a service not yet registered in the IC chip.

In the board's view, it was obvious to display the same known bookmark links on a device on which an "open platform" was installed, in accordance with feature (c), to help the user find and download/register a service not yet registered in the IC chip, i.e. for their known purpose.

9.3 As for feature (d), the board considers that it was a standard feature of mobile devices that users may access a service from a displayed menu of services.

9.4 According to the appellant, in the context of claim 1, features (c) and (d) allowed displaying "a single service list for bookmarked services and services that can already be used on the information processing device".

However, claim 1 does not require the "information related to a bookmark for registering a service" and the "information for allowing a user to use a registered service" to be displayed in a single list and not, for example, in two separate submenus. In any event, the choice to display such information in a single list is a matter of presentation of information and does not achieve any technical effect in the present case.

9.5 The appellant argued that, as stated in paragraph [0029] of the application, it had not been possible to display the bookmark of a non-registered service in prior-art devices on which an open platform was installed.

However, the board cannot see any technical reason why this would not have been possible. Since the prior-art device included a processor and a display unit, mere programming was sufficient to display the known bookmark link.

9.6 The subject-matter of claim 1 of auxiliary request II therefore lacks inventive step (Article 56 EPC).

Conclusion

10. Since none of the requests on file is allowable, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



S. Lichtenvort

J. Geschwind

Decision electronically authenticated