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**Datasheet for the decision
of 13 May 2022**

Case Number: T 0929/18 - 3.5.01

Application Number: 09157669.4

Publication Number: 2239694

IPC: G06Q10/00

Language of the proceedings: EN

Title of invention:

Publishing location for a limited time

Applicant:

BlackBerry Limited

Headword:

Mobile location data sharing/BLACKBERRY

Relevant legal provisions:

EPC Art. 56, 92

RPBA 2020 Art. 11

EPC R. 103(1)(a)

Keyword:

Remittal to the department of first instance

Remittal - (yes - search required)

Substantial procedural violation (no - error of judgement)

Decisions cited:

T 1242/04, T 1411/08, T 2467/09, T 1515/07, T 1924/07,
T 0690/06, T 0698/11



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Case Number: T 0929/18 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 13 May 2022

Appellant: BlackBerry Limited
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 13 November
2017 refusing European patent application No.
09157669.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: A. Wahrenberg
C. Schmidt

Summary of Facts and Submissions

- I. This is an appeal against the examining division's decision to refuse the European patent application No. 09157669.4 for lack of inventive step (Article 56 EPC).
- II. Neither the search report nor the decision under appeal referred to any prior art documents. The closest prior art was considered to be a notorious data processing system known before the filing date. The examining division considered that the features distinguishing the claimed invention over the prior art did not provide a technical effect, and, therefore, an inventive step was denied.
- III. The appellant requested that the decision to refuse the application be set aside and that a patent be granted on the basis of the refused main request or one of the refused first to third auxiliary requests, all re-filed with the statement setting out the grounds of appeal.
- IV. In a communication accompanying the summons to oral proceedings, the Board tended to agree with the appellant that the independent claims comprised features which were technical and non-notorious. However, as those features were not described as an inventive concept in the application, the Board had doubts whether they could establish an inventive step. The Board noted that, since there had been no search, the case had to be remitted to the examining division if the Board concluded that the claimed invention involved an inventive step over the available prior art.

V. In reply to the Board's communication, the appellant provided further arguments in favour of its case and requested, as a further auxiliary request, that the case be remitted to the examining division for a search.

VI. The oral proceedings took place by videoconference. The appellant confirmed its requests submitted in writing that the decision under appeal be set aside and that a patent be granted on the basis of the main request or one of the first to third auxiliary requests. The appellant further requested to remit the case to the examining division to perform a search.

VII. Claim 5 of the main request reads:

A method for limiting a time for which location data sharing by a mobile user device of a peer-to-peer data sharing group is enabled,

the mobile user device comprising an output interface (702), the output interface (702) comprising a port connectable to a wireless network, a user interface comprising a touch display screen, a processor (828) coupled to the output interface (702) and to the touch display screen, a battery (821) to power active elements of the mobile user device (700), a location sharing module (706) and a location determination system from which the location sharing module receives the location data,

the data sharing group comprising at least two mobile user devices inclusive of the mobile user device, each mobile user device of the data sharing group configured to store data shared by mobile user devices of the data sharing group on the respective mobile user device and to maintain a list of the mobile user devices in the data sharing group, wherein traffic

from any one mobile user device is directed through at least a relay or router configured to direct traffic to the mobile user device (700) of respective members of the group (100), and wherein the relay or router is configured to accept from the mobile user device (700) of a sending group member a single message containing the addresses of multiple receiving group members, and to re-distribute the message independently to the mobile user device (700) of each of the multiple receiving group members,

the mobile user device (700) the method comprising:
receiving an instruction through the user interface on the user device, the instruction indicating that location data sharing is to be enabled for a limited time period after which location sharing is to be disabled (202);

obtaining location data of the user device during the limited time period (204); and

transmitting the location data to at least one other mobile user device of the sharing group during the limited time period (206), the location data being transmitted using the output interface (702);

wherein obtaining location data of the mobile user device comprises obtaining a current location from GPS data in the mobile user device, and

the method further comprising turning off a GPS receiver in the mobile user device after the limited time period expires.

Reasons for the Decision

1. *Summary of the invention*

1.1 The invention concerns the sharing of mobile location data in a peer-to-peer data sharing group. For privacy

reasons or other reasons (paragraph [0005]), the location data sharing is limited to certain time periods (e.g. the next 30 minutes or specific days - see paragraphs [0037] to [0039]). The user can select those time periods via a user interface of the mobile device (see Figures 4B, 5A to 5C, and 6A to 6C).

2. *Main request and first to third auxiliary requests*

2.1 The appellant's request that a patent be granted on the basis of the main request, or one of the first to third auxiliary requests, cannot be allowed because no patent can be granted without a prior art search (Article 52(1) in combination with Article 92 and Rule 61(1)EPC).

3. *The request for remittal*

3.1 The appellant further requested that the case be remitted to the examining division for a search. The Board allows this request for the following reasons.

3.2 The examining division refused the application for lack of inventive step without referring to any document. Essentially, they considered that the technical character of independent claim 5 resided solely in the implementation of an administrative scheme on a notoriously known electronic data processing system comprising a local and a remote computer communicating over a network and exchanging data.

3.3 The Board does not see a problem with the practice of referring to notorious knowledge in such cases; it has the obvious benefit of avoiding the need to prove facts that are self-evident or indisputably well known.

According to the Boards' jurisprudence (see e.g. T 1242/04 - *Provision of product-specific data/MAN*, T 1411/08 - *Pairing providers with consumers/In-Development*, and T 2467/09 - *Custom stores/APPLE*), it is possible to raise an objection of lack of inventive step without documentary prior art if the technical features of the invention are notorious, i.e. so well known that it cannot reasonably be contested that they are prior art.

3.4 The Board does not doubt that the data processing systems envisaged by the examining division are examples of notorious prior art. Hence, no document is needed to prove their existence.

3.5 However, in T 1411/08 (see paragraph 4.2), the Board interpreted "notorious" as implying that technical detail was not significant:

"The examination of a combination of features in relation to inventive step normally involves questions such as what advantages and disadvantages the combination is said to have, and in what technical areas it is used. This is the sort of information a search should uncover. On the other hand, a claim may be so drafted that such questions do not arise. It is prior art reflecting such generic features that the Board understands as "notorious". Thus a "computer for sending a message" is notorious, whereas a "32-bit computer for sending a message" would not be, when, for example, questions of advantages and disadvantages of 32-bit computers arise."

3.6 Claim 5 refers to mobile user devices in a "peer-to-peer" data sharing group. Each mobile user device of the data sharing group stores the shared data and

maintains a list of the mobile user devices in the data sharing group. Messages from one mobile user device are directed to the respective members of the group through a relay or router, and the messages contain the addresses of the group members.

- 3.7 It appears from their decision that the examining division considered that the "peer-to-peer" data sharing group was administrative in nature (end of point 1.3) and that the implementation via the relay or router was an example of the above-mentioned insignificant technical detail, essentially being mapped onto the router in a conventional network (point 2.2).
- 3.8 In its communication accompanying the summons to oral proceedings, the Board had misgivings about the peer-to-peer aspect of the invention. Firstly it did not appear to be part of the inventive concept in the sense that it contributed to the problem that the application set out to solve. It also rather appeared from the way in which the application presented the invention that "peer-to-peer" was part of the background framework or at least technically irrelevant. Finally since the application did not go into much detail on how the peer-to-peer data sharing was to be implemented, there might have been some doubt whether the invention was sufficiently disclosed (Article 83 EPC).
- 3.9 At the oral proceedings, the appellant argued that the application did not describe the claimed aspects of peer-to-peer networking as known, and moreover that limiting the time period during which the devices shared data was particularly advantageous in mobile peer-to-peer networks. In other words, the peer-to-peer aspect was a significant technical detail and was part

of the inventive concept.

- 3.10 The Board considers that, taken together, the features of the mobile device, peer-to-peer, group data and address arrangement and the relay or router given in paragraph 3.6 above define details of an electronic communication architecture that cannot be dissected into non-technical and technical parts. In other words, the Board considers that a mobile user device of a peer-to-peer data sharing group is a technical feature of the infrastructure of the system. The Board also considers that this implies the type of technical detail meant in T 1411/08 (*supra*) and thus goes beyond a notorious data processing system.
- 3.11 Although the Board still has doubts about the significance of the peer-to-peer feature it would be unfair to judge such issues without proper prior art. This would be to put the cart before the horse by putting the substantive examination before the search (see e.g. T 1515/07 - *Cost estimate/SAP* at point 6, last paragraph). Indeed, a search may reveal prior art which puts the invention in a perspective that is different from what was originally set out in the application. Also, there has been a lot of development in mobile communication networks since the filing date of the application. Thus, what is self-evident now might not have been so in 2009. Therefore, the Board judges that a search is necessary.
- 3.12 According to Article 11 RPBA 2020, the Board shall not remit a case to the department whose decision was appealed for further prosecution unless special reasons present themselves for doing so. Remitting the case for a search to be carried out is a special reason.

3.13 For these reasons, the Board remits the case to the examining division for an additional search to be carried out (Guidelines C-IV 7.2). The Board notes that the Guidelines do not define what such an additional search should cover. However, it goes without saying that, in a case like this where no search has been carried out, the additional search should be just as complete as a normal prior art search under Article 92 EPC. Furthermore, in the interest of proper administration, the results of the search ought to be presented in the public file, either in a separate document or in a communication of the examining division. At a minimum, the field of search and the relevant documents should be indicated. Should the search not reveal any relevant documents, a statement to that effect would allow the applicant, a Board of Appeal, and third parties to conclude that the search has been completed.

4. *Reimbursement of the appeal fee*

4.1 Under Rule 103(1)(a) EPC, the appeal fee shall be reimbursed where the Board deems the appeal to be allowable if such reimbursement is equitable by reason of a substantial procedural violation.

The jurisprudence holds that the failure of the examining division to carry out an additional search when this was "manifestly necessary" amounts to a substantial procedural violation which warrants the reimbursement of the appeal fee (see T 1242/04, *supra* and T 1515/07, *supra*). However, when judging whether a search was "manifestly necessary" a distinction must be made between a situation where the examining division failed to carry out a search despite realising that the feature was technical, and the situation where the

division misjudged the feature's technical contribution (see T 1924/07 - *FA Information/BRIDGESTONE CORP.* referring to T 690/06 - *Financial records/AUKOL* and T 698/11 - *Financial records/AUKOL*). The latter is an error of judgement rather than a procedural error. In such cases, the appeal fee shall not be reimbursed since no procedural violation occurred.

In the present case the examining division considered that the "peer-to-peer" data sharing was non-technical and the relay or router was part of a notorious network infrastructure. The examining division gave reasons to this effect, and those reasons were coherent and logical. The Board, however, simply has a different interpretation of the same facts. Therefore, the Board judges that no substantive procedural violation occurred. Consequently, the criteria for reimbursing the appeal fee set out in Rule 103(1) (a) EPC are not satisfied.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution including a search.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated