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**Datasheet for the decision
of 16 March 2023**

Case Number: T 1225/19 - 3.4.03

Application Number: 12174629.1

Publication Number: 2665023

IPC: G06Q10/10

Language of the proceedings: EN

Title of invention:

Methods and devices for providing action item reminders

Applicant:

BlackBerry Limited

Headword:

Relevant legal provisions:

EPC Art. 52(1), 56

RPBA Art. 12(4)

Keyword:

Inventive step - mixture of technical and non-technical features - main request (no) - first and second auxiliary request (no)

Late-filed request - submitted with the statement of grounds of appeal - third auxiliary request - admitted (no)

Decisions cited:

T 0641/00, T 1212/08

Catchword:



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Case Number: T 1225/19 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 16 March 2023

Appellant: BlackBerry Limited
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 12 December
2018 refusing European patent application No.
12174629.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman T. Häusser
Members: J. Thomas
T. Bokor

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 12 174 629 on the grounds that the subject-matter defined in the independent claims of the then main request and the then first and second auxiliary requests did not involve an inventive step (Article 52(1) EPC in combination with Article 56 EPC).
- II. At the end of the oral proceedings before the board the appellant requested that the decision under appeal be set aside and a patent be granted on one of the main request or first to third auxiliary requests, all submitted with the statement setting out the grounds of appeal. The main request and the first and second auxiliary requests are identical to the corresponding requests underlying the impugned decision.
- III. The following documents are referred to below:
- D4: US 2007/188319 A1
D5: US 7 212 827 B1
- IV. Claim 1 of the main request reads as follows:
- "A method performed by a processor (240) on an electronic device (201),
the method comprising:
receiving (310) a request for creation of an action item (300), the action item (300) comprising a record of proposed future action;
obtaining (312) context information associated with the action item, the context information specifying two or more reminder conditions associated with the action*

item (300), wherein one of the reminder conditions comprises a contact to be involved in completing the action item; and triggering (1102) a reminder of the action item based on the two or more reminder conditions when conditions corresponding to the two or more reminder conditions are determined to exist, wherein a visual, audible or vibratory reminder is generated on the electronic device (201) when the reminder is triggered, wherein triggering a reminder of the action item comprises identifying possible interactions with the contact and triggering the reminder when such possible interactions are identified, and wherein identifying possible interactions with the contact comprises: consulting a location sharing service, the location sharing service providing location information identifying a location of the contact, wherein the location of the contact is a current or future location of the contact; and determining whether an interaction is possible by comparing a location of the electronic device (201) obtained from a location sensor (261) of the electronic device (201) with the location of the contact."

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

"A method performed by a processor (240) on an electronic device (201), the method comprising: receiving (310) a request for creation of an action item (300), the action item (300) comprising a record of proposed future action; obtaining (312) context information associated with the action item, the context information specifying two or

more reminder conditions associated with the action item (300), wherein one of the reminder conditions comprises a contact to be involved in completing the action item; and triggering (1102) a reminder of the action item based on the two or more reminder conditions when conditions corresponding to the two or more reminder conditions are determined to exist, wherein a visual, audible or vibratory reminder is generated on the electronic device (201) when the reminder is triggered, wherein triggering a reminder of the action item comprises identifying possible interactions with the contact and triggering the reminder when such possible interactions are identified, and wherein identifying possible interactions with the contact comprises one of: identifying one or more appointments scheduled with the contact, identifying a communication with the contact, and identifying planned travel to a region associated with the contact."

VI. Claim 1 of the second auxiliary request reads as follows:

"A method performed by a processor (240) on an electronic device (201), the method comprising: receiving (310) a request for creation of an action item (300), the action item (300) comprising a record of proposed future action; wherein the request for creating of the action item (300) is a request to create the action item (300) based on stored content (301) and wherein a reminder of the action item provides access to the stored content (301), wherein the stored content (301) is one of: a video; an audio

file; a word-processor document; an electronic book; or an image;
obtaining (312) context information associated with the action item, the context information specifying two or more reminder conditions associated with the action item (300), wherein one of the reminder conditions comprises a contact to be involved in completing the action item; and
triggering (1102) the reminder of the action item based on the two or more reminder conditions when conditions corresponding to the two or more reminder conditions are determined to exist, wherein a visual, audible or vibratory reminder is generated on the electronic device (201) when the reminder is triggered, wherein triggering a reminder of the action item comprises identifying possible interactions with the contact and triggering the reminder when such possible interactions are identified, and
wherein identifying possible interactions with the contact comprises:
consulting a location sharing service, the location sharing service providing location information
identifying a location of the contact, wherein the location of the contact is a current or future location of the contact; and
determining whether an interaction is possible by comparing a location of the electronic device (201) obtained from a location sensor (261) of the electronic device (201) with the location of the contact."

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

*"A method performed by a processor (240) on an electronic device (201),
the method comprising:*

receiving (310) a request for creation of an action item (300), the action item (300) comprising a record of proposed future action;
obtaining (312) context information associated with the action item, the context information specifying two or more reminder conditions associated with the action item (300), wherein one of the reminder conditions comprises a contact to be involved in completing the action item; and
triggering (1102) a reminder of the action item based on the two or more reminder conditions when conditions corresponding to the two or more reminder conditions are determined to exist, wherein a visual, audible or vibratory reminder is generated on the electronic device (201) when the reminder is triggered, wherein triggering the reminder of the action item comprises identifying possible interactions with the contact and triggering the reminder when such possible interactions are identified, and
wherein identifying possible interactions with the contact comprises:
identifying planned travel to a region associated with the contact by comparing a destination address input into a navigation application to an address or location associated with the contact."

VIII. The appellant's arguments, insofar as they are relevant to the present decision, may be summarised as follows:

Main request - inventive step

The subject-matter of claim 1 comprised a combination of technical and non-technical features. However, it involved an inventive step because

- feature a) ("*wherein identifying possible interactions with the contact comprises: consulting*

a location sharing service, the location sharing service providing location information identifying a location of the contact, wherein the location of the contact is a current or future location of the contact") and

- *feature b) ("determining whether an interaction is possible by comparing a location of the electronic device (201) obtained from a location sensor (261) of the electronic device (201) with the location of the contact")*

defined technical means which should not be part of the non-technical business constraints. The separation between the technical and the non-technical features should be drawn differently from what was done by the examining division. The use of an external service like a *"location sharing service"* provided an inventive contribution in particular in combination with an additional location sensor. Including these features in the business constraints raised the question how *"smart"* the business person was and which technical information were known to the business person. Therefore, the use of both a location sensor and a location sharing device could not be considered as being part of the business constraints. The processor had to consult two different sources, the location sharing service and the location sensor and bring the corresponding information together. This combined use of a location sharing service and a location sensor were technical and not obvious. Both features were also nowhere disclosed in combination in the prior art. Hence, the two features a) and b) as defined in claim 1 involved an inventive step.

First auxiliary request - inventive step

The further definitions of the identifying step as defined in claim 1 of this request related to the technical improvement of the functionality of the electronic device. It was not rendered obvious by the available state of the art and was therefore inventive.

Second auxiliary request - inventive step

The amended features, namely the link of the reminder to a stored content which was stored prior to the creation of the action item was not obvious and could not be reduced to a business constraint. It allowed automatic access to a stored content and thus eliminated the need for manual access to that stored content, since it was automatically provided in combination with the reminder. This made the access to the stored content easier and faster and reduced power consumption and wear and tear on the input device. Hence, an inventive step should be acknowledged.

Third auxiliary request - admittance

The subject-matter of claim 1 of the third auxiliary request did not constitute a "*fresh case*". The newly added features had a basis in the originally filed claim 8 and were only further refined by features from the description. Since only one embodiment was shown in the description in relation to the subject-matter defined in original claim 8, it could be assumed that these features, even though taken from the description, had also been searched. Moreover, the absence of the appellant/applicant at the oral proceedings before the examining division should not be punished in the appeal proceedings. The appellant/applicant at that time rightly considered participation in the oral proceedings as useless due to the deadlocked opinion of

the examining division. Moreover, this request was only filed with the statement setting out the grounds of appeal because time was needed to react thoughtfully and not hastily to the examining division's decision. Therefore, the third auxiliary request should be admitted into the proceedings as it constituted the first possible reaction to the division's decision.

Reasons for the Decision

1. Main request - inventive step
 - 1.1 The subject-matter defined in claim 1 of the main request relates to a method for automated triggering of a reminder in an electronic device in order to manage the tasks of a user in an electronic device. The conditions for automated triggering of a reminder are based on business requirements which are considered non-technical constraints. These non-technical constraints for automated reminder triggering consist in obtaining contextual information associated with the task foreseen in the reminder specifying conditions relating to the proximity of the user to other people/ contacts that are involved in this task. The problem addressed does not require a technical solution, but rather relates to a straightforward computer implementation of a purely administrative scheme based on the mentioned non-technical constraints. The scheme can even be performed as a mental act by a non-technical actor such as a secretary.
 - 1.2 There is no doubt that the claimed subject-matter as a whole is technical because the business scheme is executed by a processor, i.e. the non-technical method is computer-implemented. Thus, in addition to the non-technical features, the subject-matter of claim 1

includes technical features, in particular a "processor ... on an electronic device". Thus, the subject-matter of claim 1 relates to an invention within the meaning of Article 52(1) EPC.

- 1.3 However, the features defined in claim 1 represent a mixture of technical and non-technical features. An invention consisting of a mixture of technical and non-technical features and having technical character as a whole is to be assessed with respect to inventive step by taking account of all those features which contribute to the technical character whereas features making no such technical contribution cannot support the presence of inventive step (see T 641/00; Official Journal EPO, 7/2003, pages 352 to 364).
- 1.4 The board is of the opinion that the technical features of claim 1 pertain to a processor on an electronic device configured to receive and process information, the device being adapted to generate visual, audible or vibratory reminders. The processor further receives data from the location sensor integrated in the electronic device and the location of a contact determined by additional means, namely the location sharing service. Both obtained locations are compared by the processor for determining their proximity.
- 1.5 All these features as such are individually known and are also known as being, if necessary, integrated in a notorious computer system. This represents the technically skilled person's notorious knowledge. Although no documentary evidence is necessary for notorious knowledge, D4 and D5 are cited in this context as examples of such devices. This notorious knowledge represents the starting point for assessing inventive step. Therefore, for assessing inventive step

the board starts from a processor of an electronic device configured to receive and process information, the device being adapted to generate visual, audible or vibratory reminders and also including a location sensor, as for example a personal digital assistant (PDA).

- 1.6 When starting from a notorious computer system, like a PDA, the business person provides the following purely administrative/business scheme as business constraints to the technically skilled person for implementation on the notorious computer system:
- receiving a request for creation of an action item, the action item concerning proposed future action of a user;
 - obtaining context information associated with the action item, the context information specifying two or more reminder conditions associated with the action item, wherein one of the reminder conditions comprises a contact of the user to be involved in completing the action item; and
 - triggering a reminder of the action item based on the two or more reminder conditions when conditions corresponding to the two or more reminder conditions are determined to exist, wherein triggering a reminder of the action item comprises the identification of possible interactions of the user with the contact and the triggering of the reminder when such possible interactions are identified, and wherein identifying possible interactions with the contact comprises determining the position of the user and the current or future location of the contact and determining whether an interaction is possible between the user and the contact.

The entire scheme can be summarized by the following, purely administrative instructions: "*please, remind the user of an action (item), when a contact which is involved in the action (item) is or will be close to the user, in order to realise the action (item)*", whereby the board considers "action" and "action item" being equivalents.

Having this business scheme in hand, the skilled person, a software programmer, has to solve the objective technical problem of providing the computer implementation and automation of the above formulated business method in the notorious electronic device. The provided technical solution neither calls for a particular technical implementation nor provides a further technical effect beyond the straightforward computer implementation. In particular, the implementation of this business constraint ("*please, remind the user, ... the action item*") relating to the determination of the proximity of a contact and the user, is held by the board, contrary to the appellant's view, not inventive. It will be set out in the following that

- the business person does not provide any technical input but only the above cited business method including only non-technical, administrative constraints and that
- the technically skilled person implements the above cited business method in a straightforward manner on the processor (of the PDA) using only common general knowledge in order to arrive immediately at the solution defined in claim 1.

In relation with the business constraints the appellant argued that the following two features a) and b) defined in claim 1 were technical and should not be

part of the formulation of the administrative business scheme:

- feature a): *"consulting a location sharing service, the location sharing service providing location information identifying a location of the contact, wherein the location of the contact is a current or future location of the contact"* and
- feature b): *"determining whether an interaction is possible by comparing a location of the electronic device (201) obtained from a location sensor (261) of the electronic device (201) with the location of the contact"*.

In the board's view, even though the two features a) and b) include some technical features, they cannot contribute to inventive step since they derive immediately and obviously from the straightforward computer implementation of the underlying non-technical aim. This underlying non-technical aim is based on the business constraint, see also above: *"please, remind the user of an action (item), when a contact which is involved in the action (item) is or will be close to the user, in order to realise the action (item)"*.

This business constraint is clearly not of a technical nature and falls within the normal realm of a business person, who has no technical knowledge. Contrary to the appellant's doubts, the board does not consider the possible technical knowledge of a notional business person to be relevant for the present case, because the technical parts are notorious or obvious to the technically skilled person.

As discussed above the device according to the closest prior art includes a location sensor. Therefore, the determination of the location of the user is

straightforward using the location sensor of the device. It is also obvious that for locating "the contact" a different tool from the device is necessary. Locating an external contact using a location based service or a location sharing service was at the filing date part of the state of the art, as the location based services had long been known at that time (they are known since the 1990s). One known and commercialised location sharing service, namely "FoursquareTM", is even mentioned in paragraph [00132] of the application itself, thereby indicating known prior art at the time of filing. Therefore the skilled person would have taken this knowledge of available tools into account in its straightforward implementation of the above mentioned business constraint. In this way the skilled person would easily and in a straightforward manner implement the determination of the location of the electronic device (the user) and the contact. Finally, knowing these two locations, the skilled person finds a way to determine if an interaction is possible by comparing the two locations, e.g. the corresponding coordinates. This is all the more true as the determining step (feature b)) including a comparison of the two locations is defined in a technically unspecific manner in the wording of claim 1.

Hence, features a) and b) derive immediately from the straightforward implementation of the non-technical business requirement mentioned above. All other features relating to the remaining steps of the computer implementation of the business scheme are also straightforward implementations since the technical means required for all these various procedural steps are well-known standard features and the definition

according to claim 1 is technically unspecified. This is not disputed by the appellant.

Since the result of the straightforward implementation of the above cited business scheme is the method defined in claim 1, the board concludes that the subject-matter of claim 1 of the main request does not involve an inventive step (Articles 52(1) and 56 EPC).

2. First auxiliary request - inventive step
 - 2.1 Claim 1 of the first auxiliary request was amended in relation to claim 1 of the main request by deleting the above discussed features a) and b) and replacing the passage "*wherein identifying possible interactions with the contact comprises:*" by the following wording:
*"wherein identifying possible interactions with the contact comprises one of:
identifying one or more appointments scheduled with the contact,
identifying a communication with the contact, and
identifying planned travel to a region associated with the contact"*.
 - 2.2 The board is of the opinion that these amendments do not to change the non-technical nature of the underlying problem nor do they provide any further technical effect. These newly introduced features represent further non-technical business constraints of the underlying administrative/business method. They are handed over to the skilled person, who implements them in a straightforward manner without any difficulty.
 - 2.3 As to the appellant's argument in this regard, the board notes that the automatic determination of the "identification" of appointments, communications or

planned travel are inherent side effects of the computer implementation and automation of the process. This automation is not considered as a further special technical effect that may establish inventive step. It is a foreseeable effect of the computer implementation of the underlying business constraint.

2.4 Therefore, these features cannot support inventive step, and the board concludes that the subject-matter defined in claim 1 of the first auxiliary request lacks an inventive step (Articles 52(1) and 56 EPC).

3. Second auxiliary request - inventive step

3.1 Claim 1 was amended compared to claim 1 of the main request by adding after the "receiving" step and prior to the "obtaining" step the following wording:
"wherein the request for creating of the action item (300) is a request to create the action item (300) based on stored content (301) and wherein a reminder of the action item provides access to the stored content (301), wherein the stored content (301) is one of: a video; an audio file; a word-processor document; an electronic book; or an image;"

3.2 In addition to the non-inventive subject-matter defined in claim 1 of the main request these features now additionally defined in claim 1 of the second auxiliary request refer to an additional business constraint provided by the business person and handed over to the technically skilled person for computer implementation, namely that the reminder is based on specific information which should then be provided to the user together with the reminder. For example, a reminder for a meeting with another persons is created using a document including the agenda of the future meeting and

access to the agenda is automatically provided to the user when the reminder is triggered. The skilled person will have no difficulty to implement this as a further implementation step in addition to all steps carried out in relation to the business scheme already dealt with for the main request.

3.3 The technical advantages as argued by the appellant, namely the reduction of wear and tear, the reduction of power consumption and the reduction of time when accessing the stored content are technical advantages which are inevitable side effects of the computer implementation itself. These side effects cannot be considered as further special technical effects since they derive inherently from the computer implementation of the desired business aim.

3.4 Therefore, the board concludes that the subject-matter defined in claim 1 of the second auxiliary request does not involve an inventive step (Articles 52(1) and 56 EPC), either.

4. Third auxiliary request - admittance

4.1 The third auxiliary request was submitted for the first time with the statement setting out the grounds of appeal. The board therefore has the discretion not to admit this request into the proceedings under Article 12(4) RPBA 2007 (which here applies according to Article 25(2) RPBA 2020), if it considers that it could and should have been filed during the first instance proceedings.

4.2 Claim 1 of the third auxiliary request is based on claim 1 of the main request with the following amendments:

- The above discussed features a) and b) ("*consulting a location sharing service ... with the location of the contact*") are deleted.
- The following feature is added at the end of claim 1: "*identifying planned travel to a region associated with the contact by comparing a destination address input into a navigation application to an address or location associated with the contact*".

Basis for the added feature is given in original claim 8 ("*identifying planned travel to a region associated with the contact*") and the original description, paragraph [00137] ("*by comparing a destination address input into a navigation application to an address or location associated with the contact*").

4.3 The addition of a feature from the description in the wording of a claim normally changes the overall focus of the claimed subject-matter and is considered a "*fresh case*". Subject-matter relating to a "*fresh case*" was not taken into account with certainty when searching the application and should therefore have been filed during the first instance proceedings. According to established case law of the Boards of Appeal (see *Case Law of the Boards of Appeal of the EPO*, 10th edition 2022, V.A.5.2.2 and V.A.5.11.4 a); T 1212/08) it was common practice under the RPBA 2007 not to admit a request filed for the first time with the statement setting out the grounds of appeal if this request constitutes a "*fresh case*" (i.e. using features taken from the description). The reasons therefore are that the board either would have to examine and decide on the amended subject-matter for the first time during

appeal, or that the board would have to remit the case to the department of first instance for further prosecution thereby considerably prolonging the proceedings. Both procedural options are generally to be avoided (see also Article 11 RPBA), as the primary objective of the appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020).

- 4.4 The board is of the opinion that, contrary to the appellant's assertion, the newly added features taken from the description, paragraph [0137], indeed constitute a "*fresh case*".

These features do not only refine or clarify the amended features taken from original claim 8, but constitute additional features which cannot be considered implicit to the features defined in original claim 8. "*[C]omparing a destination address input into a navigation application to an address or location associated with the contact*" represents a more detailed specification of a previously defined, more general feature. These additional features are not an obvious refinement or an explicit definition of a previously implicit feature, but represent a specific selection of new additional features. Therefore, the features taken from the description are separate additional features compared to the features defined in the original claim 8 going beyond a mere refinement or clarification.

Moreover, the board sees no reason to assume that the entrusted search examiner performed the search beyond the content defined in the original claims, including these features taken from the description. It is not a prerequisite that all additional features described in

the description have to be taken into account in the search, even if these features relate to a single embodiment shown in the description and relating to more general features defined in an dependent claim.

Therefore, the board concludes that the amendments of claim 1 of the third auxiliary request represent a "*fresh case*".

- 4.5 Moreover, the board is also of the opinion that the appellant/applicant did not file this request, which was submitted for the first time with the statement setting out the grounds of appeal, at the earliest possible occasion. A telephone conversation between the first examiner and the appellant/applicant took place about a week before the oral proceedings before the examining division. A protocol of this conversation, which comprised 16 pages, was sent to the appellant/applicant prior to the oral proceedings. The appellant/applicant was therefore informed during the telephone conversation (and by the protocol) in detail about the examining division's negative opinion on the subject-matter then on file and about the maintenance of the date for oral proceedings before the examining division. Since the protocol is in substance identical to the examining division's decision, the appellant/applicant was in fact well informed about the reasons of the refusal in detail prior to the oral proceedings and could have been expected to react accordingly, e.g. by participating in the oral proceedings. However, despite being aware of the examining division's negative opinion, the appellant/applicant decided not to attend the oral proceedings before the examining division, thus foregoing an opportunity to file this request.

- 4.6 The argument that the appellant, in response to the telephone conversation, wanted to react to the examining division's decision in a calm and reflected manner without any time pressure is also not convincing. On the one hand, if the appellant/applicant had attended the oral proceedings, it would have had the opportunity to file this request, whereby the available time would have been considered sufficient. On the other hand, even prior to the telephone conversation the appellant/applicant could have considered exactly which request(s) it wanted to pursue, since the negative opinion of the examining division was known prior to the above-mentioned telephone conversation. Already in the summons to oral proceedings the examining division indicated its negative opinion with regard to the main request.
- 4.7 The decision of the appellant not to attend the oral proceedings and not to submit the third auxiliary request during the first instance proceedings constitutes, according to the board's opinion, a deliberate waiver of this fallback position. This should not be created now for the first time in the appeal proceedings. Even if the appellant/applicant had considered participation in the oral proceedings futile because of a settled opinion of the examining division, it could and should have considered at that stage which subject-matter exactly it wished to pursue in the appeal proceedings. It could have filed corresponding requests in preparation of the oral proceedings at that time.
- 4.8 The board is aware that the admission of a request with substantial new matter during the oral proceedings before the examining division may have been difficult. However, that does not alter the fact that, already in

the proceedings before the examining division, the appellant did not avail itself of the procedural possibilities which, as explained above, were clearly available to it, namely attending the oral proceedings in order to defend its claims, or at least filing the new request with written observations, so that the examining division could still have made at least a *prima facie* assessment of its substance at the oral proceedings.

4.9 Therefore, in view of the above the board decides not to admit the third auxiliary request into the appeal procedure (Article 12(4) RPBA 2007).

5. Conclusion

Since the subject-matter defined in respective claim 1 of the main request and the first and second auxiliary requests does not involve an inventive step within the meaning of Articles 52(1) and 56 EPC and the third auxiliary request was not admitted into the appeal proceedings under Article 12(4) RPBA 2007, the appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

T. Häusser

Decision electronically authenticated