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**Datasheet for the decision
of 28 March 2023**

Case Number: T 1089/20 - 3.5.03

Application Number: 16157697.0

Publication Number: 3094067

IPC: H04M1/247, H04M1/725,
H04M1/2745

Language of the proceedings: EN

Title of invention:

Method and device for communication channel selection

Patent Proprietor:

QUALCOMM Incorporated

Opponents:

Apple Distribution International Ltd ("opponent 1")
Intel Corporation ("opponent 2" until 12 February 2021)

Headword:

Usable communication channels I/QUALCOMM

Relevant legal provisions:

EPC Art. 76(1), 100(c)
RPBA 2020 Art. 13(2)

Keyword:

Added subject-matter having regard to earlier application: main request, auxiliary requests 1 and 2 (yes)

Admittance of requests filed after summons - auxiliary requests 1A, 1B, 2A, 2B: no exceptional circumstances justified with cogent reasons (including reasons related to parallel national proceedings)

Decisions cited:

T 1255/18, T 2271/18, T 2632/18



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Case Number: T 1089/20 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 28 March 2023

Appellant: QUALCOMM Incorporated
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Representative: Quinn Emanuel Urquhart & Sullivan, LLP
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Respondent: Apple Distribution International Ltd
(Opponent 1) Hollyhill Industrial Estate
Hollyhill Cork (IE)

Representative: Samson & Partner Patentanwälte mbB
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 7 February 2020
revoking European patent No. 3094067 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: J. Eraso Helguera
R. Romandini

Summary of Facts and Submissions

- I. This case concerns the appeal filed by the proprietor against the decision of the opposition division revoking the opposed patent under Article 101(2) and (3) (b) EPC.
- II. Opponent 2 withdrew its opposition after having sent a reply to the statement setting out the grounds of appeal.
- III. Oral proceedings before the board were held on 28 March 2023. The final requests of the parties were:
- The proprietor (appellant) requested, as a **main request**, that the decision under appeal be set aside and that the opposition be rejected (i.e. that the patent be maintained in its granted form), or that the patent be maintained in amended form on the basis of the claims of one of six auxiliary requests: **auxiliary requests 1, 1A, 1B, 2, 2A and 2B**; auxiliary requests 1 and 2 were subject to the decision under appeal, whereas auxiliary requests 1A, 1B, 2A and 2B were filed with the proprietor's response to the board's communication under Article 15(1) RPBA 2020.
 - Opponent 1 (respondent) requested that the appeal be dismissed.

At the end of the oral proceedings, the board's decision was announced.

- IV. Claim 1 as granted (**main request**) reads as follows:

"A method for initiating a communication link from a first communication terminal (10) to a second communication terminal, comprising the steps of:

sensing input of an address number by a user in the first communication terminal (10), representing a communication address for the second communication terminal;

retrieving information associated with the communication address of the second communication terminal;

presenting the retrieved information on a display (15) of the first communication terminal (10);

retrieving information related to selectable communication channels usable for communication with second communication terminal; and

presenting, on the display (15) of the first communication terminal (10), a plurality of selectable items (152-157) only representing the usable communication channels, responsive to sensing input of the address number;

wherein once the user of the first communication terminal starts to type numbers, the different usable communications channels are presented for selection."

Claim 1 of **auxiliary request 1** is identical to claim 1 as granted, except for:

- the replacement of "representing a communication address for the second communication terminal" by:

"wherein the input address number is a communication address in the form of a telephone number for the second communication terminal"

- the deletion of "and" right after "for communication with second communication terminal;" and
- the addition of "; and presenting the plurality of selectable items (152-157) as separate icons" at the very end of the claim.

Claim 1 of **auxiliary request 1A** is identical to claim 1 of auxiliary request 1, except for the replacement of "the different usable communications channels are presented for selection" by:

"checking for communication addresses stored in a communication address memory of the first communication terminal starting with those numbers and upon recognition of the communication address of the second communication terminal presenting the different usable communications channels for selection".

Claim 1 of **auxiliary request 1B** is identical to claim 1 of auxiliary request 1A, except for:

- the insertion of "in a typing field of the display" right after "starts to type numbers" and
- the insertion of "filling in the typing field automatically and" right before "presenting the different usable communications channels for selection".

Claim 1 of **auxiliary request 2** is identical to claim 1 of auxiliary request 1, except for the addition of:

"; and wherein the different communication channels include any two types within the group of: voice

call, video call, text messaging, picture messaging and email"

at the very end of the claim.

Claim 1 of **auxiliary request 2A** is identical to claim 1 of auxiliary request 2, except for the replacement of "the different usable communications channels are presented for selection" by:

"checking for communication addresses stored in a communication address memory of the first communication terminal starting with those numbers and upon recognition of the communication address of the second communication terminal presenting the different usable communications channels for selection".

Claim 1 of **auxiliary request 2B** is identical to claim 1 of auxiliary request 2A, except for:

- the insertion of "in a typing field of the display" right after "starts to type numbers" and
- the insertion of "filling in the typing field automatically and" right before "presenting the different usable communications channels for selection".

Reasons for the Decision

1. MAIN REQUEST

Claim 1 as granted comprises the following limiting features:

- 1.0 A method for initiating a communication link from a first communication terminal to a second communication terminal, comprising the steps of:
 - 1.1 sensing input of an address number by a user in the first communication terminal, representing a communication address for the second communication terminal;
 - 1.2 retrieving information associated with the communication address of the second communication terminal;
 - 1.3 presenting the retrieved information on a display of the first communication terminal;
 - 1.4 retrieving information related to selectable communication channels usable for communication with second communication terminal;
 - 1.5 presenting, on the display of the first communication terminal, a plurality of selectable items only representing the usable communication channels, responsive to sensing input of the address number;
 - 1.5.1 once the user of the first communication terminal starts to type numbers, the different usable communication[s] channels are presented for selection.

1.1 *Claim 1 - added subject-matter (Articles 100(c) and 76(1) EPC)*

1.1.1 The opposition division indicated in Reasons B of the appealed decision that neither page 12, lines 14 to 27 nor page 14, lines 11 to 13 of the earlier application as filed disclosed the claimed combination of features 1.5 and 1.5.1.

1.1.2 The appellant argued that, starting from page 14, line 11 of the earlier application, several variations

of the invention were disclosed. They were all relying on the condition "upon input of the address number". The embodiments only distinguished between the point in time when *selectable* items were presented, i.e. either once a user starts to type numbers (as soon as a first character is typed), which was the "preferred" embodiment, or after a *full* number has been typed. In both scenarios, however, the selectable items were presented "upon input of the address number". According to page 14, lines 22 to 24, it was necessary to identify the second communication terminal ("recognizes that phone number") in order to retrieve the usable channels ("an email number linked to that contact"). This was achieved, even when only a few numbers had been entered, by the data retrieval mechanism 65 disclosed at page 13, lines 22 and 23, with memory 66 containing the contact list. Such identification and its presentation appeared already in features 1.2 and 1.3 of claim 1 (based on original claim 16 of the earlier application), whereas features 1.4 and 1.5 (based on original claim 17 of the earlier application) related to the retrieval and presentation of the usable channels. Feature 1.5.1 merely specified the "presenting" step of feature 1.5 a little bit more. It was not necessary to wait until a *full* number was entered, but this did not mean that something was presented before the information was retrieved. At least a partial match was needed in order to present the usable channels at the earliest possible point in time. This was indeed built into the claim. Feature 1.5.1 could be derived from the embodiment comparable to the known T9 function taught at page 18, lines 11 to 14. This embodiment recited "upon sensing typing of a number", it did not say "of the full number". Rather than looking for matches in a dictionary, as the known T9 feature did, the data retrieving mechanism checked

for matching numbers in a memory containing communication addresses.

- 1.1.3 The board concurs with the opposition division and with the opponents.

The embodiments of the earlier application as filed where the "usable communication channels" can be defined somewhat as a fixed minimum set (cf. page 14, lines 15 to 17) or be derived from the capabilities of the first communication terminal alone (cf. page 14, lines 17 and 18) do not require a retrieval of information related to selectable communication channels usable for communication with the *second* communication terminal as per claimed feature 1.4. The embodiment described at page 14, lines 18 to 27 of the earlier application as filed requires a full identification of the second communication terminal using "the input address number" before the selectable items can be presented (cf. page 14, lines 22 to 24):

"... it may be possible to type a persons phone number, upon which terminal 10 recognizes that phone number and establishes that there is also e.g. an email number linked to that contact ...".

Rather than a partial match obtained "once the user starts to type numbers" and including many possible second communication terminals, this disclosure still requires a *complete* identification of a second communication terminal before "the different usable communication channels are presented for selection". Finally, the embodiment of the earlier application as filed where the typing field is filled in automatically (cf. page 18, lines 11-14) discloses, at most, some assistance for the identification of "a second

communication terminal", but it falls short of a disclosure as to presentation of usable communication channels "once the user starts to type numbers", i.e. even before the typing field has been completely filled and the user has confirmed the automatically proposed second communication terminal.

In summary, in the earlier application as filed, the different communication channels "usable for communication with second communication terminal" are presented for selection only after the second communication terminal has been fully identified, rather than "once the user of the first communication terminal starts to type numbers", as it appears in claimed feature 1.5.1. This is the case irrespective of whether or not the claim is interpreted so as to imply at least a partial match before the "different usable communication channels are presented for selection" according to feature 1.5.1 (cf. point 3.1.3 below).

1.2 Since the subject-matter of claim 1 extends beyond the content of the earlier application as filed, the ground for opposition under Article 100(c) in conjunction with Article 76(1) EPC prejudices the maintenance of the patent as granted.

2. AUXILIARY REQUESTS 1 AND 2

2.1 *Claim 1 - added subject-matter (Article 76(1) EPC)*

2.1.1 According to the decision under appeal (Reasons C.1), given that the independent claims of auxiliary requests 1 and 2 contained the same features 1.5 and 1.5.1 as claim 1 of the main request, the same arguments as those provided in Reasons B applied.

- 2.1.2 The appellant referred to the reasons provided for the main request.
- 2.1.3 The board concurs with the opposition division and with the opponents for the same reasons as stated in point 1.1.3 above.
- 2.2 Since the subject-matter of claim 1 of each of auxiliary requests 1 and 2 extends beyond the content of the earlier application as filed, none of these claim requests is allowable under Article 76(1) EPC either.
- 3. AUXILIARY REQUESTS 1A, 1B, 2A AND 2B
 - 3.1 *Admittance into the appeal proceedings (Article 13(2) RPBA 2020)*
 - 3.1.1 The claims of **auxiliary requests 1A, 1B, 2A and 2B** were filed *after* notification of the summons to oral proceedings before the board. The admittance of these requests is governed by Article 13(2) RPBA 2020, according to which any amendment to a party's appeal case is, in principle, not taken into account, unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
 - 3.1.2 The appellant submitted that these claim requests were the direct response to the board's preliminary opinion, since the board's objection of added subject-matter was based on the broad claim language of feature 1.5.1 rather than on the lack of an embodiment combining both "dynamic search" (first sentence of feature 1.5.1) and the presentation of "usable channels" (feature 1.5 and the second part of feature 1.5.1). Furthermore, these claim requests were not detrimental to procedural

economy. In addition, similar auxiliary requests were subject to the related German nullity proceedings. These requests did not make any difference in terms of novelty and inventive step, nor did they change the substance of claim 1. This was made apparent by the fact that opponent 1 had raised novelty and inventive-step objections against these new claim requests by mere reference to earlier submissions.

3.1.3 This is not persuasive. In its preliminary opinion, the board rather confirmed the opposition division's and the opponents' stance: the earlier application as filed discloses the presentation of communication channels "usable for communication with second communication terminal" for selection only in combination with a *complete* identification of the second communication terminal. In addition to this, the board expressed its reservations as to the wording of feature 1.5.1 vis-à-vis the features of the embodiment where the typing field is filled in automatically (cf. page 18, lines 11 to 14 as filed), in the event that this embodiment was read in combination with the presentation of an email number or address upon recognition of the phone number disclosed in a different paragraph (cf. page 14, lines 22 to 24). The board's comment explicitly addressed the appellant's allegations in points 3.b) (3) and 3.d) (3) of the statement setting out the grounds of appeal concerning the implicit requirement of a (partial) match.

3.1.4 Against this background, the negative opinion on allowability under Articles 100(c) and 76(1) EPC as regards the main request in the preliminary opinion does not constitute an "exceptional circumstance". Indeed, the board, in response to the proprietor's argumentation, made, at most, only additional and

supporting observations which were not a repetition of a written statement appearing in the decision under appeal or in the opponents' submissions. These observations were only *supporting* and not *determining* the final assessment, which was in fact based on the reasoning already provided in the decision under appeal and in the opponents' written submissions. Only for the sake of completeness, the board adds that even where a new objection had been raised, contrary to the conclusions drawn in T 1255/18 (Reasons 6.1) cited by the appellant, this would not *per se* amount to "exceptional circumstances" within the meaning of Article 13(2) RPBA 2020 (cf. T 2632/18, Reasons 4.3; T 2271/18, Catchword).

3.1.5 As to the allegation that these claim requests were not detrimental to procedural economy, the fact that the parties might have dealt with the same or similar submissions in related national proceedings or even in proceedings before another board (e.g. in case of divisional applications) cannot automatically guarantee their admittance in a separate and distinct appeal proceedings. This is true for at least two reasons. First, even if all parties concerned were familiar with the issues raised by the new claim requests, this would not be the case for the competent board, which would rather have to consider such new claims for the first time in the entire proceedings. Secondly, procedural economy is only *one* of the applicable criteria to be considered for admittance issues and generally not the decisive one.

3.2 In view of the above, the board did not admit auxiliary requests 1A, 1B, 2A and 2B into the appeal proceedings (Article 13(2) RPBA 2020).

4. Since there is no allowable claim request on file, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



T. Buschek

K. Bengi-Akyürek

Decision electronically authenticated