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**Datasheet for the decision
of 7 November 2022**

Case Number: T 1098/20 - 3.5.05

Application Number: 15728307.8

Publication Number: 3108422

IPC: G06Q10/10

Language of the proceedings: EN

Title of invention:

MESSAGE USER INTERFACES FOR CAPTURE AND TRANSMITTAL OF MEDIA
AND LOCATION CONTENT

Applicant:

Apple Inc.

Headword:

MESSAGE USER INTERFACES FOR CAPTURE AND TRANSMITTAL OF MEDIA
CONTENT / Apple

Relevant legal provisions:

EPC Art. 123(2), 56
RPBA 2020 Art. 13(1), 13(2)

Keyword:

Amendments - extension beyond the content of the application
as filed (yes)

Inventive step - (no) - effect not made credible within the
whole scope of claim

Amendment after summons - exceptional circumstances (no)

Decisions cited:

T 1958/13, T 1188/04



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Case Number: T 1098/20 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 7 November 2022

Appellant: Apple Inc.
(Applicant) One Apple Park Way
Cupertino CA 95014 (US)

Representative: Barton, Russell Glen
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 18 December
2019 refusing European patent application No.
15728307.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: N. H. Uhlmann
K. Kerber-Zubrzycka

Summary of Facts and Submissions

- I. The applicant appealed against the examining division's decision to refuse the European patent application in suit.
- II. The examining division decided that the main request and the first to third auxiliary requests did not meet the requirements of Article 56 EPC.
- III. The examining division made reference, *inter alia*, to the following documents:

D1 US 2009/005011
D2 US 2013/310089
- IV. With its statement setting out the grounds of appeal, the appellant resubmitted the requests on which the contested decision had been based.
- V. The board summoned the appellant to oral proceedings.

In a communication under Article 15(1) RPBA 2020, the board set out its provisional opinion on the case.
- VI. With a letter dated 16 October 2022, the appellant:
 - unconditionally withdrew the main request and auxiliary request 2
 - declared that the auxiliary request 1 that had accompanied the grounds of appeal now became the new main request
 - submitted amended auxiliary requests 1 and 2
 - conditionally withdrew the auxiliary request 3 that had been submitted with the grounds of appeal, on the condition that the new auxiliary requests 1 and 2 were admitted into the proceedings

VII. In the course of the oral proceedings, the appellant withdrew auxiliary request 3.

VIII. Final requests

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the new main request (submitted as auxiliary request 1 with the grounds of appeal) or one of the auxiliary requests 1 or 2 (filed with the letter of 16 October 2022).

IX. Claim 1 of the main request reads as follows:

"A method, comprising:

at an electronic device having a touch-sensitive surface and a display:

displaying, on the display, a media user-interactive graphical user interface object and a message region for displaying messages sent between participants in a message conversation;

detecting a gesture on the touch-sensitive surface that includes detecting a contact at a location on the touch-sensitive surface that corresponds to a location of the media user-interactive graphical user interface object on the display;

in response to detecting the contact:

displaying a send user-interactive graphical user interface object on the display;

detecting a continuation of the gesture that includes detecting movement of the contact across the touch-sensitive surface followed by detecting lift-off of the contact from the touch-sensitive surface;

determining whether the contact moved to a location on the touch-sensitive surface that corresponds to a location of the send user-interactive graphical user interface object; and

in accordance with a determination that the contact moved to the location on the touch-sensitive surface that corresponds to the location of the send user-interactive graphical user interface object, and in response to detecting the lift-off, sending a new media item captured in response to at least a portion of the gesture to a participant in the message conversation, wherein capturing the new media item in response to at least the portion of the gesture includes creating the new media item based on data detected by a microphone or a camera of the device during the portion of the gesture."

X. Claim 1 of auxiliary request 1 corresponds to claim 1 of the main request. The term "new media item" has been replaced by "audio message", the term "data" in the penultimate line has been replaced by "audio data" and the wording "or a camera" has been deleted.

XI. Claim 1 of auxiliary request 2 is based on claim 1 of auxiliary request 1. The following wording has been added to claim 1:

"in accordance with a determination that the contact did not move to the location on the touch-sensitive surface that corresponds to the location of the send user-interactive graphical user interface object and in response to detecting the lift-off, replacing display of the media user-interactive graphical user interface object with display of a send button for sending the captured new media item to the participant"

Reasons for the Decision

1. The present application relates to a method carried out in an electronic device having a touch screen. A messaging application offers a function for sending media items to a participant in a message conversation. Upon a dragging gesture, commencing on a media icon and continuing over a send icon, a media item is captured by a microphone or a camera and sent to the participant.
2. Document D2 discloses a method for sending voice messages or photos to a participant. The user touches several icons in succession to trigger the sending.

Main request

3. Article 123(2) EPC
- 3.1 The last "wherein" clause in claim 1 reads:

wherein capturing the new media item in response to at least the portion of the gesture includes creating the new media item based on data detected by a microphone or a camera of the device during the portion of the gesture.
- 3.2 The appellant argued that this clause was based on paragraphs 209 to 211 and 227.
- 3.3 The board is not convinced, for the following reasons.

According to claim 1, the new media item is based on data detected by a microphone or a camera. Thus, given the wording "based on data detected by a microphone **or a camera**", claim 1 specifically teaches that a video or an image is created and sent. There is no apparent basis for this specific teaching in combination with

the sending of the media item taking place upon a single gesture (lines 5 to 17 of present claim 1).

- 3.4 With regard to videos, paragraphs 234, 235 and 239 and original claims 28 to 31 disclose that a video is sent to a participant following **three contacts** on the screen (touching the capture affordance 610, the record affordance 1006 and the send affordance 1210) or following **two swipe gestures** (swiping from the capture affordance to the record affordance followed by swiping towards the send affordance).

In relation to images, the description discloses that an image **shown in the live media preview area** 1010 is captured and sent upon a swipe gesture (paragraphs 227 and 229, Figure 11A). The application does not include any basis for capturing and sending an image that is not displayed in a media preview area.

- 3.5 The appellant further argued that claim 1 as originally filed included the term "media item" which covered "audio items, image and videos and did not cover the referenced video embodiments for the same reasons as set in relation to the current claims". Hence, it went on, covering video with a single gesture was not new to the amendments but rather already present in original claim 1.

The board disagrees. It is correct that the matter for which protection is sought by original claim 1 includes any kind of media item in combination with a single gesture. However, neither claim 1 as originally filed nor any other parts of the application specifically disclose an image or a video based on data detected by a camera in combination with a single swipe gesture.

- 3.6 For these reasons, claim 1 as amended does not meet the requirements of Article 123(2) EPC.

Auxiliary request 1

4. Admission

The amended claims resolve the Article 84 and 123(2) EPC objections raised in the board's communication under Article 15(1) RPBA. The board thus decided to admit auxiliary request 1 into the appeal proceedings.

5. Article 56

5.1 Document D2 forms a suitable starting point for inventive-step analysis.

5.2 D2 discloses a smart phone with a touch screen. A messaging application allows a user to send voice messages to a participant (paragraphs 90 to 92, Figures 6A to 6H).

5.3 D2 does not disclose that capturing a voice message and sending a message is performed upon a gesture of contact on the screen with a media user-interactive graphical user interface object, continuing the gesture across a send user-interactive graphical user interface object and lift-off of the contact. Rather, in D2 the user makes four separate touch contacts on the screen.

The appellant made no objection to this analysis of D2 (sections 62 to 64 of the statement of grounds).

5.4 With regard to a technical effect, the appellant submitted that the distinguishing features led objectively to simplification and reduction in the user input required to achieve the desired output. These effects were entirely independent of any subjective user preference (section 64 of the statement of grounds).

5.5 The board agrees with the appellant that those effects are in principle technical effects, following decision T 1958/13, point 2.2.5.

5.6 The board further considers that in the present case, as in the case underlying T 1958/13, the question of whether these effects are actually achieved depends exclusively on subjective user skills or preferences.

The claimed method leads objectively to a reduced number of input gestures. However, entering the single gesture as claimed makes greater demands of the user: they must maintain contact with the screen and continue the gesture for a period of time, while, for example, orienting the microphone of the phone appropriately. Whether such a complex input gesture will be seen as simpler or reduced by comparison with the four simple touch inputs disclosed in D2 is a question of subjective preference.

Therefore, the board considers that the effects suggested by the appellant cannot be regarded as technical effects credibly achieved over the whole scope of claim 1; see also the Case Law of the Boards of Appeal of the EPO, 10th edition, July 2022, chapter I.D.9.2.8 and the last paragraph of chapter G-II 3.7.1 of the Guidelines for Examination in the EPO.

5.7 The appellant argued, in section 47 of the statement of grounds, that the technical advantages were objectively achieved.

However, the examples given in section 47 concern the distinguishing features and not the effects submitted by the appellant in section 64. Furthermore, D2 discloses a single application.

5.8 The appellant referred to decision T 1188/04 in support of its arguments regarding technical effects.

In the board's view, decision T 1188/04 is not pertinent, because it does not discuss the crucial question of whether an effect is credibly achieved. Additionally, the board notes that claim 1 does not refer to a duration of a media content (section 52 of the statement of grounds).

5.9 The appellant argued that the claimed method led objectively to a reduced number of gesture inputs. This was in itself a technical effect.

This argument is not convincing.

To go into more detail, the claimed method objectively leads to:

- reducing the number of touches and lift-offs (one touch and one lift-off) and
- increasing the number of contact positions (during the continuous gesture).

However, these are not technical effects but rather aspects implied by the distinguishing features (point 5.3 above). In the board's view, in the case at hand technical effects might be present within the electronic device or within interaction with the user. As admitted by the appellant, no effects within the device, such as reducing power consumption, computational complexity, etc., are apparent. Within interaction with the user, none of the effects suggested by the appellant is credibly achieved over the whole scope of claim 1.

5.10 The example relating to a vacuum cleaner that was set out in the letter dated 16 October 2022 is not pertinent because it is very remote from the claimed method; furthermore, the arguments of the board are not based on a "hypothetical end user that might not want or be able to use an invention or use the invention to

provide a technical effect", but on the objective fact that entering the single complex gesture as claimed makes greater demands of the user.

5.11 The appellant submitted that the distinguishing features led to a reduction in physical interactions.

The board notes that the physical interactions are not reduced: by performing a continuous gesture, the user moves their finger through a plurality of positions; the device must detect a longer-lasting contact and a corresponding plurality of contact positions.

5.12 According to the appellant, "most of the referenced case law in I D.9.2.8 concern mental considerations not physical benefits".

This argument is not convincing. As explained above, the case at hand does not concern "physical benefits".

5.13 With regard to the decision T 1958/13, the appellant noted that in this decision a technical problem was formulated.

This is correct. However, as consistently held by the boards of appeal, when, as in the present case, the distinguishing feature does not lead to an effect credibly achieved over the whole claimed scope it cannot contribute to an inventive step.

5.14 For the reasons given above, the distinguishing features (point 5.3) do not lead to an effect credibly achieved over the whole scope of claim 1, and thus they cannot contribute to inventive step (Case Law of the Boards of Appeal of the EPO, 10th edition, July 2022, chapter I.D.9.2.8). That such distinguishing features are not disclosed in the prior art is of no relevance.

5.15 Consequently, the subject-matter of claim 1 does not involve an inventive step.

Auxiliary request 2

6. Admission

6.1 This request was submitted after the summons to oral proceedings was issued. Accordingly, its admission is at the board's discretion under Article 13(1) and (2) RPBA.

6.2 The following clause has been added to claim 1:

in accordance with a determination that the contact did not move to the location on the touch-sensitive surface that corresponds to the location of the send user-interactive graphical user interface object and in response to detecting the lift-off, replacing display of the media user-interactive graphical user interface object with display of a send button for sending the captured new media item to the participant.

6.3 The appellant stated that this addition was based on paragraph 223, Figure 9A and claims 9 and 10 of the application as originally filed. It referred furthermore to paragraphs 216 and 224.

6.4 According to paragraph 223 and Figure 9A, a representation of the audio message is displayed in the message compose field 604. Claim 9 as filed also teaches that a waveform representing the audio message is displayed.

Current claim 1 does not refer to any representation of the audio message. However, the application as filed does not provide any basis for displaying a send button without displaying a representation of the audio message.

6.5 The appellant argued that the display of a representation of the audio message was optional, pointing to paragraphs 216 and 224.

The board considers that the wording "in some embodiments" that is used in these paragraphs does not imply that the features recited therein are optional.

- 6.6 The appellant submitted that displaying a representation of the audio message was not functionally linked to "replacing the media GUI object with the send button".

The board disagrees. The introduction of a dedicated send button for sending the audio message enables the user to check the captured audio message (e.g. to verify whether a proper message was recorded, or only silence) before sending it. The representation of the audio message supports the user in this regard.

- 6.7 Consequently, the board finds that claim 1 as amended does not meet the requirements of Article 123(2) EPC. Furthermore, an equivalent objection was raised in section 14.3 of the communication under Article 15(1) RPBA.

- 6.8 For these reasons, the board found that, since auxiliary request 2 does not overcome an objection previously raised by the board, it does not meet the criteria set out in Article 13(1) RPBA. Thus, no exceptional circumstances are present which could justify its admission. Hence, auxiliary request 2 was not admitted into the proceedings.

7. Conclusion

None of the appellant's admissible requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated