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D E C I S I O N
of 31 March 2004

Case Number: T 0743/03 - 3.5.3

Application Number: 98950038.4

Publication Number: 1021903

IPC: H04L 29/06

Language of the proceedings: EN

Title of invention:

System, as well as terminal, as well as server

Applicant:

Koninklijke KPN N.V.

Opponent:

-

Headword:

Multimediasystem/KPN

Relevant legal provisions:

EPC Art. 123(2), 56

Keyword:

"Amendments - added subject-matter (no)"
"Inventive step - no"

Decisions cited:

-

Catchword:

-



Case Number: T 0743/03 - 3.5.3

D E C I S I O N
of the Technical Board of Appeal 3.5.3
of 31 March 2004

Appellant: Koninklijke KPN N.V.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 8 April 2003
revoking European patent No. 1021903 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: D. H. Rees
R. Moufang

Summary of Facts and Submissions

I. European patent application number 98 950 038.4, publication number 1 021 903, was filed on 14 September 1998 with the international application number PCT/EP98/05867. Priority was claimed from Netherlands application number 1 007 153 dated 29 September 1997. The application was refused in a decision of the examining division announced at oral proceedings held on 18 February 2003. Written reasons were dispatched on 8 April 2003.

The subject-matter of claim 1 of the main request and a first auxiliary request was held to lack an inventive step with respect to the disclosure of

D1: WO-A-96/38962.

Second, third and fourth auxiliary requests were not admitted into the proceedings under Rule 71a EPC since they were considered to contravene, prima facie, Article 123(2) EPC. A fifth auxiliary request was admitted, but its claim 1 was also found to lack an inventive step with respect to D1.

II. With a letter dated 25 April 2003 and received 26 April the applicant lodged an appeal against this decision and paid the appropriate fee. On 20 June 2003 a statement setting out the grounds of appeal was filed together with two sets of claims according to a main and an auxiliary request. The set corresponding to the main request was the same as that submitted for the first auxiliary request in the proceedings before the first instance.

The appellant further requested that the appeal proceedings be accelerated and made a conditional request for oral proceedings.

- III. In an annex to the summons to attend oral proceedings, sent on 11 December 2003, doubts were raised as to whether the new sets of claims satisfied the requirements of Article 123(2) EPC. Arguments were also put forward that the newly claimed subject-matter lacked an inventive step in the light of D1 and a document cited in the international search report:

D4: FR-A-2 741 495.

In response, the appellant filed another four sets of claims of a new main and three auxiliary requests, together with arguments for their allowability.

At the oral proceedings held on 31 March 2004 the appellant amended the main request and filed a new auxiliary request based on the main request with certain claims deleted. All previous requests were withdrawn.

- IV. The appellant requests the grant of a patent on the basis of

claims 1, 2, 5, 6, 7, 10, 15, 16 and 18 (main request) or claims 1, 2, 5, 6, 7, and 10 (auxiliary request), both sets of claims submitted at the oral proceedings;

description pages 1 to 10 and

drawing sheets 1 to 3

as originally filed.

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

"System for the transmission of data, comprising:

- a multimedia network (3),
- a telecommunications network (5;6)
- a first server (4), and
- at least one terminal (1) comprising connection means (10,14) for setting up a link for a session with the first server (4) by way of the multimedia network (3) and for setting up automatically, during a session, by way of the telecommunications network (5;6), another IP link than the Internet link active at that point in time with a second server (7;8) as a function of a code stored in the first server (4), such as a telephone number, it being possible for the first server (4) and the second server (7;8) to be one and the same, and wherein the terminal is adapted for having a connection with only one of said networks at a time,

and wherein the connection means (10,14) comprise memory loaded with an added software module, the added software module, being adapted for being provided with parameters comprising the code stored in the first server (4) and in such a way that as the first server (4) provides the added software module with parameters, those provided parameters replace the parameters used by the added software module after a prior activation of the added software module, and the added software module furthermore after being provided with parameters

comprising the code stored in the first server (4) subsequently makes free, firstly, the Internet link via the multimedia network (3) between the terminal (1) and the first server (4) and subsequently sets up the another IP link as a function of the code stored in the first server between the terminal (1) and the second server (7;8) via the telecommunications network (5;6)."

Claim 6 of the main request is for a method corresponding to the system of claim 1 and claim 15 is for a corresponding software module on a carrier.

In the auxiliary request the software module is no longer claimed, otherwise the claims are identical with those of the main request.

VI. In the oral proceedings the appellant referred to a further document mentioned in the examination procedure,

D2: Submission by the Federal Trade Commission to the United States District Court for the Eastern District of New York, in the civil action between the Federal Trade Commission and Audiotex Connection, Inc., et al., dated February 1997, and submitted by the appellant with a letter dated 6 December 2001 and received 11 December.

The appellant firstly pointed out that the invention must be seen in the context of the state of the art in 1997, when the great majority of network users only had access via a single telephone connection. It was then argued that the problem addressed by the patent application related to access to "restricted content", i.e. content for which the provider wanted payment. In

these circumstances the skilled person would have no reason to consult D1, since it related to an expensive high-speed connection of a kind which did not in practice exist at that date, and was not concerned with problems of payment. In accordance with the application, access via a specific (premium-rate) telephone number solved the basic problem of payment for content. However, this resulted in the user having to break the current Internet connection and make another connection; the necessary data such as the telephone number had to be entered by hand, copying it for example from a card supplied by the content provider. Known diallers, as exemplified in D2, were dedicated to a single telephone number and provider, so that the use of such diallers to automate the disconnection and reconnection process would lead to a proliferation of diallers on the client system.

The inventive solution of this problem was to supply a single software module on the client system, similar to a dialler but configurable with parameters, including the appropriate telephone number, downloaded from a server. Thus the user would select a reference on a server page displayed on a browser (click on a link), and the parameters would be downloaded to the client software module which would then automatically handle the disconnection and reconnection to the appropriate server via the specified premium-rate telephone number.

VII. At the end of the oral proceedings the board announced its decision.

Reasons for the decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. Added subject-matter, Article 123(2) EPC.
 - 2.1 According to the description, a "multimedia network", exemplified by the Internet, enables user access to a large number of services in a simple manner, but suffers from having a "small-band character", whilst the quality of a service transmitted "depends on the quantity of traffic on the multimedia network," (description page 1, line 36, to page 2, line 6). On the other hand "Telecommunications networks have the characteristic that the quantity of data per second capable of being transmitted over a link, is guaranteed," (page 2, lines 25 to 27), "irrespective of any other traffic via the telecommunications network," (lines 30 and 31). The board understands that in the case of a "multimedia" network the absence of a fixed connection from the client to a specific server allows access to be changed to another server very easily, without having to break down and re-establish connections, with however the disadvantage of a lack of any guaranteed throughput of data from server to client. "Telecommunication" networks, on the other hand, have a fixed connection between client and server, and a guaranteed throughput of data from server to client. It is in this sense that the board interprets the claimed subject-matter.

2.2 It is to be noted that the situation in 1997 was such that the vast majority of domestic users of the Internet were connected to it by telephone, i.e. a "telecommunications network", referred to in the description as a "calling-in network" (page 4, line 34). The client would place a telephone call, i.e. have a fixed connection with guaranteed throughput, to a service provider or "portal" which gave access to the connectionless Internet proper. Thus when the claims refer to for example "having a connection with only one of said networks at a time," it must be understood as having a connection to a portal into the multimedia network or having a direct telephone connection to a content server, but not both simultaneously.

2.3 The features of claim 1 of both requests up to the phrase "one and the same", are those claimed in the original claim 1, somewhat reorganised, with the exception of the replacement of "a link with a second server" by "another IP link than the Internet link active at that point in time with a second server". The examining division rejected this amendment, in the then fourth auxiliary request, as a prima facie violation of Article 123(2) EPC, giving an alternative interpretation of the passages in the description cited by the appellant in its support, *inter alia* page 6 lines 10 and 11. According to this interpretation, the new IP link referred to in those passages was a second IP link with the first server to download a video with basic quality. While this interpretation is possible, the board considers that it would have been discarded by the skilled person in the light of the passage at page 6 lines 9 to 20, which states, "The software module makes it possible to set up another IP link than

the Internet link active at that point in time, namely, in the event that the user clicks a special reference in an HTML page ... The HTML pages comprise a reference to a file stored in the server 4, in which the following parameters for the software module are stored:
- the telephone number which must be used to call in on the second server ..." The board accordingly considers that the skilled person would have understood from the description as originally filed that the new link to the second server also uses the IP protocol.

2.4 That the system is adapted to set up another link via the telecommunications network to a second server as a function of the code, such as a telephone number, stored in the first server, is also in the original claim 1. That the "terminal is adapted for having a connection with only one of said networks at a time", i.e. that the link to the first server is made free and another link is subsequently set up, is disclosed in the description at page 5, lines 23 and 24. That the mechanism for doing so is a software module in the "connection means" which is supplied with parameters comprising the code stored in the first server, is disclosed *inter alia* in the description at page 6, line 8, to page 7, line 14. While not explicitly disclosed, it would seem to be implicit that the module may be used more than once, since accessing the "still higher quality" after the "higher quality" (page 9, lines 24 to 27) implies, according to page 9, lines 28 to 33, a change of connection. That the new parameters replace the old for use by the software module, as claimed, is then a necessity.

2.5 The board therefore considers that claim 1 of both requests satisfies the requirements of Article 123(2) EPC. Corresponding arguments apply to the further independent claims 6 and (in the main request) 15, so that they too would not appear to add subject-matter to the original application.

2.6 Dependent claims 2, 7 and (in the main request) 16 are at least implicitly disclosed by the description at page 7 lines 3 to 5. The only remaining dependent claims, claims 5, 10 and (in the main request) 18 correspond in substance to original claim 2. The dependent claims accordingly do not give rise to objection under Article 123(2) EPC either.

2.7 The amendments made at the oral proceedings to the previously submitted requests were directly in response to observations by the board and do not raise any new objections. The new main and auxiliary requests are therefore considered admissible.

3. *Novelty*

Document D1 does not directly and unambiguously disclose the claimed feature that "the terminal is adapted for having a connection with only one of said networks at a time." Document D2 does not disclose the use of a software module in the connection means provided with parameters from a first server. The other documents mentioned in the proceedings before the first instance do not call into question the novelty of the subject-matter of the independent claims of both requests. Hence the board considers that the claimed

subject-matter of both requests satisfies the requirements of Articles 52 and 54 EPC as to novelty.

4. Inventive step

4.1 The board considers the closest prior art to be document D1. The appellant argued that D1 would not have been considered by the skilled person, firstly because it concerned an expensive and at the priority date unused broadband system and secondly because it did not address the problem which is the subject of the application, namely how to gain payment for "restricted access" content. However, the board is not convinced by these arguments. The problem addressed in the application as filed was not primarily the payment issue; the beginning of the section "Summary of the invention" (page 2, line 9 and following) reads, "It is therefore an object of the invention to provide for a system according to the preamble, whereby a user may obtain access to a service, with the bandwidth and throughput of the link between the terminal and the server which offers said service, being guaranteed." The application also explains extensively the disadvantages of the prior art Internet access in this respect and the measures proposed to achieve this object - see for example the application at page 1, line 36 to page 2, line 6, page 2, lines 21 to 33, page 8, lines 9 to 18, page 9, lines 28 to 37, and page 10 lines 28 to 30. It may also be noted that the feature of using a premium rate telephone number for the second connection was originally - and indeed still is - only in a dependent claim.

4.2 D1 states that its object is to provide an integration of "computer nets" and "communication nets" in such a way as to make use of the advantages of each of these network architectures (page 1, lines 5 to 9), and goes on to define these terms (page 1, line 26 to page 2, line 10, and page 2, lines 12 to 28, respectively) in a manner which corresponds to the definitions of "multimedia network" and "telecommunications network" in the application. In doing so, it identifies the problem that computer nets do not deliver guaranteed rates of transfer (page 2, lines 6 to 10), which on the other hand is a property of communication nets (page 2, lines 23 to 28 - synonymously described as data transfer "in realtime"). It further identifies this property of computer nets as being disadvantageous to the online reproduction of video and audio information (page 12, lines 9 to 17), and the solution to this problem as being transmitting the data over a switched virtual circuit, i.e. via the telecommunications network in the sense used in the present application (page 13, lines 10 to 14).

4.3 The board therefore considers this document to be highly relevant and an appropriate starting point for the invention as claimed.

4.4 D1 shows (mainly with reference to Figure 5 and page 11, line 25 to page 15, line 9):

A system for the transmission of data (page 11, line 25), comprising

- a multimedia network (Figure 5, "Internet")
- a telecommunications network (Figure 5, "B-ISDN network")

- a first server (Figure 5, "Internet server with B-ISDN access"), and
- at least one terminal comprising connection means for setting up a link for a session with the first server by way of the multimedia network (Figure 5, customer terminal "CPE", connection (1), "Internet gateway", connection (2), "Internet" and "Internet server with B-ISDN access") and for setting up automatically, during a session, by way of the telecommunications network, another link than the Internet link active at that point in time with a second server as a function of a code stored in the first server, such as a telephone number (page 13, line 32 to page 14, line 12, with a Broadband-ISDN address certainly being similar to a telephone number in its function), it being possible for the first server and the second server to be one and the same (Figure 5, "Internet server with B-ISDN access")

and wherein the connection means comprise memory loaded with an added software module, the added software module being adapted for being provided with parameters comprising the code stored in the first server, and the added software module furthermore after being provided with parameters comprising the code stored in the first server subsequently setting up another link as a function of the code stored in the first server between the terminal and the second server via the telecommunications network (page 13, line 32 to page 14, line 12 again).

4.5 The following features of claim 1 of the main and auxiliary request are not specifically disclosed by D1:

- (a) the new link is an IP link;
- (b) the provided parameters replace the parameters used by the added software module after a prior activation of the added software module; and
- (c) the added software module makes free the Internet link, and the terminal is adapted for having a connection with only one of said networks at a time.

As to feature (a), the appellant has not identified any technical problem solved by this feature, and the board considers that the choice of protocol for each link is a matter of everyday design choice for the skilled person. Nonetheless the board notes that document D4 is relevant to this point. D4 relates to a very similar arrangement to that of D1 and shares some of the same inventors, so that it would have been consulted by the skilled person looking for more information about or suggestions for such an arrangement. In D4 an example of suggested parameters to be sent for the setting-up of a new link is given (page 6, Table 1, and page 5, lines 29 to 30), indicating that at least one new connection should use TCP/IP as protocols.

As to (b), the board considers that from the whole disclosure of the section of D1 at page 11, line 25 to page 14 line 22 entitled (in translation) "Real-time multimedia for WWW with the help of B-ISDN", the skilled person would envisage that after one video

display ends the user might well want to call up another, so that the skilled person would be expected to provide the possibility for the module to be used more than once in a session, in which case feature (b) would immediately follow.

Finally, as to (c), the board considers that while D1 is largely concerned with a hypothetical future broadband telecommunications infrastructure, it nonetheless provides motivation for the skilled person to apply its teaching to the telephone network as it existed at the priority date of the present application, in 1997, namely to the situation where most users could only have one connection at a time (as indeed pointed out by the appellant in the oral proceedings - see above). The skilled person would note that the initial summary of the invention in D1, at page 1, lines 5 to 10, does not require a broadband connection, but only a "communications net", and that a "communications net" is defined at page 2, lines 12 to 28, to include as one "important example" the analogue telephone network (otherwise known as the PSTN, which is one of the "telecommunications networks" in the present application - see page 5, lines 6 to 8 and lines 28 to 29). Claim 1 of D1 reflects this in that it is not limited to broadband networks, the only restriction being again to "communication nets". The board therefore takes the view that at the claimed priority date the skilled person would have been led to consider how to implement the teaching of D1 on the PSTN. It would have been immediately apparent to the skilled person that to be usable on the PSTN the system would have to be designed to drop the first connection before opening another.

In response to this last point, the appellant argued in the oral proceedings that the analogue telephone network was not suitable for realtime transfer of data, a view which the board cannot share. Precisely this property is given as a characteristic of "communications nets" in D1 (page 2, lines 12 to 28), such nets explicitly including the analogue telephone network (PSTN). This is confirmed by the present application itself, at page 2, lines 25 to 27, page 2, lines 31 and 32, and page 9, lines 33 to 35.

- 4.6 In a written submission in preparation for the oral proceedings the appellant pointed to various alleged differences between D1 and the claimed invention. In addition to those dealt with in point 4.5 above, it was argued that in D1 the software module is "spread over the internet server and the connection means", citing D1 page 14, lines 18 to 22. However, this appears to be a misreading of that passage; in fact, the only change that has to be made at the server is the definition of a new file type (page 13, line 32 to page 14, line 3). Browsers, when they receive files of a specific type, call up an appropriate "viewer" (D1, page 14, lines 5 to 10) - a software module in the sense of the present application - to process the file. In the present application the parameters for the software module are also contained in a file on the server (page 6, lines 16 to 18).

Thus D1 appears to require no more modification of software at the server than does the system claimed in the present application.

4.7 The board therefore comes to the conclusion that the subject-matter of claim 1 of both the main and the auxiliary request lacks the inventive step required by Articles 52 and 56 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland