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D E C I S I O N
of 24 February 2006

Case Number: T 0960/03 - 3.5.03

Application Number: 01307286.3

Publication Number: 1233585

IPC: H04L 25/02

Language of the proceedings: EN

Title of invention:
Channel sounding system

Applicant:
LUCENT TECHNOLOGIES INC.

Opponent:
-

Headword:
Channel sounding system/LUCENT

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Added subject-matter (yes)"

Decisions cited:
G 0010/93, T 0737/90, T 0689/90

Catchword:
An amendment to the description which introduces as an appendix the entire text of a document "incorporated by reference" will prima facie introduce features which are not within "the context of the application as filed" and thus give rise to objection under Article 123(2) EPC.



Case Number: T 0960/03 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 24 February 2006

Appellant: LUCENT TECHNOLOGIES INC.
600 Mountain Avenue
Murray Hill, NJ 07974-0636 (US)

Representative: Sarup, David Alexander
Lucent Technologies NS UK Limited
5 Mornington Road
Woodford Green, Essex IG8 0TU (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 25 April 2003
refusing European application No. 01307286.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: D. H. Rees
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. This is an appeal from the decision of the examining division, dispatched on 25 April 2003, to refuse the European patent application number 01 307 286.3, publication number 1 233 585. The independent claims were held not to be clear, in violation of Article 84 EPC. The application was also said to contain subject-matter extending beyond the content of the application as filed, in violation of Article 123(2) EPC, as a result of the addition by the applicant of an "Appendix" to the application consisting of the description and drawings of US application number 09/648,983.
- II. Notice of appeal was filed and the fee paid on 26 June 2003. A statement setting out the grounds of the appeal was filed on 21 August 2003.
- III. The board issued, of its own motion, a summons to attend oral proceedings to be held on 24 February 2006. In the accompanying communication the board gave its preliminary opinion that the application failed to satisfy various requirements of the EPC, *inter alia* Articles 123(2) and 84 EPC, with reasons.
- IV. In a submission on 23 January 2006 the appellant's representative informed the board that he would not attend the oral proceedings. It was requested that the oral proceedings be cancelled and that the procedure be continued in writing. New description pages 3 and 4 were filed (with a corrected version of these pages being refiled on 24 January 2006). A new set of

claims 1 to 10 was also filed as the basis of an auxiliary request.

V. Independent claims 1, 5 and 10 of the main request read as follows:

"1. A transmitter [131] for use in performing channel sounding, comprising:
means [101, 501] for repeatedly supplying an orthogonal sequence that is a function of first and second other orthogonal sequences and has a perfectly white spectrum should it be repeated an infinite number of times; and
means [103, 503] for modulating a carrier signal by said orthogonal sequence, said means for modulating being coupled to said means for repeatedly supplying; whereby no channel filtering to reduce out-of-band emissions caused by said means for supplying is required between said means for repeatedly supplying and said means for modulating.

5. A receiver [133] for use in performing channel sounding, comprising:
means [109, 533] for demodulating a received version of an orthogonal sequence that modulates a carrier and which is repeated at least once and was derived as a function of first and second other orthogonal sequences; and
means [111, 511] for implementing a least squares algorithm using finite impulse response, FIR, filtering to produce a channel estimate, said means for implementing being coupled to receive said demodulated orthogonal sequence from said means for demodulating without any channel filtering being performed between

said means for demodulating and said means for implementing.

10. A system for use in performing channel sounding, comprising:

a transmitter [131, 531], said transmitter comprising a source [101, 501] of an orthogonal sequence which is repeatedly supplied as an output, said orthogonal sequence having been developed as a function of first and second other orthogonal sequences and having a perfectly white spectrum should it be repeated an infinite number of times; and

a modulator [103, 503] for modulating a carrier signal by said orthogonal sequence, said modulator being coupled to said source;

whereby no channel filtering is required between said source and said modulator to reduce out-of-band emissions caused by said source; and

a receiver comprising

a demodulator [109, 509] for demodulating a received modulated version of said orthogonal sequence that modulates a carrier and was transmitted by said transmitter; and

a finite impulse response, FIR, filter [111, 511] implementing a least squares algorithm for developing an estimate of the channel characteristic, said FIR filter being coupled to receive said demodulated orthogonal sequence from said demodulator;

whereby no channel filtering is performed between said demodulator and said FIR filter to reduce out-of-band noise inherently resulting from said orthogonal sequence prior to its being supplied to said modulator."

In claim 1 of the auxiliary request, the last feature, starting with "whereby" has been deleted. In claim 5 the last feature, beginning with "without" has been deleted. In claim 10, both the equivalent features have been deleted. Otherwise, the claims of the auxiliary request differ from those of the main request only in very minor editorial details, having no impact on the substantive content.

VI. The appellant requests that the decision under appeal be set aside and that a patent be granted. The text on the basis of which the patent should be granted has not been explicitly stated. However, the board's assumption stated in the communication accompanying the summons to oral proceedings that it was the text as refused was not contradicted in the appellant's subsequent submission. With the further amendments submitted the text is as follows:

claims 1 to 10 filed with the letter dated 2 October and received on 5 October 2002 (main request) or alternatively claims 1 to 10 submitted on 23 January 2006 (auxiliary request);

description pages 1, 2, 2A, 5 to 9 and 13 to 23 (these last pages being labelled "Appendix") filed with the letter dated 2 October and received on 5 October 2002; and

pages 3 and 4 submitted on 24 January 2006;

drawing sheets

1 and 2 as originally filed; and

3 filed with the letter dated 02 October and received on 5 October 2002.

In the appellant's final submission on 23 January 2006, two possible further amendments of the description were also discussed, but not put forward as formal requests.

- VII. Oral proceedings took place as scheduled on 24 February 2006, the board having informed the appellant that the request to cancel oral proceedings could not be granted. The appellant was not represented at the oral proceedings, during which the board deliberated and the chairman announced the decision taken.

Reasons for the Decision

1. The function of a board of appeal is to reach a decision on the issues presented to it, not to act as an alternative examining division (G 10/93 OJ 1995, 172, in particular Point 4). The need for procedural economy dictates that the board should reach its decision as quickly as possible while giving the appellant a fair chance to argue its case. In the present appeal the holding of oral proceedings was considered by the board to meet both of these requirements. A summons was therefore issued. The appellant gave no reasons to support the request to cancel the oral proceedings scheduled by the board and to continue the procedure in writing. The board considered that, despite the appellant's announced intention not to attend, the twin requirements of fairness and procedural economy were still best served by holding the oral proceedings as scheduled. The mere choice by the appellant not to attend was not sufficient reason to delay the board's decision. As made clear in the Rules of Procedure of

- the Boards of Appeal, Article 11(3), a party duly summoned to oral proceedings and not attending may be treated as relying only on its written case. The board considered that Article 113(1) EPC had been satisfied. The request that the oral proceedings be cancelled was therefore refused. The board understands the further request that "the procedure be continued in writing" as a request that the board should issue a further communication, rather than taking a decision at this stage. For the same reasons, this request is also refused.
2. The original application contained the following statement (Paragraph 12 of the published application): "The periodic orthogonal sequences are generated by using the techniques disclosed in the previously filed copending application Serial No. 09/648,983 - which is incorporated by reference as if fully set forth herein - ..." (this document will be referred to as P1 in the rest of the decision). In response to objections raised in the course of examination of the application, the appellant amended the present application to include, in the form of an appendix, the complete description and drawings of P1.
 3. In the communication accompanying the summons to oral proceedings the board raised the question whether the reference to "copending application Serial No. 09/648,983", without an indication of the country in which the application had been made, sufficed for the purposes of satisfying the requirements for unambiguous identification and easy retrieval enumerated in for example T 737/90 (unpublished). However, in the light of the conclusions which the board reaches below

concerning the content of the referenced document it is unnecessary to decide on this point.

4. With respect to the inclusion of P1 in the description of the present application the appellant relies on decision T 689/90 (OJ EPO 1993, 616), and argues that the "added matter meets the requirements" of this decision (appellant's letter of 23 January 2006, page 3, line 5). The cited decision discusses the status of features not included in an original application but only contained in a document identified in the application. It is stated (at Point 1.4) that, "*Prima facie*, such features are not within 'the content of the application as filed', which for the purpose of Article 123(2) EPC is constituted by the description of the invention, the claims, and any drawings, in accordance with Article 78(1) EPC." The decision goes on to explain, "If this were not the case, the content of an application containing in its description numerous references to other documents, whether other patent specifications or handbooks for example, would become almost limitless; especially if such documents themselves contain references to other documents, and so on." At Point 2.2 this decision goes on to give, as one of the conditions for allowing an application to be amended by the addition of matter from a referenced document, "that the features which are only disclosed in the reference document implicitly clearly belong to the description of the invention contained in the application (Article 78(1)(b) EPC) and thus to the content of the application as filed (Article 123(2) EPC)."

5. The board considers that it can adopt these considerations in the present appeal. Self-evidently however the conclusion the board reaches depends on the specific facts of the case. These facts are not the same as in the cited decision. It is in fact immediately apparent that in the present case the "Appendix" includes subject-matter which does not belong to the description of the invention as originally filed. For example, page 21, together with Fig. 2 (of the Appendix), puts forward a particular structure of the receiver, involving "parallel weight computers". This structure is stated to offer improved computational efficiency over the prior art. There is no hint in the present application that the reader should refer to P1 for an advantageous structure of a receiver; on the contrary, the only reference to P1 as a source of features of the invention is in the context of constructing suitable orthogonal sequences (as quoted above in Point 2). Thus this structure of the receiver cannot be considered as "implicitly clearly belong[ing] to the description of the invention contained in the application (Article 78(1)(b) EPC) and thus to the content of the application as filed (Article 123(2) EPC)."
6. The appellant argued that the orthogonal sequence that is a function of first and second other orthogonal sequences "is the only subject of P1," (appellant's letter of 23 January 2006, page 3, lines 5 to 15), and went on to argue that according to the conditions of T 689/90, the contents of P1 could therefore be incorporated into the application. The appellant made no comment on the parallel weight computers also described in P1, even though the board had pointed to

- this particular feature as a violation of Article 123(2) EPC in its communication accompanying the summons to oral proceedings (see Point 5). The appellant's arguments therefore do not convince the board.
7. The description of both the appellant's requests includes the "Appendix". Hence neither request satisfies the requirements of Article 123(2) EPC and as a consequence the appeal must be dismissed.
 8. In the appellant's submissions of 23 January 2006 it was also argued that even if the Appendix were removed the application would be allowable (page 3, lines 16 and 17), and the board was asked to deal with this specific argument, "if an allowance is not forthcoming" (page 3, lines 31 to 34). So for the sake of completeness the board observes that the argument is not germane to the situation as it stands, since there is no request before the board in which the amendments have been removed.
 9. The board notes that the amendments either to paragraph 12 or to paragraph 21 of the application suggested by the appellant in the final submission (letter of 23 January 2006, page 4, line 20 to page 5, line 15, mentioned in Point VI above) would have no effect on the above considerations, since the "Appendix" would remain part of the description. Further, the concrete objections raised in at least Points 6, 7, 11 and 13 of the board's communication relating to a lack of clarity and support by the description of the claimed subject-matter (Article 84 EPC) still apply to both the main and the auxiliary requests, and the appellant's arguments on these points do not appear convincing.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland