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**Datasheet for the decision
of 11 May 2007**

Case Number: T 1520/05 - 3.5.03

Application Number: 98308355.1

Publication Number: 0918417

IPC: H04L 12/28

Language of the proceedings: EN

Title of invention:

Message and communication system in network

Applicant:

LUCENT TECHNOLOGIES INC.

Opponent:

-

Headword:

Communication system/LUCENT

Relevant legal provisions:

EPC Art. 84

RPBA Art. 11(3)

Keyword:

"Clarity - (no)"

Decisions cited:

G 0010/93

Catchword:

-



Case Number: T 1520/05 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 11 May 2007

Appellant: LUCENT TECHNOLOGIES INC.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 August 2005
refusing European application No. 98308355.1
pursuant to Article 97(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. This is an appeal against the decision of the examining division, dispatched on 3 August 2005, to refuse patent application number 98 308 355.1, publication number 0 918 417. The reason given for the refusal was that the claims did not meet the requirements of Article 84 EPC. It was also argued that the subject-matter of claim 1 did not involve an inventive step with respect to the disclosure of document

D1: WO 96 21983 A

II. Notice of appeal was filed in a letter dated 8 and received 14 September 2005. The fee was paid on 14 September 2005. A statement setting out the grounds of the appeal was submitted on 29 November 2005 together with an auxiliary request claim set.

A conditional request for oral proceedings was made.

The board issued a summons to attend oral proceedings to be held on 11 May 2007. In the accompanying communication the board cited, in addition to D1,

D2: L. Wetterborg, "CDPD - Adding wireless IP services to D-AMPS/AMPS wireless networks," Ericsson Review, v.73 n.4, 1996, p.151-156

D3: J. Haemaelaeinen et al., "GSM Access to Internet," Telecommunications, vol. 28 no. 3, 1994, Dedham, MA, US, pages 37, 38, 40 and 42

D4: C. Perkins et al., "IP Mobility Support," IETF RFC 2002, 1996, IETF, CH.

D2 had previously been cited by the examining division. Documents D3 and D4 were mentioned in the search report of related application 98 308 332.0 (publication number 0 912 027) and introduced into the proceedings by the board of its own motion in accordance with Article 114(1) EPC.

The board gave its preliminary opinion that the claims of both requests were not clear for a number of reasons. Furthermore the subject-matter specified in the independent claims appeared not to be novel in the case of claim 38 and not to involve an inventive step otherwise. If the interpretation given by the appellant in the statement of grounds to independent claims 38 and 41 of the auxiliary request were adopted, these claims added subject-matter to the application as originally filed, in violation of Article 123(2) EPC.

III. In a submission on 4 April 2007 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 the procedure be continued in writing. Amended claim sets were submitted for both the main and the auxiliary request.

The appellant was informed that the oral proceedings would not be cancelled.

IV. The independent claims of the main request read as follows:

"1. A data network providing end users with remote wireless access to public internet, private intranet and internet service providers, characterized in that a foreign network (62) includes a foreign base station (64) with a foreign access hub (84), the foreign access hub including a first serving inter-working function unit (66), a home network (70) includes a first home inter-working function unit (72); and a first mobile end system (32) subscribed to the home network and connected within the foreign network, the first mobile end system generating a first message, the first message transmitted between the first mobile end system and a first communications server (40) through the first home inter-working function unit and through the first serving inter-working function unit of the foreign access hub in the foreign base station using an XTunnel protocol, the first home interworking [sic] function unit serving as through the first home inter-working function unit and through the first serving inter-working function unit of the foreign access hub in the foreign base station using an XTunnel protocol, the first home working interworking [sic] function unit serving as an anchor point that is not changed during a communication session as the first mobile end system roams in other foreign networks."

"38. A mobile end system (32) for use in a data network, the data network including a foreign network (62) having a foreign base station (64) a foreign access hub (84) the foreign access hub including a first serving inter-working function unit (66), and a home network (72) with a first home inter-working function unit (72), the mobile end system characterized by:

said first mobile end system subscribed to the home network and connected within the foreign network, a first message being transmitted between the first mobile end system and a first communications server through the first home inter-working function unit and through the first serving inter-working function unit of the foreign access hub (84) in the foreign base station using an XTunnel protocol, the first home interworking [sic] function unit serving as an anchor point as the first mobile end systems [sic] roams in other foreign networks, and an end unit registration agent in the mobile end system communicating with a proxy registration agent in the foreign access hub to discover a point of attachment to the foreign network [sic - no full stop]"

"41. A home network (70) for use in a data network, the data network including a foreign network (62) comprising a foreign base station (64), a foreign access hub (84), the foreign access hub including a first serving inter-working function unit (66), and a mobile end system (32) subscribed to the home network and connected within the foreign network, the home network characterized by:

a home switching center (40);
a first home inter-working function unit (72) being included in said home mobile switching center; and
wherein a first message is transported between the first mobile end system and a first communications server through the first home inter-working function unit and through the first serving inter-working function unit of the foreign access hub in the foreign base station using an XTunnel protocol, the first home interworking [sic] function unit coupled to the first

serving interworking [sic] function [sic - no "unit"] of the foreign access hub via an I-interface and serving as an anchor point as the first mobile end system roams in other foreign networks."

In claim 1 of the auxiliary request a definition of "XTunnel protocol" has been added after the first appearance of that expression, thus: "using an XTunnel protocol, as used herein, the XTunnel protocol is a protocol that provides in-sequence transport of point-to-point (PPP) protocol." The second occurrence of "XTunnel protocol" in claim 1 of the main request has been replaced by "I-interface" ("the first home interworking [sic] function unit serving as through the first home inter-working function unit and through the first serving inter-working function unit of the foreign access hub in the foreign base station using an I-interface").

In claim 38 of the auxiliary request the same definition of "XTunnel protocol" has been added and the "first message being transmitted between the first mobile end system and a first communications server through the first home inter-working function unit" has been qualified by "via an I-interface".

The definition of "XTunnel protocol" used in the other independent claims has also been added to claim 41 of the first auxiliary request (the reference to the "I-interface" is already a feature of claim 41 of the main request).

- V. The appellant requests that the decision under appeal be set aside and a patent be granted. The board

understands the basis on which grant is requested to be the following:

claims

1 to 44 labelled "primary request claim set" or alternatively claims 1 to 44 labelled "auxiliary request claim set", both sets filed on 4 April 2007;

description

pages 1 to 89 as originally filed, and page 2A filed with the letter dated 16 and received 19 July 2004, with the amendments to pages 16 and 89 filed with the letter dated 16 and received 19 July 2004; and

drawing sheets 1 to 32 as originally filed.

- VI. 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).

According to Article 116(1) EPC, oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings. Oral proceedings are an effective way to discuss cases

mature for decision, since the appellant is given the opportunity to present its concluding comments on the outstanding issues (Article 113(1) EPC), and a decision can be made at the end of the oral proceedings (Rule 68(1) EPC).

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 these requirements. A summons was therefore issued. In accordance with Article 11(3) of the Rules of Procedure of the Boards of Appeal the board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying on its written case. 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 appellant's request that oral proceedings be cancelled was therefore refused.

The board considers that its reasons for coming to its decision do not constitute a departure from grounds or evidence previously put forward, requiring that the appellant be given a further opportunity to comment. The board concludes that Article 113(1) EPC has been satisfied and it was therefore in a position to make its decision at the oral proceedings. The appellant's request that the procedure be continued in writing, which the board interprets as a request for a further

communication before a decision is issued, is therefore also refused.

2. *The main request*

2.1 The claims of the main request do not satisfy the requirement of Article 84 EPC for clarity, for at least the following reasons.

2.1.1 There are a large number of errors which appear to be of an editorial nature but which in combination make the matter for which protection is sought unclear (uses of wrong parts of speech, inconsistent hyphenation, plural where singular appears to be called for, etc.). In particular, the board is unable to assign any meaning to the phrase "the first home interworking function unit serving as through the first home interworking function unit" of claim 1.

2.1.2 All of the independent claims refer to the first mobile end system roaming "in other foreign networks". The claims have previously referred to "a foreign network", so that the "other foreign networks" apparently refers to networks not including the foreign network previously defined. The relationship between the "foreign network" and the "other foreign networks" is unclear.

2.1.3 All the independent claims, although directed to a network or a system, include features which relate only to the network or system in use. Claim 1 specifies, for example, "the first mobile end system generating a first message", "the first message transmitted" (i.e. being transmitted) and "the first home working

interworking function unit serving as an anchor point that is not changed during a communication session as the first mobile end system roams". These features make it unclear whether protection is sought for an apparatus or for a method of operating an apparatus.

With respect to the last of these features, the appellant argues that the present phrasing "overcomes any uncertainty as to the category of the matter for which protection is sought." The board cannot follow this argument; both "that is not changed during a communication session," and "the first mobile end system roams," are dynamic properties - things that the system does rather than what it is.

- 2.1.4 It is not clear in the independent claims which part or parts of the data transfer the appellant means to specify as using the "XTunnel protocol".

The appellant argued, in response to the same objection raised against the previous claims, that the part intended was in fact clear, citing the claim on page 2 of the letter of 4 April 2007 thus, "the first message being transmitted ... through the first home inter-working function unit and through the first serving inter-working function unit of the foreign access hub in the foreign base station using an XTunnel protocol." However, firstly the use of "through" (twice) rather than "between" or equivalent (once), suggests that other parts of the transmission may use the protocol without defining which and secondly the phrase "between the first mobile end system and a first communications server (40)" is omitted, rather suggesting that the whole transmission uses the XTunnel protocol (which

would actually not be in correspondence with the description, see paragraph [0070]).

- 2.1.5 The "XTunnel protocol" is stated in the description to be new (paragraph [0061]). Hence using this name in the claim without any definition is *per se* unclear. Moreover, it is not clear what limitation is implied by this feature, i.e. whether only some properties of the XTunnel protocol, and if so which, are regarded as limiting the matter for which protection is sought (see the claims of the auxiliary request, where a definition of required properties has been added).

The appellant argued, in response to the same objection raised against the previous claims that, "The Description at page 19, lines 17-24 [paragraph [0034] of the published application] describes the formation of the XTunnel protocol in sufficient detail taken in conjunction with details provided by search engines to enable a worker skilled in the art to implement the XTunnel protocol in a network," (page 2 of the letter of 4 April 2007). The board is not convinced. Firstly material in the description does not relieve the appellant of the necessity for the claims themselves to be clear. Secondly details provided by search engines, which may have been published at any time up to the present, do not necessarily provide evidence of what the skilled person knew at the priority date. Thirdly as a matter of fact the board has tried searching the Internet for "XTunnel" and "XTunnel protocol" and has found those terms, used in the way they are in the present application, only in other patent applications of roughly the same age and from the same applicant. Finally the board observes that paragraph [0034] merely

states some of the properties of the protocol but fails to define it.

- 2.1.6 Independent claims 38 and 41 are directed to parts of the overall data network, namely the mobile end system and the home network respectively, but specify features of the rest of the data network whose intended limiting effect on the claimed subject-matter is unclear.

In response to the same objection raised against the previous claims the appellant has only added features thus possibly overcoming a novelty objection raised against previous claim 38 but not addressing the clarity problem.

- 2.1.7 Claim 41 mentions an "I-interface", without definition. There is no indication in the application, nor has the appellant provided any evidence, that this term and its definition would have been known to the skilled person at the present priority date. The use of this term in the claim is therefore also unclear. Moreover, as in the case of "XTunnel protocol", it is not clear what limitation is implied by this feature, i.e. whether only some properties of the I-interface, and if so which, are regarded as limiting the matter for which protection is sought. It is noted that even in the description the "I-interface" is only defined to the extent that a list of some services it provides is given (paragraph [0041]).

- 2.2 Thus the claims of the present main request do not satisfy the requirement of Article 84 EPC for clarity and the request is therefore not allowable.

3. *The auxiliary request*
- 3.1 The claims of the auxiliary request also do not satisfy the requirement of Article 84 EPC for clarity.
 - 3.1.1 All of the objections raised above with respect to the main request also apply to the claims of the auxiliary request. With respect to point 2.1.5 it is noted that a definition of "XTunnel protocol" has been added ("as used herein, the XTunnel protocol is a protocol that provides in-sequence transport of point-to-point (PPP) protocol") but also that the definition is itself unclear. A "protocol" is not "transported".
- 3.2 Thus the claims of the present auxiliary request do not satisfy the requirement of Article 84 EPC for clarity and the request is therefore not allowable.
4. Hence there is no allowable request and the appeal must be dismissed.
5. While the reasons given above are sufficient for the decision, the board observes that the appellant has not overcome the objection raised in the communication accompanying the summons to oral proceedings that the claimed subject-matter did not involve an inventive step with respect to the disclosure of document D1 supplemented if necessary with a commonplace element illustrated by D2, D3 and D4 and common general knowledge. The appellant's arguments on this point seem firstly only to consider the teachings of the various documents in isolation from one another, i.e. they do not address the combination of D1 with other documents, and secondly to rely on artificial distinctions based

on the use of different terminology for what in the board's view are corresponding features.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland