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**Datasheet for the decision  
of 12 January 2010**

**Case Number:** T 1916/07 - 3.5.03

**Application Number:** 00304796.6

**Publication Number:** 1065870

**IPC:** H04M 7/00

**Language of the proceedings:** EN

**Title of invention:**  
Internet protocol telephony

**Applicant:**  
LUCENT TECHNOLOGIES INC.

**Opponent:**  
-

**Headword:**  
Internet protocol telephony/LUCENT

**Relevant legal provisions:**  
EPC Art. 56, 111(1), 123(2)  
RPBA Art. 15(3)

**Keyword:**  
"Remittal - fresh case following amendment"  
"Absence of appellant at oral proceedings"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 1916/07 - 3.5.03

**DECISION**  
of the Technical Board of Appeal 3.5.03  
of 12 January 2010

**Appellant:** LUCENT TECHNOLOGIES INC.  
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**Representative:** Sarup, David Alexander  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 20 April 2007  
refusing European application No. 00304796.6  
pursuant to Article 97(1) EPC 1973.

**Composition of the Board:**

**Chairman:** F. van der Voort  
**Members:** T. Snell  
M.-B. Tardo-Dino

## Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division refusing European patent application No. 00304796.6, with publication number EP 1 065 870 A, on the ground that the subject-matter of claims 1 and 16 did not involve an inventive step having regard to the disclosure of the following document:
- D1: EP 0 818 908 A
- II. In the notice of appeal the appellant requested that the decision be set aside and a patent granted. In a subsequently filed statement of grounds, the appellant filed new claims 1-17 intended to replace the previous set of claims on file.
- III. In a communication accompanying a summons to oral proceedings the board gave a preliminary opinion in which issues concerning Articles 84 and 123(2) EPC, and Article 52(1) EPC in combination with Article 56 EPC were raised.
- IV. In response to the board's communication, the appellant filed, with a letter dated 27 November 2009, new claims intended to replace the previous set of claims on file, together with supporting arguments. The appellant further informed the board that it would not attend the oral proceedings, and requested that the oral proceedings be cancelled and the procedure be continued in writing.

- V. The board subsequently informed the appellant in writing that the date fixed for oral proceedings was maintained. Reasons were given.
- VI. Oral proceedings were held on 12 January 2010 in the absence of the appellant. The board understood from the appellant's written submissions that the appellant requested that the decision under appeal be set aside and a patent granted on the basis of claims 1-17 as filed with the letter dated 27 November 2009. After deliberation, the board's decision was announced at the end of the oral proceedings.
- VII. Claim 1 of the appellant's request reads as follows:

"A method of establishing a telecommunications call via the Internet to a called Internet customer whose station is not registered on a connection to the Internet,  
comprising the steps of:  
receiving (301) said call at a first access point on the Internet;  
responsive to receiving said call, obtaining (303) location information for notifying the called customer station;  
responsive to receiving said location information, notifying (327, 329) said called customer station with a procedure that informs said called customer station that it is being called on an Internet call; and  
Characterized in that the method further comprises the steps of:  
responsive to receiving said location information, notifying (327, 329) said called customer station from a switch of the wireline public switched telephone

network (PSTN) or wireless public switched telephone network serving said called customer station, via a signaling connection over the wireless public switched telephone network or wireline PSTN, with a procedure that informs said called customer station that it is being called on an Internet call;  
said called customer station responsive to said notifying, initiating a registration (331) on a second access point on the Internet; and  
responsive to the registration, establishing the connection (601) between the called customer station and the second access point and connecting (623) the first access point and the second access point;  
wherein said second access point is made part of the method for establishing said call only after said called customer station has been notified."

VIII. Claim 16 of the request reads as follows:

"Apparatus for establishing a telecommunications call via the Internet to a called customer whose station is not registered on a connection to the Internet, comprising:  
means for receiving said call, at a first access point on the Internet;  
means, responsive to receipt of said call for obtaining location information for notifying the called customer station; and  
means, responsive to receipt of said call and said location information, for notifying said called customer station with a procedure that informs said called customer station that is being called on an Internet call;

Characterized in that the apparatus further comprises:  
means, responsive to receipt of said call and said  
location information, for notifying said called  
customer station from a switch of the wireline public  
switched telephone network (PSTN) or wireless public  
switched telephone network serving said called customer  
station, via a signaling connection over the wireless  
public switched telephone network or wireline PSTN,  
with a procedure that informs said called customer  
station that it is being called on an Internet call;  
means, responsive to receiving the notification, for  
initiating a registration of said called customer  
station on a second access point on the Internet; and  
means, responsive to said registration for establishing  
the connection between the called customer station and  
the second access point, and connecting the first  
access point and the second access point;  
wherein said second access point is made part of said  
apparatus for establishing said call only after said  
called customer station has been notified."

IX. Claim 17 of the request reads as follows:

"Apparatus comprising means for performing a method as  
claimed in any one of the claims 1-15."

## **Reasons for the Decision**

### 1. *Procedural matters*

1.1 The board considered it to be expedient to hold oral  
proceedings in accordance with Article 116(1) EPC for  
reasons of procedural economy. The appellant requested

cancellation of the oral proceedings but offered no reasons for doing so and none were apparent to the board. The request for cancellation of the oral proceedings was therefore rejected. Having verified that the appellant was duly summoned the board decided to continue the oral proceedings in the absence of the appellant (Rule 115(2) EPC and Article 15(3) RPBA).

- 1.2 The appellant requested that the appeal proceedings be continued in writing, which the board understood as a request that a further communication be issued before a decision be taken. However, in accordance with Article 15(3) RPBA, the board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at oral proceedings of any party duly summoned who may then be treated as relying only on its written case. In the absence of any reasons submitted by the appellant to continue the procedure in writing, and none being apparent to the board, this request was rejected.

2. *The claims filed during the appeal proceedings*

- 2.1 The most significant amendment to claim 1 as compared with the version refused by the examining division is the addition of the feature "wherein said second access point is made part of the method for establishing said call only after said called customer station has been notified". An implicit basis for this amendment is to be found in column 1, lines 38-44 and column 2, lines 1-4 of the patent application as published. As described, the called station initiates connection to the Internet after having been notified of the call via the signalling network of either the PSTN or a page

transmitted by a wireless network. Since the called station itself initiates connection to an access point on the Internet (the "second access point"), the skilled person would understand that the second access point, ie a home agent or point of presence server, has until this point not been involved in the call. No new information has therefore been added by this amendment, which thus complies with Article 123(2) EPC.

2.2 Further, in the board's view, the amendment is clear and hence does not give rise to any objection under Article 84 EPC.

2.3 The intention of the aforementioned amendment is clearly to distinguish the claimed subject-matter from Document D1, which the examining division considered to represent the closest prior art. D1 discloses a method for establishing a call via the Internet to a called Internet customer whose station is not registered on a connection to the Internet. This method includes an alerting process (cf. col. 5, line 34 to col. 6, line 39 and Fig. 1) involving the calling of the called station by a server computer  $S_b$ , which is the server to which the called station belongs and which provides it with access to the Internet by allocating an IP address (cf. col. 6, lines 27-31). As part of the process for setting up an Internet call to the called station, server computer  $S_b$  dials up the called user's computer  $P_b$  to make an IP connection (col. 10, lines 13-17). In the terminology of claim 1, server computer  $S_b$  is therefore the "second access point" via which the called station connects to the Internet. Hence, in the method described in D1, the second access point is involved in notifying the called station that it should



connect to the Internet. Thus D1, in the board's view, does not disclose the new feature of claim 1 that "said second access point is made part of the method for establishing said call only after said called customer station has been notified".

2.4 The examining division in the impugned decision observed that according to D1 (corroborating with the board's comments above) "it is server B [board's note: server computer  $S_b$ ], associated with the called user, which notifies the called user to establish an IP connection". This part of the reasoning thus runs directly contrary to the requirement that, according to the above-mentioned added feature, the second access point is not involved until after the notification step. Consequently, the examining division's reasoning does not apply to claim 1 currently on file.

2.5 The same considerations apply, *mutatis mutandis*, to independent claim 16.

2.6 As the reasoning for refusing the application is not applicable to the independent claims now on file, it follows that the impugned decision is to be set aside.

### 3. *Remittal - fresh case*

3.1 In order not to deprive the applicant of an examination of the claims on file by two instances, the board considers it appropriate to remit the case to the department of first instance, since as a result of the above-mentioned amendment a new assessment of inventive step is required (ie a "fresh case" has resulted). It is even possible that D1 no longer represents the

closest prior art. In this respect, the board notes that the added feature referred to above was not included in the claims as originally filed and therefore plausibly has not been searched. However, these are all matters to be considered by the examining division.

3.2 In view of the above, the board exercises its power under Article 111(1) EPC to remit the case to the department of first instance for further prosecution.

4. *Additional comments*

4.1 In relation to the further prosecution of this application, it appears to be necessary that further amendments to the claims be made in order to comply with Articles 84 and 123(2) EPC, as set out in the following paragraphs.

4.2 *Article 123(2) EPC - Claims 1 and 16*

4.2.1 Claim 1 includes the feature "notifying ... via a signaling connection over the wireless public switched telephone network ...". Claim 16 includes a corresponding apparatus feature.

However, in the application as originally filed, a signalling connection is apparently only mentioned in the context of sending a signalling message to a called station which is a wireline station and not a wireless station (cf. paragraph [0015] of the description and claim 10 as filed). If the called station is a wireless station, it is notified by a page (cf. paragraph [0014] and claims 6 and 7 as filed). A "signaling connection"

to a mobile terminal has a broader scope than the transmission of a page. The board is therefore of the opinion that subject-matter has been added which extends beyond the content of the application as filed, contrary to Article 123(2) EPC.

4.2.2 In the application as originally filed, two separate embodiments are disclosed, depending on whether the called station is a wireless station connected to a data-based wireless access network or a wireline station connected to the wireline public switched telephone network (cf. Fig. 1; "cellular wireless station 2", "data-based wireless access network 6", "wireline station 8", "PSTN 7"). If the called station is paged via the data-based wireless access network, it connects to the Internet via the data-based wireless access network (cf. paragraph [0019] and Fig. 3B), and if the called station is a wireline station called by means of a signalling message over the telephone network, it connects to the Internet via the wireline connection (cf. paragraphs [0015] to [0017] and Fig. 1).

However, claims 1 and 16 merely include the limitation that the called customer station is notified from a switch of the wireless or wireline public switched telephone network and initiates a registration on a second access point on the Internet, which is an intermediate generalisation of the originally disclosed subject-matter, since it is not defined via what type of connection a registration on the Internet is made. Thus, claims 1 and 16 now embrace embodiments where, for example, the called station is paged via the wireless access network and connects to the Internet via a wireline connection.

Hence, claims 1 and 16 apparently do not comply with Article 123(2) EPC.

4.2.3 In order to assist in overcoming the objections under Article 123(2) EPC, it appears to be appropriate that separate independent claims be filed for the wireline and wireless embodiments, respectively.

4.3 *Article 84 EPC - Claim 17*

Claim 17 appears to be unclear, contrary to Article 84 EPC.

In this respect, the reference to claims 1-15 does not enable the limitations on the claimed apparatus to be properly determined. In the board's view it is unclear whether the apparatus is intended to include the complete infrastructure consisting of Internet, called station and either wireline or wireless network, or whether claim 17 should be construed narrowly as being limited merely to an apparatus for establishing a telecommunications call comprising only means for carrying out the method steps defined in claims 1-15 (i.e. "means for receiving ...", "means for notifying ...", etc. It is thus unclear whether claim 17, insofar as referring back to claim 1, is merely a repetition of claim 16, or whether a different scope is implied.

4.4 It also appears that claims 16 and 17 do not meet the requirements of Rule 43(2) EPC regarding the number of independent claims in one category.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

D. Magliano

F. van der Voort