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**Datasheet for the decision
of 20 December 2012**

Case Number: T 0543/09 - 3.4.01

Application Number: 02705026.9

Publication Number: 1468305

IPC: G01S 1/24

Language of the proceedings: EN

Title of invention:
PROVISION OF LOCATION INFORMATION

Applicant:
Nokia Corporation

Headword:
-

Relevant legal provisions:
EPC Art. 113(2)
RPBA Art. 13(1)

Keyword:
"Late-filed request (not admitted)"
"No agreed text"

Decisions cited:
-

Catchword:
-



Case Number: T 0543/09 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 20 December 2012

Appellant: Nokia Corporation
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 November 2008
refusing European patent application
No. 02705026.9 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: G. Assi
Members: H. Wolfrum
A. Pignatelli

Summary of Facts and Submissions

I. European patent application 02 705 026.9 (filed under the PCT and published as WO 03/060547) was refused by a decision of the examining division dispatched on 3 November 2008, on the basis of objections under Articles 56, 84 and 83 EPC 1973 and Rule 42(1)(e) EPC against the claims then on file.

The examining division had based its decision on document D1 (US-A-6 081 229).

II. The applicant lodged an appeal against the decision and paid the prescribed fee on 22 December 2008. On 25 February 2009 a statement of grounds of appeal was filed together with an amended set of claims.

III. Upon a corresponding request, the appellant was summoned to oral proceedings.

In a communication annexed to the summons, the Board gave a preliminary opinion, *inter alia* on the issue of inventive step. In this context, the Board indicated why the claimed subject-matter could be considered to lack inventive step in view for instance of the teaching of document D1 and the skilled person's common knowledge.

IV. In response, the appellant filed by letter of 19 November 2012 three sets of claims according to a main request and a first and second auxiliary request.

V. Oral proceedings were held on 20 December 2012.

After discussion of the matter of inventive step, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of an amended set of claims 1 to 14 filed in the oral proceedings as a sole request replacing all former requests.

VI. Claim 1 of the appellant's request reads as follows :

" 1. A method comprising:

estimating ~~determining~~ a likely location of a mobile user equipment (1) relative to a station (5) of a communication system for estimation of a delay between the mobile user equipment and the station when timing advance value is not provided, wherein the station provides a cell and the likely location is determined based on information ~~determined for the cell~~ **of at least one of a mass center of a coverage area of the cell, average location of users in the cell, average locations of the user equipment in the cell, average timing advance for the cell and average round trip time for the cell;**
based on the determined likely location, determining an estimate of the delay between transmission of a signal from the station (5) and reception of said signal at the mobile user equipment (1);
receiving assistance data at the mobile user equipment (1) from the station (5), said assistance data comprising information about the timing of a positioning system; and
accomplishing a more accurate location determination at the user equipment (1) based on signals from entities (10) of the positioning system, the assistance data and said estimated delay."

[The emphasis added indicates the amendments made with

respect to independent claim 1 of the second auxiliary request filed with the letter of 19 November 2012.]

Corresponding amendments are made to further independent claim 11, being directed to a system for determining the location of a mobile user equipment, claim 12, being directed to a location determination apparatus for a mobile user equipment, and claim 14, concerning a mobile user equipment.

Claims 2 to 10 and 13 are dependent claims.

VII. The appellant argued in favour of the admission of its request into the proceedings that it constituted a modification of a request that had already been filed in writing, ie the second auxiliary request filed in preparation of the oral proceedings. Moreover, the amendments which were made only served for clarifying that the expression "determining a likely location of a mobile user equipment" did not mean a physical measurement of the location. The necessity for such amendment became apparent only from concerns as to a lack of inventive step that were expressed by the Board in the discussion at the oral proceedings. The amendments as such overcame these concerns, were readily understandable and had a clear basis of disclosure in the application documents as originally filed.

Reasons for the Decision

1. In the following reference is made to the provisions of the EPC 2000, which entered into force as of 13 December 2007, unless the former provisions of the EPC 1973 still apply to pending applications.
2. The appeal complies with the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is, therefore, admissible.
3. Admissibility of the appellant's request
 - 3.1 Article 13(1) RPBA stipulates that *"any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy."*

The case law of the boards of appeal has established a variety of criteria for the exercise of such discretion (cf. chapter VII.E.16. of the 6th edition of the "Case Law of the Boards of Appeal of the European Patent Office"). Among these criteria are, for example, whether the amendments respond to fresh objections, whether the amendments overcome the objections that had been raised, or whether the amendments raise *prima facie* new objections or render the request clearly allowable.

- 3.2 In the present case, the amendments allegedly answer concerns as to lack of inventive step that were raised by the Board in the oral proceedings. However, such concerns were not new to the appellant. After all, lack of

inventive step was one of the grounds for refusal by the examining division and was addressed in the Board's communication annexed to the summons to oral proceedings. Thus, the amendments filed with the appellant's request are not occasioned by new objections which arose for the first time either shortly before or in the oral proceedings before the Board.

- 3.3 Substantive amendments at such an advanced stage of the appeal proceedings as are oral proceedings would normally be accepted only under exceptional circumstances, in which the amended subject-matter would for instance be immediately allowable. This is not the case here. On the contrary, *prima facie* the concerns as to lack of inventive step (Article 56 EPC 1973) remain and new doubts arise, for instance as to added subject-matter (Article 123(2) EPC).

Having regard to the issue of lack of inventive step, the amendments do not add aspects which the skilled person in the technical field at issue would not have been aware of. After all, the application itself recognizes on originally-filed page 10, line 31 to page 11, line 3, that an average timing advance value may be determined for the cell for instance by a base station and that this kind of functionality was already supported by some communication systems.

Concerns as to non-compliance with the requirement of Article 123(2) EPC arise for instance from the replacement of the term "determining" by the term "estimating" and the introduction of the term "average round trip time for the cell". According to the appellant, the term "estimating" had a basis of disclosure in

original claim 16 which made reference to "location estimation means for provision of an estimate of the likely location of the mobile user equipment ...". The Board fails to recognize in this term a clear and unambiguous basis of disclosure for the claimed step of "estimating" in the narrow meaning, intended by the appellant, of excluding any kind of measurement. Moreover, neither original claim 11, with the phrase "wherein average timing advance (TA) or round trip time (RTT) is used ..." nor the description on originally-filed page 10, line 31 to page 11, line 7, which refers to an Average Timing Advance value determined for the cell, on the one hand, and Round Trip Time that "can be used in similar manner" provide a clear and unambiguous disclosure of an "average round trip time".

- 3.4 For the above reasons, the Board did not admit the appellant's request into the proceedings.
4. According to Article 113(2) EPC, the "European Patent Office shall examine, and decide upon, the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent."

As a result of the Board's decision not to admit the appellant's sole request into the proceedings there was no text which would have been submitted or agreed by the applicant and thus there was no basis for continuation of the appeal.

Order

For these reasons it was decided that:

The appeal is dismissed.

The Registrar

The Chairman

R. Schumacher

G. Assi