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**Datasheet for the decision  
of 5 February 2014**

**Case Number:** T 2004/10 - 3.5.03

**Application Number:** 98921461.4

**Publication Number:** 976236

**IPC:** H04M3/50

**Language of the proceedings:** EN

**Title of invention:**

Communication system for providing messages in different languages

**Applicant:**

Telefonaktiebolaget LM Ericsson (publ)

**Headword:**

Communication system/ERICSSON

**Relevant legal provisions:**

EPC Art. 56, 84

RPBA Art. 13(1)

**Keyword:**

Inventive step (former main request) (no)

Late-filed auxiliary requests - admitted (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
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Case Number: T 2004/10 - 3.5.03

**D E C I S I O N  
of Technical Board of Appeal 3.5.03  
of 5 February 2014**

**Appellant:** Telefonaktiebolaget LM Ericsson (publ)  
(Applicant) 164 83 Stockholm (SE)

**Representative:** Burchardi, Thomas  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 7 June 2010 refusing European patent application No. 98921461.4 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** F. van der Voort  
**Members:** A. J. Madenach  
M.-B. Tardo-Dino

## **Summary of Facts and Submissions**

I. The present appeal arises from the decision of the examining division refusing application No. 98921461.4 with international publication number WO 98/47274 A on the ground that the subject-matter of claims 1 and 10 did not involve an inventive step (Articles 52(1) and 56 EPC) having regard to the disclosure of

D1: WO 95/20859 A

and the common general knowledge. The decision under appeal is a decision according to the state of the file, as requested by the applicant with its letter dated 26 April 2010, and refers to the reasons given in the examining division's communication dated 15 December 2009.

II. The appellant requested reversal of the decision and grant of a patent. As an auxiliary measure, oral proceedings were requested.

III. The board summoned the appellant to oral proceedings and sent a communication according to Article 15(1) RPBA, in which its preliminary opinion that the subject-matter of claim 1 did not involve an inventive step was expressed.

IV. With its reply dated 7 January 2014 the appellant submitted a set of claims 1 to 14 of a main request and claims 1 to 15 of an auxiliary request and requested that the decision of the examining division be set aside and a patent be granted on the basis of the claims of the main request or, in the alternative, on the basis of the claims of the auxiliary request.

- V. Oral proceedings were held on 5 February 2014. In the course of the oral proceedings, after discussion of the main request, the appellant withdrew the main request and filed claims 1 to 12 of a first auxiliary request replacing the auxiliary request on file and claims 1 to 11 of a second auxiliary request.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the first auxiliary request or, in the alternative, of the second auxiliary request.

At the end of the oral proceedings, after deliberation, the board's decision was announced.

- VI. Claim 1 of the main request, which was withdrawn during the oral proceedings, reads as follows:

"A method in a communication system for providing messages to subscribers in one of different languages, the communication system comprising communication devices (T1; T2; T3) used by the subscribers, each of them comprising input/retrieval devices (EA1, EA2) for inputting, changing or deleting a list of preferred languages,

at least one storage device (S) for storing the list of preferred languages, and at least one message device (BV1, BV2, BV3), for providing messages to subscribers in one of different languages, the method comprising the steps of:

- receiving, via the input/retrieval device (EA1, EA2) of the communication device (T1; T2; T3), the list of preferred languages from the subscriber, wherein the list of preferred languages comprises at least two

preferred languages in a sequence in accordance with the subscriber's preference;

- storing the list of preferred languages in the [sic] least one storage device (S), wherein the list of preferred languages is assigned to the subscriber;
- transmitting, the list of preferred languages from the storage device (S) to the message device (BV1, BV2, BV3) for providing the message in one of different languages;

In case the message needs to be transmitted to the subscriber, the method comprises the steps of:

- screening, by the message device (BV1, BV2, BV3), the at least two languages of the list of preferred languages;
- selecting, by the message device (BV1, BV2, BV3), in accordance with the sequence of subscriber preference, the first screened language available at the message device (BV1, BV2, BV3); and
- transmitting, by the message device (BV1, BV2, BV3), the message in the selected language to the subscriber via the communication device (T1; T2; T3).".

Claim 1 of the first auxiliary request reads as follows:

"A communication system including message means (BV1, BV2, BV3) for providing messages in one of different languages, comprising:

- at least one transmission device (UEV1, UEV2, UEV3);

- at least two communication devices (T1, T2, T3);
  
- at least one storage device (S) for storing at least one list comprising at least two preferred languages entered in a sequence in accordance with a subscriber preference, while each of the at least one list is assigned to one subscriber;
  
- at least one message device (BV1, BV2, BV3) for providing messages in different languages;
  
- at least one subscriber input/retrieval device (EA1, EA2) is provided, for storing a list with at least two preferred languages in the at least one storage device (S) and for retrieving and displaying the list from said at least one storage device (S), wherein the list is one of the at least one list stored on [sic] the at least one storage device (S);
  
- each of the at least one subscriber input/retrieval devices (EA1, EA2) include input means (K1, K2) for entering sequences of digits or characters specifying a list of preferred languages, and include display means (D1, D2) for displaying the list of at least two preferred languages;
  
- a list with at least two preferred languages assigned to a subscriber is transmitted between said at least two communication devices (T1, T2, T3), or other units of the communication system, during establishing a connection or during an existing connection; and
  
- the at least one message device (BV1, BV2, BV3) includes determining means (PV1) for screening the at least two languages of the list in the sequence of

subscriber preference and for selecting, in accordance with the sequence of subscriber preference, the first language available at the at least one message device, and for initiating that the message is transmitted to any one of the at least two communication devices (T1, T2, T3) in the selected language."

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that it comprises the following additional feature:

"and wherein the at least one message device (BV1, BV2, BV3) includes retrieval means (AV1) for retrieving a list with at least two preferred languages from [sic] storage means (S, TS1, TS2), in case the list is not transmitted or not properly transmitted from a communication device (T1, T2, T3) to [sic] message device (BV1, BV2, BV3)".

## **Reasons for the Decision**

### *1. Preliminary remarks*

1.1 Even though the main request was withdrawn, the board will set out below the reasons why the subject-matter of claim 1 of the main request did not involve an inventive step, since this is relevant to the question of admissibility of the first auxiliary request (see point 2).

1.2 At the oral proceedings the question of whether or not the subject-matter of claim 1 involved an inventive step was discussed. Reference was made to the prior art as discussed in the application as published (page 2, line 15 to page 3, line 9), in particular to

D2: DE 44 30 991.

This document discloses, using the language of claim 1, a method in a communication system for providing messages, *i.e.* announcements, to subscribers in one of different languages (see the title). The communication system comprises communication devices, *i.e.* mobile telephones, used by the subscribers (see Figure 2: MSA, MSB, ... MSn). These communication devices may be part of a GSM network (column 3, lines 61-67) and, hence, may each comprise input/retrieval devices, in the form of a keyboard and a display, for inputting, changing or deleting data. The communication system further comprises at least one storage device (see Figure 2: HLR and VLR/MS) for storing subscriber data LA, L'A representing a list of two languages (column 4, lines 39-46), and at least one message device (see Figure 2: AU, column 4, lines 34-39 and claim 7), for providing the messages, *i.e.* the announcements, to subscribers in one of different languages. The list of two languages is for use in providing an announcement to a calling subscriber (column 4, lines 39-46). One language represents the mother tongue of the calling subscriber, the other language a foreign language which the calling subscriber can understand. The method comprises the steps of: storing the list of two languages in the at least one storage device HLR and/or VLR (column 4, lines 26-34, lines 39-46, and lines 52-58), wherein the list of two languages is assigned to the subscriber (column 4, lines 26-34); and transmitting the list of two languages from the storage device (HLR/VLR) to the message device (AU) for providing the message in one of the two languages (column 4, line 65, to column 5, line 3). In case a message is to be transmitted to the subscriber, the method comprises implicitly the steps of: screening, by the message device (AU), the two



languages of the list of two languages; selecting, by the message device (AU), in accordance with a preferred sequence of the subscriber, the first screened language available at the message device (AU) (column 4, lines 46-51); and transmitting, by the message device (AU), the message in the selected language to the subscriber via the communication device (MSA, MSB, ... MSn).

- 1.3 The method of claim 1 differs from the method known from D2 in that the input/retrieval devices are for inputting, changing or deleting the list of languages and in that the list of languages is received via the input/retrieval device.
  
- 1.4 The board notes that D2 does not disclose the origin of the subscriber data LA, L'A which represents the list of languages and which is stored in the storage device. In the context of the claimed method, the above mentioned distinguishing features thus solve the problem of providing the list of languages to the storage device.
  
- 1.5 Faced with this problem, the skilled person would have considered document D1, since this document relates to flexible language selection in a telecommunication system, wherein a language selection indicator for a particular system user is stored in a telecommunication system storage means (see the title and the abstract). More specifically, D1 discloses two alternative methods of inputting a preferred language, namely by using voice or DTMF commands using the subscriber's terminal or, alternatively, by filling out initial paperwork when setting up a new account (page 17, lines 3-17). The skilled person would thus realise, *inter alia*, that using the subscriber's terminal would solve the above-mentioned problem of providing the list of languages to

the storage device. Applying this teaching to the method disclosed in D2, the skilled person would thus arrive at a method in which the terminals, *i.e.* the input/retrieval devices, are for inputting the list of languages, thereby arriving at a method which includes all features of claim 1, without the exercise of inventive step.

1.6 The subject-matter of claim 1 of the main request does not therefore involve an inventive step (Articles 52(1) and 56 EPC).

1.7 As noted above, the main request was withdrawn at the oral proceedings. Two auxiliary requests were filed in an attempt to overcome the above inventive step objection.

2. *Admissibility of of the first auxiliary request (Article 13(1) RPBA)*

2.1 In accordance with Article 13(1) RPBA, "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". In line with the established case law of the boards of appeal, one of the criteria for admitting further amendments to a claim at a late stage of the appeal proceedings is whether or not the claim is *prima facie* allowable.

2.2 Claim 1 of the first auxiliary request (see point VI above), which was filed during the oral proceedings, is directed to a communication system. The system includes

a message device, communications devices, a storage device and an input/retrieval device, which correspond to the devices referred to in method claim 1 of the main request.

In claim 1 of the auxiliary request, the at least one subscriber input/retrieval device is further defined in that it includes an input means for entering sequences of digits or characters specifying a list of preferred languages, in that it is for storing a list in the at least one storage device, in that it is for retrieving and displaying the list from the at least one storage device, and in that it includes display means for displaying the list of at least two preferred languages. As set out at point 1.2 above, it is implicit in the method of D2 that the at least one subscriber input/retrieval device may include a keyboard and a display.

- 2.3 The appellant argued that the system according to claim 1 of the first auxiliary request essentially differed from the system used in the method of claim 1 of the main request in that the input/retrieval device was not only provided for storing the list of preferred languages but also for retrieving the list from the storage device and for displaying it. The board agrees.
- 2.4 The problem underlying the claimed subject-matter may thus be seen in establishing a possibility for the user to check, *e.g.* in order to modify, the stored list of preferred languages. This problem is a common problem in the art, since it is generally desirable to be able to modify entries at a later stage.
- 2.5 In a GSM system it is the service provider who has access to and manages subscriber or subscription

related entries in the home location register (HLR), which, in the method disclosed in D2, serves, *i.a.*, to store the list of languages. Various ways of contacting the service provider with the aim of checking or modifying subscriber or subscription related data were known at the priority date. A common way of checking subscriber or subscription related data was by contacting the service provider via SMS, who, in turn, would send a reply via SMS with the requested subscriber/subscription related data to the subscriber. This was not contested by the appellant. It would therefore have been obvious to the skilled person desirous to establish a possibility to at least check the subscriber related entries concerning the list of languages in the method of D2 to provide for a corresponding SMS communication between the subscriber, using the input/retrieval device of the subscriber's mobile telephone, and the service provider. Therefore, *prima facie*, the subject-matter of claim 1 of the first auxiliary request does not involve an inventive step (Article 52(1) and 56 EPC).

2.6 The appellant essentially argued that an SMS communication was not an instantaneous communication mode. This may be true. Claim 1 does not, however, require that the retrieving of the list be instantaneous. The board notes that the application is in fact silent on what technical means are to be employed in order to perform the retrieving.

2.7 For these reasons and in view of the reasons set out at point 1 in connection with the main request, the board concluded that claim 1 was *prima facie* not allowable. Using its discretion pursuant to Article 13(1) RPBA, the first auxiliary request was therefore not admitted to the appeal proceedings.

3. *Admissibility of the second auxiliary request (Article 13(1) RPBA)*

- 3.1 Claim 1 of the second auxiliary request includes the following additional feature "and wherein the at least one message device (BV1, BV2, BV3) includes retrieval means (AV1) for retrieving a list with at least two preferred languages from storage means (S, TS1, TS2), in case the list is not transmitted or not properly transmitted from a communication device (T1, T2, T3) to message device (BV1, BV2, BV3)".

This feature presupposes that the list of at least two languages may previously be transmitted from a communication device to the message device. However, the board cannot find support for a transmission of the list from a communication device to the message device in the description. The appellant referred to the paragraph bridging pages 9 and 10 of the application as published. However, from this paragraph, it merely follows that the list assigned to the subscriber is available to the message device. As described at page 9, lines 12-14, of the application as published, the list is transmitted from the subscriber to the storage device. Hence, it is only through the storage device that the list becomes available to the message device.

Further, it is unclear to what extent the feature "in case the list is not transmitted ..." implies constructional features of the claimed system, since the claim does not exclude that the retrieval means of the message device is also for retrieving the list from the storage device in case the list is transmitted from the communication device to the message device.

- 3.2 It follows that, *prima facie*, claim 1 of the second auxiliary request is not clear and not supported by the description and, hence, does not meet the requirements of Article 84 EPC. Using its discretion pursuant to Article 13(1) RPBA, the second auxiliary request was therefore not admitted to the appeal proceedings.
4. For the reasons set out above, the first and second auxiliary requests were not admitted. There being no admissible request on file, the appeal is thus to be dismissed.

**Order**

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

The appeal is dismissed

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated