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**Datasheet for the decision
of 11 October 2016**

Case Number: T 0361/14 - 3.5.05

Application Number: 08770907.7

Publication Number: 2171915

IPC: H04L12/14, H04M15/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for accounting in a mobile data packet network

Applicant:

QUALCOMM Incorporated

Headword:

Mobile accounting/QUALCOMM

Relevant legal provisions:

EPC Art. 83, 111(1)

Keyword:

Sufficiency of disclosure - (yes)

Remittal to the first instance for further prosecution - (yes)

Decisions cited:

G 0002/93



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Case Number: T 0361/14 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 11 October 2016

Appellant: QUALCOMM Incorporated
(Applicant) Attn: International IP Administration
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San Diego, CA 92121 (US)

Representative: Heselberger, Johannes
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 24 September
2013 refusing European patent application
No. 08770907.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chair A. Ritzka
Members: K. Bengi-Akyuerek
F. Blumer

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse the present European patent application on the sole ground of insufficiency of disclosure (Article 83 EPC) with respect to the claims of a main request and two auxiliary requests.

- II. With the statement setting out the grounds of appeal, the appellant filed new sets of claims according to a main request and five auxiliary requests. It requested that the decision of the examining division be set aside and that a patent be granted on the basis of the main or one of the auxiliary requests.

- III. In a communication under Rule 100(2) EPC, the board gave its preliminary opinion on the appeal. In particular, it indicated that it agreed with the appellant that the claims of the main request on file fulfilled the requirements of Article 83 EPC but that they gave rise to different, minor defects under Article 84 EPC. It also informed the appellant that the case could be remitted to the examining division if those defects were remedied.

- IV. With a letter of reply, the appellant submitted amended claims according to a new main request (replacing the main request on file) with the aim of overcoming the objections raised in the board's communication, and requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution on the basis of that new main request. It further requested that oral proceedings be held if the board did not decide according to the above requests.

V. **Claim 1** of the main request (sole claim request) reads as follows:

"A method for preparing a usage data record for data packet services to a wireless access terminal, comprising:
providing data packet communication services via an access gateway (212) from a core network (202) to a base station for the access terminal (206);
sending accounting rules (214) from the access gateway (212) to the base station when the base station becomes a data attachment point for the access terminal or during access authentication and authorization;
receiving air link records (216) from the base station at the access gateway (212) in accordance with the accounting rules (214) based upon usage data of the access terminal (206);
merging the air link records (216) at the access gateway (212) into a usage data record (218) formatted in accordance with an accounting protocol; and
transmitting the usage data record (218) from the access gateway (212) to an accounting component (220) of the core network (202)."

The further independent **claim 8** of the main request is directed to a corresponding apparatus.

Reasons for the Decision

1. MAIN REQUEST

This claim request was filed in response to the board's communication under Rule 100(2) EPC, and differs from the main request underlying the appealed decision essentially in that independent claims 1 and 8 no

longer comprise reference sign "204" in connection with the "base station" and in that dependent claims 4, 6, 7, 8 and 9 have been removed.

1.1 Article 83 EPC

1.1.1 The board first emphasises that, in the context of Article 83 EPC, it has to be generally established whether the person skilled in the relevant art is enabled by the application together with his common general knowledge to put the claimed invention into practice without undue burden over the whole range claimed (see e.g. G 2/93, OJ EPO 1995, 275, Reasons 4). In this respect, it is worth noting that a patent application is directed to a skilled person and that therefore the *technical context* of that application has to be taken into account when assessing whether there is an enabling disclosure in respect of the claimed invention.

1.1.2 The examining division held that the application contravened Article 83 EPC, since the skilled person at the application's priority date did not know how to implement the "enhanced base station" as mentioned in the present description (cf. appealed decision, Reasons 1.1), or the "base station", "access gateway", "air link records" and "user data record" as claimed with respect to the 3GPP-related telecommunication standards of CDMA2000, UMTS and GSM (cf. appealed decision, Reasons 1.2).

1.1.3 It is however apparent to the board that sub-components of a mobile network such as a "base station", "access gateway" and "enhanced base station eBS" (which is not even included in claim 1) or data items such as "air link records" and "user data record" represent *generic*

terms in relation to any mobile network based on the 3rd Generation Partnership Project (3GPP) standards. The board therefore holds that the skilled person in the field of mobile telecommunication networks would well be aware of the meanings and the functions typically associated with those units and data items. More specifically, from his 3GPP-related common general knowledge (and also from the present description as filed), the skilled person would indeed know that a "base station" or an "enhanced base station eBS" is supposed to signify a network unit which is located within a radio access network (RAN), and is responsible for handling wireless traffic and signaling between an access terminal (AT) and the RAN, while an "access gateway" is intended to embrace a network unit which is located between the RAN and the core or backbone network (e.g. via an accounting server), and is tasked with protocol conversions.

As to the data items claimed, "air link records" and "user data records" are simply to be taken and implemented - in their broadest meaning - as monitored and reported data on a wireless link between the AT and the RAN (created by the base station), and on the overall network usage of a user's access terminal (created by the access gateway) respectively.

1.1.4 As a consequence, the board concludes that the application discloses the "invention" as defined by claim 1 in a manner sufficiently clear and complete for it to be carried out by a skilled person within the meaning of Article 83 EPC.

1.2 In view of the above, the board judges that the objections raised by the examining division under Article 83 EPC are unfounded and that, consequently,

the sole ground for refusal, namely insufficiency of disclosure as regards claim 1, is no longer applicable.

2. *Remittal of the case for further prosecution*

2.1 In the appealed decision, the issues of novelty and inventive step were not decided upon, nor was any assessment of novelty and inventive step conducted in any form with respect to any prior-art document. Hence, the board holds that under the present circumstances it is not appropriate to take a final decision on the matters of novelty and inventive step for the very first time in these appeal proceedings.

2.2 For these reasons, and in order not to deprive the appellant of the possibility of examination of the claims on file by two instances, the board decides, in the exercise of its discretion under Article 111(1) EPC and in full accordance with the appellant's request (cf. point IV above), to remit the case to the examining division for further prosecution on the basis of the claims of the newly filed main request.

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 on the basis of claims 1 to 8 filed as the main request with the letter dated 16 September 2016.

The Registrar:

The Chair:



L. Malécot-Grob

A. Ritzka

Decision electronically authenticated