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**Datasheet for the decision
of 14 July 2020**

Case Number: T 0578/16 - 3.5.03

Application Number: 07816566.9

Publication Number: 2081347

IPC: H04L29/06

Language of the proceedings: EN

Title of invention:

A method and system for negotiating the session description protocol version

Patent Proprietor:

Huawei Technologies Co., Ltd.

Opponents:

James Poole Limited
Telefonaktiebolaget LM Ericsson (publ) (until 7 July 2016)

Headword:

Negotiating SDP versions/HUAWEI

Relevant legal provisions:

EPC Art. 14(2), 19(2), 100(c), 123(2), 111(1)
EPC R. 103(1)(a)
RPBA 2020 Art. 11

Keyword:

Added subject-matter - main request (no)
Remittal to the first instance for further prosecution -
(yes): "special reasons"
Reimbursement of appeal fee - (no): change in composition of
opposition division per se not a procedural violation

Decisions cited:

T 0700/05, T 1652/08, T 1483/10



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Case Number: T 0578/16 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 14 July 2020

Appellant: Huawei Technologies Co., Ltd.
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Respondent 1: James Poole Limited
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Respondent 2: Telefonaktiebolaget LM Ericsson (publ)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 4 January 2016 revoking European patent No. 2081347 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chair	K. Bengi-Akyürek
Members:	K. Schenkel
	J. Geschwind

Summary of Facts and Submissions

I. The appeal was lodged against the decision of the Opposition Division to revoke the opposition filed against the present European patent on the sole ground that claim 1 of a main request (patent as granted) and of first to fourth auxiliary requests contained added subject-matter (Article 100(c) EPC in conjunction with Article 123(2) EPC).

Moreover, the Opposition Division did not admit into the opposition proceedings the claims of the fifth and sixth auxiliary requests on the grounds that they were late-filed and were not clearly allowable under Articles 123(2) and/or 84 EPC.

II. In the statement of grounds of appeal, the appellant maintained their claim sets according to the main request and first to sixth auxiliary requests and additionally requested that the appeal fee be reimbursed on the grounds that the Opposition Division committed a substantial procedural violation.

III. Opponent 1 (respondent 1) did not file any response to the statement of the grounds of appeal in substance.

IV. Opponent 2 (respondent 2) withdrew their opposition with letter of 7 July 2016.

V. In a communication under Article 15(1) RPBA, the board indicated that the sole ground for the revocation of the patent appeared to be overcome and that therefore the board was minded to exercise its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of the

main request.

VI. In response to the board's communication, the appellant withdrew the request for oral proceedings on the condition that the board decided as indicated in its preliminary opinion, whilst respondent 1 indicated that they will not attend the scheduled oral proceedings before the board.

VII. Oral proceedings were then cancelled.

VIII. The appellant requests that the decision under appeal be set aside and that the opposition be rejected (main request), or, in the alternative, that the patent be maintained in amended form on the basis of one of the first to sixth auxiliary requests on file. Further, reimbursement of the appeal fee was requested.

IX. Claim 1 of the patent as granted (**main request**) reads as follows:

"A method for negotiating a session description protocol, SDP, version, characterized in comprising:
 requesting a Media Gateway, MG, by a Media Gateway Controller, MGC, for information of an SDP version supported by the MG;
 returning, by the MG, information of a locally supported SDP version to the MGC in response to the request;
 selecting, by the MGC, an SDP version to be used, the SDP version being supported by both the MGC and the MG; and
 informing the MG, by the MGC, of corresponding information of the SDP version to be used."

The further independent claim 6 of the main request is directed to a corresponding "system".

Reasons for the Decision

1. *Background of the patent*

The patent relates to the negotiation of a version of the session description protocol (SDP) used in the communication between two network entities, those entities being further characterised as a media gateway (MG) and a media gateway controller (MGC) respectively.

2. *Patent as granted (main request) - Article 100(c) EPC*

2.1 Claim 1 as granted includes the following limiting features (as labelled by the board):

A method for negotiating an SDP version comprising:

- (a) requesting an MG, by an MGC, for information of an SDP version supported by the MG;
- (b) returning, by the MG, information of a locally supported SDP version to the MGC in response to the request;
- (c) selecting, by the MGC, an SDP version to be used, the SDP version being supported by both the MGC and the MG;
- (d) informing the MG, by the MGC, of corresponding information of the SDP version to be used.

2.2 The application underlying the opposed patent had been originally filed as International patent application in the Chinese language. An English translation had been filed when entering the European phase. The board notes

that it is permissible under Article 14(2) EPC to bring the translation into conformity with the original application throughout the whole proceedings before the EPO including the appeal proceedings.

2.3 In the present case, as regards feature (c), it is therefore permissible to replace "local terminal" by "first network entity" (i.e. the "MGC" in claim 1) if clear evidence is provided that this is the correct translation of the original Chinese term used for the relevant component in the present application (see also T 700/05, Reasons, point 4; T 1483/10, Reasons, point 2).

2.4 The appellant filed a certified translation of the underlying description with the statement of grounds of appeal. In this corrected translation, "local terminal" has been replaced with "first network entity" (see, for example, paragraphs [0010], [0022] and [0036]). For this amendment, the explanation has been given that the corresponding Chinese wording is a pronoun. This explanation is in line with the fact that, in the concerned sentences, a "first network entity" is indeed mentioned before the word "local terminal" (*ibid.*).

2.5 The board further notes that in the description according to both the *originally filed* translation and the *corrected* translation, at the beginning of the summary (paragraph [0007]), two communication parties are mentioned. Also in the following parts of the description two communication parties are mentioned (paragraphs [0036] and [0084]). It is therefore unlikely that the term "local terminal" was meant to refer to a *third* communication party.

The board is therefore satisfied that the appellant provided the necessary evidence that the correct translation of the term in question is "first network entity" (i.e. the MGC unit) and that claim 1 as granted does not contain added subject-matter. Hence, claim 1 of the main request complies with Articles 100(c) and 123(2) EPC.

2.6 The Opposition Division argued in point 14.2.4 of the decision under appeal that paragraph [0047] referred to three network entities. However, this argument became moot for the corrected translation.

3. *Remittal to the Opposition Division (Article 111(1) EPC)*

3.1 In view of the above, the sole ground for the revocation of the opposed patent is considered to be unfounded. Consequently, the decision under appeal is to be set aside.

3.2 Given that the compliance of the patent with the requirements of novelty and inventive step was neither discussed nor decided in the appealed decision, a ruling on those issues by the board for the very first time in these appeal proceedings could not be given without an undue burden and would run contrary to the very purpose of a judicial review within the meaning of Article 12(2) RPBA 2020. The board thus considers that the above observations represent "special reasons" within the meaning of Article 11 RPBA 2020 for remittal of the case.

3.3 Accordingly, the board remits the case to the Opposition Division for further prosecution on the basis of the main request (Article 111(1) EPC).

4. *Reimbursement of the appeal fee (Rule 103(1)(a) EPC)*

4.1 The appellant requested the reimbursement of the appeal fee on the grounds that the composition of the Opposition Division had changed after a communication setting out their preliminary opinion had been issued and that this was contrary to Article 19(2) EPC and thus violated the appellant's right to be heard.

4.2 The board takes from the file that the change in the composition of the Opposition Division, however, occurred *before* the oral proceedings before the division. The composition of the Opposition Division did not change *after* those oral proceedings *until* the decision was issued. The change at this early stage, i.e. before holding oral proceedings before the Opposition Division, does not *per se* constitute a procedural violation which could justify the reimbursement of the appeal fee (see e.g. T 1652/08, Reasons, point 2).

4.3 Therefore, the request for reimbursement of the appeal fee is to be refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated