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**D E C I S I O N**  
**of 31 January 1997**

**Case Number:** T 0793/94 - 3.5.1

**Application Number:** 83902386.8

**Publication Number:** 0115499

**IPC:** H04B 1/00

**Language of the proceedings:** EN

**Title of invention:**

Selective call paging and priority signalling system

**Patentee:**

MOTOROLA, INC.

**Opponent:**

Alcatel N.V.  
Nokia Cellular Systems Oy

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 108, 123(2)

**Keyword:**

"Appeal - grounds - substantiation (yes)"  
"Amendments - added subject-matter (yes)"

**Decisions cited:**

-

**Catchword:**

-



Case Number: T 0793/94 - 3.5.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.1  
of 31 January 1997

**Appellant:**  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 14 July 1994  
revoking European patent No. 0 115 499 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. K. J. van den Berg  
**Members:** R. R. K. Zimmermann  
G. Davies

## Summary of Facts and Submissions

- I. The appeal was filed against a decision of an Opposition Division revoking the European Patent No. 0 115 499 based on the international application No. PCT/US83/00972 (European patent application No. 83 902 386.8) filed on 24 June 1983 and published as International Publication No. WO 84/00650.

The patent was granted with seven claims filed on 2 November 1989 and seeking protection for a method of emergency calling in a communications system for voice communication between a primary station and a plurality of remote stations. The method is characterized by commanding remote stations in response to receiving an emergency signal and in accordance with the emergency. The description of a preferred embodiment was left unamended.

- II. Against this patent, several oppositions were filed, invoking Article 100(c) EPC in combination with Article 123(2) EPC as a ground for opposition; only two opponents, 01 and 03, pursued their oppositions and were respondents in the present appeal procedure.

In the course of oral proceedings before the Opposition Division, the appellant finally maintained a main and subsidiary request for maintenance of the patent on the basis of amended claims. In claim 1 of both requests, the commanding of remote stations was defined as being automatic.

- III. The Opposition Division considered both requests as not allowable, the main request because of added subject-matter under Article 123(2) EPC in claim 1, (no basis for added features "signal arranged to", "at least one", "functionalization" in the patent application as

filed) and claim 5 (no disclosure of the repeater function in the application as filed), the auxiliary request because of lack of inventive step, and thus revoked the patent. Notification of the decision was effected by registered letter dated 14 July 1994. The reasons for the decision enclosed with this letter also summarised the arguments submitted by the appellant during the oral proceedings.

In its decision, the Opposition Division took the view that the feature of the automatic commanding of remote stations, which was comprised in claim 1 of both the main and the auxiliary request, was at least implicitly derivable from the application as filed. According to the description, a first type of acknowledge signal provided a simple handshaking of the remote station sending the emergency signal and was transmitted automatically in response to the emergency signal, whereas a second type of acknowledge signal was an emergency monitor data packet used to disable all the other remote stations. Although the automatic transmission of the second type of acknowledge signal was not explicitly disclosed, there was no reason apparent why only the first type of acknowledge signal should be sent automatically. The manual activation of an emergency monitor sequence as described in the application as filed was merely an optional feature.

- IV. The appellant filed a notice of appeal on 26 September 1994 requesting that the decision revoking the patent should be cancelled in its entirety and the patent be reinstated and paid the appeal fee the same day.

The appellant filed a further letter on 24 November 1994 stating that it represented its "Statement of Grounds". The letter set out reasons why the invention was novel and inventive and contained two requests, a main request to reinstate the patent with the "issued"

claims replaced by the claims as filed on 7 May 1994 and a subsidiary request to maintain the patent on the basis of an enclosed set of claims. The claims of both requests still include definitions which caused the Opposition Division to refuse the main request under Article 123(2) EPC.

The "Statement of Grounds" did not explicitly indicate the reasons why the Opposition Division was considered to be wrong in refusing the main request, but referred in general terms to arguments submitted during the oral proceedings and cited the Opposition Division as having expressed the opinion that exact correspondence between the wording of the application as filed and the amended claims would be necessary to satisfy Article 123(2) EPC. This opinion was contested. However such an opinion of the Opposition Division was neither reflected in the minutes of the oral proceedings nor in the reasons for its decision.

V. Both respondents, 01 and 03, requested dismissal of the appeal. All parties to the appeal procedure subsidiarily requested oral proceedings. Respondent 01 submitted that the statement setting out the grounds for appeal did not properly consider the reasons for revocation under Articles 100(c) and 123(2) EPC and thus did not fulfil the requirements of Article 108, third sentence EPC, for admissibility of the appeal.

In a first communication, the Board of Appeal indicated that the appeal might be considered admissible. In response to this communication, respondent 01 repeated its reservations regarding admissibility of the appeal. In a further communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, the Board called the admissibility of the appeal into question for the first time.

In a letter dated 24 January 1997, the appellant cited published decisions J 22/86 (OJ 87, 28), T 220/83 (OJ 86, 249), and unpublished decisions T 140/88 and T 355/86 and argued that the "Statement of Grounds" complied at least with the minimum standard set in those decisions.

VI. In the oral proceedings which were held on 30 January 1997, continued on 31 January 1997, and attended by the appellant and respondent 01, the appellant pointed out that the "Statement of Grounds" referred, although in general terms, to arguments submitted by the appellant during the oral proceedings before the Opposition Division. Decision J 22/86, headnote and point 2 of the reasons, determined that the question whether a particular statement met the minimum requirement of Article 108 EPC could only be decided in the context of the particular case, which would normally include the grounds for the decision under appeal. The further case law cited showed that the Boards of Appeal would consider the reference to documents submitted in proceedings before the first instance sufficient to fulfil the requirements of Article 108, third sentence EPC.

Respondent 01 disagreed and argued that the decision J 22/86 had been issued in exceptional circumstances and could therefore not be relied on. It should thus not be considered a precedent in other cases. The same applied to decisions T 140/88 and T 355/86. A vague and unspecified reference to arguments submitted before the first instance was certainly insufficient.

After deliberation, the Board decided that the appeal was admissible and continued the oral proceedings.

VII. In the further course of the oral proceedings, the appellant withdrew its former requests and submitted a single request for consideration. The only independent claim 1 of this request reads as follows:

"1. In a communication system for voice communications over a communications medium, having a primary station (52) and a plurality of remote stations (60,62,64), each remote station having a predetermined station address stored in a station address register (52), a method of emergency calling comprising the steps of:

- (a) at a remote station (60,62,64):
  - (i) transmitting an emergency command signal containing a predetermined emergency digital control code (Fig. 2; bits 24-28) in an operation code field of the emergency command signal and the predetermined station address;

characterised by

- (b) at the primary station (52):
  - (i) receiving said transmitted emergency command signal and transmitting an acknowledge command signal, in response thereto, having a predetermined digital control code in an operation code field of the acknowledge command signal and the predetermined station address contained in the received emergency command signal;
  - (ii) automatically commanding the other remote stations (60,62,64) with a digital command signal having a control code in an operation code field of the digital command to provide a clear-channel for the remote station transmitting the emergency command signal in response to receiving the transmitted emergency command signal."

VIII. The appellant pointed out that the automatic commanding of remote stations provided a major improvement over the prior art. For this reason alone the invention was already novel and involved an inventive step. The term

"automatic" meant that at the primary station the whole commanding process from receiving an emergency command signal until transmitting the digital command signal should be performed fully automatically without any operator intervention.

Respondent O1 accepted this interpretation, but argued that such a wholly automatic commanding of remote stations was not disclosed in the application as filed. In particular, the description, column 7, lines 60 ff. of the patent specification indicated that a decision had to be taken by the base operator on transmitting the digital command signal; besides, an adequate response to an emergency situation always required the intervention of a qualified person.

The Board of Appeal drew attention to Figure 7, 8A, 9A and 9B illustrating the flow diagram of a keyboard handler routine and, in particular, to the steps 234 and 426 effecting the transmission of an emergency monitor packet for commanding remote stations.

The appellant replied that commanding the transmission of an emergency monitor packet via keyboard was an optional feature. Column 5, lines 38 ff., column 10, lines 19 to 23, and 29 to 31, and column 19, lines 8 ff. and 30 to 35 of the description disclosed the fully automatic commanding of remote stations in response to receiving an emergency command signal.

## Reasons for the Decision

### 1. *Admissibility*

The question was raised whether the appeal complied with the provision of Article 108, third sentence EPC, which stipulates that within four months after the date of notification of the decision a written statement setting out the grounds of appeal must be filed. According to the established case law of the boards of appeal, the grounds of appeal are required to set out the substance of the appellant's case and to include sufficient legal and factual reasons to enable the board to decide.

In the present appeal, the reasons given in the decision of the Opposition Division are still relevant to the decision to be taken by the Board, since features judged upon by the Opposition Division to be added subject-matter are still present in the claims of both requests filed on 24 November 1994 with the same "Statement of Grounds". Instead of explicitly setting out the reasons why the decision is considered to be wrong in refusing the main request under Article 123(2) EPC, the "Statement of Grounds" refers in general terms to arguments on this point submitted in more detail in the oral proceedings before the first instance.

The Opposition Division did in fact summarize those arguments in the reasons given in its decision, as has been pointed out by the appellant.

Thus the reference to the decision under appeal may, under the present circumstances, be considered to be acceptable as a substitute for an explicit statement of the grounds of appeal in relation to Article 123(2) EPC, because the statement of grounds and the reasons

for the decision under appeal, if read together, make the grounds on which the appellant relies understandable and sufficient. In addition, the facts of the present case neither impose particular technical or legal difficulties nor require further investigation on the part of the Board of Appeal.

Moreover, the statement of grounds contained adequate argumentation in defence of inventive step.

Therefore, the statement of grounds as filed by the appellant is considered to meet the requirements of Article 108 and the appeal is admissible.

2. *Meaning of claim 1*

Claim 1 of the present request defines an automatic commanding of remote stations with a digital command signal to provide a clear-channel for the remote station transmitting an emergency command signal.

There is no dispute between the parties about the meaning of the term "automatic" in this feature: the whole commanding process at the primary station from the time of receiving the emergency command signal until transmitting the digital command signal to remote stations is fully automatic and does thus not require any operator intervention. The Board sees no reason to consider a different construction of the claim.

3. *Disclosure*

3.1 The international application as filed, published in the International Publication No. WO 84/00650, discloses a radio communication system providing an audio channel for data and voice communication between a primary station and a plurality of remote stations. The control processors at the primary and remote

stations are configurable by means of code plugs which must be programmed prior to use, allowing for the installation of different calling options, for example, selective calling, paging, and priority alert or emergency calling.

By means of the preprogrammed code plug, a so-called emergency monitor feature can be selected in the priority alert or emergency calling mode. As explained in the international publication on page 12, lines 17 to 23, page 17, line 33 to page 18, line 11 and page 31, lines 7 to 24, this emergency monitor feature allows the base operator to listen via the audio channel into the remote station sending the emergency call. To this end, a digital command signal, the emergency monitor data packet, is sent to the remote stations, commanding the calling remote station to enable and the other remote stations to disable their audio transmitters.

Emergency monitoring is the only option disclosed by the international publication for providing a clear-channel in the emergency calling mode. The only alternative disclosed is a "normal" acknowledgement with a first type of acknowledge signal "which simply handshakes" the emergency calling station (see for example column 7, lines 60 ff. of the description). This normal acknowledgement does not clear the audio channel and does thus not allow the operator to voice monitor the emergency calling station.

Therefore, only the emergency monitoring option using emergency monitoring packets as digital command signal complies with the definition of present claim 1.

For this option, however, there is no explicit disclosure in the application as filed that the commanding is fully automatic, i.e. does not need any intervention on the part of an operator.

On the contrary, the international publication, page 17, lines 34 ff. states the following: "when a priority alert packet is received the base unit will go immediately in the priority mode and acknowledge the mobile unit and terminate any retransmission sequence. The base operator may then activate an emergency monitor sequence ...". This is an indication that the operator, although not necessarily in direct control of the acknowledgement, decides on the activation of an emergency monitor sequence and, therefore, on the transmission of an emergency monitor packet for clearing the audio channel and voice monitoring the emergency calling station.

Transmission of an emergency monitor packet is effected by the keyboard handler routine as shown in box 426 of Figure 9B of the international publication. Since the only entry point to this routine is the keyboard interrupt (see box 370 in Figure 9A and box 234 in Figure 7), the emergency monitor packet is only transmitted if two keys of the keyboard, as shown in box 420 of Figure 9B, are activated. However, such a mode may at most be considered as being semiautomatic, but certainly not as fully automatic in accordance with claim 1.

Consequently an automatic commanding of remote stations as defined in claim 1 is not directly and unambiguously derivable from the application as filed.

Therefore, this feature seems to constitute added subject-matter within the meaning of Article 123(2) EPC.

3.2 Moreover, this feature of automatic commanding remote stations is technically meaningful and obviously relevant for assessing the patentability of the invention. The appellant itself referred to the automatic commanding for distinguishing the invention from the prior art. Thus this feature provides a technical contribution and can, pursuant to the decision G 1/93 not be allowed under Article 123(2) EPC.

3.3 The arguments submitted by the appellant have not convinced the Board that the application as filed can be interpreted differently.

The argument that commanding remote stations by using the keyboard is only an option which might be used in addition to the automatic mode, was not substantiated by the appellant and the Board does not find any support for this argument in the application as filed.

The further argument that the description, column 7, line 55 to column 8, line 6 and column 19, line 33 to line 63 of the patent specification discloses the fully automatic commanding of remote stations is not accepted either, as those text portions may relate to a fully automatic as well as to a semiautomatic commanding of remote stations. Therefore, the automatic mode cannot be said to be unambiguously disclosed by those parts of the application as filed.

In addition, the appellant, and the opposition division, referred to the normal acknowledgement which is indeed disclosed as an automatic mode. However, this does not imply that the emergency monitoring mode is automatic too. In fact, monitoring as disclosed requires automatic muting of all remote stations other than the emergency calling station to provide the clear channel. Cutting off the connection between the primary

station and all those other remote stations might have serious consequences and is prone to a misuse of the system. The emergency monitoring mode should thus remain under control of an operator if no particular security measures are taken. The normal type of acknowledgement, on the other hand, does not clear the audio channel and does thus not cause any such problems.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg