DECISION
of 11 January 2001

Case Number: W 0015/00 - 3.5.1
Application Number: PCT/EP 98/08512
Publication Number: WO 00/41431
IPC: H04Q 11/04, H04L 12/56

Language of the proceedings: EN

Title of invention:
Packet Transmission method and apparatus

Applicant:
Nokia Networks OY et al

Opponent:

Headword:

Relevant legal provisions:
PCT Art. 17(3)(a)
PCT R. 13.2, 40.2
EPC Art. 106, 116, 154(3)

Keyword:
"Assessment of unity a posteriori"
"Oral proceedings (no)"
"Time limit for substantiation of protest"

Decisions cited:
W 0004/93, W 0011/93, G 0001/89, G 0002/89

Catchword:

EPA Form 3030 10.93
DECISION
of the Technical Board of Appeal 3.5.1
of 11 January 2001

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Subject of the Decision:
Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicant against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 6 October 1999.

Composition of the Board:
Chairman: P. K. J. van den Berg
Members: A. S. Clelland
          C. Holtz
Summary of Facts and Submissions

I. International patent application No. PCT/EP 98/08512 was searched by the European Patent Office, acting in its capacity as an International Search Authority (ISA).

II. On 6 October 1999 the ISA invited the applicant to pay an additional search fee on the ground that a partial international search had revealed that the subject-matter of each of claims 1, 17 and 29 was known from prior art document EP-A-851 706. It was held that the remaining claims fell into two groups with different special technical features solving different problems, so that these claims were not so linked as to form a single general inventive concept. The groups of claims were held to relate to the following inventions:

(i) Claims 1 to 4, 7, 11, 17 to 21, 24, 25, 29 to 31
Packet transmission method and apparatus using bit error detection

(ii) Claims 5 (as dep. on 1), 6, 12 (as dep. on 10), 13 to 14 (both as dep. on 1), 15, 16, 22 (as dep. on 17), 23, 26 to 27 (both as dep. on 17), 28
Packet transmission method and apparatus using signal strength in a mobile radio network.

III. The applicant paid the additional fee under protest and in a reasoned statement dated 4 November 1999 argued that the ISA was incorrect in its analysis of the cited document. The document was concerned with tagging an ATM cell based on a priority level determined at the transmission end, whereas feature (a) of claim 1 required that the quality of a received data packet be judged. Furthermore, the cited document was concerned with the problem of congestion caused by system users...
transmitting in excess of their agreed data rate, whereas the application was concerned with the reduction of traffic when the same data stream was transmitted over a plurality of macro diversity combining (MDC) branches. Since the independent claims were novel and inventive there was no basis for the a posteriori allegation of lack of unity by the ISA.

IV. The protest was reviewed in accordance with Rule 40.2(e) PCT by a review panel of the European Patent Office, which on 28 February 2000 held that the invitation to pay an additional search fee was justified and invited the applicant to pay a protest fee in order that the protest be examined by a "special instance" of the ISA or competent higher authority in accordance with Rule 40.2(c) PCT.

V. The applicant duly paid the protest fee on 28 March 2000 and submitted further arguments. It was stated that in document EP-A-851 706 the quality of the received traffic as a whole was judged, whereas claim 1 was concerned with the quality of a received individual data packet. The subject-matter of claim 1 was accordingly considered to be novel and involve an inventive step. Additionally, it was argued that the alleged two inventions were linked so as to form a single general inventive concept as required by Rule 13.1 PCT. The technical contribution achieved by the alleged two inventions over the prior art was that of judging the quality not on the basis of traffic parameters but on the basis of each single received data packet.

VI. The appellant made an auxiliary request for oral proceedings in the event that the protest was not considered to be entirely justified.
VII. Claim 1 reads as follows:

"1. A packet transmission method for transmitting data packets via a telecommunication network, comprising the steps of:

(a) judging the quality of a received data packet;

(b) tagging said data packet by adding a dropping information in response to the result of said judging step; and

(c) dropping said tagged data packet based on said added dropping information, when a predetermined dropping condition is met."

Claim 17 reads as follows:

"17. A transmission apparatus for transmitting data packets via a telecommunication network, comprising:

(a) judging means (12, 23) for judging the quality of a received data packet; and

(b) tagging means (13, 22) for adding a dropping information to said data packet in response to a judging result of said judging means (12, 23)."

Claim 29 reads as follows:

"29. A network element for a telecommunication network, comprising dropping means for detecting a dropping information included in a received data packet, and for dropping said data packet based on said detected dropping information, when the predetermined dropping condition is met."
Reasons for the Decision

1. In its invitation to pay additional fees the international searching authority (ISA) argued that prior art document EP-A-851 706 completely disclosed the subject-matter of independent claims 1, 17 and 29. Two inventions were identified in the remaining claims, the one using bit error detection and the other using signal strength in a mobile radio network.

2. It is thus apparent that the ISA's objection is a posteriori. In its decisions G 1/89 and G 2/89 (OJ EPO 1990, 152) the Enlarged Board held that such an objection was permissible but that the charging of additional fees under Article 17(3)(a) PCT should be made only in clear cases.

3. The Board has accordingly considered whether in the present case the ISA's finding meets the Enlarged Board's criteria and whether the reasoning is sufficient to substantiate a finding of lack of unity. It has concluded that the invitation is sufficiently reasoned.

4. Rule 40.2(c) PCT states that an applicant may pay an additional search fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. In the present case the protest as filed is accompanied by a statement which discusses at pages 1 and 2 the cited document and at page 3 a further document mentioned in the international search report.

5. However, the statement gives no convincing arguments as to why the ISA's reasoning was wrong. The discussion of EP-A-851 706 in the paragraph bridging pages 1 and 2 of
the statement quotes column 8, lines 42 to 51 of the
document as disclosing a logic circuit 84 which decides
whether a specific packet should be marked as being
transmitted at an excessive transmission rate. The
actual passage in EP-A-851 706 is however concerned
with resources reservation and makes no mention of
tagging. Similarly, the first full paragraph on page 2
of the statement refers to "column 12, lines 26 to 29",
and "column 12, last paragraph", passages which are not
relevant to the argument being advanced. The final
paragraph on page 2 of the statement discusses the
object of the invention and its solution. This
discussion is only relevant to the second invention
identified by the ISA, namely packet transmission
method and apparatus using signal strength in a mobile
radio network, and the arguments in the paragraph do
not deal with the objection raised by the ISA.

6. In conclusion, the Board finds no argument in the
statement which casts doubt on the international search
authority's finding of lack of unity.

7. The Board has considered whether the subsequent
submission of 28 March 2000, according to which in
EP-A-851 706 received packets are tagged on the basis
of quality of service criteria, should be taken into
account in reaching its conclusion. According to
Rule 40.3 PCT a time limit is set by the ISA for the
payment of additional search fees; in the present case
the ISA set a limit of 30 days for payment. Since in
accordance with Rule 40.2(c) PCT the reasoned statement
must accompany the payment it follows that it must also
be received within 30 days. No provision is made for
substantiation of the protest at a later date. Thus,
any later statement does not form part of the protest
and cannot be taken into account. This is consistent
with the established case-law of the boards of appeal
which also denies to the ISA the right to amplify
inadequate or incomplete reasoning, see for example W 4/93 (OJ EPO 1994, 939) concerning the analogous position of an International Preliminary Examining Authority (IPEA) and W 11/93 (not published).

8. The Board accordingly concludes that the protest as filed on 4 November 1999 is not justified.

9. The appellant has in the submission of 28 March 2000 requested oral proceedings if the protest is not considered to be entirely justified. As noted in W 4/93, discussed at point 7 above, the PCT makes no provision for oral proceedings. The Boards of Appeal act to decide on a protest in accordance with the special provision of Article 154(3) EPC and not by virtue of Article 106 EPC; Article 116 EPC does not therefore apply, so that there is no provision either under the PCT or EPC which would permit oral proceedings to be held.

Order

For these reasons it is decided that:

The protest under Rule 40.2(c) PCT is dismissed.

The Registrar: 

M. Kiehl

The Chairman: 

P. K. J. van den Berg