BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [ ] To Chairmen
(D) [X] No distribution

D E C I S I O N
of 17 February 2006

Case Number: T 1105/03 - 3.5.03

Application Number: 99304456.9

Publication Number: 0966144

IPC: H04M 3/42

Language of the proceedings: EN

Title of invention:
Apparatus method and system for providing information to a called party in multiple leg telecommunication sessions

Applicant:
LUCENT TECHNOLOGIES INC.

Opponent:
-

Headword:
Flexible alerting/LUCENT

Relevant legal provisions:
EPC Art. 116(1), 113(1), 123(2), 84, 114(1), 54(2), 56
EPC R. 68(1)
RPBA Art. 11(3)

Keyword:
"Novelty - main request and first auxiliary request (no)"
"Inventive step - second, third, fourth, fifth and sixth auxiliary requests (no)"

Decisions cited:
T 1059/04, G 0010/93

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1105/03 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 17 February 2006

Appellant: LUCENT TECHNOLOGIES INC.
600 Mountain Avenue
Murray Hill
New Jersey 07974-0636 (US)

Representative: Sarup, David Alexander
Lucent Technologies NS UK Limited
5 Mornington Road
Woodford Green
Essex IG8 0TU (GB)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 17 June 2003 refusing European application No. 99304456.9 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: A. S. Clelland
Members: A. Ritzka
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dated 17 June 2003, refusing European patent application No. 99 304 456.9 for the reason that the subject-matter of claim 1 of a main and a first auxiliary request did not involve an inventive step having regard to the disclosure of:

D1: WO 98 19490 A

and that the subject-matter of claim 1 of a second and a third auxiliary request did not involve an inventive step having regard to the disclosure of D1 combined with the disclosure of one of the following documents:

D2: EP 0 771 126 A,

D3: Patent Abstracts of Japan vol. 011, no. 212 (E-522), 9 July 1987 & JP 62 034448 A.

Notice of appeal was filed on 28 July 2003 and the appeal fee paid. With the statement of grounds of appeal filed on 25 September 2003 the appellant submitted claim 1 according to each of a main request and six auxiliary requests and dependent claims 2 to 13 which were the same for all requests and corresponded to claims 2 to 13 as considered in the appealed decision. The appellant requested that the appealed decision be cancelled in its entirety and that a patent be granted on the basis of one of these requests.

II. The board issued an invitation to oral proceedings accompanied by a communication. In the communication it expressed the preliminary view that claim 1 and claim 7 according to all the requests did not appear to comply with the provisions of Article 84 EPC, in that the feature "step (c) comprises, concurrently with the routing of each outgoing call leg and in addition to providing an alert for each outgoing call leg, providing first called party information in all outgoing call legs" did not appear to be supported by the description as originally filed. Insofar as it could be understood the subject-matter of claim 1 according to the main, first and sixth requests did not appear to be novel and the subject-matter of claim 1 according to the second, third, fourth and fifth auxiliary requests did not appear to involve an inventive step.

III. With a letter dated 17 January 2006, in response to the communication, the appellant filed sets of claims of a new main and six auxiliary requests to replace the existing requests.

IV. Claim 1 according to the main request reads as follows:

"A method of providing information to a called party in multiple leg telecommunication sessions, the method comprising:

(a) receiving an incoming call leg designating a primary directory number (505);

(b) determining a plurality of secondary directory numbers associated with the primary directory number (510);

(c) processing and routing an outgoing call leg associated with each secondary directory number, of the plurality of secondary directory numbers to form a plurality of outgoing call legs (515);

CHARACTERIZED IN THAT:

step (c) comprises, concurrently with the routing of each outgoing call leg and separate from providing an alert for each outgoing call leg, providing first called party information in all outgoing call legs (515),

wherein the first called party information distinguishes each outgoing call leg as a multiple leg telecommunication session (515)."

Claim 1 according to the first auxiliary request differs from claim 1 according to the main request in that the wording "separate from" is replaced by "in addition to" and the following feature is added:

"and that said method includes:

(d) maintaining the first called party information on a selected outgoing call leg, of the plurality of outgoing call legs, the selected outgoing call leg having been first to be answered, for a period of time at least as long as a connection time lag period (530)."

Claim 1 according to the second auxiliary request adds to claim 1 according to the first auxiliary request "continuously" at the beginning of step (d).

Claim 1 according to the third auxiliary request differs from claim 1 according to the main request in that the wording "separate from" is replaced by "in

addition to" and that the second called party information is specified as call directing information and is provided in all outgoing legs by a switch.

Claim 1 according to the fourth auxiliary request reads as follows:

"A method of providing information to a called party in multiple leg telecommunication sessions, the method comprising:

(a) receiving an incoming call leg designating a primary directory number(505);

(b) determining a plurality of secondary directory numbers associated with the primary directory number (510);

(c) processing and routing an outgoing call leg associated with each secondary directory number, of the plurality of secondary directory numbers to form a plurality of outgoing call legs (515);

CHARACTERIZED IN THAT:

step (c) comprises, concurrently with the routing of each outgoing call leg and in addition to providing an alert for each outgoing call leg, providing first and second called party information in all outgoing call legs (515);

wherein the first called party information provided in all outgoing call legs by a switch is call directing information and the second called party information is a waiting signal;

and in that said method includes:

(d) maintaining the second called party information on a selected outgoing call leg, of the plurality of outgoing call legs, for a period of time

at least as long as a connection time lag period (530)."

Claim 1 according to the fifth auxiliary request adds to claim 1 according to the fourth auxiliary request "continuously" at the beginning of step (d).

Claim 1 according to the sixth auxiliary request adds to claim 1 according to the main request in step (c) the feature of "differentially processing and routing the outgoing call legs".

V. The appellant announced that it would not attend the oral proceedings set for 17 February 2006 and requested that the oral proceedings be cancelled and the procedure continued in writing. The board informed the appellant that the oral proceedings would take place as scheduled on 17 February 2006.

VI. Oral proceedings took place as scheduled on 17 February 2006. Neither the appellant nor its representative attended the hearing. After deliberation on the basis of the submissions and requests of 17 January 2006 the chairman announced the board's decision.

Reasons for the Decision

1. *Oral proceedings*

As pointed out by this board in a different composition in decision T 1059/04, the function of a board of appeal is to reach a decision on the issues presented

to it, not to act as an alternative examining division (cf. G 10/93, OJ 1995 172, in particular point 4).

According to Article 116(1) EPC, oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at request of any party to the proceedings. Rule 68(1) EPC provides that where oral proceedings are held before the European Patent Office, the decision may be given orally. Oral proceedings are considered as an effective way to discuss cases mature for decision, because the appellant is given the opportunity to present its concluding comments on the outstanding issues (Article 113(1) EPC). A decision can be made at the end of oral proceedings based on the requests discussed during oral proceedings. In accordance with Article 11(3) of the Rules of Procedure of the Boards of Appeal the board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case.

The need for procedural economy dictates that the board should reach its decision as quickly as possible while giving the appellant a fair chance to argue its case. In the present appeal the holding of oral proceedings was considered by the board to meet both of these requirements. The appellant gave no reasons to support the request to cancel the oral proceedings scheduled by the board and to continue the procedure in writing. The board considered that, despite the appellant's announced intention not to attend, the twin requirements of fairness and procedural economy were

still best served by holding the oral proceedings as scheduled. The mere choice by the appellant not to attend was not a sufficient reason to delay the board's decision. If the appellant had attended the oral proceedings, it would have had an opportunity to present its comments. The board considered therefore that Article 113(1) EPC had been satisfied. The request to cancel the scheduled oral proceedings was therefore refused.

2. *Technological background*

2.1 Some advanced telecommunication systems provide a service referred to as "flexible alerting" in which a single incoming call is branched into multiple outgoing calls. The incoming call is directed to a primary or pilot directory number which is associated with a flexible alerting group of other directory numbers, often referred to as secondary directory numbers. When a call is placed to the primary directory number, all of the secondary directory numbers are alerted. The subscriber with the secondary directory number which is first to answer the alert is connected with the calling party. Thus, using a single extension, namely the primary directory number, all the subscribers of the flexible alerting group may be alerted and a connection to one of these subscribers may be set up.

2.2 A problem which arises in flexible alerting groups consists in the delay caused by the set-up procedure for the connection to the subscriber who is first to answer the alert. No voice transmission is provided during this delay so that the answering subscriber may wonder if the connection has been dropped. Additionally

a further subscriber might answer the alert during this delay although no further connection with the calling party can be set up. In accordance with the application in suit this problem is overcome by providing first called party information, for example a continuous tone, in all outgoing call legs in addition to the alert, the first called party information distinguishing each outgoing call leg as a multiple leg telecommunication session.

3. *Main request*

3.1 Interpretation of claim 1

3.1.1 Step (c) comprises, concurrently with the routing of each outgoing call leg and separate from providing an alert for each outgoing call leg, providing first called party information in all outgoing call legs.

3.1.2 If the term "routing" is taken in the usual sense of the process by which the route for a call is set up, it is not clear what can be meant by the first called party information being provided concurrently with the routing of each outgoing call leg. Thus, the prima facie interpretation of this feature leads to the conclusion that claim 1 does not comply with Article 84 EPC. Moreover, this interpretation has no support in the description and gives rise to the further objection that the subject-matter of claim 1 does not comply with Article 123(2) EPC.

3.1.3 However, the board notes that if the term "routing" is taken in a broader sense to include activities beyond path determination as suggested by the appellant in its

letter of 17 January 2006, the term can then be understood to include receiving and processing an incoming call leg by a network switch, call placement and processing for multiple outgoing call legs, providing a mobile paging message to locate a mobile telephone, if any wireless equipment is involved, and providing an alert for each outgoing call leg. However, such a broad interpretation applies equally to the application and the prior art documents, regardless of whether the prior art documents use different terms for these activities.

3.1.4 The expression "separate from" in "separate from providing an alert for each outgoing call leg", which has now been introduced into claim 1, does not have any direct support in the description. If the term were taken literally, the subject-matter of claim 1 would not comply with Article 123(2) EPC.

3.1.5 The description discloses that information is provided by a switch on all outgoing call legs of a flexible alerting or other multi-leg communication session and that such information to a called party is not provided for direct calls to that directory number, see [0022] lines 52 to 58. It also discloses that such information provided to a called party is independent of any telecommunications standard and of any particular network embodiment, see [0023] lines 24 to 33. This implies that providing an alert for each outgoing call leg in a multiple leg telecommunication session is done additionally to the signals specified by the known telecommunications standards. Thus, the board interprets "separate from providing an alert for each

outgoing call leg" as "independent of providing an alert..." or "in addition to providing an alert...".

3.1.6 Turning now to the appellant's argument that no objection according to Article 123(2) EPC had been raised in the summons to attend oral proceedings dated 13 December 2002 and the minutes of the oral proceedings before the examining division of 18 February 2003 and that the examining division and the "appeal board" [sic] therefore had been aware of the recitation in step (c) and understood that the feature was supported by the specification, see page 3 of the appellant's letter of 17 January 2006, the board refers here to the general principles governing the appeal proceedings in ex parte cases set out in G 10/1993, OJ EPO 1995, 172. The first aim of such proceedings is to examine the contested decision in the light of the requirements for grant set forth in the EPC. In the above-mentioned decision the Enlarged Board stated in point 3 that the power of a board to review the contested decision extends not only to the grounds, facts and evidence on which the contested decision is based on but can extend to new grounds, i.e. requirements for patentability that the examining division did not take into consideration, in addition to those mentioned as having been met.

The general legal basis for these principles in the EPC is Article 114(1), which allows the boards of appeal to examine the facts of their own motion without being restricted by the submissions of the parties. Thus, the fact that the examining division did not raise the question of whether step (c) complies with

Article 123(2) EPC does not prevent the board from examining this requirement.

3.2 Novelty

The board's comments on novelty are based on the interpretation of claim 1 discussed above.

D1 discloses a method of providing a delayed connection announcement to a mobile subscriber within a radio telecommunication system. To set up a call between a calling mobile and a called mobile a call directed to a primary directory number (PDN) is received in a gateway switching centre (see page 4, lines 19 to 21). Thus, D1 discloses that an incoming call leg is established.

The gateway mobile switching centre requests from a home location register (HLR) routing information related to the PDN. The HLR identifies a plurality of mobile switching centres each currently serving a mobile associated with the PDN, i.e. secondary directory numbers. The gateway mobile switching centre sends messages to the corresponding mobile switching centres asking them to send paging messages to the corresponding mobiles (see page 4, lines 21 to 25). Upon receiving a paging response from at least one of the paged mobiles a voice channel to the answering mobile is established and an alert signal indicating the incoming call is sent (see page 4, lines 26 to 29). A multiple leg telecommunication session is thereby established.

Thus, D1, page 4, lines 19 to 29 discloses the features of the preamble of claim 1, namely receiving an

incoming call leg designating a primary directory number (PDN), determining a plurality of secondary directory numbers associated with the PDN and processing and routing an outgoing call leg associated with each secondary directory numbers to form a plurality of outgoing call legs.

D1, page 6, lines 11 to 13 discloses the use of a distinctive ringing tone to distinguish a PDN call from a normal call, i.e. providing first called party information in all outgoing call legs, wherein the first called party information distinguishes each outgoing call leg as a multiple leg telecommunication session. In D1, the distinctive ringing tone is simultaneously used as alert and as first called party information. The interpretation of "routing" suggested by the appellant includes providing an alert for each outgoing call leg, see point 3.1.3 above. In the board's view the use of a distinctive ringing tone can be understood as providing two items of information concurrently in the sense of claim 1.

D1, page 8, lines 5 to 9 discloses that subscribers who answer the phone in response to a ringing tone are provided with an announcement informing them that there may be a delay in call setup. This announcement is provided in addition to the ringing tone which falls within the interpretation of "separate from" given in point 3.1.4 above. Thus, D1 discloses the step of "separate from providing an alert for each outgoing call leg, providing first called party information in all outgoing call legs".

The subject-matter of claim 1 is therefore not novel.

Even if, for the sake of argument, "concurrently" were understood in the sense of "simultaneously", the subject-matter would lack inventive step. In this case, claim 1 according to the main request would differ from D1 by "separate from providing an alert for each outgoing call leg, providing first called party information in all outgoing call legs". As set out in point 3.1.5 above "separate from" is understood as "in addition to " or "independent of".

The problem underlying the application in suit could then be seen as being to provide information to the called party of the answering outgoing leg in order to distinguish a flexible alerting call leg or other multiple outgoing call leg from other types of communication sessions, see [0008] lines 27 to 33. The information should especially enable the called party to distinguish between direct calls and flexible alerting calls in view of the connection time lag, see [0017] lines 28 to 32.

D1 also addresses this problem, see page 1, lines 22 to 29 and page 2, lines 10 to 13. D1 solves this problem by providing a distinctive ringing tone to signify that the call being placed is a pilot directory number call, i.e. a flexible alerting call instead of a normal call, see page 6, lines 11 to 13. The distinctive ringing tone is simultaneously used as alert and as first called party information. Prior to D1 only one ringing tone was used for alerting in both kinds of telecommunications session. Thus, the skilled person faced with the above mentioned problem would derive from D1 that the outgoing call legs should be provided

with distinctive information simultaneously with the alerting function and that alerting and distinguishing between different kinds of telecommunications session are independent of one another. It is merely a matter of choice on the part of the skilled person to use an alert and simultaneously additional distinctive information, namely a first called party information, instead of a distinctive ringing tone. Consequently, on such an interpretation the subject-matter of claim 1 would not involve an inventive step.

4. *First auxiliary request*

4.1 Interpretation of claim 1

4.1.1 Step (c) comprises, concurrently with the routing of each outgoing call leg and in addition to providing an alert for each outgoing call leg, providing first called party information in all outgoing call legs.

4.1.2 The comments made at points 3.1.2 and 3.1.3 referring to the interpretation of the term "routing" apply equally.

4.1.3 Step (d) comprises "maintaining the first called party information on a selected outgoing call leg, ... ,for a period of time at least as long as a connection time lag period." Maintaining the first called party information is understood as providing the information during a given time.

4.2 Novelty

4.2.1 Claim 1 according to the first auxiliary request differs from claim 1 according to the main request in that

(a) "separate from" is replaced by "in addition to"; and

(b) the further feature of "maintaining the first called party information on a selected outgoing call leg, of the plurality of outgoing call legs, the selected outgoing call leg having been first to be answered, for a period of time at least as long as a connection time lag period." is added.

4.2.2 Difference (a) does not constitute a difference of substance, see the interpretation of "separate from" discussed at point 3.1.4 above. Thus, the arguments presented at point 3.2 above apply.

4.2.3 D1 discloses at page 8, line 30 to page 9, line 4 the provision of an announcement which is sent to mobile stations associated with a pilot directory number, stating that the call connection may be delayed, so that called subscribers are more likely to remain on the line until call delivery is completed. The delayed message may be sent at the time that the visited mobile switching centre sends a routing for the answering mobile stations to the home location register. Thus, in line with the interpretation of the term "routing" given in point 3.1.3, D1 discloses concurrently with the routing of each outgoing call leg and in addition to providing an alert for each outgoing call leg,

providing first called party information in all outgoing call legs. Moreover, D1, page 9, lines 4 to 6 discloses that the delayed connection message may be repeated periodically until the voice trunk is established between the originating MSC and the visited MSC which is understood as maintaining the first called party information on a selected outgoing call leg, of the plurality of outgoing call legs, the selected outgoing call leg having been first to be answered, for a period of time at least as long as a connection time lag period in accordance with the interpretation discussed at point 4.1.3 above.

Turning to the appellant's argument that a periodically repeated message could not be construed as information that is maintained, the board notes that the claimed first called party information is not specified further and does not exclude a periodically repeated message.

Thus, the subject-matter of claim 1 according to the first auxiliary request is not novel.

5. *Second auxiliary request*

Claim 1 according to the second auxiliary request adds to claim 1 of the first auxiliary request the feature of continuously maintaining the first called party information. D1 discloses at page 8, lines 9 and 10 periodically repeating the delayed connection message as needed but does not specify the frequency used for repeating.

The problem solved by the claimed subject-matter can be seen as providing a method in which the called party is securely informed about the delayed connection until the connection is set up. The skilled person is taught by D1, page 8, lines 9 to 12 that, if needed, the announcement can be repeated periodically and that different embodiments for the announcement, namely a voice announcement or a signalling message over the air interface, may be chosen. A signalling message implies continuity. Thus, it would be obvious to the skilled person that the frequency of repetition can be adjusted as needed. No inventive step can be seen in replacing a frequently repeated by a continuously repeated message. Thus, the subject-matter of claim 1 according to the second auxiliary request does not involve an inventive step.

Turning to the appellant's argument that the suggestion that the skilled person could be expected to adjust the frequency of repetition if needed was based on an ex post facto analysis, the board notes that the skilled person is taught by D1, page 8, lines 8 to 12 that the announcement may be varied as needed. Even if no explicit advice is given to adjust the frequency of repetition, in the board's view the skilled person would consider this as one of the possible adjustments to the announcement.

6. *Third auxiliary request*

6.1 Interpretation of claim 1

Claim 1 according to the third auxiliary request replaces the wording "separate from" in claim 1

according to the main request by "in addition to" and adds the feature that the second called party information which is provided in all outgoing legs by a switch is call directing information.

As the term "call directing information" is not explicitly used in the description, it is interpreted in line with [0029] lines 44 to 48 and the grounds of appeal as information appropriate to direct the incoming call leg to the most suitable called party.

6.2 Inventive step

Referring to replacing "separate from" by "in addition to" the argument set out in point 4.2.2 applies.

The problem solved by the claimed subject-matter can be seen as being the separate, additional problem of providing the subscriber with additional information to direct the incoming call leg to the most suitable called party.

D2 discloses a solution to this problem. D2, page 3, lines 45 to 48 and page 4, lines 30 to 32 teaches that in addition to information about the category of the group call, the service area identity and the group identity, information about the extension of the calling subscriber, i.e. information appropriate to direct the incoming call leg to the most suitable called party or to form the basis of a decision whether or not to answer the call, can be provided.

The skilled person seeking to improve the method disclosed in D1 in order to solve the additional

problem mentioned above would be led by the disclosure of D2 to provide first and second called party information as claimed. The subject-matter of claim 1 according to the third auxiliary request therefore does not involve an inventive step.

7. *Fourth auxiliary request*

Claim 1 according to the fourth auxiliary request differs from claim 1 according to the third auxiliary request in that

(a) call directing information as first called party information and a waiting signal as second called party information are provided, and

(b) the further feature of "maintaining the second called party information on a selected outgoing call leg, of the plurality of outgoing call legs, for a period of time at least as long as a connection time lag period." is added.

Since in accordance with [0009] lines 42 to 46 the waiting signal is a special embodiment for the information to a called party in multiple leg telecommunications sessions, difference (a) appears to be a renaming of first and second called party information. Thus, the arguments presented on the third auxiliary request apply.

Difference (b) corresponds mutatis mutandis to difference (b) according to the first auxiliary request. Thus, the arguments presented in point 4.2.3 above apply.

The subject-matter of claim 1 of this request accordingly does not involve an inventive step.

8. *Fifth auxiliary request*

Claim 1 according to the fifth auxiliary request adds to claim 1 of the fourth auxiliary request the feature that the second party information is maintained "continuously" in step (d). The arguments presented on the second auxiliary request apply, see point 5.

9. *Sixth auxiliary request*

9.1 Interpretation of claim 1

Claim 1 according to the sixth auxiliary request adds to claim 1 according to the main request in step (c) the feature of "differentially processing and routing the outgoing call legs".

The expression "differentially processing and routing the outgoing call legs" is used in the description at [0010] lines 18 and 19, [0040] lines 37 and 38, [0041] lines 52 and 53 and in claim 1 lines 14 and 15 in the originally filed version, without giving any explanation as to what is meant by "differentially". Although the originally filed description refers at [0001] to a related US Patent Application, the serial number of this related US Patent Application is missing; but even if the related application could be retrieved, the skilled person would not be taught by the mere reference to a related application how the disclosures of both applications might be combined. No

link between the term "differentially" as used in the present application and the related application can be found. Thus, an interpretation of "differentially processing and routing" restricted to the details presented in the letter of 17 January 2006 on page 7, third paragraph would not comply with the provisions of Article 123(2) EPC.

The board accordingly takes the view that the expression "differentially processing and routing" should not be understood in the restricted sense presented in the appellant's letter of 17 January 2006 at page 7, third paragraph and interprets the term in the sense that for every outgoing call leg a different connection is set up.

9.2 Inventive step

The arguments presented on claim 1 according to the main request apply, see point 3 above.

Moreover, D1 discloses at page 4, lines 19 to 25 that when a call to the pilot directory number is received in a gateway mobile switching centre, the gateway mobile switching centre of the originating exchange sends a location request invoke message to the home location register. In response, the home location register transmits an individual routing request invoke message to each one of the plurality of mobile switching centres identified as currently serving a mobile station associated with the pilot directory number. Thus, D1 discloses that the outgoing call legs are "differentially" processed and routed.

Consequently, the subject-matter of claim 1 does not involve an inventive step.

Turning to the appellant's argument that D1 and D2 do not disclose or suggest differentially processing and routing, the board notes that the meaning of the expression "differentially processing and routing" is not restricted to the narrow interpretation presented in the letter of 17 January 2006 on page 7, third paragraph, see point 9.1 above.

There being no other requests, it follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Magliano A. S. Clelland