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Datasheet for the decision of 22 March 2007

Case Number: T 1174/04 - 3.5.03

Application Number: 98943602.7

Publication Number: 1016260

IPC: H04M 7/00

Language of the proceedings: EN

Title of invention:
Apparatus and method to use a conventional telephone set to make telephone calls on a packet network

Applicant:
Media5 Corporation

Opponent:
-

Headword:
Telephone to packet adapter/MEDIA5

Relevant legal provisions:
EPC Art. 123(2), 54, 56

Keyword:
"Amendments - added subject-matter (no)"
"Inventive step - (yes) after amendment"

Decisions cited:
-

Catchword:
-

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Case Number: T 1174/04 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 22 March 2007

Appellant: Media5 Corporation
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 2 April 2004 refusing European application No. 98943602.7 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 2 April 2004, refusing European patent application No. 98943602.7 for the reasons that the subject-matter of each of independent claims 1 and 12 was not novel having regard to the disclosure of:

D1: US-5 654 957 A

and that the subject-matter of independent claim 19 did not involve an inventive step having regard to the disclosure of D1.

II. Notice of appeal was filed on 1 June 2004 and the appeal fee paid. The statement of grounds of appeal was filed on 6 August 2004 by fax. The appellant requested that the appealed decision be set aside and that the application be allowed based on the claims of a main request, a first auxiliary request or a second auxiliary request, filed with the grounds of appeal. The claims of the main request corresponded to the claims on which the appealed decision was based. A conditional request for oral proceedings was made.

III. In a communication accompanying a summons to oral proceedings the board made observations regarding the validity of the priority claim and noted that the Canadian application of which the priority was claimed did not mention a local area network, so that the priority claim appeared to be invalid for claims which comprised a feature related to a local area network.

The board further took the preliminary view that the subject-matter of the independent claims of all of the requests did not involve an inventive step having regard to the disclosure of D1.

IV. With a letter submitted 22 February 2007, in response to the communication, the appellant filed claims of a new main request and new first and second auxiliary requests. All references to a local area network were said to have been deleted from the claims. Further, the independent claims were said to have been amended to overcome the objections of lack of inventive step having regard to the disclosure of D1. Moreover, the appellant presented arguments for inventive step.

At the oral proceedings held on the 22 March 2007 the appellant presented a new main request and first and second auxiliary requests which replaced the requests on file. These are dated erroneously 21 instead of 22 March 2007.

At the end of the hearing the chairman announced the decision of the board.

V. Claim 1 of the main request reads as follows:

"A method for routing a telephone call issued by a telephone set via a telephone to packet adapter provided with a telephone line interface, a telephone interface, a packet network interface and a controller circuit interconnecting the telephone line, telephone and packet network interfaces, and wherein the controller circuit includes a telephone number database

of telephone numbers that may be reached via the packet network; said method comprising the steps of:

connecting a telephone line to the telephone line interface;
connecting a telephone set to the telephone interface;
connecting the adapter to a packet network via the packet network interface;
running an agent software on the controller circuit for routing the telephone call to either the telephone line interface and the packet network interface depending on at least one preestablished routing rule;
wherein said at least one preestablished routing rule is such that said outgoing call is routed to said telephone line interface when no packet network address corresponding to a dialed telephone number exist [sic]."

In view of the board's decision it is not necessary to give details of the auxiliary requests.

Reasons for the Decision

1. *Article 123(2) EPC*

The application as originally filed discloses, in accordance with one aspect of the invention, a telephone to packet adapter comprising a telephone line interface, a telephone interface, a local area network interface and a controller circuit interconnecting the telephone line interface, the telephone interface and a local area network interface, the controller circuit having a specific configuration, see page 2, lines 15 to 27 of the patent application as published. According

to another aspect of the invention the telephone to packet adapter comprises a telephone line interface, a telephone interface, a local area network interface, a packet network interface and a controller circuit with a given configuration, see page 3, lines 1 to 17.

Two embodiments of the telephone to packet adapter are shown in the drawings at Figures 1 and 6 respectively and described at page 6, line 20 to page 8, line 15. In both embodiments the telephone to packet adapters 10, 400 comprise a local area network interface.

The packet network to which the users are connected via adapters 10, 400 is described with reference to Figure 2, see page 8, line 17 to page 10, line 24. It is stated at page 8, lines 19 to 21 that Figure 2 illustrates "some of the various possibilities of the telephone to packet adapters 10 and 400". In other words, the skilled person is taught that the telephone to packet adapters used to connect the users to the packet network in the embodiment shown in Figure 2 are embodied as disclosed with reference to Figures 1 and 6.

Thus, all of the adapters shown in Figure 2 could be expected to comprise a local area network port 13.

However, the board notes that in Figure 2 and the associated description at page 8, line 27 to page 9, line 4 the first user 32 is connected to the packet network 30 via a telephone to packet adapter 10a using a conventional modem 40 connected to a packet network IO port 16a. The first user 32 has a telephone set 42 connected to a telephone IO port 12a. The local area

network port 13a of the adapter 10a is said not to be used. The skilled person would therefore understand that in a method for routing a telephone call issued by a telephone set via a telephone to packet adapter to a modem the local area network port of the adapter need not be used.

Thus, claim 1 of the main request complies with the provisions of Article 123(2) EPC.

2. *Priority claim*

Given that the claim does not refer to a feature related to a local area network, the priority claimed for claim 1 of the main request appears valid. Accordingly, the board has only taken account of prior art published before the claimed priority date.

3. *Inventive step*

D1, published before the priority date, represents the most relevant prior art document.

D1 discloses a packet communication system which it is stated can reliably and economically ensure communication between communication units connected in a conventional telephone network and those connected in a packet mode network, see column 3, lines 2 to 6. The communication system includes a communication unit 30 for connection to both the conventional telephone network and a local area network, that is, a packet communication network, see Figure 2 and column 5, lines 5 to 9. The communication unit is provided with a connection path for connection to the local area

network 101 and a connection interface line 103 for connection to a private branch exchange network, that is, the conventional telephone network, see column 5, lines 9 to 13.

Referring to Figure 2 of D1 and the associated description at column 5, lines 21 to 37, the communication unit 30 includes a processor 31 executing overall control, a display 32 displaying various kinds of messages, a keyboard 35 inputting information required for operation, a speech packet processor 31 processing a speech input and a speech output to and from a handset so as to transmit and receive a speech packet to and from the local area network, a telephone interface control 34 controlling the subscriber line interface of the conventional telephone network, and a switch 36 to select whether speech data to the handset 19 is supplied from the local area network or from the private branch exchange network. These parts of the communication unit are interconnected with each other via an internal bus. The processor 31 controls *inter alia* the switch 36. The skilled person would understand that the communication unit represents an integrated device comprising a telephone set and a telephone to packet adapter.

When setting up a call using the communication unit the user inputs address information, i.e. a telephone number or a network address. The processor 31 identifies whether the inputted address information is a network address or a telephone number. On the basis of the result of this decision, the packet communication unit controls the switch so that the communication unit is connected either to the local

area network or to the conventional telephone network, see column 5, lines 52 to 64.

The method according to claim 1 of the main request differs from the method of D1 in that a database of telephone numbers that may be reached via a packet network is used, the database being included in a controller circuit of the telephone to packet adapter. If a user dials a telephone number for setting up a call, the telephone call is routed to either the telephone line interface or the packet network interface depending on whether a packet network address corresponding to the dialled telephone number exists. If no packet network address corresponding to the dialled telephone number exists, the call is routed to the telephone line interface. Thus, the method according to claim 1 of the main request is novel having regard to the disclosure of D1.

Starting from the disclosure of D1 the problem underlying claim 1 can be seen as providing a method of routing a telephone call to either the telephone line interface or a packet network interface, transparently for the user setting up the call. This problem is solved by checking the telephone number database for telephone numbers that may be reached via the packet network. If no packet network address corresponding to the dialled telephone number exists, the call is automatically routed to the telephone line interface. This decision is made transparently for the user. By contrast, according to D1 the user has to input an identifier specifying the communication network he/she wishes to use, see column 5, lines 58 to 64. Replacing this requirement for an explicit choice by the user by

a transparent decision was not, in the board's view, obvious at the priority date.

Thus, the subject-matter of claim 1 of the main request involves an inventive step.

4. *Remittal*

The case is remitted to the department of first instance for further examination. The board notes that clerical errors require correction and that the question of whether the dependant claims comply with the provisions of Articles 84 and 123(2) EPC has yet to be examined. Nor have the title and description been adapted to the new claims.

5. *The first and second auxiliary requests*

As claim 1 of the main request has been found to comply with the provisions of Articles 123(2), 54, and 56 EPC, the board has not considered the first and second auxiliary requests.

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 claim 1 of the main request.

The Registrar: The Chairman:

D. Magliano A.S. Clelland