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**Datasheet for the decision
of 8 July 2009**

Case Number: T 0429/07 - 3.5.03

Application Number: 00944086.8

Publication Number: 1114526

IPC: H04B 7/00

Language of the proceedings: EN

Title of invention:

Method of identifying information addressed to a user in a communication system, and a communication system

Patent Proprietor:

Qualcomm Incorporated (after transfer of patent)

Opponent:

Qualcomm Incorporated (opposition withdrawn)

Headword:

Communication system/QUALCOMM

Relevant legal provisions:

EPC Art. 54, 83, 84, 111(1)
EPC R. 139

Relevant legal provisions (EPC 1973):

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Keyword:

-

Decisions cited:

G 0009/92, G 0009/93

Catchword:

-



Case Number: T 0429/07 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 8 July 2009

Appellant I: Qualcomm Incorporated
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Appellant II: Qualcomm Incorporated
(Opponent
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Decision under appeal: Interlocutory decision of the opposition
division of the European Patent Office posted
9 January 2007 concerning maintenance of
European patent No. 1114526 in amended form.

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
R. Menapace

Summary of Facts and Submissions

- I. The present decision arises from appeals filed by both the proprietor, at the time Nokia Corporation, and the opponent, Qualcomm Incorporated, against the decision of the opposition division finding European patent No. 1114526 in amended form, which included claims 1 to 34 as granted, to meet the requirements of the EPC.
- II. The opposition was filed against the patent as a whole and on the grounds that the claimed subject-matter was not new and did not involve an inventive step (Article 100(a) EPC), the European patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC), and the patent contained subject-matter which extended beyond the content of the application as filed (Article 100(c) EPC).

The opponent argued, *inter alia*, that the claimed subject-matter lacked novelty or at least an inventive step. Further, independent claims 35 and 37 as granted violated Article 123(2) EPC, since the application as filed did not provide a basis for claiming the transmitter and the receiver of the disclosed communication system separately.

In support of its arguments the opponent referred, *inter alia*, to the following documents:

D01: WO 98/57441 A; and

D07: US 5 838 672 A.

III. In the decision under appeal the opposition division held that claims 1 to 34 as granted met the requirements of the EPC. It was further held that the subject-matter of independent claims 35 and 37 as granted lacked novelty having regard to the disclosure of D01 and D07, respectively.

IV. In the statement of grounds of appeal filed by the proprietor (hereinafter appellant I), appellant I requested that the decision under appeal be set aside and that the patent be maintained either as granted (main request) or in amended form on the basis of claims of any one of auxiliary requests I to III as filed with the statement of grounds. Oral proceedings were conditionally requested.

With a further letter dated 10 December 2007, appellant I submitted, "separately from (in addition to)" the main and auxiliary requests filed with the statement of grounds of appeal, claims of a "2nd" main request and of "2nd" auxiliary requests I to III.

V. In the statement of grounds of appeal filed by the opponent (hereinafter appellant II), appellant II requested that the decision under appeal be set aside and that the patent be revoked in its entirety. The arguments submitted only concerned claims 1 and 18 as granted.

In the reply to the statement of grounds of appeal as filed by appellant I, appellant II argued in relation to claim 35 of auxiliary request I that, due to the added feature "the transmitter is arranged to transmit on the shared channel using at least one spreading code", the claimed invention was not disclosed in a manner

sufficiently clear for it to be carried out by a person skilled in the art, since in connection with this feature the application as filed included conflicting statements; on page 3, lines 32 to 35, it was taught that the receiver identified the information addressed to it "by means of the training sequence", whereas on page 11, lines 8 to 10, it was mentioned that "spreading codes are used to separate the users". Hence, it was not clear whether spreading codes or training sequences were used for the addressing and, consequently, Articles 83 and 84 EPC were not complied with. This objection was also raised against claim 37 of auxiliary request II in connection with the added feature "the receiver is arranged to receive on the shared channel using at least one spreading code". Further, it was argued that claim 37 was unclear because it recited a spreading code on the receiver side, whereas the receiver did not carry out a spreading.

Appellant II did not raise any novelty objections against claim 35 of auxiliary request I and claim 37 of auxiliary request II.

With a letter dated 7 October 2008 appellant II informed the board that it withdrew the opposition.

- VI. In a communication accompanying a summons to oral proceedings, the board drew attention to issues to be discussed at the oral proceedings. Appellant I was requested to clarify its requests.

- VII. On 24 February 2009 the registration of a transfer of the patent in suit to Qualcomm Incorporated, i.e. the opponent at the time, took effect.

VIII. In preparation for the oral proceedings, appellant I filed with a letter dated 18 June 2009 amended claims 35 to 38, of which claims 35 and 37 essentially correspond to claims 35 and 37 of auxiliary requests I and II, respectively, as filed with the statement of grounds of appeal. Appellant I requested, by way of a new main request, that the patent be maintained on the basis of claims 1 to 34 as granted and these amended claims 35 to 38. Auxiliary requests I and II as filed with the statement of grounds of appeal and the requests as filed with the letter dated 10 December 2007 were withdrawn. Auxiliary request III as filed with the statement of grounds of appeal remained as the only auxiliary request. Further, appellant I withdrew the request for oral proceedings, on the condition that the new main request could be granted or that the matter could be remitted to the opposition division.

IX. With a communication dated 24 June 2009 the board informed appellant I that the oral proceedings were cancelled and that the proceedings would be continued in writing.

X. Claims 35 to 38 of the main request read as follows:

"35. A transmitter for a communication system, which transmitter (120) is arranged to transmit on a shared channel (312) data packets (330A to 330D) provided with a training sequence (300), the transmitter being arranged to signal the training sequence to the receivers in another channel than the shared channel, characterized in that
the transmitter is arranged to transmit the data

packets on the shared channel using at least one spreading code,

the transmitter is arranged to transmit on the shared channel data packets (330A to 330D) addressed to different receivers or receiver groups with different training sequences (300).

36. A transmitter as claimed in claim 35, characterized in that the transmitter is a base station.

37. A receiver for a communication system, which receiver is arranged to receive on a shared channel data packets (330A to 330D) provided with a training sequence, the receiver being arranged to receive the training sequence in another channel than the shared channel, and the receiver is arranged to generate a channel estimate on the basis of the training sequence (300),

characterized in that

the receiver is arranged to receive the data packets on the shared channel, using at least one spreading code,

the receiver is arranged to further process data packets (330A to 330D) whose training sequence (300) the receiver identifies, and

the receiver is arranged to ignore the data packets (330A to 330D) whose training sequence (300) the receiver does not identify.

38. A receiver as claimed in claim 37, characterized in that the receiver is a mobile phone."

Reasons for the Decision

1. *Procedural matters*

Since appellant II withdrew its opposition, it thereby withdrew its appeal and, hence, the (new) proprietor/appellant I became the sole appellant. Under these circumstances, the prohibition of *reformatio in peius* (see G 9/92, OJ EPO 1994, 875) applies and, hence, the board may not challenge the maintenance of the patent as amended in accordance with the decision under appeal. The board will therefore not consider the objections raised by the opponent/appellant II against claims 1 to 34 as granted, which the opposition division held to meet the requirements of the EPC.

The board notes that, since appellant II withdrew its opposition before the patent was transferred to it (see above, point V, last paragraph, and point VII), at no stage of the opposition/appeal procedure were the opponent and the patent proprietor the same legal person. The present case is therefore to be distinguished from self-opposition (see G 9/93, OJ EPO 1994, 891).

2. *Interpretation of the claims as granted*

In the context of the patent in suit, and in line with the general understanding by a person skilled in the art of the term "spreading code", this term is interpreted in relation to digital radio communication systems as referring to a spread-spectrum technique as commonly used, for example, in code division multiple access (CDMA) methods for accessing a communication channel (see the patent in suit, page 2, lines 25 to 28, page 3,

paragraph [0010], page 4, paragraph [0018], and claims 14 and 31).

3. *Amendments (main request)*

- 3.1 Claim 35 differs from claim 35 as granted in that the feature "the transmitter is arranged to transmit the data packets on the shared channel using at least one spreading code" was added.

Claim 36 differs from claim 36 as granted in that the reference to claim 36, i.e. the claim itself, was replaced by a reference to claim 35.

Claim 37 differs from claim 37 as granted in that the feature "the receiver is arranged to receive the data packets on the shared channel, using at least one spreading code" was added.

Claim 38 differs from claim 38 as granted in that "A transmitter as claimed in claim 37" was replaced by "A receiver as claimed in claim 37".

- 3.2 The above-mentioned added features in claims 35 and 37 are based on the description, page 3, lines 31 to 36, and claims 31 to 33 of the application as filed. The amendments made to claims 36 and 38 constitute corrections in the sense of Rule 139 EPC.

The board notes that the opponent argued that the application as filed did not provide a basis for claiming the transmitter and the receiver separately (see point II above). However, the board agrees with the opposition division that Fig. 4, upper and lower parts,

and the corresponding passage in the description at page 13, line 18, to page 14, line 34, of the application as filed disclose the transmitter and receiver as separate entities.

- 3.3 The board is therefore satisfied that claims 35 to 38 have not been amended in such a way that they contain subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC) or which extends the protection conferred (Article 123(3) EPC).

4. *Disclosure of invention and clarity of the claims*

The board sees no reason to raise any objections under Article 83 EPC in respect of the subject-matter claimed in claims 35 to 38 or to raise any objections under Article 84 EPC as far as the amendments made to these claims are concerned. In this respect, the board notes that the passages which were referred to by appellant II (see point V above) and which correspond to paragraphs [0010] and [0029] of the patent specification, merely disclose two possibilities of addressing the users, i.e. by means of different spreading codes or by means of different training sequences, in which one does not exclude the other, see also claim 33 as granted. Hence, these passages do not include conflicting statements which could potentially give rise to an objection under Article 83 EPC. Further, the board notes that it is clear that a receiver may use a spreading code in order to despread a received signal.

5. *Novelty (main request)*

- 5.1 Document D01 discloses a transmitter for transferring

data, which is particularly suitable for use in a GSM telecommunication system, in which a channel is characterised by a time slot and a frequency range (page 1, lines 12 to 16, 21 to 24, and 28 to 32, page 5, lines 14 to 18, and page 6, lines 11 and 12).

Hence, D01 does not disclose that the transmitter is arranged to transmit data packets using a spreading code.

- 5.2 Document D07 discloses a receiver for receiving a signal in a digital time division communication system and, in particular, in a GSM system (see the abstract and col. 1, lines 25 to 40, col. 3, lines 1 to 4). At col. 6, lines 19 to 25, it is explicitly mentioned that the invention can be applied to other digital communication systems, such as DCS 1800/1900, US-TDMA, or JDC.

The board notes that none of the above-mentioned systems use spread-spectrum techniques and, hence, D07 does not disclose that the receiver is arranged to receive data packets using a spreading code.

- 5.3 Consequently, the subject-matter of independent claims 35 and 37 and their respective dependent claims 36 and 38 is novel having regard to the disclosure of D01 and of D07 (Articles 54 and 100(a) EPC). The board notes that no novelty objections were raised by appellant II against these claims. The board is also satisfied that the subject-matter of claims 35 to 38 is novel having regard to the disclosure of any other of the prior art documents on file.

- 5.4 For these reasons the decision under appeal is to be set aside.

6. *Remittal*

Since the ground of opposition under Article 100(a) EPC in combination with Article 56 EPC (inventive step) was not discussed in the decision under appeal as concerns the subject-matter of claims 35 to 38, the board considers it appropriate to remit the case to the department of first instance pursuant to Article 111(1) EPC for further prosecution, which would also permit an examination of this opposition ground by two instances.

7. Since the board accedes to the main request, it was not necessary to hold oral proceedings or to consider the only remaining auxiliary request, i.e. auxiliary request III.

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.

The Registrar:

The Chairman:

N. Maslin

A. S. Clelland