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**Datasheet for the decision
of 15 October 2009**

Case Number: T 1725/07 - 3.5.03

Application Number: 01941378.0

Publication Number: 1302032

IPC: H04Q 7/22

Language of the proceedings: EN

Title of invention:

Method and arrangement to secure access to a communications network

Patentee:

Birdstep Technology AB

Opponents:

Swisscom (Schweiz) AG
Vodafone Group PLC
Option

Headword:

Communications network/BIRDSTEP

Relevant legal provisions:

EPC Art. 123(2), (3)
EPC Art. 84
RPBA Art. 13(1), (3)

Keyword:

"Added subject-matter - main request (yes)"
"Extension of the protection conferred - first auxiliary request (yes)"
"Clarity - second auxiliary request (no)"
"Late-filed third auxiliary request - not admitted"

Decisions cited:

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Case Number: T 1725/07 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 15 October 2009

Appellant: Birdstep Technology AB
(patent proprietor) Hälsingegatan 32
SE-113 43 Stockholm (SE)

Representative: Hagström, Lena
BRANN AB
P.O. Box 1344
SE-751 43 Uppsala (SE)

Respondent 1: Swisscom (Schweiz) AG
(Opponent 1) Alte Tiefenaustrasse 6
CH-3050 Bern (CH)

Representative: Weiland, Andreas
Patents & Technology Surveys SA
Rue de Terreaux 7
CH-2001 Neuchâtel (CH)

Respondent 2: Vodafone Group PLC
(Opponent 2) Vodafone House
The Connection
Newbury
Berkshire RG14 2FN (GB)

Representative: Foster, Mark Charles
Mathisen, Macara & Co
The Coach House
6-8 Swakeleys Road
Ickenham
Uxbridge UB10 8BZ (GB)

Respondent 3: Option
(Opponent 3) Gaston Geenslaan 14
BE-3001 Leuven (BE)

Representative: Sarlet, Steven Renaat Irène
Gevers & Vander Haeghen SA
Holidaystraat 5
B-1831 Diegem (BE)

Decision under appeal: **Decision of the opposition division of the
European Patent Office posted 1 August 2007
revoking European patent No. 1302032 pursuant
to Article 102(1) EPC 1973.**

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
 M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. This appeal is against the decision of the opposition division revoking European patent No. 1302032 which is based on European patent application 01941378.0 which was published as international application WO 02/01822 A pursuant to Article 158(1) EPC 1973.
- II. The opposition division held that claim 1 of each one of a main request, a first auxiliary request and a second auxiliary request comprised subject-matter extending beyond the application as filed and thus did not meet the requirements of Article 123(2) EPC. In the course of the oral proceedings further requests were filed, which the opposition division held *prima facie* not allowable and did not therefore admit into the proceedings.
- III. The proprietor (appellant) lodged an appeal against the decision and requested that it be set aside and that the patent be reinstated. Oral proceedings were conditionally requested. A statement of grounds of appeal was subsequently filed.
- IV. In response to the notice of appeal and the statement of grounds of appeal, the opponents 1, 2 and 3 (respondents 1, 2 and 3, respectively) requested that the appeal be dismissed. Respondents 2 and 3 argued, *inter alia*, that the appeal should be rejected as inadmissible. All respondents conditionally requested oral proceedings.
- V. The parties were summoned by the board to oral proceedings. In a communication accompanying the summons the board gave a preliminary opinion on the question of the admissibility of the appeal and informed the parties

that, if the appeal were to be held admissible, it would subsequently be necessary to discuss the question of whether or not the appeal was allowable, in which case the board would consider at the oral proceedings the opposition ground pursuant to Article 100(c) EPC and the question of whether or not amendments made to the claims as granted complied with the requirements of Articles 84 and 123 EPC.

VI. In preparation for the oral proceedings the appellant filed with a letter dated 14 September 2009 claims of a main request and two auxiliary requests and submitted arguments in support. Respondent 1 also submitted further arguments.

VII. Oral proceedings were held on 15 October 2009.

The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claims 1 to 30 of the main request or, alternatively, claims 1 to 30 of either the first or the second auxiliary request, all requests as filed with the letter dated 14 September 2009, or, alternatively, on the basis of claim 1 of a third auxiliary request as filed during the oral proceedings.

The respondents requested that the appeal be dismissed. Respondents 2 and 3 withdrew their request that the appeal be rejected as inadmissible.

At the end of the oral proceedings the board's decision was announced.

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

"A method for setting-up a remote and secure access session from a computer (401) to a data communications network (440), via a data communication technology device (403), where said data communication technology is characterised in that it requires some set-up information and it uses a specialised access network and dedicated gateways, said data communication technology hereafter being called Pseudo-Connectionless Technology ,PCT, characterised in that the method comprises the following steps:

- a user of the computer (401) *performing* (301) one single connect activity, which automatically triggers a Remote Access Login, RAL, system comprised in the computer (401) to perform the following steps:
- *defining* (302) a PCT Packet Data Protocol, PDP, session context, comprising pseudo-connectionless characteristics of a PCT session and
- *passing* (303) said session context on to the PCT device (403) in a message;
- *triggering* (304) setting-up of a dial-up connection;
- when required, *triggering* (305) establishing of a secure Virtual Private Network, VPN, session between the computer (401) and a VPN gateway within the data communications network (440)."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that, in the first paragraph, the feature

"where said data communication technology is characterised in that it requires some set-up information and it uses a specialised access network and

dedicated gateways"

is replaced by:

"where said data communication technology is characterised in that it is always connected and it requires some complex set-up information and it uses a specialised access network and uses dedicated gateways to access the Internet"

and in that, in the last paragraph, "when required" is replaced by "where VPN components shall be used, as indicated in the user-defined profile".

Claim 1 of the second auxiliary request reads as follows:

"A method for setting-up a remote and secure access session from a computer (401) to a data communications network (440), via a GPRS or UMTS device (403), characterised in that the method comprises the following steps:

- a user of the computer (401) *performing* (301) one single connect activity, which automatically triggers a Remote Access Login, RAL, system, which is configured with a user-defined session profile and comprised in the computer (401), to perform the following steps:
- *defining* (302) a Packet Data Protocol, PDP, session context, comprising pseudo-connectionless characteristics of a GPRS or UMTS session and
- *passing* (303) said session context on to the GPRS or UMTS device (403) in a message;
- *triggering* (304) setting-up of a dial-up connection;

- when required, in cases where VPN components shall be used as indicated in the user-defined session profile, *triggering* (305) establishing of a secure Virtual Private Network, VPN, session between the computer (401) and a VPN gateway within the data communications network (440)."

Claim 1 of the third auxiliary request reads as follows:

"A method for setting-up a remote and secure access session from a computer (401) to a data communications network (440), via a GPRS device, characterised in that the method comprises the following steps:

- a user of the computer (401) *performing* (301) one single connect activity, which automatically triggers a Remote Access Login, RAL, system, which is configured with a user-defined profile and comprised in the computer (401) to perform the following steps:
 - *defining* (302) a GPRS Packet Data Protocol, PDP, session context, comprising pseudo-connectionless characteristics of a GPRS session and
 - *passing* (303) said session context on to the GPRS device (403) in a message;
 - *triggering* (304) setting-up of a dial-up connection;
 - in cases where the user-defined profile requires that VPN components shall be used, *triggering* (305) establishing of a secure Virtual Private Network, VPN, session between the computer (401) and a VPN gateway within the data communications network (440)."

At the oral proceedings the appellant suggested a further amendment to claim 1 of the third auxiliary request according to which in the first characterising feature ", which is configured with" is replaced by

"having". This suggested amendment was not made the subject of a formal request filed in writing, but will nevertheless be addressed by the board in the present decision as set out below.

Reasons for the Decision

1. *Admissibility (Rule 65(1) EPC 1973)*

The admissibility of the appeal was not or no longer contested by the respondents, see points IV and VII above. The appeal complies with Articles 106 to 108 EPC 1973 and Rules 1(1) and 64 EPC 1973 and is therefore admissible.

2. *Main request - Amendments (Article 123(2) EPC)*

2.1 According to claim 1 of the main request the last step, i.e. the triggering of an establishment of a secure VPN session, is performed "when required".

2.2 The appellant argued that this feature was based on claim 14 as originally filed, which reads as follows:

"The method according to any of the claims 1-11, wherein the step of triggering (305) the establishment of a secure VPN session is optional."

The term "optional" was to be considered as equivalent to "when required". In support of its arguments, the appellant also referred to page 20, lines 23 to 25, of the description as filed.

2.3 In the board's view, the wording "when required" is sufficiently clear in order for an addressee to be able to understand the claim without a need to refer to the description. Giving it the meaning it normally has in the relevant art, the wording "when required" in claim 1 in the board's view implies that in the course of carrying out the method it is determined, on the basis of unspecified criteria, whether or not the triggering step is to be carried out and that, if these criteria are met, the triggering step must be performed.

The board notes that claim 1 as filed includes the triggering step in question as one of four steps which are performed by the RAL system. However, claim 14 as filed (see above) provides a basis for a claim in which the above-mentioned triggering step is optional.

The term "optional" is understood by the board as referring to a matter of choice, not compulsion, i.e. something that may be done but need not. Hence, if a method step is defined as being optional, it is not compulsory that it is determined, on the basis of certain criteria, whether or not the step is to be carried out. Consequently, the term "optional" cannot be considered as having the same meaning as "when required". Claim 14 as filed does not therefore provide a basis for the wording "when required" in claim 1.

Page 20, lines 23 to 25, of the description as filed, as referred to by the appellant, reads as follows: "In cases where VPN components shall be used, as indicated in the user-defined profile, the RAL system then triggers the next step, the necessary procedures to establish a secure VPN session."

In the board's view, this passage describes a specific condition which is to be met in order for the RAL system to perform the triggering step, namely that the user-defined profile indicates that VPN components are to be used. Present claim 1 does not however include this specific condition.

2.4 The Board therefore concludes that the introduction of the wording "when required" in claim 1 results in a definition of a method which is an intermediate generalisation of the methods as disclosed in the application as filed and which is not directly and unambiguously derivable from the application as filed.

2.5 Claim 1 of the main request does not therefore meet the requirements of Article 123(2) EPC. The main request is therefore not allowable.

3. *First auxiliary request - Amendments (Article 123(3) EPC)*

3.1 Claim 1 of the first auxiliary request differs from claim 1 of the main request *inter alia* in that, in the last paragraph, the wording "when required" is replaced by "where VPN components shall be used, as indicated in the user-defined profile". The wording which was replaced was present in the last paragraph of claim 1 as granted.

3.2 The appellant argued that "where VPN components ..." as used in the present claim and "in cases where VPN components ..." as used at page 20, lines 23 to 25, of the description as filed were synonymous.

3.3 However, irrespective of whether or not "where VPN components ..." and "in cases where VPN components ..." are synonymous, in the board's view, due to the deletion of the wording "when required" from the last paragraph of claim 1 as granted, it is no longer implicit that in the course of carrying out the method it is determined, on the basis of unspecified criteria, whether or not the triggering step is to be carried out and that, if these criteria are met, the triggering step must be performed. Instead, the triggering step is now predetermined by the content of the user-defined profile. Whether or not the user-defined profile indicates that VPN components shall be used may therefore be determined separately from the claimed method, i.e. in advance, and, hence, need not be part of the claimed method. In this respect, whether or not "where VPN components ..." and "in cases of where VPN components ..." are synonymous, as argued by the appellant, is not relevant.

3.4 Claim 1 as granted has therefore been amended in such a way as to extend the protection conferred and, consequently, claim 1 of the first auxiliary request violates Article 123(3) EPC.

3.5 The first auxiliary request is therefore not allowable.

4. *Second auxiliary request - Amendments (Article 84 EPC)*

4.1 According to the second auxiliary request claim 1 as granted is amended *inter alia* in that in the last paragraph "when required" is replaced by the wording "when required, in cases where VPN components shall be used as indicated in the user-defined session profile".

4.2 In the board's view, this amendment results in an ambiguity in that it is unclear whether "when required" is to be read in conjunction with "in cases where VPN components shall be used as indicated in the user-defined session profile" so that the latter wording defines the criterion on the basis of which it is determined whether or not the triggering step is required, or is to be read separately and independently from the latter wording, i.e. two independent conditions are defined. In this latter case, it is unclear whether it would be sufficient for the triggering step to be performed if only one of the conditions is met or whether both conditions have to be met. Hence, the amendment made to claim 1 as granted results in a claim which is unclear.

4.3 Claim 1 of the second auxiliary request therefore does not meet the requirements of Article 84 EPC. The second auxiliary request is accordingly not allowable.

5. *Third auxiliary request - admissibility*

5.1 The third auxiliary request was filed during the oral proceedings before the board. In accordance with Article 13(1) of the Rules of Procedure of the Boards of Appeal (OJ EPO 2007, 536 ff.), any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. This discretion shall be exercised in view of, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Further, amendments sought to be made after oral proceedings have been arranged shall not

be admitted if they raise issues which the board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings (Article 13(3) RPBA).

5.2 In the board's view, and in line with the established case law of the boards of appeal, one of the criteria for admitting further amendments to the claims at a late stage of the appeal proceedings, in the present case in the course of the oral proceedings, is whether or not the claims are clearly allowable. In the board's judgement, claim 1 of the third auxiliary request is not clearly allowable for the following reason:

5.3 Claim 1 of the third auxiliary request differs from claim 1 as granted *inter alia* in that the feature "via a data communication technology device (403), where said data communication technology requires some set-up information and uses a specialised access network and dedicated gateways, said data communication technology hereafter being called Pseudo-Connectionless Technology ,PCT," is replaced by "via a GPRS device".

5.4 In support of this amendment, the appellant referred to page 3, lines 21 to 30, of the application as filed, which reads as follows:

"A wide range of fixed and mobile data communications technologies exists. All these technologies have in common that they are always connected but require some complex set-up information. In the following, these characteristics will be termed 'pseudo'-connectionless. These technologies have further in common that they use a specialised access network and use dedicated gateways

to access the Internet. These technologies will further on be termed Pseudo-Connectionless Technologies (PCT).

One such mobile data communications technology is the so-called GPRS technology."

Referring to this passage, the appellant argued that a person skilled in the art would understand that a GPRS device, used in a method for setting-up a remote and secure access session from a computer to a data communication network via this GPRS device, constituted a data communication technology device which required some set-up information and which used a specialised access network and dedicated gateways. The proposed replacement therefore met the requirements of Article 123(3) EPC.

5.5 Respondent 2, however, contested this and argued that the appellant's submission was merely an assertion and that, irrespective of what was disclosed in the application as filed, it was necessary to have available evidence showing that any GPRS device for use in a method for setting-up a remote and secure access session from a computer to a data communication network via the GPRS device was necessarily a data communication technology device which required some set-up information and which used a specialised access network and dedicated gateways, in order to be able to determine whether or not claim 1 complied with the requirements of Article 123(3) EPC.

5.6 In the board's view, evidence in support of the appellant's submission would indeed have been necessary if, as was the case here, it was contested by the other

party. Since the appellant was not in a position to provide this evidence at the oral proceedings, an adjournment of the oral proceedings would have been necessary, which the appellant did not request. In the absence of the required evidence, the board was not in a position to verify that the amendments made to claim 1 as granted did not result in an extension of the protection conferred by the patent as granted. Hence, at least *prima facie*, claim 1 of the third auxiliary request did not comply with the requirements of Article 123(3) EPC.

5.7 At the oral proceedings the appellant suggested a further amendment to claim 1 of the third auxiliary request according to which in the first characterising feature ", which is configured with" is replaced by "having". This suggested amendment did not however affect the above considerations. Nor did the appellant argue otherwise.

5.8 The board therefore concluded that claim 1 of the third auxiliary request was not clearly allowable and exercised its discretion pursuant to Article 13(1) RPBA not to admit the third auxiliary request to the appeal proceedings.

6. There being no allowable request for maintaining the patent in amended form, 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