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Datasheet for the decision of 19 January 2010

Case Number: T 1851/07 - 3.5.03

Application Number: 03014440.6

Publication Number: 1367846

IPC: H04Q 7/36

Language of the proceedings: EN

Title of invention:
PCS pocket phone/microcell communication over-air protocol

Applicant:
XIRCOM Wireless, Inc.

Opponent:
-

Headword:
Communication system/XIRCOM

Relevant legal provisions:
EPC Art. 113(1), 116(1)
EPC R. 115(2)

Relevant legal provisions (EPC 1973):
EPC Art. 76(1)

Keyword:
"Divisional application: added subject-matter (yes)"
"Absence of the appellant at oral proceedings"

Decisions cited:
-

Catchword:
-

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Case Number: T 1851/07 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 19 January 2010

Appellant: XIRCOM Wireless, Inc.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 21 May 2007 refusing European patent application No. 03014440.6 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

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

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European patent application No. 03014440.6, with publication number EP-A-1367846. This application is a divisional application of European patent application No. 95914135.9, published in accordance with the PCT as WO-A-95/26094.

The refusal was based on the ground that the subject-matter of claims 1 and 9 extended beyond the content of the application as filed, Article 123(2) EPC.

II. The appellant filed a notice of appeal against the above decision and paid the prescribed fee. Subsequently, the appellant filed a statement of grounds including claims 1-9 of a new main request.

The appellant requested that the impugned decision be set aside and a patent granted on the basis of the claims of the main request.

As an auxiliary request, the appellant requested that "In view of the lack of reasoning of the Examining Division regarding novelty and inventive step ... the application be remitted to the Examining Division for a full examination of novelty and inventive step".

Conditionally, oral proceedings were also requested.

III. The board issued a summons to attend oral proceedings. In a communication accompanying the summons, the board gave a reasoned preliminary opinion that, *inter alia*, claims 1 and 9 contained subject-matter which extended

beyond the content of the earlier (parent) application as filed, Article 76(1) EPC.

IV. No reply was received to the board's communication.

V. Oral proceedings were held on 19 January 2010 in the absence of the appellant. In accordance with the written submissions, the appellant requested that the decision under appeal be set aside and, as a main request, a patent be granted on the basis of claims 1-9 filed with the statement of grounds of appeal dated 20 September 2007. As an auxiliary request, the appellant requested that the case be remitted to the examining division for full examination of novelty and inventive step. At the end of the oral proceedings, the board announced its decision.

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

"A communication system comprising:

a plurality of user stations (102);

a plurality of base stations (104), each having a network independent format and each capable of communicating with at least one of the plurality of user stations using a spread-spectrum communication technique in time division duplex communication; and

a plurality of cells (103) each containing at least one of said base stations, each cell being defined by a combination of a spread-spectrum code group selected from a plurality of spread-spectrum code groups and a frequency group selected from a plurality of frequency

groups, wherein said cells are arranged in a repeating pattern according to said combination; characterised in that:

said base stations are adapted to translate over-the-air signalling traffic into internal communication messages for a base station controller; and by:

a base station controller (105, 407, 408) coupled to the base stations, the base station controller adapted to communicate with a plurality of different networks including a GSM network and an ISDN-based network, wherein the base station controller is adapted to translate said internal communication messages received from said base stations into signalling suitable for the GSM network or the ISDN-based network."

VII. Claim 9 of the main request reads as follows:

"A base station controller for use in a communication system comprising a plurality of user stations and a plurality of base stations, each capable of communicating with at least one of the plurality of user stations using a spread-spectrum communication technique in time division duplex communication and adapted to translate over-the-air signalling traffic into internal communication messages for the base station controller; wherein the base station controller is characterised in that:

it is coupled to the base stations;

it is adapted to communicate with a plurality of different networks including a GSM network and an ISDN-based network;

it is adapted to translate said internal communication messages received from said base stations into signalling suitable for the GSM network or the ISDN-based network."

Reasons for the decision

1. *Absence of the appellant at oral proceedings*

1.1 The board appointed oral proceedings in accordance with Article 116(1) EPC following a request from the appellant. Having verified that the appellant was duly summoned, the board decided to continue the oral proceedings in the absence of the appellant (Rule 115(2) EPC).

1.2 The reasons on which this decision is based were essentially communicated to the appellant in the communication accompanying the summons to oral proceedings. Hence, the appellant was in a position to comment on these reasons, either in writing, or at the oral proceedings if it had chosen to attend. The board was therefore in a position to issue a decision at the oral proceedings in compliance with Article 113(1) EPC.

2. *Article 76(1) EPC 1973*

2.1 According to Article 7 of the Act revising the EPC of 29 November 2000, the revised version of the Convention

shall apply to all European patent applications filed after its entry into force, as well as to all patents granted in respect of such applications. It shall not apply to European patents already granted at the time of its entry into force, or to European patent applications pending at that time, unless otherwise decided by the Administrative Council of the European Patent Organisation.

The Administrative Council has made no special transitional provisions for Article 76 EPC (cf. Article 1 of the decision of the Administrative Council of 28 June 2001 on the transitional provisions pursuant to the above-mentioned Article 7). Hence, Article 76(1) EPC 1973 applies to the pending application, although this is only a matter of formal correctness since there is no difference in substance between the old and the new versions.

Hence, in the following, references to Article 76(1) concern the EPC 1973.

2.2 In accordance with Article 76(1) EPC, "[a European divisional application] may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed". In the present case the earlier application is the application EP 95914135.9 (the "parent application"), published in accordance with the PCT as WO-A-95/26094, to which the board refers in this decision, noting however that only pages 1-268 (including original claims 1-9) and the drawings of WO-A-95/26094 are to be taken into account as content of the earlier application "as [originally] filed", since amended claims 2 and 9-113 of this

document (pages 269-306) were filed after the filing date.

2.3 In the board's view, claim 1 of the present divisional application does not comply with Article 76(1) EPC for the reasons set out in the following paragraphs.

2.4 The board finds that there is no basis in WO-A-95/26094 for the expression used in claim 1 "base stations, each having a network independent format". The only occurrence of the term "network independent format" appears to be on page 57, lines 22-23 of WO-A-95/26094, where it is used in connection with the format of the signalling traffic, called "Notes", passed between the base stations and the base station controller. The board cannot derive from the type of signalling traffic an implicit disclosure that the base stations themselves have a network independent format, all the more so since it is unclear what meaning and scope should be ascribed to the term "base station ... having a network independent format".

2.5 The board finds that there is no basis in WO-A-95/26094 for the reference in claim 1 to a cell defined by the combination of a spread spectrum code group selected from a plurality of spread spectrum code groups and a frequency group selected from a plurality of frequency groups. The only explicit reference to the frequency and code use in each cell appears to be on page 6, lines 7-18 in conjunction with Fig. 2-1, according to which each cell uses a combination of a single spread spectrum code and a single frequency, different to the frequency of adjacent cells. Furthermore, as the system described in the parent application is apparently a

proprietary system, the skilled person would not be led to read into this disclosure an implicit basis for an extension to the use of groups, eg based on common general knowledge relating to standard cellular systems.

2.6 The board finds that there is no basis in WO-A-95/26094 for the expression "internal communication messages" appearing in claim 1. On page 8, lines 7-10 of the parent application, it is disclosed that the signalling format conforms to a particular ISDN-based format called "Notes". There is no clear and unambiguous suggestion that any message communication format may be used. Hence claim 1 is broader than the disclosure of the parent application as originally filed.

2.7 The board finds that there is no clear and unambiguous basis in WO-A-95/26094 for the feature of claim 1 "a base station controller adapted to communicate with ... a GSM network and an ISDN-based network [by translating] internal communication messages received from said base stations into signalling suitable for the GSM network or the ISDN-based network". This feature embraces a base station controller (BSC) with direct connections to both a GSM network and an ISDN-based network. However, in Figs. 1-1 to 1-7 of WO-A-95/26094, a BSC is connected only to a single switch, which is either a GSM MSC (Figs. 1-1, 1-5), an AIN switch (Fig. 1-1), a PCSC or the PSTN (Figs. 1-2, 1-3, 1-6, 1-7), or a LEC or CAP based switch (Fig. 1-4) . Furthermore, no direct connection to an ISDN-based network is shown. Instead, Fig. 1-5 shows a connection to "other networks" indirectly via an MSC.

The appellant argues in the statement of grounds (albeit in connection with Article 123(2) EPC) that this feature is supported by the description on pages 8 and 9. However, in the board's view this passage discloses unambiguously only that the base station controller is connected directly (possibly by a plurality of links, including the X.25 link 114 shown in Fig. 1-2) to a single network 106, which may either be a PSTN or a personal communications switching centre (cf. WO-A-95/26094, page 8, lines 29-35). Fig. 1-1 discloses an environment in which each base station controller can be connected to a different respective network (in this case an AIN-based network or a GSM network), but there is no disclosure of a single base station controller able to connect directly to both a GSM network and an ISDN-based network.

Although it is stated on page 8, lines 5-7 that "The overall system thus provides flexibility to interface with a variety of different networks depending upon the desired application", this general statement is consistent with configuring a system as shown in Fig. 1-1, rather than a clear disclosure that one base station controller may be linked to two or more networks.

The appellant also refers to page 8, lines 17-22. However, this passage applies to the link between the base station and the base station controller and not to a connection to an external network such as a GSM network. Therefore, the board does not agree that pages 8 and 9 provide a basis for this feature of claim 1.

2.8 The board therefore concludes that claim 1 fails to comply with Article 76(1) EPC.

2.9 The same considerations apply, *mutatis mutandis*, to independent claim 9.

2.10 As neither claim 1 nor claim 9 is allowable, the main request as a whole is not allowable.

3. *Auxiliary Request*

3.1 As an auxiliary request, the appellant requests remittal to the examining division in view of the lack of reasoning regarding novelty and inventive step.

3.2 The board firstly notes that the alleged lack of reasoning regarding novelty and inventive step was not a procedural violation because it is explicitly stated in the impugned decision that the application was rejected based on Article 123(2) EPC alone. Hence there was no requirement to comment on novelty or inventive step.

3.3 Further, considering that there is no request which complies with Article 76(1) EPC, there would be no point in an examination of the claims with respect to novelty and inventive step, either by the board or the examining division. It follows that there is no reason to remit the case to the examining division. Hence, the auxiliary request for remittal is rejected.

Conclusion

As there is no allowable request, 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