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Datasheet for the decision of 17 November 2011

Case Number: T 1953/07 - 3.5.06

Application Number: 99309091.9

Publication Number: 1004966

IPC: G06F 13/40

Language of the proceedings: EN

Title of invention:
A method and apparatus for determining an address uniquely identifying a hardware component on a common bus

Applicant:
LUCENT TECHNOLOGIES INC.

Opponent:
-

Headword:
Hardware identification/LUCENT

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
EPC Art. 54
EPC R. 29(2)

Keyword:
"Novelty (main request) - no"
"Too many independent claims in same category (main request) - yes"
"Added subject-matter (auxiliary request) - yes"

Decisions cited:
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Case Number: T 1953/07 **-** 3.5.06

D E C I S I O N
of the Technical board of Appeal 3.5.06
of 17 November 2011

Appellant: LUCENT TECHNOLOGIES INC.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 16 July 2007 refusing European patent application No. 99309091.9 pursuant to Article 97(1) EPC 1973.**

Composition of the board:

Chairman: D. H. Rees
Members: G. Zucka
M-B. Tardo-Dino

Summary of Facts and Submissions

I. The appeal is against the decision by the examining division dispatched on 16 July 2007 to refuse European patent application 99309091.9 on the basis that the independent claims in the main request did not satisfy Rule 29(2) EPC 1973, that the subject-matter of claim 1 in the main request was not novel, Article 54 EPC 1973, and that the auxiliary request contained subject-matter which extended beyond the content of the application as filed, Article 123(2) EPC. The following document was cited in the decision:

D1: US 5 836 785 A.

II. A notice of appeal was received on 6 September 2007, the appeal fee being paid on the same day. A statement of the grounds of the appeal was received on 9 November 2007.

III. The appellant requested that the decision be set aside and the appeal procedure "based on the main request, description and drawings as currently on file". The appellant further requested that "the auxiliary request currently on file...be considered if the main request is not deemed acceptable to the Appeal Board".

IV. The board understands the appellant's main request to be that the decision under appeal be set aside and that a patent be granted on the basis of the documents already submitted to the examining division, ***viz.*** claims 1-19 filed with telefax on 23 November 2006; description pages 2, 4-7, 9 as originally filed and pages 1, 3, 3a, 8, 10 filed with telefax on 23 November

2006; drawing sheets 1/5-5/5 received on 20 December 1999.

The board understands the appellant's auxiliary request to be that a patent be granted on the basis of claims 1-19 filed with telefax on 4 June 2007, and the same description and figures as for the main request.

V. The independent claims of the main request read as follows:

Claim 1

"A method for determining an address that uniquely identifies a hardware component (200) on a common bus (115), said method characterized by the steps of:

reading identification information from a connector of said hardware component, said identification information having physical significance; and

deriving a bus address from said identification information that uniquely identifies said hardware component on said common bus"

Claim 3

"A system for determining an address that uniquely identifies a hardware component on a common bus, said system characterized by:

a memory (220) for storing computer readable code; and a processor (210) operatively coupled to said memory, said processor configured to:

read identification information from a connector of said hardware component, said identification information having physical significance; and

derive a bus address from said identification information that uniquely identifies said hardware component on said common bus"

Claim 10

"A method for determining the configuration of a plurality of hardware components installed on a larger piece of equipment, said method characterized by the steps of:

providing an identification value to each of said hardware components, said identification value having physical significance;

receiving physical identification information from each of said hardware components; and

determining how said plurality of hardware components are interconnected"

Claim 12

"A system for determining the configuration of a plurality of hardware components installed on a larger piece of equipment, said system characterized by:

a memory for storing computer readable code; and

a processor operatively coupled to said memory, said processor configured to:

provide an identification value to each of said hardware components, said identification value having physical significance;

receive physical identification information from each of said hardware components; and

determine how said plurality of hardware components are interconnected"

VI. The independent claims of the auxiliary request read as follows:

Claim 1

"A method for determining an address that uniquely identifies a hardware component (200) on a common bus (115), said method characterized by the steps of:

reading identification information from a connector of said hardware component, said identification information related to a configuration of one or more application-oriented system parameters and having physical significance; and

deriving a bus address from said identification information that uniquely identifies said hardware component on said common bus"

Claim 3

"A system for determining an address that uniquely identifies a hardware component on a common bus, said system characterized by:

a memory (220) for storing computer readable code; and

a processor (210) operatively coupled to said memory, said processor configured to:

read identification information from a connector of said hardware component, said identification information related to a configuration of one or more application-oriented system parameters and having physical significance; and

derive a bus address from said identification information that uniquely identifies said hardware component on said common bus"

Claim 10

"A method for determining the configuration of a plurality of hardware components installed on a larger piece of equipment, said method characterized by the steps of:

providing an identification value to each of said hardware components, said identification value related to a configuration of one or more application-oriented system parameters and having physical significance;

receiving physical identification information from each of said hardware components; and

determining how said plurality of hardware components are interconnected"

Claim 12

"A system for determining the configuration of a plurality of hardware components installed on a larger piece of equipment, said system characterized by:

a memory for storing computer readable code; and a processor operatively coupled to said memory, said processor configured to:

provide an identification value to each of said hardware components, said identification value related to a configuration of one or more application-oriented system parameters and having physical significance;

receive physical identification information from each of said hardware components; and

determine how said plurality of hardware components are interconnected"

Reasons for the decision

1. Reference is made to the transitional provisions in Article 1 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000, for the amended and new provisions of the EPC, from which it may be derived which Articles of the EPC 1973 are still applicable to the present application and which Articles of the EPC 2000 shall apply.

2. *The admissibility of the appeal*

In view of the facts set out at points I and II above, the appeal is admissible, since it complies with the EPC formal admissibility requirements.

3. *The procedural steps*

According to Article 113 EPC, the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. As stated by the Enlarged Board in G04/95, OJ 1996, 412, section 4(c) of the Reasons, "oral proceedings shall take place either at the instance of the EPO, or at the request of any party to the proceedings. Thus oral proceedings are an optional extra. Both opposition and opposition appeal procedures are primarily written procedures". *A fortiori*, the same

is true for ex parte appeal procedures. It means that, when the grounds and evidence on which the board bases its decision have already been addressed in the written submissions of the concerned party, its right to be heard is fully satisfied without any obligation for the board to schedule oral proceedings that have not been requested.

This is precisely the case in the current appeal proceedings. The board has established that all the grounds and evidence necessary to take a decision in the present case (see 4.1 and 5 below) have already been introduced by the first instance. The appellant and sole party has, therefore, had an opportunity to present his comments on these grounds and evidence. The appellant has further not requested an opportunity to present his arguments during oral proceedings, either conditionally or unconditionally, which could have led the board to assume that oral proceedings may have been of critical importance to the decision-making process. For these reasons, the board did not consider it appropriate to issue a summons to oral proceedings or to send a communication prior to taking its decision.

4. *Main request*

4.1 *Novelty; Article 54 EPC 1973*

As set out in the appealed decision (point 2.1), D1 discloses (the references in parentheses applying to D1)

a method for determining an address that uniquely identifies a hardware component on a common bus (see figure 2A: the hardware components visible on the figure are designated by reference numbers 251 and 252,

and the common bus is designated by the reference number 200), the method comprising the steps of:

reading identification information from a connector of said hardware component (column 3, lines 31-45); and

deriving a bus address from said identification information that uniquely identifies said hardware component on said common bus (column 5, lines 29-45).

The board notes that the appellant does not contest the disclosure of these features by D1.

In addition, as is also set out in the appealed decision, the identification information in D1 has physical significance (more specifically, it is a voltage level; see column 3, lines 37-41).

Whilst not contesting that a voltage level has physical significance *in se*, the appellant maintains that, within the context of the present application, the physical significance is related to, for example, the carrier frequency, frame, sector number (such as α, β, γ), unit type and unit number associated with the hardware component. According to the appellant, the wording "physical significance" does not have a well known definition in the art and, therefore, a person of ordinary skill in the art would look to the detailed description of the present application for its meaning.

The board does not agree. The question is not whether an expression has "a well known definition in the art" but rather whether the skilled person would derive a clear meaning from it. In this case, "having physical significance" is extremely broad but not unclear. The

appellant seeks protection for identification values having any physical significance, whatever it may be. The argument that the examples in the description are considerably narrower does not persuade the board that the appellant intended to claim anything other than the plain meaning of the expression. Further, the appellant has not pointed to any statement in the application as filed which could give any hint that this expression was intended to be more limited than its plain meaning in any way.

The board concludes that the reasoning given in the appealed decision is correct and complete, in spite of the appellant's counterarguments. This means that, as set out in the appealed decision, D1 discloses, in combination, all the features of claim 1 and the subject-matter of that claim is, consequently, not novel (Article 54 EPC 1973).

4.2 For this reason, the main request is not allowable. Furthermore, the decision under appeal should also be upheld as far as the issue of plural independent claims in the same category is concerned.

4.3 *Independent claims in the same category; Rule 29(2) EPC 1973*

As set out in the appealed decision (point 1), the subject-matter claimed in the independent method claims 1 and 10, as well as the subject-matter claimed in the independent apparatus claims 3 and 12, does not involve any of the exceptions (a), (b) or (c) mentioned under Rule 29(2) EPC 1973.

According to the appellant, the independent claims in each category involve "a plurality of interrelated products" (Rule 29(2)(a) EPC 1973), the tasks in claims 1 and 10 both being related to managing and operating hardware components; in claim 1 by *providing* an identification value having physical significance to each hardware component, and in claims 1 and 10 by *reading/receiving* identification information having physical significance. The appellant points out that, in order for information to be read by a component, it must be provided by a component and, thus, the step of reading requires a complement or cooperation for the step of providing.

The board, however, holds the view, as did the first instance, that the mere fact that the information provided is the same as that which is read is not sufficient to demonstrate the presence of an interrelationship in the sense of Rule 29(2)(a) EPC 1973. The remainder of the claims' wording can not be left aside when arguing that such an interrelationship exists. For example, in order for the subject-matter in two independent claims to be considered interrelated, there should, at the very least, be no discrepancy in the wording that is used to define those elements in the subject-matter in each of these claims that would be identical in view of the nature of the interrelationship. This is clearly not the case for respectively claims 1 and 10. Indeed, claim 1 relates to "a method for determining an address that uniquely identifies a hardware component on a *common bus*", whereas claim 10 relates to "a method for determining the configuration of a plurality of hardware components installed on a *larger piece of*

equipment". The appellant has provided no reason why, although the subject-matter of both claims is, allegedly, interrelated, the component in claim 1 is on a bus, whereas the components in claim 10 are on a "larger piece of equipment", which may or may not be a bus.

The same applies to independent system claims 3 and 12.

The appellant has, thus, not provided any counterarguments that successfully rebut the arguments given in the appealed decision and that would thereby show that the presence of two independent claims in, respectively, the method and the apparatus category is, or possibly could be, justified. The board, therefore, concludes that the main request does not satisfy the requirements of Rule 29(2) EPC 1973.

5. *Auxiliary request*

As set out in the appealed decision (point 3), the [original] application does not directly and unambiguously disclose the feature that has been added to the independent claims (claims 1, 3, 10 and 12), *i.e.* that the identification information is "related to a configuration of one or more application-oriented system parameters", even when account is taken of matter which is implicit to the skilled person.

According to the appellant, the carrier frequency, frame, sector number, unit type and unit number associated with a hardware component (page 3, lines 24-26 of the original description) are *parameters* that are related to the *configuration* of the hardware

components. The hardware components, *e.g.* "circuit packs", are utilised for communicating with cellular telephone units or for communicating on a T1 line with a switch of the PSTN (page 1, line 26, - page 2, line 8 of the original description). The hardware components are, therefore, elements of the cell station (the *system*) and are utilised for the principal *application* of the system (cellular communications). The cited parameters are, therefore, *application-oriented system parameters*.

In view of the board, this demonstrates, at best, that the "illustrative embodiment" mentioned in said passage falls under the given definition, *i.e.* that the identification information is "related to a configuration of one or more application-oriented system parameters", or at least that it does not contradict said definition. The appellant has, however, given no justification for generalising the given embodiment to the wording that has been added to the independent claims, for example by mentioning alternative embodiments in the original application, that would "relate identification information to a configuration of application-oriented system parameters" in a different manner than in the cited passage.

The reasoning given in the appealed decision has, thus, not been refuted by the appellant's counterarguments. This means that, as set out in the appealed decision, the auxiliary request contains subject-matter that extends beyond the content of the application as filed (Article 123(2) EPC).

The appellant's auxiliary request is, therefore, not allowable.

6. *Conclusion*

For the reasons given in 4 and 5 above, none of the appellant's requests is allowable.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

B. Atienza Vivancos D. H. Rees