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Case Number: T 0137/08 - 3.5.03

Application Number: 97908407.6

Publication Number: 0890269

IPC: H04Q 3/00

Language of the proceedings: EN

Title of invention:
Peripheral control in an intelligent network

Patentee:
BRITISH TELECOMMUNICATIONS public limited company

Opponent:
Alcatel Lucent

Headword:
Intelligent network/BRITISH TELECOM

Relevant legal provisions:
EPC Art. 54, 84, 100(a), 101(3)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Novelty (main request - no)"
"Clarity and admissibility (auxiliary requests - no)"

Decisions cited:
-

Catchword:
-

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Case Number: T 0137/08 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 19 March 2009

Appellant: (Patent Proprietor)	BRITISH TELECOMMUNICATIONS public limited company 81 Newgate Street London EC1A 7AJ (GB)
Representative:	Williamson, Simeon Paul BT Group Legal Intellectual Property Department PP C5A BT Centre 81 Newgate Street London EC1A 7AJ (GB)
Respondent: (Opponent)	Alcatel Lucent 54 rue La Boétie F-75008 Paris (FR)
Representative:	Schätzle, Albin Alcatel Lucent Intellectual Property & Standards D-70430 Stuttgart (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 21 November 2007 revoking European patent No. 0890269 pursuant to Article 102(1) EPC 1973.**

Composition of the Board:

Chairman: A. S. Clelland
Members: T. Snell
R. Moufang

Summary of Facts and Submissions

I. This appeal was lodged by the proprietor against the decision of the opposition division revoking European patent No. EP 0890269 on the ground that claim 1 of the granted patent lacked novelty (Article 100(a) in combination with Articles 52(1) and 54 EPC). The decision was based on the disclosure of two documents relating to the standard for the "Intelligent Network Application Protocol" (INAP), of which only the following is relevant to this decision:

D3: ITU-T Recommendation Q.1218, "Interface Recommendation for Intelligent Network CS-1" (10/95), pages 1,3,13,14,29,142-145 and 236-242

II. In the notice of appeal, the appellant requested that the impugned decision be set aside and that the patent be maintained. Claims of first to fourth auxiliary requests were filed with a statement of grounds.

In a response to the notice of appeal, the opponent (respondent) requested that the appeal be dismissed.

Both parties conditionally requested oral proceedings.

III. In a communication accompanying a summons to attend oral proceedings, the board gave a preliminary opinion that, *inter alia*, the subject-matter of claim 1 of the main request was not new with respect to the standardized INAP protocol as disclosed in D3. Matters relating to novelty, clarity and added subject-matter were also raised in connection with various of the

independent claims of the first to fourth auxiliary requests.

IV. In a response to the board's communication, the appellant filed claims of amended first to third auxiliary requests together with arguments.

V. Oral proceedings took place on 19 March 2009.

The appellant requested that the decision under appeal be set aside and the patent maintained as granted (main request) or, in the alternative, in amended form on the basis of the first, second or third auxiliary requests, all filed with letter dated 19 February 2009. The fourth auxiliary request filed with the statement of grounds was withdrawn.

The respondent requested that the appeal be dismissed.

At the conclusion of the oral proceedings, after due deliberation, the board gave its decision.

VI. Claim 1 of the **main request** (ie claim 1 of the patent as granted) reads as follows:

"A method of operating an intelligent peripheral (IP) under the control of a service control point (SCP) in a telecommunications intelligent network, including passing control messages conforming to a standard protocol from the service control point to the intelligent peripheral, and executing on the intelligent peripheral in response to at least some of the control messages predetermined functions provided for in the said standard protocol,

characterised in that one or more of the control messages conforming to the standard protocol include a field identifying the messages as relating to an additional function not provided for in the standard protocol, and by executing on the intelligent peripheral in response to a message including the said field a routine implementing the additional function."

VII. Claim 1 of the **first auxiliary request** reads as follows:

"A method of operating an intelligent peripheral (IP) under the control of a service control point (SCP) in a telecommunications intelligent network, including: passing control messages conforming to a standard Intelligent Network Application protocol from the service control point to the intelligent peripheral, and executing on the intelligent peripheral in response to at least some of the control messages predetermined functions provided for in the said standard protocol, characterised in that
one or more of the control messages conforming to the standard protocol include an extension field identifying the messages as relating to an additional function not provided for in the standard protocol said control messages conform to, and by executing on the intelligent peripheral in response to a message including the said field a routine implementing the additional function instead of any of said predetermined functions provided for in the said standard protocol that the intelligent peripheral executes in response to said at least some of the plurality of control messages.

VIII. Claim 1 of the **second auxiliary request** differs from claim 1 of the first auxiliary request in that the final clause of the claim reads as follows:

"and by executing on the intelligent peripheral in response to a message including the said field a routine implementing the additional function instead of any of said predetermined functions provided for in the said standard protocol that the intelligent peripheral executes in response to said at least some of the plurality of control messages and that an operation conforming to the standard protocol carrying the extension field suggests."

IX. Claim 1 of the **third auxiliary request** differs from claim 1 of the second auxiliary request in that the following wording is added to the end of the claim:

"wherein the operation carrying the extension field is a PlayAnnouncement or PromptAndCollectUserInformation operation that the said standard intelligent network application protocol provides for the service control point to access on the intelligent peripheral, wherein the standard Intelligent Network Application protocol comprises the protocol set out in the Intelligent Nework *[sic]* Capability Set CS1 of the ETS 300 374-1 standard document."

X. Dependent claims 5-8 of each request read as follows:

"5. A method according to any one of the preceding claims, in which any data collected by an additional function is returned in the form of an

argument of one of the predetermined functions provided for in the said standard protocol.

6. A method according to claim 5 when directly or indirectly dependent on claim 2, in which the collected data is returned as the argument of a PromptAndCollectUserInformation function.

7. A method according to any one of the preceding claims, in which the step of executing the additional function includes carrying out an in-band interaction with a user connected to the intelligent peripheral via an SSP.

8. A method according to claim 7, in which the additional function includes a voice recognition function."

Reasons for the decision

1. *Novelty (claim 1 - main request)*

1.1 The patent in suit relates to a telecommunications system using an intelligent network architecture. It concerns in particular control messages passed from a service control point (SCP) to an intelligent peripheral (IP).

1.2 Document D3, which is cited in the patent, is part of the standardization of the Intelligent Network Application Protocol INAP. Document D3 mentions two standard operations carried out by intelligent peripherals, namely "PlayAnnouncement" and "PromptAndCollectUserInformation" (hereinafter referred

to as "PA" and "P&C" respectively). These operations are carried out in response to INAP control messages transmitted by the SCP to the IP. As mentioned in the description (cf. paragraph 0009), "this [INAP] protocol includes an unassigned field, the extension field, in messages passed between the IP and SCP. Conventionally this extension field would be used for passing additional data or parameters to one of the standard functions of the IP. In the preferred implementation of the present invention, this field is used instead as the identifier for messages invoking one or more additional functions available on the IP [by] the SCP".

1.3 In the view of the board, claim 1 of the main request is so broad as to embrace the conventional use of the extension field set out in the standard.

1.4 Using the language of claim 1, document D3 discloses a method of operating an intelligent peripheral (IP) under the control of a service control point (SCP) in a telecommunications intelligent network, including passing control messages conforming to a standard protocol ("Intelligent Network Application Protocol, INAP") from the service control point to the intelligent peripheral (intelligent peripherals and service control points are implicit elements of an intelligent network), and executing on the intelligent peripheral in response to at least some of the control messages predetermined functions provided for in the said standard protocol ("PlayAnnouncement" and "PromptAndCollectUserInformation", cf. page 29), wherein

one or more of the control messages include a field ("extensions marker", cf. page 14, paragraph 0.7.2.2, relating to "minor additions to INAP") identifying the messages as relating to an addition not provided for in the standard protocol (future standardized additions are not part of the basic protocol).

1.5 In paragraph 0.7.2.2, it is not explicitly stated that the additions are additional functions.

However, in paragraph 0.7.1 it is stated that a minor change can be defined as a change of a functionality which is not essential for the requested IN service, and that the change [of functionality] may be purely additional. Reading this paragraph in combination with paragraph 0.7.2.2 leads to the conclusion that "minor additions to INAP" embrace "additional functions".

1.6 Claim 1 further requires that the one or more messages including the field relating to the additional function conform to the standard protocol.

In this respect, it is stated in paragraph 0.7.1 that the peer Application Entity [of the intelligent peripheral] need not know about the effects of the change. In paragraph 0.7.2.2 it is stated that "When an entity receives unrecognized parameters that occur after the [extensions] marker, they are ignored". In the board's view these passages teach that an intelligent peripheral operating according to the basic standard is intended to be able to receive and process a control message of a later version of the standard which has an extensions marker. However, the extension is ignored and only the basic functionality carried out

(backward compatibility). Hence such extended control messages still "conform" to the basic standard as well as the later version.

1.7 The only remaining feature of claim 1 is the step of "executing on the intelligent peripheral in response to a message including the said field a routine implementing the additional function". In document D3 it is however implicit that the additional function ("modified variant", cf. paragraph 0.7.1) is carried out by intelligent peripherals able to receive and process the extension.

1.8 Thus in the board's view document D3 discloses all the features of claim 1. The board therefore concludes that the subject-matter of claim 1 of the main request is not new (Articles 52(1) and 54 EPC).

1.9 The appellant's principal arguments in favour of the novelty of the subject-matter of claim 1 were understood by the board to be as follows:

The board has not taken into account the provision of Article 69(1) EPC that the description should be used to interpret the claims. In the light of the description, the skilled person would understand that claim 1 discloses a new mechanism for delivering an additional function which differs from that disclosed in D3. According to this new mechanism, a control message has two separate identities. The first identity is associated with a first function used by an operation complying with the standard protocol, ie PA or P&C. This first function is defined in the main body of the control message. The second identity is

associated with a different function not used by an operation provided for by the standard protocol, ie not used by a PA or P&C operation. A "delete message" operation is an example of such an additional function. The function/operation corresponding to the second identity is transmitted in the extension field provided for in the standard protocol. If an intelligent peripheral receives a control message with such an extension field, the operation/function according to the second identity is performed. Optionally, the operation/function according to the first identity may be performed as well, but the two operations are distinct and self-contained. This is different to the use of the extension field in D3 because in D3 the additional functionality provided by the extension field concerns only minor additions associated with the function/operation identified in the main body of the control message, which must always be carried out. Thus, in D3, the control messages have only a single identity related to a single operation/function. Furthermore, the second identity provides a major functional addition as opposed to the minor additions possible in accordance with the INAP extension mechanism. According to INAP, major changes require a new "application context" to be negotiated between the SCP and the IP. The invention on the other hand "disguises" major additions in a standard message without requiring a new application context.

1.10 In accordance with Article 84 EPC, "The claims shall define the matter for which protection is sought". In, the board's view, the claims as far as possible should be clear by themselves (cf. the Guidelines for Examination, C-III, 4.1 and 4.2). In connection with

Article 69(1) EPC, it is however established case law that the description may be used to either interpret an ambiguous term, or to give a term a special meaning different to its normal meaning where the description makes this clear. In the present case, in the board's view, neither of these criteria apply. Firstly, the expressions used in claim 1 "additional function", "standard protocol", and "not provided for in the standard protocol", although broad, are not as such unclear, and the board finds the entire claim to be comprehensible without recourse to the description. Secondly, there is no clear and unambiguous indication in the description that these terms should be given a special meaning different to their normal meaning. In fact, referring to paragraphs 2.1-2.9 below in connection with the meaning of the term "additional function", it appears from the description that "minor" enhancements to an existing function are also envisaged, contradicting the appellant's argument that in the light of the description the term "additional function" unambiguously concerns "major" functional additions. In this light, the board does not agree with the appellant that the terms "additional function", "standard protocol", and "not provided for in the standard protocol" are required to be interpreted more narrowly than the interpretation given them by the board in sections 1.4 to 1.7 above.

1.11 The appellant also argued that since D3 is a document describing a standard protocol, everything disclosed in this document is by implication part of the standard protocol. Hence D3 by its very nature cannot anticipate a function "not provided for in the standard protocol".

The board however does not find this argument convincing. Although the basic standard protocol provides a standardized mechanism (extension field) for delivering additional functionality, it does not define the additional functionality itself. Hence, such additional functionality is not provided for by this basic version and can only be performed by equipment operating a later version of the protocol.

1.12 The appellant also argued that the subject-matter of claim 1 was new with respect to D3 because the control messages of the preamble and the characterising part of claim 1 are required by the claim to conform to the same standard. In contrast, in D3 control messages incorporating an extension conform to a different (later) version of the standard as compared to the control messages conforming to the basic standard.

The board does not accept this argument because control messages incorporating the standardized extension mechanism are required to be backward compatible. Thus such control messages conform to the basic protocol version as well as to the later version (cf. point 1.6 above).

1.13 Since claim 1 of the granted patent is not allowable, the patent cannot be maintained in the version as granted (Article 100(a) EPC in combination with Articles 52(1) and 54 EPC). The appellant's main request is therefore not allowable.

2. *First to third auxiliary requests - clarity and admissibility*

2.1 Although clarity is not a ground of opposition, Article 101(3) EPC requires that if a patent is amended during opposition proceedings, it must meet the requirements of the EPC. In consequence, the board has to determine, *inter alia*, whether the amendments comply with Article 84 EPC.

2.2 Claim 1 of each of the first to third auxiliary requests includes the step "executing .... a routine implementing the additional function instead of any of said predetermined functions provided for in the said standard protocol ...." (board's underlining).

2.3 In the view of the appellant this wording means that only the function defined in the extension field is executed and that the standardized function defined in the main body of the control message is not executed. The amendment is allegedly based on paragraph 0007 of the description of the patent, which reads "The intelligent peripheral then responds by executing application code performing an appropriate one of the additional functions instead of the relevant standard function", and paragraph 0025, which reads "The IP then runs the dialogue indicated by the sub-field “dialogue identifier” contained within the extension field, instead of the standard dialogues the operation carrying this extension suggest ... ie PA or P&C".

2.4 However, in the board's view the meaning to be ascribed to amended claim 1 of each auxiliary request and the above-mentioned passages of the description is not

clear, particularly in the light of the detailed embodiments disclosed in paragraphs 0026-0028 of the description. Moreover, the interpretation of this limitation is crucial for examining these claims in respect of novelty.

2.5 Paragraph 0026 describes an embodiment in which P&C operation is enhanced by a voice recognition function. This embodiment is also the subject-matter of dependent claims 5-8. In accordance with claims 5 and 6, the data collected by an additional function is returned in the form of an argument of the P&C function provided for in the standard protocol. This embodiment appears to the board to relate to the same use of the extension field as provided for in D3, in that the additional function (voice recognition) enhances the function defined in the main body of the control message (P&C). In any event, the P&C operation must be carried out.

Paragraphs 0027 and 0028 describe the second detailed embodiment enabling an intelligent peripheral to function as a messaging platform. Three functions (referred to as "dialogues") are mentioned, namely "record message", "play back message", and "delete message". The board understands from paragraph 0028 that the "play back" message is an enhanced PA function enabling the message to be returned as a fax or in other formats in addition to the speech format of the standard PA operation. The board also finds the respondent's view plausible that the functions "record message" and "delete message" are enhanced versions of the P&C function. Hence it seems likely that this embodiment also requires the function specified in the main body of the control message to be carried out.

2.6 The board therefore considers that there is no clear disclosure of a detailed embodiment in which only the function specified in the extension field is carried out without the function defined in the main body of control message. Moreover, the expression "executing .... a routine implementing the additional function instead of any of said predetermined functions provided for in the said standard protocol ....", given the interpretation submitted by the appellant, would be incompatible at least with the detailed P&C embodiment described in paragraph 0026 and claimed in dependent claims 5-8.

2.7 The appellant argued that it was not necessary to provide detailed embodiments covering the whole ambit of the claims. It was clear from the wording of paragraphs 0007 and 0025 that "instead of" meant that only the additional function included in the extension field was executed.

2.8 The board however disagrees that this is unambiguously the intended meaning, since the term "additional function" in this context can equally well be understood as the enhanced function created by varying the standard function specified in the main part of the control message using data transmitted in the extension field. Hence, "executing the additional function instead of the standard function" embraces simply replacing the standard function by the enhanced function as defined above. Moreover, the fact that the enhanced play announcement operation described in paragraph 0026 is consistent with this interpretation and immediately follows the second passage relied on by

the appellant in paragraph 0025 gives this added plausibility.

2.9 The board therefore concludes that the expression "executing .... a routine implementing the additional function instead of any of said predetermined functions provided for in the said standard protocol ...." appearing in claim 1 of each auxiliary request is not clear. These claims therefore fail to comply with Article 84 EPC.

This lack of clarity applies *mutatis mutandis* to the remaining independent claims of each request.

2.10 As the independent claims of the first to third auxiliary requests do not meet the requirement of clarity, Article 84 EPC, the board decided not to admit these auxiliary requests.

3. Since the main request is not allowable and there is no further admissible request, 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