

**Internal distribution code:**

- (A)  Publication in OJ  
(B)  To Chairmen and Members  
(C)  To Chairmen  
(D)  No distribution

**Datasheet for the decision  
of 29 July 2010**

**Case Number:** T 0876/08 - 3.5.03

**Application Number:** 99973969.1

**Publication Number:** 1157531

**IPC:** H04M 3/487

**Language of the proceedings:** EN

**Title of invention:**

Method and device for generating voice/text/image commercial information ringback tone during communication wait

**Patentee:**

Ringfree Co., Ltd.

**Opponent:**

T-Mobile International AG & Co. KG  
T-Mobile (UK) Ltd  
FRANCE TELECOM  
VODAFONE GROUP PLC

**Headword:**

Commercial information ringback tone/RINGFREE

**Relevant legal provisions:**

EPC Art. 100(c), 123(2), 123(3)

**Relevant legal provisions (EPC 1973):**

-

**Keyword:**

"Added subject-matter - main request, auxiliary requests 1 to 4, 4A, 5 to 7, 7A, 10 to 12 (yes)"  
"Extension of protection conferred - auxiliary requests 8 and 9 (yes)"  
"Reimbursement of appeal fee (no)"

**Decisions cited:**

T 0308/05, J 0030/94, J 0038/97

**Catchword:**

-



Case Number: T 0876/08 - 3.5.03

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.03**  
**of 29 July 2010**

**Appellant:**  
(patent proprietor) Ringfree Co., Ltd.  
22-217 Ho, Anyang International logistics  
complex  
555-9 Hokyedong Donganggu  
Anyang  
Kyoungkido (KR)

**Representative:**  
Bethenod, Marc  
Novagraaf Technologies  
122, rue Edouard Vaillant  
F-92593 Levallois-Perret Cedex (FR)

**Respondent 1:**  
(opponent 1) T-Mobile International AG & Co. KG  
Landgrabenweg 151  
D-53227 Bonn (DE)

**Representative:**  
Riebling, Peter  
Patentanwalt  
Rennerle 10  
D-88131 Lindau (DE)

**Respondent 2:**  
(opponent 2) T-Mobile (UK) Ltd  
Imperial Place, Maxwell Road  
Borehamwood, Hertfordshire WD6 1EA (GB)

**Representative:**  
Slingsby, Philip Roy  
Page White & Farrer  
Bedford House  
John Street  
London, WC1N 2BF (GB)

**Respondent 3:**  
(opponent 3)  
FRANCE TELECOM  
6 Place d'Alleray  
F-75015 Paris (FR)

**Representative:**  
Thiel, Frédéric  
France Télécom/FTR&D/PIV/brevets  
38-40, rue du Général Leclerc  
F-92794 Issy-les-Moulineaux Cedex 9 (FR)

**Respondent 4:**  
(opponent 4)  
VODAFONE GROUP PLC  
Vodafone House  
The Connection  
Newbury, Berkshire RG14 2FN (GB)

**Representative:**  
Keston, David Arthur  
Vodafone Group Services Ltd.  
Group Legal (Patents)  
Babbage House  
The Connection  
Newbury, Berkshire RG14 2FN (GB)

**Decision under appeal:** **Decision of the opposition division of the European Patent Office posted 3 March 2008 revoking European patent No. 1157531 pursuant to Article 101(3)(b) EPC.**

**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. 1 157 531 B which is based on European patent application 99 973 969.1 which was published as international application WO 01/06735 A pursuant to Article 158(1) 1973 EPC.
- II. Four notices of opposition had been filed. The opposition division held, *inter alia*, that claim 1 of a main request and auxiliary requests 1 to 4, 4A, 5 to 7 and 7A did not meet the requirement of Article 123(2) EPC and that claim 1 of auxiliary requests 8 and 9 did not meet the requirement of Article 123(3) EPC.
- III. The proprietor (appellant) lodged an appeal. In the statement of grounds of appeal the appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of the main request or one of the auxiliary requests 1 to 4, 4A, 5 to 7, 7A, 8 and 9, in this order of preference, all as considered by the opposition division and as resubmitted with the statement of grounds of appeal. Further, the appellant requested that the appeal fee be reimbursed in view of a substantial procedural violation committed by the opposition division. Oral proceedings were conditionally requested.
- IV. In response to the statement of grounds of appeal, opponent 1 (respondent 1) and opponent 2 (respondent 2) each filed observations and in essence requested that the appeal be dismissed. Respondent 2 conditionally requested oral proceedings. Opponents 3 and 4

(respondents 3 and 4, respectively) made no submissions in response to the statement of grounds of appeal.

V. The parties were summoned by the board to oral proceedings. In a communication accompanying the summons, the board informed the parties, *inter alia*, that at the oral proceedings the opposition ground pursuant to Article 100(c) EPC would be discussed and that, if the main request were held not to be allowable, it would be necessary to discuss whether or not the amendments made to the claims of the auxiliary requests complied with the requirements of Articles 84 and 123(2) and (3) EPC.

VI. In response to the summons, respondent 4 informed the board that it would not be represented at the oral proceedings and requested that the decision of the opposition division be upheld. Further auxiliary requests were made for consideration by the board in the event that the board were to decide to remit the case to the department of first instance or if the board were to consider at the oral proceedings the opposition ground concerning novelty and inventive step.

VII. Oral proceedings were held on 29 July 2010 in the absence of respondent 4.

In the course of the oral proceedings the appellant filed auxiliary requests 10 to 12.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of the main request or one of the auxiliary requests 1 to 4, 4A, 5 to 7, 7A, 8 and 9, in

this order of preference, all as considered by the opposition division, or on the basis of the auxiliary request 10, 11 or 12 as filed during the oral proceedings. Further, the appellant requested that the appeal fee be reimbursed.

Respondents 1, 2 and 3 requested that auxiliary requests 10 and 11 be rejected as late filed and that the appeal be dismissed.

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

VIII. Claim 1 of the main request is identical to claim 1 as granted and reads as follows:

"A method for providing commercial information instead of original ringback tone to an originating side in at least one form of a voice, a text and/or image from a commercial information generating system in a communication system, the method comprising the steps of:

providing the commercial information to an originating side when receiving an originating call from the originating side;

requesting a call connection between a terminating side and the originating side; and

stopping to provide the commercial information and connecting a communication line between the originating side and the terminating side if the terminating side accepts the connection request;

**characterized in that**

the call connection to the terminating side is requested after a first predetermined time; and

the provision of the commercial information is also stopped and a relay line between the originating side and the terminating side is connected if a second predetermined time lapses during the connection request."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request only in that the last paragraph is amended to read as follows (amendments underlined by the board):

"the provision of the commercial information is also stopped and a relay line between an originating switch system of the originating side and a terminating switch system of the terminating side is connected if a second predetermined time lapses during the connection request."

Claim 1 of auxiliary request 2 differs from claim 1 of the main request only in that the last paragraph is amended to read as follows (amendment underlined by the board):

"the provision of the commercial information is also stopped and a relay line between the originating side and the terminating side is connected if a second predetermined time lapses during the connection request, since the connection request begins."

Claim 1 of auxiliary request 3 differs from claim 1 of the main request in that the characterising portion is amended to read as follows (amendments underlined by the board):



"the call connection to the terminating side is requested after a first predetermined time; and the method comprises a step of checking whether a second predetermined time lapses since the commercial information is provided if the call connection request is not accepted;

the provision of the commercial information is also stopped and a relay line between the originating side and the terminating side is connected if the second predetermined time lapses during the connection request."

Claim 1 of auxiliary request 4 combines the features of claim 1 of auxiliary requests 1 and 2.

Claim 1 of auxiliary request 4A differs from claim 1 of auxiliary request 4 in that the following feature is added at the end of the claim:

", if the connection request didn't fail within the second predetermined time."

Claim 1 of auxiliary request 5 combines the features of claim 1 of auxiliary requests 1 and 3.

Claim 1 of auxiliary request 6 combines the features of claim 1 of auxiliary requests 2 and 3.

Claim 1 of auxiliary request 7 combines the features of claim 1 of auxiliary requests 1, 2 and 3.

Claim 1 of auxiliary request 7A differs from claim 1 of auxiliary request 7 in that the following feature is added at the end of the claim:

", if the connection request didn't fail within the second predetermined time."

Claim 1 of auxiliary request 8 reads as follows:

"A method for providing commercial information instead of original ringback tone to an originating telephone in at least one form of a voice, a text and/or image from a commercial information generating system in a communication system, the method comprising the steps of:

(a) checking a telephone call (S1), connecting with an information generating system at an originating or a receiving communication system when the call is detected (S2), beginning to transmit the commercial information instead of the original ringback tone to the originating side telephone from the information generating system during a communication wait (S3), requesting a connection to a receiving telephone from the information generating system after a first predetermined time lapses (S4), and continuously transmitting the commercial information to the originating telephone (S5);

(b) checking whether the receiving telephone accepts the connection request (S6), checking whether a second predetermined time lapses since the commercial information is provided if the connection request is not accepted (S11), checking whether a telephone connection fails if within the second predetermined time (S14) and continuously providing the commercial information to the originating telephone if the telephone connection does not fail (S15);

(c) stopping the providing of the commercial information if the telephone connection is made (S7), connecting a communication line between the originating telephone and the receiving telephone (S8), checking whether the communication is finished (S9), and disconnecting the communication line if the communication finishes (S10);

(d) stopping the sending of the commercial information if the second predetermined time lapses since the connection request begins (S12), and connecting a relay line between an originating switch system and a receiving switch system (S13)."

Claim 1 of auxiliary request 9 differs from claim 1 of auxiliary request 8 in that the following step is added:

"(e) stopping the sending of the commercial information if the connection request fails (S15), releasing the relay line between the originating switch and the receiving switch (S16), checking whether a next connection request is pending (S17), and beginning to transmit the commercial information to the originating telephone from the information generating system if pending (S3)."

Claim 1 of auxiliary request 10 differs from claim 1 of auxiliary request 9 only in that in step (d) the comma in "... (S12), and ..." is deleted.

Claim 1 of auxiliary request 11 differs from claim 1 of auxiliary request 10 only in that step (d) is amended to read as follows:

"(d) if the second predetermined time lapses since the connection request begins (S12), stopping the sending of the commercial information and connecting a relay line between an originating switch system and a receiving switch system (S13)."

Claim 1 of auxiliary request 12 differs from claim 1 of auxiliary request 11 only in that step (e) is amended to read as follows:

"(e) if the connection request fails (S15), stopping the sending of the commercial information releasing the relay line between the originating switch and the receiving switch (S16), checking whether a next connection request is pending (S17), and beginning to transmit the commercial information to the originating telephone from the information generating system if pending (S3)."

## Reasons for the Decision

1. *Article 100(c) EPC - main request and auxiliary requests 1, 2 and 3*

- 1.1 Claim 1 of the main request and auxiliary requests 2 and 3 include the wording "a relay line between the originating side and the terminating side is connected".

The board concurs with the opposition division that the use of the term "side" instead of "switch" has the consequence that the claim includes subject-matter which extends beyond the content of the application as filed, since the term "side" has a broader meaning than "switch" or "switch system"; in this respect the application as filed only discloses a step of connecting a relay line between switches, or switch systems, at the respective sides, see the description, page 4, lines 27 and 28, page 5, lines 2 and 3, page 13, lines 14 and 15, and claim 1, feature (d), as originally filed.

- 1.2 Further, claim 1 of the main request and auxiliary request 1 include the feature that the relay line is connected "if a second predetermined time lapses during the connection request".

The board interprets "second predetermined time" in the context of the claim as a time period or duration rather than a point in time, since it "lapses". The appellant agreed that it represented a duration.

Claim 1 of the main request and auxiliary request 1 do not however specify the starting point in time from

which the second predetermined time period runs. Hence, according to the claimed method, the starting point may be arbitrarily chosen. The board concurs with the opposition division that the application as filed does not provide a basis for omitting a starting point for the second predetermined time period. It is particularly noted that in claim 1 as filed this starting point is defined either as the moment the commercial information ringback tone is provided or the moment the request for connection is made, see claim 1 as filed, feature (b) ("checking whether a second predetermined time(B-timeout) lapses since the commercial information ringback tone is provided") and feature (d) ("stopping the sending of the commercial information ringback tone if the second predetermined time lapses since the connection request in the step S11(S12)").

- 1.3 The appellant argued that from "during the connection request" in the claim it was clear that the second predetermined time began when the connection request was made. It further argued that the second predetermined time represented a predetermined duration, in which it did not matter from which point in time it was calculated.

The board does not find these arguments convincing. The term "during" is commonly understood as "in the course of" or "in the time of". The application as filed does not include a statement that in the context of the application this term has another meaning, in particular one according to which it should be understood as, e.g., "as soon as the connection request is made", as suggested by the appellant. Nor could a

basis in the application as filed be found in support of a teaching according to which in the proposed method it did not matter from which point in time the second predetermined time was calculated. Nor did the appellant refer to any specific passages of the application as filed in support of this argument.

1.4 Claim 1 of the main request and auxiliary requests 1, 2 and 3 do not therefore meet the requirement of Article 123(2) EPC (opposition ground pursuant to Article 100(c) EPC).

1.5 The main request and auxiliary requests 1, 2 and 3 are therefore not allowable.

2. *Article 123(2) EPC - auxiliary requests 4, 4A, 5 to 7 and 7A*

2.1 Claim 1 of the application as filed includes the following two features which relate to a connection failure:

"checking whether a telephone connection fails if within the second predetermined time (S14) and continuously providing the commercial information ringback tone to the originating telephone if the telephone connection does not fail(S5);" (see claim 1 as filed, feature (b)) and

"(e) stopping the sending of the commercial information ringback tone if the connection request fails(S15), releasing the relay line between the originating switch and the receiving switch(S16), checking whether a next connection request is(S17) [*sic*], and beginning to

transmit the commercial information to the originating telephone from the commercial information ringback tone generating system (S3)".

2.2 Claim 1 of auxiliary requests 4, 4A, 5 to 7 and 7A (see point VIII above) do not include any steps relating to stopping the sending of the commercial information when the connection request fails. They only specify steps relating to stopping the commercial information either when the connection request is accepted or when the second predetermined time period has lapsed, which correspond to steps (c) and (d) of claim 1 as filed. The third possibility as defined in claim 1 as filed, according to which the commercial information is stopped when a telephone connection request fails (see point 2.1, feature (e)), is thus no longer part of the claimed subject-matter.

2.3 The application as filed does not however provide a basis for this omission. It would require that the above-mentioned third possibility is disclosed as optional. This is, however, not the case for the following reasons:

Claim 1 as filed, the corresponding disclosure of the invention at page 3, line 13, to page 5, line 7, and the description of the preferred embodiment at page 11, line 25, to page 13, line 23, with reference to Fig. 2, consistently describe that the commercial information is stopped if any one of the following three conditions is met:

(1): a connection request is completed (Fig. 2, steps S6 and S7);



(2): the second predetermined time period (B-timeout) has lapsed (steps S11 and S12); or

(3): a telephone connection has failed (steps S14 and S15).

Fig. 3 and the corresponding passage in the description (page 13, line 24, to page 14, line 9) concern an alternative embodiment in which the commercial information is already stopped when the first predetermined time period (A-timeout) has lapsed.

Figs 4, 6, 8, 12, 14, 16 and 18 and the corresponding passages in the description only refer to a condition which is similar to the above condition (1) (see Figs 4, 6, 8, 12, 14, 16 and 18: "when the receiving telephone receives a call") and, hence, do not provide a basis for claiming in combination conditions (1) and (2), as in present claim 1.

Figs 5a, 5b, 7, 9a, 9b and 13 and the corresponding passages in the description explicitly include a condition relating to a connection failure (see Figs 5a, 5b, 7, 9a, 9b and 13: "when the communication connection fails after B-timeout lapses"), which, as set out above, is omitted in present claim 1.

Figs 1 and 10 and the corresponding passages in the description do not specify any condition for stopping the sending of the commercial information.

Figs 11, 15, 17 and 19 and the corresponding passages in the description only disclose stopping the

commercial information on request (see Fig. 11, step 70, Fig. 15, step 107, Fig. 17, step 136, and Fig. 19, step 176).

Claims 2 to 17 as filed are dependent on claim 1, whereas the remaining claims, i.e. device claims 18 and 19, do not specify any of the above conditions.

Nor did the board find in any other part of the application as filed a statement in support of the above-mentioned omission.

- 2.4 The appellant did not refer to any parts of the application as filed in support of the omission. Rather, it argued that it was self-evident that, if a telephone connection failed, the commercial information would then be stopped and that it was common in view of saving resources that relay lines were released if no longer required. Hence, it was not necessary to explicitly include these features in the claim.

The board notes however that, even if it were assumed that from the claim it is implicit that if the telephone connection fails the commercial information is stopped, the claim would not include the remaining features referred to at point 2.1 above, including the (mandatory) step of checking for connection failure and the step of releasing the relay line. As to the latter step, even if it were a common feature, this does not imply that it is necessary and thus implicitly part of the claimed subject-matter. The appellant's arguments are therefore not convincing.

2.5 Claim 1 of auxiliary requests 4, 4A, 5 to 7, and 7A do not therefore meet the requirement of Article 123(2) EPC (opposition ground pursuant to Article 100(c) EPC).

2.6 The auxiliary requests 4, 4A, 5 to 7, and 7A are therefore not allowable.

3. For the sake of completeness, the board notes that the above considerations in respect of claim 1 of auxiliary requests 4, 4A, 5 to 7, and 7A also apply to claim 1 of the main request and auxiliary requests 1 to 3 for the same reasons.

4. *Article 123(3) EPC - auxiliary requests 8 and 9*

4.1 Claim 1 as granted includes the following feature:

"the provision of the commercial information is also stopped and a relay line between the originating side and the terminating side is connected if a second predetermined time lapses during the connection request".

4.2 Claim 1 of auxiliary requests 8 and 9 include only one corresponding feature, namely feature (d), which reads as follows:

"stopping the sending of the commercial information if the second predetermined time lapses since the connection request begins (S12), and connecting a relay line between an originating switch system and a receiving switch system (S13)".

- 4.3 On comparing the above features, it follows that, whereas in claim 1 as granted the step of connecting a relay line is subject to the condition "if a second predetermined time lapses during the connection request", this is not necessarily the case in claim 1 of auxiliary requests 8 and 9. Hence, claim 1 as granted is amended in such a way as to extend the protection it confers. The board thus concurs with the opposition division that claim 1 of auxiliary requests 8 and 9 contravene Article 123(3) EPC.
- 4.4 The appellant did not submit arguments against this finding, but filed further auxiliary requests 10 and 11 in response (see points 5 and 6 below).
- 4.5 For the above reasons, auxiliary requests 8 and 9 are not allowable.
5. *Auxiliary requests 10 and 11 - admissibility*
- 5.1 Claim 1 of auxiliary request 10 differs from claim 1 of auxiliary request 9 only in that a comma is deleted (see point VIII above). Claim 1 of auxiliary request 11 differs from claim 1 of auxiliary request 9 only in that in feature (d) the wording "if ... begins (S12)," is moved to the beginning of the sentence (see point VIII above). Both amendments were made by the appellant in an attempt to overcome the above objection under Article 123(3) EPC against claim 1 of auxiliary requests 8 and 9, which was also referred to in the board's communication.

- 5.2 Respondents 1, 2 and 3 requested that auxiliary requests 10 and 11, which were filed by the appellant in the course of the oral proceedings, be rejected as late filed.
- 5.3 In accordance with Article 13(1) and (3) RPBA, 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. 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 parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.
- 5.4 The board concurs with the respondents that auxiliary requests 10 and 11 are late filed in that they could have been filed earlier. However, see point 5.1, the amendments in question are clear and simple and in response to an objection raised in the board's communication. They were therefore predictable and could easily be dealt with by the board, without giving rise to issues which the board or the other parties could not reasonably have been expected to deal with without adjournment of the oral proceedings.
- 5.5 The board therefore exercised its discretion pursuant to Article 13(1) RPBA to admit auxiliary requests 10 and 11 to the appeal proceedings.

6. *Auxiliary requests 10 and 11 - allowability*

6.1 The amendment to claim 1, feature (d), according to auxiliary request 10 overcomes the objection under Article 123(3) EPC as set out at point 4 above, since both the step of stopping the sending of the commercial information and the step of connecting the relay line are again subject to the condition "if the second predetermined time lapses since the connection request begins". The same applies to claim 1 of auxiliary request 11.

6.2 A basis for this amendment can only be found in the flow chart of Fig. 2 of the application as filed, see steps S11 to S13. The appellant did not argue otherwise.

6.3 However, claim 1 of auxiliary requests 10 and 11 also include the following feature (underlining by the board):

"(e) stopping the sending of the commercial information if the connection request fails (S15), releasing the relay line between the originating switch and the receiving switch (S16), checking whether a next connection request is pending (S17), and beginning to transmit the commercial information to the originating telephone from the information generating system if pending (S3)."

The board notes that according to Fig. 2 the releasing or disconnecting step S16, the checking step S17 and the beginning to transmit step S3 are all subject to step S14, in which it is determined that the telephone connection has failed.

Since, as stated above, Fig. 2 is the only basis for step (d) of each claim 1, the figure must also provide a basis for, or at least not be in conflict with, the subject-matter of the claim as a whole. However, whereas Fig. 2 requires that all of the steps S16, S17 and S3 are subject to the condition that the connection request has failed, the claim includes embodiments in which not all of the steps of feature (e), which correspond to steps S16, S17 and S3 of Fig. 2, are subject to this condition. More specifically, only the step of stopping the sending of the commercial information is subject to the condition "if the connection request fails". Further, the application as filed does not provide a basis for a combination of features including feature (d), which corresponds to steps S11 to S13 of Fig. 2, but without the steps corresponding to steps S14 to S17 of Fig. 2. Nor did the appellant argue otherwise.

6.4 The board therefore concludes that claim 1 of auxiliary requests 10 and 11 contain subject-matter which extends beyond the content of the application as filed, Article 123(2) EPC.

6.5 The appellant did not submit arguments against this finding, but filed a further auxiliary request 12 in response (see point 7 below).

6.6 For the above reasons, auxiliary requests 10 and 11 are not allowable.

7. *Auxiliary requests 12 - allowability*

7.1 The respondents made no objection to the admission of auxiliary request 12 filed by the appellant in the course of the oral proceedings and the board saw no reason to question its admissibility of its own motion. The board therefore exercised its discretion pursuant to Article 13(1) RPBA to admit auxiliary request 12 to the appeal proceedings.

7.2 The amendment to claim 1, feature (e), according to auxiliary request 12 overcomes the objection under Article 123(2) EPC as set out above at point 6, since all of the cited steps of feature (e) are now made subject to the condition "if the connection request fails".

7.3 A basis for this amendment can only be found in the flow chart of Fig. 2 of the application as filed, see steps S14 to S17 and S3, and the appellant did not argue otherwise.

7.4 However, claim 1 of auxiliary request 12 further includes the following features (see point VIII above, claim 1, features (b) and (d); underlining by the board):

"checking whether a second predetermined time lapses since the commercial information is provided"; and

"if the second predetermined time lapses since the connection request begins (S12), stopping the sending of the commercial information and connecting a relay



line between an originating switch system and a receiving switch system (S13)".

- 7.5 Since, as stated above, Fig. 2 is the only basis for steps (d) and (e) of claim 1, the figure must also provide a basis for, or at least not be in conflict with, the subject-matter of the claim as a whole.

The board notes that Fig. 2 shows one box S11 including the text "B-timeout lapse?", which has two output branches corresponding to "Yes" and "No", respectively. This representation suggests that only one test is carried out at step S11, namely that of checking of whether or not the second predetermined time period, i.e. the B-timeout, hereinafter noted as  $\Delta t_{B\text{-timeout}}$ , has lapsed.

However, the above-quoted features of claim 1, see point 7.4, imply that two separate tests are carried out, namely a first test which takes the moment the commercial information is provided as the starting point ( $t_{\text{start test 1}}$ ) for the second predetermined period and a second test which takes the moment the connection is requested as the starting point ( $t_{\text{start test 2}}$ ).

From both Fig. 2 (steps S3 and S4) and present claim 1 (feature (a)) it follows that the commercial information is provided or transmitted as soon as a call is made, whereas a connection request is made only after a first predetermined time has lapsed (A-timeout; hereinafter noted as  $\Delta t_{A\text{-timeout}}$ ). Hence, the second test starts at  $t_{\text{start test 2}} = t_{\text{start test 1}} + \Delta t_{A\text{-timeout}}$ . Further, the first test expires at  $t_{\text{end test 1}} = t_{\text{start test 1}} +$

$\Delta t_{B\text{-timeout}}$ , whereas the second test expires  $\Delta t_{A\text{-timeout}}$  later (at  $t_{\text{end test 2}}$ ).

7.6 The appellant argued that the claim did not determine specific starting points, but merely expressed these in terms of their functional roles. In the board's view, the claim indeed defines the method steps in functional terms rather than constructional features of the communication system. However, this, in itself, does not imply that the above-cited features, see point 7.4, do not define starting points for the second predetermined time.

7.7 The board also considered the argument that the skilled reader would interpret box S11 in Fig. 2 such that it concisely represents both tests, in which the "No" branch would be followed as long as it is determined at step S11 that  $t < t_{\text{end test 1}}$  and the "Yes" branch as soon as it is determined that  $t \geq t_{\text{end test 2}}$ . However, this would have the consequence that, in the time period between  $t_{\text{end test 1}}$  and  $t_{\text{end test 2}}$ , step S6 in Fig. 2, in which it is determined whether or not a connection request is completed, i.e. the call is accepted, can not be reached. Hence, during this time period, which lasts as long as  $\Delta t_{A\text{-timeout}}$ , the communication system would remain in a non-responding state, during which the commercial information cannot be stopped, even if, in the meantime, the call is answered. This would clearly serve no purpose and, in any case, be contrary to the wording of claim 1 as filed ("transfer of a commercial information to an originating telephone ... till a receiving side is received"). The argument is therefore not convincing.

7.8 The board thus concludes that the application as filed does not provide a basis for the subject-matter of claim 1. Hence, claim 1 of auxiliary request 12 contains subject-matter which extends beyond the content of the application as filed, thereby violating Article 123(2) EPC.

7.9 Auxiliary request 12 is therefore not allowable.

8. Since the opposition ground pursuant to Article 100(c) prejudices the maintenance of the patent as granted and since there is no amended set of claims on file which meets the requirements of Articles 123(2) and (3) EPC and on the basis of which a remittal to the department of first instance for further prosecution could have been considered, the board concludes that the appeal is to be dismissed.

9. *Reimbursement of the appeal fee*

9.1 The appellant argued that the opposition division committed a substantial procedural violation in that at the oral proceedings before the opposition division the proprietor was not given an opportunity to comment on an objection under Article 100(c) EPC, which was raised against auxiliary request 4 at the oral proceedings for the first time. The objection concerned the wording "during the connection request" in claim 1.

In the statement of grounds of appeal the appellant submitted that, even though the opposition division gave the proprietor one hour during lunch time to consider the new objection, it did not have sufficient time to consider the new issue, noting that it did not

only require a review of the complete application, but also an assessment of whether or not an adjournment of the oral proceedings was necessary as well as a preparation of new requests in order to try to overcome the new objection.

The appellant further argued that the new objection constituted a new "ground or evidence" within the meaning of Article 113(1) EPC which should have been raised earlier in writing. It submitted that, even if the new objection under Article 100(c) EPC were to be considered as an "argument", it should have been disregarded by the EPO, since the opponent should have submitted all objections under Article 123(2) EPC in writing before the oral proceedings. It was contrary to the requirement of a fair procedure that the opponent was allowed to withhold its arguments concerning Article 123(2) EPC until at the oral proceedings.

The appellant therefore requested that it be acknowledged that the opposition division had no competence to examine the new objection under Article 123(2) EPC and that, consequently, the sets of claims be examined by the board without considering the new objection or that, if the case were to be remitted to the department of first instance, it be ordered that the opposition division examine the sets of claims without considering the new objection. Since the opposition division had committed a substantial procedural violation, the reimbursement of the appeal fee was deemed equitable.

9.2 The board does not find these arguments convincing for the following reasons:

9.3 In accordance with Rule 103(1) (a) EPC, the appeal fee is to be reimbursed if all of the following three conditions are met:

(i) a substantial procedural violation has been committed;

(ii) a reimbursement is equitable; and

(iii) the appeal is allowable.

Since, for the reasons given at points 1 to 8 above, the appeal is not allowable and since, for the reasons given below, the opposition division did not commit any procedural violation, the conditions (i) and (iii) are not met.

9.4 As to the alleged substantial procedural violation the board notes that the new objection merely constituted a further argument in support of the opposition ground pursuant to Article 100(c) EPC. It did not introduce a new ground or new evidence in the sense of Article 113(1) EPC, since three of the oppositions were based, *inter alia*, on the opposition ground pursuant to Article 100(c) EPC and the examination of the objection did not require anything but the application as filed and the patent as granted.

The board agrees with the appellant that it is desirable that an opponent presents all of its arguments in writing well before the oral proceedings, in order to enable the proprietor and the opposition division to prepare for the oral proceedings in the

best possible way. However, it cannot be excluded that, given the course of events during the procedure, an opponent presents a new argument at the oral proceedings for the first time. As long as this does not amount to an abuse of the procedure in that it was evidently done deliberately at such a late stage for tactical reasons, the new argument cannot be disregarded. In the present case, in the absence of evidence to the contrary, the board sees no reason to conclude that there was an abuse of the procedure by the opponent. Consequently, the admission into the procedure by the opposition division of the new argument did not give rise to a procedural violation.

The board further notes that the minutes do not mention any request by the appellant for additional time after it was given one hour to consider the new objection. Nor did the appellant argue otherwise. Further, according to the minutes, after the one hour interruption, the new objection was discussed with the parties and the appellant was given an opportunity to file a further request taking into account the new objection. The appellant made use of this opportunity by filing auxiliary requests 4A and 7A, which were subsequently discussed with the parties (see the minutes, page 15, line 18, to page 20, line 17). In the board's view, the right to be heard was therefore fully respected (Article 113(1) EPC).

The board concludes that the opposition division did not commit any procedural violation, let alone a substantial procedural violation.

9.5 Further, the board sees no exceptional circumstances which, if at all, might have justified a reimbursement of the appeal fee outside the scope of Rule 103(1) (a) EPC for reasons of equity, see T 308/05 (point 5 of the reasons), J 30/94, and J 38/97 (all not published in OJ).

9.6 The request for reimbursement of the appeal fee must therefore be rejected.

### **Order**

#### **For these reasons it is decided that:**

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland