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Datasheet for the decision of 9 February 2010

Case Number: T 1415/08 - 3.5.03

Application Number: 96913509.4

Publication Number: 0823187

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Language of the proceedings: EN

Title of invention:
Monitoring method and monitoring system

Patent proprietor:
Koninklijke KPN N.V.

Opponents:
T-Mobile Deutschland GmbH
Nokia Siemens Networks GmbH & Co. KG
Vodafone D2 GmbH
Ministerie van Justitie

Headword:
Monitoring method and system/KPN

Relevant legal provisions:
EPC Art. 54, 84, 123(2)
RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):
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Keywords:
"Novelty - main request and fourth auxiliary request (no)"
"Late-filed first and second auxiliary requests - not admitted"
"Added subject-matter - third auxiliary request (yes)"

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-

Catchword:

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Case Number: T 1415/08 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 9 February 2010

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Decision under appeal:

Decision of the opposition division of the European Patent Office posted 7 May 2008 revoking European patent No. 0823187 pursuant to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
R. Moufang

Summary of Facts and Submissions

I. This appeal is against the decision of the opposition division revoking European patent No. 0823187 which is based on European patent application 96913509.4 which was originally filed as international application PCT/EP96/01611 (publication number WO 96/34506 A).

II. Four oppositions were filed against the patent as a whole, *inter alia* on the grounds that the claimed subject-matter was not new and did not involve an inventive step (Article 100(a) EPC).

In the course of the opposition proceedings, reference was made, *inter alia*, to the following document:

D26: EP 0 629 092 A.

In its decision the opposition division held, *inter alia*, that the subject-matter of claim 1 as granted lacked novelty having regard to the disclosure of D26.

III. The proprietor (appellant) lodged an appeal against the decision. In the statement of grounds of appeal the appellant requested that the decision under appeal be set aside and that the patent be maintained either as granted (main request) or, alternatively, in amended form on the basis of claims of one of first and second auxiliary requests, both as filed with the statement of grounds of appeal. Oral proceedings were conditionally requested.

IV. Opponents I and II (respondents I and II) withdrew their oppositions with letters dated 28 July 2008 and

4 August 2009, respectively, and, hence, are no longer parties to these appeal proceedings.

V. In response to the statement of grounds of appeal, opponents III and IV (respondents III and IV) each requested that the appeal be dismissed and each conditionally requested oral proceedings.

VI. The parties were summoned by the board to oral proceedings. In a communication accompanying the summons the board drew attention to issues to be discussed at the oral proceedings in respect of the main request and, if necessary, each of the auxiliary requests.

VII. In preparation for the oral proceedings the appellant filed with a letter dated 8 January 2010 revised first and second auxiliary requests as well as a third and a fourth auxiliary request and provided arguments in support.

VIII. Respondents III and IV each filed further arguments with letters dated 7 January 2010 and 4 February 2010, respectively. Respondent IV argued, *inter alia*, that the first, second and fourth auxiliary requests should not be admitted to the appeal proceedings.

IX. With a letter dated 9 February 2010 respondent III informed the board that it would not attend the scheduled oral proceedings.

X. Oral proceedings were held on 9 February 2010 in the absence of respondent III.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or, in the alternative, in amended form on the basis of one of the first, second, third, and fourth auxiliary requests, all as filed with the letter dated 8 January 2010.

At the oral proceedings the appellant suggested further amendments to the first, second, and fourth auxiliary requests, in particular that the method claims be deleted. These further amendments will be considered at point 7 below.

Respondent III requested in writing that the appeal be dismissed.

Respondent IV requested that the appeal be dismissed.

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

XI. Claim 1 of the **main request**, i.e. claim 1 as granted, reads as follows:

"Method for monitoring, via monitoring means (1), a signal which is to be transmitted via at least one telecommunication link and with said signal comprising at least a signalling signal and a content signal, which method comprises the steps of:
-- detecting, by the monitoring means (1), at least one code word situated in the signalling signal, and
-- monitoring, by the monitoring means (1), dependent on the code word to be detected, at least a part of the content signal,

characterised in that the method comprises the steps of:
-- generating, by the monitoring means (1), dependent on the code word to be detected, a further signalling signal, and
-- transmitting, by the monitoring means (1), dependent on the further signalling signal, the part of the content signal which is to be monitored to processing means (70) defined by the further signalling signal."

Claim 6 of the **first auxiliary request** reads as follows:

"Monitoring system comprising monitoring means (1) for monitoring a signal to be transmitted via at least one telecommunication link, said telecommunication link being established from a source to a destination via a switch matrix (3), which signal at least comprises a signalling signal and a content signal, and provided with processing means (70) which can be coupled to the monitoring means (1), said monitoring means (1) being provided with
-- a detecting device (2) for detecting at least one code word situated in the signalling signal, and
-- a monitoring device (4) for monitoring, dependent on the code word to be detected, at least a part of the content signal,
and said processing means (70) being provided with
-- a processing device (72) for processing at least the part of the content signal which is to be monitored,
characterised in that the monitoring means (1) are provided with a monitor controlling device (40) comprising

-- a generating device (43) for generating, dependent on the code word to be detected, a further signalling signal, and
-- a transmitting device (48) for transmitting, dependent on the further signalling signal, at least the part of the content signal which is to be monitored to the processing means (70) defined by the further signalling signal."

Claim 6 of the **second auxiliary request** reads as follows:

"Monitoring system comprising monitoring means (1) for monitoring a signal to be transmitted via at least one telecommunication link which signal at least comprises a signalling signal and a content signal, and provided with processing means (70) which can be coupled to the monitoring means (1), said monitoring means (1) being provided with
-- a detecting device (2) for detecting at least one code word situated in the signalling signal, and
-- a monitoring device (4) for monitoring, dependent on the code word to be detected, at least a part of the content signal,
and said processing means (70) being provided with
-- a processing device (72) for processing at least the part of the content signal which is to be monitored, characterised in that the monitoring means (1) are arranged for supplying part of the signalling signal which is to be monitored supplemented by at least one of a date code, a time code, an operators code and a base station code, and are provided with a monitor controlling device (40) comprising

-- a signalling receiving interface (42) for receiving the supplemented part of the signalling signal which is to be monitored,
-- a data receiving interface (41) for receiving the part of the content signal which is to be monitored,
-- a generating device (43) for generating, dependent on the code word to be detected, a further signalling signal, and
-- a transmitting device (48) for transmitting, dependent on the further signalling signal, at least the part of the content signal and the supplemented part of the signalling signal which is to be monitored to the processing means (70) defined by the further signalling signal."

Claim 1 of the **third auxiliary request** differs from claim 1 as granted in that, in the characterising portion, the following step is added:

"-- selecting the part of the content signal to be monitored dependent on the code word to be detected,".

Claim 5 of the **fourth auxiliary request** reads as follows:

"Monitoring system comprising monitoring means (1) for monitoring a signal to be transmitted via at least one telecommunication link which signal at least comprises a signalling signal and a content signal, and provided with processing means (70) which can be coupled to the monitoring means (1), said monitoring means (1) being provided with
-- a detecting device (2) for detecting at least one code word situated in the signalling signal, and

-- a monitoring device (4) for monitoring, dependent on the code word to be detected, at least a part of the content signal,
and said processing means (70) being provided with
-- a processing device (72) for processing at least the part of the content signal which is to be monitored,
characterised in that the monitoring means (1) are provided with a monitor controlling device (40) comprising
-- a generating device (43) for generating, dependent on the code word to be detected, a further signalling signal,
-- a memory device (44) for buffering at least the part of the content signal which is to be monitored,
-- a memory controlling device (43) for reading out the memory device (44), and
-- a transmitting device (48) for transmitting, dependent on the further signalling signal, at least the part of the content signal which is to be monitored delayed in time to the processing means (70) defined by the further signalling signal."

Reasons for the Decision

1. *Interpretation of claim 1 as granted*

1.1 The board notes that the monitoring means (1) as referred to in claim 1 does not merely carry out the step of monitoring the content signal but also carries out the steps of detecting a code word, generating a further signalling signal, and transmitting the content signal to processing means. Hence, the board interprets the term "monitoring" in "monitoring means" broadly in

the sense that the monitoring means (1) also includes means which only indirectly contribute to the monitoring of the content signal.

1.2 This broad interpretation is also in accordance with the patent specification, since in accordance with Fig. 1 and the corresponding part of the description, see paragraphs [0051] and [0052], the monitoring means 1 includes, in addition to a monitoring processor 2 and a monitoring device 4, various other means for performing functions other than monitoring, e.g. switch matrix 3, controlling processor 43, insert/extract matrix 45, signal generator 46, and combiner 48. The presence of switch matrix 3 in the monitoring means 1 also implies that call routing may be managed by the monitoring means 1.

2. *Main request - novelty - claim 1 as granted*

2.1 Document D26 discloses, see, in particular, the abstract and Figs 1 and 2, a telecommunications network, in which outgoing calls from a particular subscriber location 11-1 are delivered via a serving terminal 21 and an access network 31 to a routing-to-intelligence (RTI) facility 40 which includes an RTI distributor 410 through which the subscriber location is caused to be connected to an appropriate intelligent network element (INE) server, e.g. ISDN-capable central office switch 75 or video switch 55. Incoming calls directed to a particular subscriber location directory number are delivered to an RTI collector 420 of the RTI facility 40 and connections for these calls are caused to be made from the RTI collector 420 to an appropriate INE server as a function of the telecommunications

application type and the dialled directory number. Communications within the network are by way of asynchronous transfer mode (ATM) cells. In making connections in and out of RTI distributor 410 and RTI collector 420, the RTI facility 40 makes use of routing information which is stored in a number translation table 425, see col. 5, lines 24 to 42, and Figs 4 and 5.

As disclosed in col. 8, lines 24 to 40, in the event of either an incoming call being made to or an outgoing call being made from a specific directory number which is under a wiretap order, the RTI facility will further initiate a call to a law enforcement agency's wiretap facility, the directory number of which is stored in the number translation table 425, and will supply the "tapped" conversations over the call thus initiated.

2.2 In the board's view, the terms "law enforcement agency's wiretap facility" and "tapped" conversations imply that the conversations in question are being eavesdropped, which is a particular kind of monitoring, which, in turn, implies that the wiretap facility is provided with processing means for monitoring purposes.

2.3 Using the language of claim 1 as granted and having regard to point 1 above, D26 thus discloses a method for monitoring, namely eavesdropping, via monitoring means 21, 31, 40, 55, 75, 410, 420, a signal which is to be transmitted via a telecommunication link, in which the signal includes a signalling signal, in particular a signal which includes the specific directory number which is under a wiretap order, and a content signal, in particular the conversation eavesdropped on. The method includes the steps of:

detecting a code word situated in the signalling signal, namely the specific directory number which is under a wiretap order; monitoring, dependent on the code word to be detected, at least a part of the content signal, i.e. the conversation to be wiretapped; generating, dependent on the code word to be detected, a further signalling signal, namely the call signal to the wiretap facility; and transmitting, dependent on the further signalling signal, the part of the content signal which is to be monitored to processing means at the wiretap facility defined by the further signalling signal.

D26 thus discloses all the features of claim 1 as granted.

2.4 The appellant argued that D26 related to call routing rather than to network monitoring or network management as in the patent in suit, network management being concerned with Quality of Service issues in the network. The problem to be solved by the patent in suit was therefore completely within the context of monitoring of a particular call and not within the context of routing calls of different application types as in D26. Further, it was argued that the call routing and the wiretap functionality according to D26 were based on the application type of a call rather than on the detection of a code word. The wiretap function was said to be nothing other than a deflection functionality. The appellant further argued that in D26 wiretapping was only available for network communication traffic that was routed by an RTI facility.

2.5 The board does not find these arguments convincing. Claim 1 does not refer to network monitoring, network management, or Quality of Service issues; what is monitored is a particular content signal which is transmitted via a telecommunication link. Further, the claim does not exclude that the monitoring is within the context of routing calls. Nor does it require that all communication traffic can be monitored. The board further notes that the wiretap disclosed in D26, col. 8, lines 24 to 40, is based on a directory number of the subscriber location for which a wire tap order has been obtained, i.e. not on the application type of the call.

2.6 The board therefore concludes that the subject-matter of claim 1 as granted lacks novelty having regard to the disclosure of D26. The main request is therefore not allowable.

3. *First auxiliary request - admissibility*

3.1 Claim 6 of the first auxiliary request, see point XI above, differs from claim 6 as granted only in that in the preamble of the claim the wording "said telecommunication link being established from a source to a destination via a switch matrix (3)" is added.

3.2 The appellant argued that, in the claimed monitoring system, the monitor controlling device 40, which is part of the monitoring means 1, is separate from the switch matrix. This also followed from the patent specification, according to which the monitoring means 1, which included the switch matrix 3, was "supplemented" by monitor controlling device 40, cf. col. 15, lines 21 to 27.

3.3 The board preliminarily notes that in order to comply with the requirements of Article 84 EPC, a claim must be clear in itself, i.e. an addressee must be able to understand the claim without a need to refer to the description, since the claims, rather than a combination of the claims and the description, shall define the matter for which protection is sought, cf. Article 84 EPC.

In the present case, it is however unclear from the wording of the claim alone to what extent, if at all, the subject-matter for which protection is sought differs from claim 6 as granted. This is due to the fact that the claim does not specify whether or not the switch matrix (3) is part of the claimed monitoring system which is defined as comprising monitoring means (1) and processing means (70). The same considerations apply to "source" and "destination" in the above wording. In any case, irrespective of whether or not these means are part of the claimed monitoring system, the claim does not exclude that the switch matrix is part of the monitor controlling device or *vice versa*. Hence, the claim does not define, as argued by the appellant, that the switch matrix is separate from the monitor controlling device.

In view of the above, due to the amendment made, the matter for which protection is sought is unclear. Consequently, the claim is unclear and, hence, violates Article 84 EPC.

3.4 The board, in exercising its discretion pursuant to Article 13(1) RPBA, therefore decided not to admit the first auxiliary request to the appeal proceedings.

4. *Second auxiliary request - admissibility*

4.1 Claim 6 of the second auxiliary request, see point XI above, differs from claim 6 as granted *inter alia* in that the transmitting device (48) is in addition for transmitting to the processing means (70) the part of the signalling signal which is to be monitored, supplemented by at least one of a data code, a time code, an operators code and a base station code.

4.2 The appellant argued that a basis for the amendments could be found at page 18, lines 14 to 36, page 3, lines 5 to 17, and page 8, lines 15 to 26, of the application as filed (cf. paragraphs [0057], [0010], and [0029] of the patent specification).

4.3 The board notes that the first passage describes that "the part of the signalling signal which is to be monitored (possibly supplemented by a date code, a time code, an operators code, a base station code etc)" is supplied to signalling receiving interface 42 which transmits the entire signal to controlling processor 43 (page 18, lines 15 to 27). The controlling processor 43 generates a further signalling signal which comprises "for example a further telephone number" and which is transmitted to combiner 48 which supplies the further signalling signal to the ISDN network which establishes a connection to processing means 70 (page 18, line 37, to page 19, line 10). Further, it is disclosed in the application as filed that "At least a part of the

further signalling signal (viz. a so-called monitor source code) and the part of the content signal which is to be monitored ... then arrive at splitter 71 of processing means 70." (page 19, lines 24 to 30) and that the further signalling signal generated by the controlling processor 43 may be extended by a destination code, a monitor code, and/or a signal type code (page 20, lines 4 to 8).

It follows from the above passages that the combiner 48, i.e. the "transmitting device (48)" as referred to in the claim, transmits to the processing means 70 a further signalling signal generated by the controlling processor 43, i.e. not the supplemented part of the signalling signal to be monitored. Further, the above passages disclose that the further signalling signal may include a monitor source code and may be extended by a destination code, a monitor code, and/or a signal type code, but do not disclose that the further signalling signal is supplemented by a data code, a time code, an operators code and/or a base station code.

Further, the wording "(possibly supplemented by a date code, a time code, an operators code, a base station code etc)", see page 18, lines 19 and 20, does not imply that the part of the signalling signal which is to be monitored may be supplemented by only "at least one of" a data code, a time code, an operators code, and a base station code.

The other passages referred to by the appellant, i.e. those at pages 3 and 8, disclose that a large part of the signalling signal may indicate the destination and the source in a coded manner, but are silent on

supplementing the part of the signalling signal by a data code, a time code, an operators code, or a base station code.

4.4 The board therefore concludes that, due to the above amendment, claim 6 of the second auxiliary request contains subject-matter which extends beyond the content of the application as filed and, hence, violates Article 123(2) EPC.

4.5 The board, in exercising its discretion pursuant to Article 13(1) RPBA, therefore decided not to admit the second auxiliary request to the appeal proceedings.

5. *Third auxiliary request - added subject-matter*

5.1 The claims of the third auxiliary request are identical to the claims of the previous first auxiliary request as was filed with the statement of grounds of appeal. Claim 1 differs from claim 1 as granted only in that the feature "selecting the part of the content signal to be monitored dependent on the code word to be detected" is added.

5.2 The appellant argued that a basis for this feature could be found in the application as filed at page 1, lines 7 to 10, and page 2, lines 23 to 26.

These passages read as follows:

"-- detecting, by the monitoring means, at least one code word situated in the signalling signal, and

-- monitoring, by the monitoring means, dependent on the code word to be detected, at least a part of the content signal."; and

"-- transmitting, by the monitoring means, dependent on the further signalling signal, the part of the content signal which is to be monitored to processing means defined by the further signalling signal.".

5.3 The board notes that the steps referred to in these passages are already *expressis verbis* in claim 1 as granted, see point XI above. These passages do not therefore provide a basis for the above-mentioned added step. The appellant did not refer to any other passage in the application as filed. Nor was the board able to find a basis in any of the other parts of the application as filed.

In any case, for the sake of argument, if, as argued by the appellant, the above-cited passages were to implicitly provide a basis for the above-mentioned added step, this step would then also be implicitly included in claim 1 as granted. Since the subject-matter of claim 1 as granted lacks novelty having regard to the disclosure of D26 for the reasons set out at point 2 above, the same would apply to claim 1 of the present request.

5.4 The board therefore concludes that claim 1 of the third auxiliary request contains subject-matter which extends beyond the content of the application as filed and, hence, does not meet the requirement of Article 123(2) EPC.

5.5 The third auxiliary request is therefore not allowable.

6. *Fourth auxiliary request - novelty - claim 5*

6.1 The appellant argued that claim 5 of the fourth auxiliary request was based on a combination of claims 6 and 9 as granted. At the oral proceedings the appellant suggested, in order to overcome an objection under Article 123(2) EPC, that a further amendment be made according to which in the last feature, see point XI above, "consequently" is inserted between "for" and "transmitting", cf. claim 9 as granted. Even though this amendment was not made the subject of a formal request, for the sake of argument, the board will interpret the claim accordingly.

6.2 It was common ground between the parties that D26 disclosed digital signal processing in a telecommunication network.

More specifically, the board notes that D26 discloses that the outputs of video terminal 11-11, telephone set 11-12 and personal computer 11-14 are packetized by a conventional packet assembler/disassembler within serving terminal 21, see col. 3, lines 41 to 51, and Figs 1 and 2. In particular, the serving terminal creates a data packet, e.g., an ATM cell having a standard 53 byte ATM cell envelope format, in which the first five bytes comprise standard ATM header information and the remaining bytes comprise payload, see col. 9, lines 39 to 48, and Fig. 7. The ATM cell is then transmitted to the appropriate INE server which completes outbound call processing. Communications into and out of RTI collectors are in packetized form so

that any server/RTI collector interconnection must have appropriate packetizing/depacketizing circuitry, see col. 5, lines 15 to 19.

It was also common ground between the parties that, if a wiretap was to be set up for a particular incoming or outgoing call, as specified by the number translation table 425, a call to the wiretap facility was set up by the RTI facility and new ATM cells had to be created, either by stripping the ATM cells of the call to be wiretapped or by encapsulating these ATM cells, in which the new ATM cells included at least the directory number of the wiretap facility and the payload of the call to be wiretapped.

6.3 In the board's view, it is inherent to the above digital signal processing of ATM cells, including depacketizing, packetizing, stripping, and/or encapsulating, that the payload of these ATM cells is temporarily stored, i.e. buffered, simply in order not to lose it whilst making changes to the cell headers.

Hence, D26 inherently discloses a memory device for buffering payload, including the payload of at least the part of the content signal which is to be monitored by the wiretap facility, and a memory controlling device for reading out the memory device. Consequently, due to the buffering, the content signal to be monitored is transmitted delayed in time to the processing means of the wiretap facility.

6.4 The appellant admitted that a transmission of content signals via the telecommunication network of D26 inherently involved a certain amount of delay, but

noted that this delay was negligible, since it would otherwise give rise to an unacceptable loss in quality of service. Further, even if the wiretapping of D26 were interpreted as monitoring, D26 did not specifically disclose a monitor controlling device which included a memory device for buffering at least the part of the content signal which is to be monitored, a memory controlling device for reading out the memory device, and a transmitting device for consequently transmitting the content signal delayed in time.

6.5 The board notes however that the claim does not specify any amount of time delay and does not require that it is only the monitored content signal which is subject to a time delay. Therefore, the additional features of the claim are anticipated by any buffering of signals which takes place in a telecommunication network in the course of the digital processing of these signals, as, for example, in the digital telecommunication system of D26, see point 6.2.

6.6 In view of the above and the reasons given at points 1 and 2 in respect of the subject-matter of claim 1 as granted, the board concludes that the subject-matter of claim 5 of the fourth auxiliary request is not novel having regard to the disclosure of D26 (Articles 52(1) and 54 EPC).

6.7 The fourth auxiliary request is therefore not allowable.

7. At the oral proceedings the appellant suggested further amendments to the first, second, and fourth auxiliary requests, in particular that the method claims of these

requests be deleted. These further amendments were however not made the subject of any formal request and, in any case, were not relevant to the objections which were discussed at the oral proceedings in relation to the system claims of each of these requests, cf. points 3, 4, and 6 above. Nor did the appellant argue otherwise.

8. There being no admissible and allowable 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