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**Datasheet for the decision
of 13 November 2012**

Case Number: T 2270/09 - 3.5.03

Application Number: 99910577.8

Publication Number: 1062823

IPC: H04Q 7/30, H04Q 7/38

Language of the proceedings: EN

Title of invention:

System and device for accessing services of a mobile communication network directly or via an IP network

Patentee:

Nokia Corporation

Opponent:

Swisscom (Schweiz) AG

Headword:

Accessing services of a mobile communication network/NOKIA

Relevant legal provisions:

EPC Art. 100 c), 123(2)

Keyword:

"Added subject-matter (main and first auxiliary request) - yes"

Decisions cited:

-

Catchword:

-



Case Number: T 2270/09 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 13 November 2012

Appellant: Swisscom (Schweiz) AG
(Opponent) CH-3050 Bern (CH)

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
3 November 2009 concerning maintenance of
European patent No. 1062823 in amended form.

Composition of the Board:

Chairman: A. S. Clelland
Members: A. J. Madenach
R. Menapace

Summary of Facts and Submissions

I. The present appeal arises from the decision of the opposition division, posted on 3 November 2009, finding that, account being taken of the amendments made by the patent proprietor during the opposition proceedings, European Patent No. 1062823 and the invention to which it relates meet the requirements of the Convention.

The opposition was based on the grounds of Articles 100(a), (b) and (c) EPC.

The opposition division came to the conclusion that claims 1, 5, 7 and 8 of the main request met the requirements of Article 123(2) EPC and that the European Patent was disclosed in a manner sufficiently clear and complete for it to be carried out by a skilled person such that the requirements of Article 83 EPC were met.

Objections made on the basis of Article 100(a) EPC were withdrawn by the opponent during the oral proceedings.

II. An appeal was filed against this decision by the opponent (appellant) on 3 December 2009 and the appropriate fee paid. The corresponding statement of grounds was filed on 19 January 2010. In the statement of grounds, arguments were provided in respect of the grounds for opposition under Articles 100b) and c) EPC. It was requested that the appealed decision be set aside and that the patent be revoked in its entirety. Oral proceedings were requested as an auxiliary measure.

- III. The patentee (respondent) in its reply of 24 May 2010 requested that the patent be maintained as amended in the course of the opposition proceedings.
- IV. With letter of 10 May 2012, the board summoned the parties to oral proceedings and gave its preliminary opinion on the matters to be discussed, *inter alia* in relation to the requirements of Article 123(2) EPC.
- V. With letter of 12 September 2012, the appellant announced that it would not attend the oral proceedings. It also withdrew its objection under Article 100b) EPC and provided further arguments in relation to the ground for opposition under Article 100c) EPC.
- VI. With letter of 11 October 2012, the respondent confirmed its previous request that the patent be maintained as amended in the course of the opposition proceedings or, in the alternative, on the basis of claim 1 to 8 of a first auxiliary request submitted with said letter.
- VII. The oral proceedings took place on 13 November 2012 in the absence of the appellant.

During the oral proceedings, the respondent confirmed its previous requests. Objections in relation to the ground for opposition under Article 100c) EPC were discussed. In particular, the board indicated that it did not find an original disclosure for the feature of claims 1 and 5 of both requests that the emulator comprises means for maintaining the call transfer information while the mobile station switches to an access protocol.

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

VIII. Claim 1 according to the main request reads as follows:

"A system for transferring information between a mobile station (MS) and a mobile communication network (MOB), the system comprising:
the mobile station (MS);
the mobile communication network (MOB);
a communication network (IP) for interfacing the mobile station and the mobile communication network;
wherein the communication network (IP) is arranged to comprise a mobile station emulator (vMS, 43) when the mobile station (MS) is coupled to said communication network (IP);
said emulator comprising:
means for receiving call transfer information from the mobile station (MS) and for forwarding it over a communication network (IP) to the mobile communication network (MOB), upon coupling of the mobile station to the communication network; and
means for maintaining the call transfer information to be used while the mobile station (MS) remains coupled to the communication network and switches to an access protocol (IP) of the communication network."

Claim 5 according to the main request reads:

"A mobile station emulator for interfacing a mobile station (MS) and a mobile communication network (MOB), the emulator comprising:

means for receiving call transfer information from the mobile station (MS) and for forwarding it over a communication network (IP) to the mobile communication network (MOB), upon coupling of the mobile station to the communication network; and
means for maintaining the call transfer information to be used while the mobile station (MS) remains coupled to the communication network and switches to an access protocol (IP) of the communication network."

Claims 1 and 5 according to the first auxiliary request are identical to those according to the main request.

In view of this decision it is not necessary to quote the further independent claims of the two requests.

Reasons for the decision:

1. *Procedural matters:*

1.1 In view of the present decision the absence of the appellant at the oral proceedings does not give rise to a conflict with the requirements of Article 113(1) EPC.

1.2 In view of the present decision and the appellant's withdrawal of all objections in relation to the grounds for opposition under Articles 100a) and 100b) EPC, the board had no reason to consider possible objections in relation to these grounds of its own motion.

2. *Added subject-matter (Article 123(2) EPC):*

2.1 The subject-matter of claims 1 and 5 of both requests results from the combination of the subject-matter of originally filed independent claims 1 and 6 (present claim 1) and of the subject-matter of original claim 6 alone (present claim 5) in each case with an additional feature as follows (emphasis by the board):

"means for maintaining the call transfer information **to be used** while the mobile station remains coupled to the communication network **and switches to an access protocol of the communication network.**"

2.2 There is agreement that the expression "call transfer information" is originally literally disclosed only in original claim 6 and its corresponding wording in the description. There is no literal disclosure of the feature (in bold) "the call transfer information **to be used**", and of the feature that the emulator comprises "means for maintaining the call transfer information to be used **while the mobile station switches to an access protocol of the communication network**".

Hence, it is necessary to decide whether the original application documents comprise an unambiguous implicit disclosure of the features in question.

2.3 In order to develop the argument, it is necessary to clarify some of the terms used.

The respondent, and likewise the opposition division, argued that "call transfer information" has to be understood as being identical to "dynamic data relating

to the state of the mobile station" as used on page 15, lines 1-6 and 17-20 of the published application (see letter of 24 May 2010, page 2, penultimate full paragraph).

In the following, for the sake of argument the board accepts such a reading and disregards the controversy related to this identification.

Furthermore, having regard to the feature "switches to an access protocol (IP) of the communication network" the board understands that in accordance with page 13, lines 21-31 in combination with Figure 4 the mobile station is connected via an access point AP to the IP network for making use of the services of a mobile communication network through an IP access protocol. Furthermore, in connection with the switching to the local area network (of which the access point AP is part, see Figure 4), "the mobile station transfers the dynamic data ... to the interworking unit through the IP network" (page 15, lines 1-3). The data transfer via the IP network necessarily implies that the mobile station has switched to an access protocol of the communication network.

Furthermore, as argued by the respondent, the mobile station emulator is understood to be equivalent to the virtual terminal (vMS) and to the mobile station emulator (see letter of 24 May 2010, page 3, second full paragraph).

- 2.4 The board agrees with the respondent that the originally filed application discloses (see page 15, lines 1-6 and 17-20 of the published application) that

the mobile station switches to the local area network and transfers dynamic data relating to the state of the mobile station and the calls in progress to the virtual terminal vMS35 to be established in the interworking unit 40. Thereafter, these data are maintained in a state machine located in the virtual terminal.

Even accepting the above correspondences and equivalents (see point 2.3), the above passage in claims 1 and 5 does not disclose the feature in question.

According to claim 1 the emulator comprises "means for maintaining the call transfer information to be used while the mobile station ... switches to an access protocol of the communication network" which the board understands as meaning that the call transfer information is present in the emulator at the moment the mobile station switches to an access protocol. Page 15, lines 17-20 of the published application states that "When changing over to the IP mode, the mobile station 34 transfers the dynamic data relating to the state of the mobile station and the calls in progress to a virtual terminal vMS 35 to be established in the interworking unit 40. These data are maintained in a state machine, which is located in the virtual terminal." This, the board understands as meaning that the dynamic data are first transferred to a virtual terminal in the interworking unit. Then, **these** data (*i.e.* the transferred data) are maintained in a state machine located in the virtual terminal. Hence, call transfer information is not maintained **while** the mobile station switches to an access protocol of the communication network, it is maintained **after** it has

switched to the access protocol. Logically, no data transfer via the communication network (the IP network) is possible before the mobile station has switched to its access protocol.

As a consequence, there is no original disclosure for the feature that the emulator comprises means for maintaining the call transfer information to be used while the mobile station switches to an access protocol of the communication network.

- 2.5 With respect to the respondent's arguments, the board notes that its above understanding of the original description, namely that the call transfer information is first transferred to the interworking unit and that then these data are maintained in a state machine located in the virtual terminal established in the interworking unit, is on the one hand confirmed by the respondent (see *e.g.* page 2, third full paragraph of the letter of 24 May 2010). On the other hand the respondent goes on to argue (see point 1.3 in the letter of 11 October 2012) that the mobile station first transfers the call transfer information to be used to the interworking unit, to be maintained there for the time the mobile station switches off its RF parts and changes over to the IP mode.

The respondent appears to imply that the changeover of the mobile station's communication with the interworking unit through the IP network is the same as the mobile station's switching to the IP network. These two actions, switching to the IP network and changing over to communicate through it, are, however, two different temporally spaced events as is made clear by

the word "after" (page 15, line 3) linking the switching to and communication through the IP network. In any case, as has already been pointed out above, logically any data transfer from the mobile station through the IP network, which is prior to the mobile station's switching off of its RF parts (page 15, lines 1-6) requires the mobile station having switched to the IP protocol.

The respondent further argued it would have been obvious to the skilled person that the emulator must have been in the possession of call transfer data previous to the switching of the mobile terminal to the access protocol.

This is, however, an obviousness argument which, according to the established case law of the boards of appeal is not valid to justify the addition of a feature otherwise not originally disclosed. The relevant test for such a feature is instead the novelty test which this feature, in view of the reasoning set out above, fails.

The board sees also no technical necessity for the transmission of call transfer data to the emulator prior to the mobile station's switching to an access protocol. It is correct that, in accordance with page 14, lines 22 to 28 of the published application, when physical access to a wireless local area network is made the mobile station receives a notice that it is within the subscription area of such a network, upon which a decision to switch to said network is made. This by no means implies the transmission of call transfer data at the moment of physical access, the

transfer of data being disclosed to commence only at the moment of switching to the network, as reasoned above at point 2.4.

3. Since the feature in question is present in both requests of the respondent, neither of the respondent's requests complies with the requirements of Articles 123(2) EPC and therefore neither request can be allowed.
4. For the reasons set out above it has proved unnecessary to decide whether the further independent claims comply with the requirements of Article 123(2) EPC.
5. There being no allowable request, the patent cannot be maintained.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar

The Chairman

G. Rauh

A. S. Clelland