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**Datasheet for the decision
of 3 September 2012**

Case Number: T 2374/09 - 3.5.03

Application Number: 00985250.0

Publication Number: 1249144

IPC: H04Q 7/34, H04L 29/14,
H04L 12/24

Language of the proceedings: EN

Title of invention:
Communication method and system

Applicant:
Nokia Corporation

Headword:
Communication method and system/NOKIA

Relevant legal provisions:
EPC Art. 56
RPBA Art. 13(1) and (3)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Inventive step (main and auxiliary request) - no"
"Admissibility (new auxiliary request) - no"

Decisions cited:
-

Catchword:
-



Case Number: T 2374/09 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 3 September 2012

Appellant: Nokia Corporation
(Applicant) Keilalahdentie 4
FI-02150 Espoo (FI)

Representative: Style, Kelda Camilla Karen
Page White & Farrer
Bedford House
John Street
London WC1N 2BF (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 July 2009
refusing European patent application
No. 00985250.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: A. J. Madenach
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. The present appeal is against the decision of the examining division to refuse application No. 00985250.0 on the ground that the independent claims according to the main request violated the provisions of Article 123(2) EPC, that various claims did not comply with the requirements of Article 84 EPC, that the subject-matter of claims 10 to 14 and 20 to 24 could not be regarded as an invention in the sense of Article 52(2)(c) EPC, and that the subject-matter of the independent claims did not involve an inventive step (Articles 52(1), 56 EPC). The independent claims of the first auxiliary request were said not to be clear (Article 84 EPC), whilst the subject-matter of claims 10 to 14 and 20 to 24 could not be regarded as an invention in the sense of Article 52(2)(c) EPC and the subject-matter of the independent claims was said not to involve an inventive step (Articles 52(1), 56 EPC). The independent claims of the second auxiliary request were said not to be clear (Article 84 EPC) and their subject-matter was said not to involve an inventive step (Articles 52(1), 56 EPC). The examining division came to similar conclusions with regard to the third and fourth auxiliary requests.
- II. In the statement of grounds of appeal the appellant requested that the decision of the examining division be set aside and a patent be granted on the basis of a set of claims 1-24 according to a main request, or, as an auxiliary measure, on the basis of a set of claims 1-24 according to an auxiliary request, both as filed with the statement of grounds of appeal. An auxiliary request was made for oral proceedings.

III. The board summoned the appellant to oral proceedings. In a communication accompanying the summons, the board gave its preliminary opinion.

IV. With letter of 3 August 2012, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main or auxiliary requests as filed with this letter or, if these requests were not to be accepted, on the basis of the original main and auxiliary requests filed with the statement of grounds of appeal.

With letter of 31 August 2012, the appellant informed the board that it would not be attending the oral proceedings.

V. The oral proceedings took place on 3 September 2012 in the absence of the appellant.

After deliberation by the board, the chairman announced the board's decision.

VI. Claim 1 according to the main request reads:

"A mobile station (8) for use in a communication system comprising said mobile station (8), at least one node (14) and another node (12), said mobile station (8) and the at least one node (14) being connectable, the mobile station comprising:

means for requesting a connection for using a service with the at least one node (14);

means for receiving an error message when a connection failure occurs between said mobile station (8) and said at least one node (14) the error message comprising an error indication of the connection failure;

means for automatically providing to said another node (12) a short message service message comprising the error indication and configuration information of the mobile station (8); and

means for receiving information determined by said another node for changing the settings of the mobile station (8) in order to permit the connection failure to be corrected."

Claim 8 according to the main request reads:

"A communication method comprising:

requesting by a mobile station (8) a connection for using a service with at least one node (14);

receiving in the mobile station (8) when a connection failure occurs between said mobile station (8) and said at least one node (14) an error message comprising an error indication of said connection failure;

automatically providing from the mobile station (8) to another node (12) a short message service message comprising the error indication and configuration information of the mobile station (8);

receiving information determined by the another node (12) for changing the settings of the mobile station

(8) in order to permit the connection failure to be corrected."

Claim 10 according to the main request is directed to a node for use in a communication system.

Claim 12 according to the main request is directed to a further communication method.

Claim 13 according to the main request is directed to a system.

Claims 1 and 8 according to the auxiliary request as filed with letter of 3 August 2012 both comprise the further feature "using a SIM tool kit" added to the end of the respective claims.

Claim 1 according to the auxiliary request as filed with the grounds of appeal reads:

"A mobile station (8) for use in a communication system comprising said mobile station (8), at least one node (14) and another node (12), said mobile station (8) and the at least one node (14) being connectable, the mobile station comprising:

means for requesting a connection for using a service with the at least one node (14);

means for receiving an error message when a connection failure occurs between said mobile station (8) and said at least one node (14) the error message comprising an error indication of the connection failure;

means for automatically providing to said another node (12) a message comprising the error indication and configuration information of the mobile station (8); and

means for receiving information for changing the settings of the mobile station (8) the received information being determined by said another node to correct the said connection failure

wherein a user of the mobile station (8) is a subscriber to the service."

Claim 15 according to the auxiliary request as filed with the grounds of appeal reads:

"A communication method comprising:

requesting by a mobile station (8) a connection for using a service with at least one node (14);

receiving in the mobile station (8) when a connection failure occurs between said mobile station (8) and said at least one node (14) an error message comprising an error indication of said connection failure;

automatically providing from the mobile station (8) to another node (12) a message comprising the error indication and configuration information of the mobile station (8);

receiving information for changing the settings of the mobile station (8), the received information being

determined by the another node (12) to correct the connection failure

wherein a user of the mobile station (8) is a subscriber to the service."

Independent claims 19, 23, 24 according to the auxiliary request as filed with the grounds of appeal are directed to a node for use in a communication system, a further communication method, and a system, respectively.

Reasons for the decision

1. *Procedural matters:*

1.1 The appellant did not attend the oral proceedings and thus chose to rely on its written case (cf. Article 15(3) RPBA). The board's reasons for not allowing either the main request or the auxiliary request as filed with the grounds of appeal concern Article 56 EPC. This matter had been raised in the impugned decision as well as the board's communication, and the appellant commented on it extensively. The board was therefore in a position to issue a decision at the oral proceedings complying with Article 113(1) EPC.

1.2 For the reasons set out below at point 2 the board did not admit the auxiliary request filed with the letter of 3 August 2012. The reasons for not admitting this request are the requirements of Article 13 RPBA, of which the appellant was well aware as becomes evident

from the letter accompanying this request in which the appellant commented on the requirements of this article. The board was therefore in a position to issue a decision on the admissibility of the auxiliary request at the oral proceedings complying with Article 113(1) EPC.

- 1.3 The board understands the conditional request made in the letter of 3 August 2012 in such a way that if one of the new main or auxiliary requests is not admitted by the board, the corresponding previous request should be maintained. In view of the decision to not admit the auxiliary request as submitted with letter of 3 August 2012 (see point 2 below), the board considered the auxiliary request as submitted with the statement of grounds as the valid auxiliary request.

2. *Admissibility of requests:*

- 2.1 The independent claims of the main request as filed with letter of 3 August 2012 essentially comprise, compared to the independent claims of the previous main request, the additional feature of the message being an SMS message. This feature was already present in the original claims and does not increase the complexity of the subject-matter of the claims.

The board therefore exercises its discretion according to Article 13(1) of the Rules of Procedure of the Boards of Appeal and admits the main request.

- 2.2 The further feature included in the claims according to the auxiliary request as filed with letter of 3 August 2012, *i.e.* the use of a SIM tool kit, is claimed for

the first time in this request. It is mentioned at only one point in the original application documents, namely at page 9, line 3 of the published description. It is unlikely that the search was performed with this feature in mind. Admitting this request would thus require remitting the case to the department of first instance, contravening the need for procedural economy.

Bearing in mind the advanced stage of the appeal proceedings and the nature of the amendments, which introduce a new feature taken from the description, the board exercises its discretion according to Article 13(3) of the Rules of Procedure of the Boards of Appeal and does not admit the auxiliary request as filed with letter of 3 August 2012.

2.3 In accordance with the appellant's implied request made in the letter of 3 August 2012, the board retains the auxiliary request made in the grounds of appeal as the valid auxiliary request.

3. *Main request, inventive step (Article 56 EPC):*

3.1 The invention as recited in claim 8 according to the main request relates to a communication method in which a mobile station upon receiving an error message during the process of setting up a connection to a network node automatically provides another network node with the error message and its configuration information in the form of an SMS and receives information from said another node for changing its settings in order to permit correction of the failed connection.

The board notes that the original invention was conceived to be also implemented in such a way that said another node comprises a human operator (see page 9, lines 5-8 of the published application).

- 3.2 The board considers communication methods as acknowledged in the present application ("Background to the invention") and in the letter of 3 August 2012 (section 4.4) as the closest prior art.

In particular, a communication method is acknowledged to be known comprising:

requesting by a mobile station a connection for using a service which is a data service (e-mail, internet) and is provided by a node ("Background to the invention", first paragraph and second paragraph, lines 1-4).

It is furthermore known that connection failures may occur between said mobile station and said node ("Background to the invention", second paragraph, lines 4-9). The board considers it to be implicit in the known method that the mobile station receives an error message in the widest sense comprising an indication of the connection failure. This follows from the fact that the acknowledged prior art indicates the possibility of the user of the mobile station contacting the network operator for assistance in determining the cause of the failure to establish a connection ("Background to the invention", third paragraph). This presupposes that the user is aware of a failed connection.

The board also assumes that during a conversation of the user with the network operator, error and

configuration information must be obtained to resolve the connection failure. Hence, the acknowledged prior art comprises prior reception of some kind of error message and providing from the mobile station to another node a message comprising information about the error indication and configuration information of the mobile station and receiving information determined by the another node (*i.e.* advice from the operator) for changing the settings of the mobile station in order to permit the connection failure to be corrected.

Hence, as also acknowledged in the letter of 3 August 2012, the subject-matter of claim 8 according to the main request differs from the known communication method essentially by **automatically** providing to another node an **SMS** message with previously received error and configuration information.

3.3 These features solve the problem of automating a hitherto manually performed method.

No invention can be seen in the mere automation of an act formerly performed manually.

The only specific feature which goes beyond a mere automation requires that the message hitherto sent orally between the user and the node (the operator) is sent as an SMS message. However, automation of the previous oral contact of the user with the network operator requires a machine readable message to replace the oral message. A short message service message is a standard option given its simplicity, and because it relies on the same connection to the node as the

previous connection between the user and the network operator.

3.4 The appellant's arguments center on the advantages of an automated solution. That a solution to a problem brings with it advantages is, however, not necessarily an indication of an inventive step if the solution was obvious in the first place.

3.5 The board therefore concludes that the subject-matter of claim 8 of the main request does not meet the requirements of Articles 52(1) und 56 EPC.

3.6 The main request as a whole is therefore not allowable.

4. *Auxiliary request, inventive step (Article 56 EPC):*

4.1 Claim 15 according to the auxiliary request as filed with the statement of grounds omits compared to claim 8 of the main request that the message is an SMS message and essentially comprises the further feature that "a user of the mobile station (8) is a subscriber to the service".

The board notes that this feature was well known at the relevant priority date and is, indeed, a prerequisite to being able to set up a connection in the first place.

4.2 The board therefore concludes that the subject-matter of claim 15 of the auxiliary request does not meet the requirements of Articles 52(1) und 56 EPC.

4.3 The auxiliary request is therefore not allowable.

5. Since, for the reasons set out above, neither of the requests is allowable, it follows that the appeal cannot be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland