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**Datasheet for the decision  
of 16 May 2012**

**Case Number:** T 0970/10 - 3.5.03

**Application Number:** 06113169.4

**Publication Number:** 1725064

**IPC:** H04Q 7/38, H04Q 7/32

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for routing a call to a dual mode wireless device

**Applicant:**

AT&T Corp.

**Opponent:**

-

**Headword:**

Call routing/AT&T

**Relevant legal provisions:**

EPC Art. 54(2), 56, 94, 84, 111(1), 123(2)

EPC R. 61, 103(1)(a)

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

EPC Art. 96

EPC R. 44

**Keyword:**

"Refusal based on a post-published state of the art document"

"Remittal - yes"

"Substantial procedural violation/reimbursement of the appeal

fee - no"

**Decisions cited:**

-

**Catchword:**

A decision relying on a post-published document which does not form part of the state of the art under Article 54(2) EPC does not constitute a substantial procedural violation justifying reimbursement of the appeal fee.



Case Number: T 0970/10 - 3.5.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.03  
of 18 May 2012

**Appellant:** AT&T Corp.  
(Applicant) 32 Avenue of the Americas  
New York, NY 10013-2412 (US)

**Representative:** Harding, Richard Patrick  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 21 December 2009  
refusing European patent application  
No. 06113169.4 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** T. Snell  
M.-B. Tardo-Dino

## Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European patent application No. 06113169.4, with publication number EP-A-1725064.

The refusal was based on the ground that the subject-matter of independent claims 1 and 6 did not meet the requirement of inventive step pursuant to Article 52(1) in combination with Article 56 EPC based on a combination of the following documents:

D1: WO-A-2004/082219

D4: "Telecommunications and Internet Converged Services and Protocols for Advanced Networking (TISPAN); Fixed Mobile Convergence; Requirements Analysis; Draft ETSI TR 181 011", ETSI Standards, Lis, Sophia Antipolis Cedex, France, vol. TISPAN, No. V 0.0.6, 1 September 2006.

The board's decision also refers to the following document mentioned in the impugned decision:

D5: US-A-2006/126582

Documents D4 and D5 were not cited in the European search report but introduced by the examining division with the communication of 09.07.2009.

In a section of the decision entitled "Remarks", it was further considered that claims 1 and 6 did not comply with Articles 123(2) and 84 EPC.

II. The appellant filed a notice of appeal against the above decision "in its entirety". New claim sets of a main request and five auxiliary requests were subsequently filed together with a statement of grounds of appeal.

The appellant also requested that "the application is not refused at any stage without first giving the applicant an opportunity to attend oral proceedings".

III. In a fax communication pursuant to Article 17 RPBA, the board advised the appellant that the decision had been based partly on document D4 which was published after the filing date of the application, ie did not form part of the state of the art pursuant to Article 54(2) EPC. The board indicated its intention to remit the case to the examining division without consideration of the substantive issues.

IV. In a reply to the board's communication, the appellant stated that it was happy for the case to be remitted to the examining division for further prosecution. However, the appellant argued that the citing of documents which are not part of the state of the art under Article 54(2) EPC was a [substantial] procedural violation with respect to Article 94 and Rule 61 EPC, and requested reimbursement of the appeal fee.

V. From the written submissions, the board understands that appellant requests that the decision under appeal be set aside and a patent granted on the basis of the main request, or alternatively one of the first to fifth auxiliary requests, all filed with the statement

of grounds of appeal. The appellant also requests reimbursement of the appeal fee.

VI. Claim 1 of the main request reads as follows:

"A method for routing a call to a dual mode wireless device (102) supporting cellular networks and wireless local area networks, the method comprising the steps of:  
receiving (302) said call at a network node (106);  
selecting (304) one of a plurality of networks for use in connecting said call to said dual mode wireless device (102);  
routing (306) said call to said dual mode wireless device (102) via said selected network;  
determining that a cellular network and a wireless local area network are available; and  
re-routing said call to said dual mode wireless device (102) via a preferred network during said call, wherein said preferred network is determined based on a capacity of each of the plurality of networks, said capacity based on information in a database and communication between the network node and the plurality of networks."

Independent claim 6 reads as follows:

"A network node (106) for routing calls associated with a dual mode wireless device (102) supporting cellular networks and wireless local area networks, the network node comprising:  
means for receiving said call at a network node (106);  
means for selecting one of a plurality of networks for use by a dual mode wireless device (102);

means for routing said call to said dual mode wireless device (102) over said selected network; and the network node characterized by  
means for determining that a cellular network and a wireless local area network are available; and  
means for re-routing said call to said dual mode wireless device (102) via a preferred network during said call, wherein said preferred network is determined based on a capacity of each of the plurality of networks, said capacity based on information in a database and communication between the network node and the plurality of networks."

VII. The claims of the first to fifth auxiliary requests are not reproduced as they are not relevant to the board's decision.

## **Reasons for the Decision**

### 1. *Inventive step*

The examining division based its reasoning on the disclosure of, *inter alia*, document D4. However, this document is dated September 2006 which is after the filing date of the present application (26 April 2006). Document D4 is consequently not prior art within the meaning of Article 54(2) EPC and hence not relevant to inventive step (Article 56 EPC); nor is there any suggestion that D4 discloses subject-matter well-known to the skilled person at the filing date of the application. The objection of lack of inventive step was therefore, *prima facie*, ill-founded. As this was

the ground leading to refusal of the application, the decision under appeal has to be set aside.

2. *Articles 123(2) and 84 EPC*

In the impugned decision, these objections are given as "Remarks" rather than as reasons for refusing the application. The examining division took the view that the feature of claims 1 and 6 "[means for] re-routing said call to said dual mode wireless device via a preferred network during said call, wherein said preferred network is an encrypted packet-based network" extended beyond the content of the application as filed and was not clear. However, the board observes that claims 1 and 6 of the appellant's new main request do not include this feature. These objections therefore apparently no longer apply.

3. *Remittal*

The amended claims of each request have to be examined for compliance with the EPC, in particular Articles 123(2), 84 and 52(1) EPC.

With respect to inventive step (cf. Articles 52(1) and 56 EPC), the claims of each request have to be re-examined without taking into account the disclosure of document D4, or indeed of document D5, a further post-published document mentioned in the impugned decision (published 15 June 2006). As this is now a new situation ("fresh case"), the board considers that this re-examination should be undertaken by the examining division in order to accord the applicant two instances of jurisdiction.



With respect to Articles 123(2) and 84 EPC, the offending subject-matter apparently has been removed from the independent claims of the main request, and replaced by a new amendment. This new matter has to be examined for compliance with Articles 123(2) and 84 EPC for the first time, ie also relates to a "fresh case".

In this light, the board has no reason to continue examination of the case itself and deems it appropriate to remit the case to the examining division for further prosecution on the basis of the new main request and the first to fifth auxiliary requests (Article 111(1) EPC).

4. *Reimbursement of the appeal fee*

4.1 An incorrect assessment of a document with regard to its date of availability to the public relates to a factual error in respect of the substantive requirements to be met by the "state of the art" in accordance with Article 54(2) EPC (which is included in Part II of the EPC, "Substantive Patent Law"), and not to an error in respect of procedural law. Such an error therefore does not amount to a substantial *procedural* violation.

4.2 The appellant argued that the citing of documents which are not part of the state of the art under Article 54(2) EPC was a procedural violation, as it was contrary to the correct procedure for performing examination under Article 94 EPC, or for drawing up a search report under Rule 61 EPC.

4.3 However the board notes that the procedure followed by the examining division apparently fully complied with Article 94 EPC, or Article 96 EPC 1973, in that the examining division examined whether the European patent application met the requirements of the EPC, determined that the application or the invention to which it relates did not meet the requirements of the EPC, and invited the applicant to file his observations. One of the purposes of the procedure set out in Article 94 EPC is in fact to provide the applicant with the opportunity to point out exactly the kind of substantive error committed by the examining division.

4.4 With regard to Rule 61 EPC (cf. Rule 44 EPC 1973), this concerns the content of the European search report. If the search report putatively contained an error of fact regarding a document's date of availability to the public (although in the present case the content of the search report is not relevant as documents D4 and D5 were not mentioned in the European search report) this would also be a substantive rather than a procedural matter.

4.5 In accordance with Rule 103(1)(a) EPC, "the appeal fee shall be reimbursed ... if such reimbursement is equitable by reason of a substantial procedural violation". As there was no substantial procedural violation, this request is refused.

5. *Oral proceedings*

There is no need to hold oral proceedings before the board as these were only requested in the event of

impending refusal of the application (ie, implicitly, dismissal of the appeal).

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland