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**Datasheet for the decision
of 7 February 2014**

Case Number: T 1619/10 - 3.5.03

Application Number: 99938966.1

Publication Number: 1103130

IPC: H04L29/06, H04M3/56, H04N7/15

Language of the proceedings: EN

Title of invention:
A method for exchanging signaling messages in two phases

Applicant:
AT&T Corp.

Headword:
Two-phase signaling message exchange/AT&T

Relevant legal provisions:
EPC Art. 123(2)
RPBA Art. 12(4), 13(1)

Keyword:
Amendments - added subject-matter (yes)
Admissibility of all requests (no)
Substantial procedural violation (no)

Decisions cited:
T 0902/10

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1619/10 - 3.5.03

**D E C I S I O N
of Technical Board of Appeal 3.5.03
of 7 February 2014**

Appellant: AT&T Corp.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 4 December 2009
refusing European patent application No.
99938966.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: F. van der Voort
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. 99938966.1, with international publication number WO 00/08821 A.

The refusal was based on the ground that the subject-matter of claim 1 of respectively the main request and the first and second auxiliary requests did not comply with Article 123(2) EPC.

- II. The appellant filed a notice of appeal against the above decision. Claims of a new main request and first to fourth auxiliary requests were subsequently filed together with a statement of grounds of appeal.

The appellant also drew attention to an alleged substantial procedural violation committed by the examining division, although made no request in connection therewith.

Oral proceedings were conditionally requested.

- III. In a communication accompanying a summons to oral proceedings the board gave a preliminary opinion in which, *inter alia*, it was considered that claim 1 of each request respectively did not comply with Article 123(2) EPC. It also gave a preliminary view that no substantial procedural violation had been committed by the examining division.

- IV. With a response to the board's communication, the appellant filed claims of a main request and first to fifth auxiliary requests intended to replace the requests on file.

V. Oral proceedings were held on 7 February 2014.

At the oral proceedings the appellant submitted a sixth auxiliary request.

The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the claims of the main request or one of the first to fifth auxiliary requests, all as submitted with the letter dated 16 December 2013, or on the basis of claim 1 of the sixth auxiliary request as submitted during the oral proceedings.

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

VI. Claim 1 of the **main request**, the **first auxiliary request**, and the **second auxiliary request** reads as follows:

"A method for exchanging signaling messages in a packet network in which at least a setup message for establishing a call is routed between a calling party and a called party through two or more packet network entities (110,111,120,121), said two or more packet network entities including at least one gate controller, and characterised in that at least one subsequent message for establishing said call is routed between the calling party and the called party through at least one of said two or more packet network entities (110,111,120,121) but not through said at least one gate controller, wherein the at least one subsequent message comprises an end-to-end message between a telephony device (170)

associated with the calling party and a telephony device (171) associated with the called party, and wherein said at least one gate controller implements a set of communication service-supporting control functions in said packet network."

VII. Claim 1 of the **third auxiliary request** is the same as claim 1 of the main request except that the term "gate controller" is amended to "controller", the term "the at least one subsequent message" is amended to "said subsequent message", and the final feature "and wherein said at least one gate controller implements a set of communication service-supporting control functions in said packet network" is deleted.

VIII. Claim 1 of the **fourth auxiliary request** is the same as claim 1 of the third auxiliary request except that the terms "at least one controller and" and "said at least one controller" are replaced by the terms "an adjunct platform (110,111) implementing a set of communication-service-supporting control functions in said packet network," and "said adjunct platform (110,111)" respectively and that twice the reference sign "(110,111,120,121)" is deleted.

IX. Claim 1 of the **fifth auxiliary request** reads as follows:

"An apparatus for exchanging signalling messages for a call between a calling party and a called party, the apparatus comprising:

means for exchanging a setup message for the call through at least one adjunct platform (110,111) implementing a set of communication-service-supporting control functions, a plurality of network resources being reserved for the call based on the exchanged

setup messages;
characterised in that it further comprises means for exchanging an end-to-end signalling message for the call without the end-to-end message being routed through the at least one adjunct platform (110,111)."

X. Claim 1 of the **sixth auxiliary request** reads as follows:

"A method for exchanging signaling messages in a packet network in which a setup message for establishing a call is routed between a calling party and a called party through a first network edge device (120) associated with the calling party, through a second network edge device (121) associated with the called party and through at least one gate controller (110,111), and characterised in that a subsequent message for establishing said call is routed between the calling party and the called party through the first and second network edge devices but not through the or each gate controller (110,111), wherein the subsequent message comprises an end-to-end message between a telephony interface unit (170) associated with the calling party and a telephony interface unit (171) associated with the called party, and wherein said at least one gate controller implements a set of service specific communication-service-supporting control functions in said packet network."

Reasons for the Decision

1. *Admissibility of the main request, the first to fourth auxiliary requests and the sixth auxiliary request*

- 1.1 In accordance with Article 13(1) RPBA "Any amendment to a party's case after it has filed its grounds of appeal or reply may be considered at the board's discretion. The 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."
- 1.2 In accordance with established case law, late-filed requests comprising new claims which are prima facie not allowable are generally not admitted.
- 1.3 In the present case, claim 1 of each of the main request, the first to fourth auxiliary requests and the sixth auxiliary request prima facie does not comply with Article 123(2) EPC for the reasons set out below.
 - 1.3.1 The standard test for compliance with Article 123(2) EPC is that amendments should be based on subject-matter directly and unambiguously derivable from the application as filed.
 - 1.3.2 Claim 1 of each the requests in question is said to be based on original claim 43, which is the originally filed claim of broadest scope. Claim 43 however includes the following step:

"exchanging a setup message for the call through at least one gate controller, a plurality of network resources being reserved for the call based on the exchanged setup messages" (Board's underlining).
 - 1.3.3 The underlined wording has been omitted from claim 1 of each of the main request, the first to fourth auxiliary requests, and the sixth auxiliary request, ie a method for exchanging signalling messages is claimed which is

not limited by the aspect of resource reservation. The board has to consider whether the application as filed provides a basis for the omission of this feature.

1.3.4 The appellant argued that the description as filed provided support for the amendment because the two aspects of resource reservation and signalling were described as distinct and independent, as shown by the fact that they were dealt with separately in the description. In this respect, a "section 2" entitled "Two-Phase Network Resource Reservation" appeared in the description on page 12, line 25 to page 19, line 17, and a "section 3" entitled "Two-Phase Signaling" appeared on page 19, line 19 ff.

1.3.5 Furthermore, the appellant drew attention to the general statement in section 3 on page 19, line 28 ff., which reads:

"Note this concept of two-phase signaling is distinct from the concept of two-phase network resource reservation in the sense that the two-phase signaling can be performed in combination with or independent of the two-phase network resource reservation. In other words, when done in combination, the messaging for the two-phase signaling can be interleaved with the messaging for the two-phase network resource reservation; when done independently, the messages for each can be distinct. The two-phase network resource reservation relates to reserving network resources without committing them, then committing those reserved resources. The two-phase signaling relates to performing signaling to set up the call, then once the call is setup (e.g., thereby confirming the authori[s]ed quality of service), exchanging end-to-end messaging."

1.3.6 As regards the extent of the disclosure of the present application as filed, the board notes firstly that it is stated in the introduction on page 1, lines 18-20, that "The present invention generally relates to allocating network resources. More specifically, the present invention relates to reserving and committing network resources based on an authorized quality of service". Furthermore all independent claims as originally filed either define that the exchange of end-to-end messages is dependent on the sending of a reserve message (claims 1, 8, 15, 22, 29 and 36) or state that network resources are reserved based on the exchanged setup messages (claim 43).

Therefore, neither the introduction to the description nor the original claims provide support for the omission of a resource reservation step from the independent claims.

1.3.7 As regards sections 2 and 3 of the description, the board does not find support for a signalling method in which there is no resource reservation step.

1.3.8 In this respect, section 3, which concerns the "Two-phase Signaling" method, states that "end-to-end messages relating to the connection of the call are exchanged only after the reservation messages have been exchanged and the reservation process is complete" (cf. page 21, lines 18-21; Board's underlining). Thus, apparently, resource reservation as described in further detail in section 2 is an indispensable part of the "Two-Phase Signaling" method.

1.3.9 Furthermore, in the general statement on page 19 referred to by the appellant (see above), the board

notes that the terms "distinct" and "independent" are given a more restricted meaning, namely that the messages concerned with resource reservation may be distinct and independent from the signalling messages as opposed to being interleaved with the signalling messages. However, this does not mean that resource reservation messages may be omitted entirely.

1.3.10 The board therefore concludes that the feature of resource reservation is presented in the application documents as filed as an essential and indispensable part of the invention. Since claim 1 of the main request, the first to fourth auxiliary requests, and the sixth auxiliary request respectively omit this feature, these claims are not directly and unambiguously based on the application documents as originally filed, contrary to Article 123(2) EPC.

1.4 As none of these requests, all filed at this very late stage, is prima facie allowable, the board holds the requests to be inadmissible (Article 13(1) RPBA).

2. *Admissibility - fifth auxiliary request*

2.1 Claim 1 of the fifth auxiliary request is in essence the same as claim 1 as filed with the letter dated 11 September 2007 during the examination procedure. Although the examining division raised no objections to the claim under Article 123(2) EPC (cf. the communication dated 28 December 2007), the claim was not maintained but replaced by claim 1 of a new main request filed with the letter dated 24 June 2008 in which the feature "a plurality of network resources being reserved for the call based on the exchanged setup messages" is omitted.

- 2.2 Article 12(4) RPBA gives the board the discretion to hold requests inadmissible which could have been presented in the first instance proceedings.
- 2.3 In exercising this discretion, it is established case law that the boards of appeal do not admit requests that were withdrawn during first instance proceedings (cf. eg T 902/10, not published, points 1.3-1.5 of the reasons), since they clearly fall into the category of requests which could have been presented [for decision] during the first instance proceedings. This is all the more evident in the present case, since it would have been clear to the applicant that the request in question would have complied with Article 123(2) EPC, non-compliance with which being the eventual ground for refusing the application. The applicant however chose expressly to not pursue the request in the examination procedure.
- 2.4 The appellant argued that claim 1 of the request had not been withdrawn but was retained as claim 25 of the claims filed with the letter dated 24 June 2008.

The board however notes that said claim 25 is not the same as claim 1 as filed with the letter dated 11 September 2007, since claim 25 is significantly broader in scope. Inter alia, as with claim 1 of that request, it omits the feature "a plurality of network resources being reserved for the call based on the exchanged setup messages".

- 2.5 The appellant explained that claim 1 had been amended during the examination procedure in order to deal with an objection of lack of novelty.

2.6 The board however does not find this to be a convincing reason for admitting the request at the appeal stage. On the contrary, if the board were to allow the re-introduction of the request, even if it prima facie overcomes the ground for the refusal (ie Article 123(2) EPC), it would be confronted with a request that had previously been objected to on the ground of lack of novelty (cf. aforementioned T 902/10). Since the appellant neither contested the objection of lack of novelty before the examining division, nor requested a reasoned decision on the issue, the admitting of the request now would run contrary to the purpose of the appeal proceedings which is primarily to examine the correctness of the first instance decision. If the applicant had regarded the objection of lack of novelty unfounded, it should have maintained the request at the examination stage in order that a reasoned decision be given by the examining division on that issue.

2.7 Consequently, the board holds the fifth auxiliary request to be inadmissible (Article 12(4) RPBA).

3. *Alleged substantial procedural violation*

3.1 In the statement of grounds, the appellant alleges that the examining division committed a substantial procedural violation by not specifying any time limit for replying to a request for information pursuant to Rule 141 EPC, which is a request to the applicant to provide information on prior art taken into consideration in the examination of national or regional patent applications and concerning an invention to which the European patent application relates.

3.2 However, the board notes that the reasons for refusing the application were based on Article 123(2) EPC. The board considers that information provided on the prior art in response to a request under Rule 141 EPC could not in any way have been relevant to the issue of Article 123(2) EPC and therefore would not have affected the decision; nor has the appellant suggested otherwise. Hence, even if the failure to specify and/or respect a time limit were for the sake of argument considered in a formal sense to have been a procedural violation, it did not negatively affect the outcome of the proceedings and was not therefore a substantial procedural violation within the meaning of Rule 103 EPC.

4. *Remittal*

The appellant requests that the decision under appeal be set aside and that the case be remitted to the department of first instance (Article 111(1) EPC). However, as there is no admissible request which could serve as a basis for further prosecution, there is no reason to remit the case. Consequently, the request for remittal is refused.

5. *Conclusion*

As there is no admissible 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:



G. Rauh

F. van der Voort

Decision electronically authenticated