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**Datasheet for the decision
of 1 December 2011**

Case Number: T 2166/10 - 3.5.03

Application Number: 01274013.0

Publication Number: 1374609

IPC: H04Q 7/26

Language of the proceedings: EN

Title of invention:
Mobile branch exchange

Patent proprietor:
Plahte, Ivar, et al

Opponent:
AWAPATENT AB

Headword:
Mobile branch exchange/PLAHTÉ

Relevant legal provisions:
EPC Art. 100(c)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Added subject-matter (yes)"

Decisions cited:
J 0003/00

Catchword:
-



Case Number: T 2166/10 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 1 December 2011

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(patent proprietor)

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Decision under appeal:

Decision of the opposition division of the
European Patent Office posted 23 August 2010
revoking European patent No. 1374609 pursuant
to Article 101(2) and 101(3)(b) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. This appeal is against the decision of the opposition division revoking European patent No. 1374609 which is based on European patent application No. 01274013.0 which was published as international application (PCT/IB01/002298) with international publication number WO 02/078368 A.
- II. The opposition was filed against the patent as a whole and on the grounds set out in Article 100(b) and (c) EPC.
- III. In its decision the opposition division held, *inter alia*, that, as concerns the description, only description pages 1, 2 and 26 to 43 were entitled to the international filing date of 4 December 2001 and that the subject-matter of the patent as granted extended beyond the content of the application as filed. A main request that the patent be maintained as granted was therefore not allowable (Article 100(c) EPC). Reasons were given.
- IV. The proprietor (appellant) lodged an appeal against this decision. In the statement of the grounds of appeal the appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request). Further, the appellant stated that "... all six auxiliary Requests as discussed at the oral proceedings dated 08.06.2010 are maintained". Oral proceedings were conditionally requested.
- V. In its reply to the statement of grounds of appeal the respondent (opponent) requested that the appeal be dismissed. Oral proceedings were conditionally requested.

VI. The parties were summoned by the board to oral proceedings. In a communication accompanying the summons, the board gave a preliminary opinion.

VII. In response to the summons the respondent informed the board that it would not attend the oral proceedings and withdrew its request for oral proceedings.

VIII. Oral proceedings were held on 1 December 2011 in the absence of the respondent. In the course of the oral proceedings, the appellant withdrew all six auxiliary requests and maintained the main request as its sole request, i.e. that the decision under appeal be set aside and that the patent be maintained as granted. At the end of the oral proceedings the board's decision was announced.

IX. Claim 1 as granted reads as follows:

"A system for providing private branch exchange, PBX, functionality to a mobile communications device, a mobile branch exchange, MBX, system; utilizing a mobile communications device (108) operable to communicate via a voice pathway (150) and a data pathway (152); further utilizing a private branch exchange (102) operable to communicate with the mobile communications device (108) via a voice pathway (150); further utilizing a server (110) being able to communicate with the mobile communications device (108) via a data pathway (152), and to monitor the PBX for activity related to a user of the mobile communications device, and to control the PBX in accordance with commands received by the data pathway from the mobile communications device; wherein the system comprises:

a software server for the mobile branch exchange, MBX, system, the MBX server (110), being operable to communicate with a private branch exchange, PBX, (102) via a data connection such as a Computer. [sic] Telephony Integration, CTI, interface (140) in order to (i) monitor the PBX for activity related to a user of the mobile communications device who is also a user of the PBX, and (ii) control the PBX in accordance with algorithms residing in the MBX server or commands received from the mobile communications device over the data pathway (152);

a mobile communications device (108), which comprises a software client for the mobile branch exchange system, MBX client, (208), operable to communicate in parallel via a voice pathway (150) with a PBX, and via a data pathway (152) with the MBX server (110), the MBX client also being operable to (i) monitor the mobile communications device for activity related to a voice pathway (150) between the mobile communications device and the PBX, and (ii) control the voice pathway (150) between the mobile communications device and the PBX in accordance with commands received via the data pathway (152) from the MBX server and from the user of the mobile communications device;

a private branch exchange, PBX, (102) operable to be in communication with the MBX server (110) by exposing a data connection such as a Computer Telephony Integration, CTI, interface (140) to the MBX server, the PBX also being operable to be in communication with the mobile communications device (108) via a voice pathway (150);

a data pathway (152) between the mobile branch

exchange server (110) and the mobile branch exchange client (208), which is in parallel to a voice pathway (150) between a mobile communications device (108) and a private branch exchange (102);
a combination of voice and data channels via a Voice Data Synchronization Protocol (VDSP) implemented in both the mobile branch exchange, MBX, server (110) and the mobile branch exchange, MBX, client (208)."

Reasons for the Decision

1. *Article 100(c) EPC*

- 1.1 The appellant argued that the international application, on which the patent in suit was based, was completely filed on the date of filing, i.e. 4 December 2001, and that it therefore included, *inter alia*, description pages 3 to 25. Further, the appellant argued that, since the arguments given by the opponent in support of the opposition grounds were solely based on the assumption that these description pages were not part of the application as filed, the opponent's arguments had to fail and, hence, that the opposition had to be rejected.
- 1.2 In the present case it is therefore necessary to determine which documents made up the application as filed and, in particular, whether or not the description pages 3 to 25 were part of the application as filed on 4 December 2001.
- 1.3 In this respect the board notes that in the proceedings before the International Preliminary Examining Authority

(IPEA), in the present case the EPO, the applicant submitted on 3 July 2002 a Demand under Article 31 PCT together with amendments under Article 34 PCT. In the accompanying letter the applicant made it clear that the amendments were to be taken into account by the IPEA only if the receiving Office, in the present case the International Bureau, were not to grant a petition which was pending before the receiving Office and in which the applicant requested that it be held that the international application was completely filed on 4 December 2001, i.e. including, *inter alia*, the description pages 3 to 25. The amendments under Article 34 PCT consisted of "new pages" 3 to 25, i.e. new paragraphs [0006](second part) and [0007] to [0057]. In a table, the applicant indicated for each of these "newly added pages" and for each paragraph thereof which parts of the application as originally filed, i.e. description pages 1, 2 and 26 to 43, Figures 1 to 23, and claims 1 to 52, provided a basis.

The board further notes that, subsequently, in a communication dated 6 August 2002 the International Bureau informed the applicant and the IPEA that following a decision:

- the originally filed pages 3 to 25 of the description were held to be null and void and were to be disregarded;
- the international filing date was corrected to read 4 December 2001;
- the earliest priority date, i.e. 5 December 2000, was reinstated; and
- the international application would be published as such, i.e. without pages 3 to 25 of the description, with an indication to this effect.

In accordance with this decision, the application was published without the above-mentioned description pages 3 to 25 and with international filing date 4 December 2001. The description as published included the following note between pages 2 and 26: "ATTENTION: PAGES 3-25 WERE MISSING UPON FILING".

The International Preliminary Examination Report (IPER), dated 20 March 2003, was based, *inter alia*, on description pages 1 to 45 "as received on 01/03/2003 with letter of 25/02/2003" and which were annexed to the IPER. More specifically, paragraphs [0001] to [0005](first part) of the annexed description correspond to paragraphs [0002] to [0006](first part) of the application as published, whereas paragraphs [0005](second part) to [0008] and [0021] to [0068] of the annexed description respectively correspond to paragraphs [0006](second part) to [0009] and paragraphs [0010] to [0057] of the description pages as filed by the applicant by way of amendment under Article 34 PCT. The renumbering of the paragraphs was due to deleting paragraph [0001] and inserting a new section concerning the prior art, namely paragraphs [0009] to [0020].

On entry of the European phase, the applicant indicated that the proceedings before the EPO as elected Office were to be based on the documents on which the IPER was based.

With the communication under Rule 51(4) EPC 1973 the applicant was informed that the examining division intended to grant a patent on the basis of, *inter alia*, description pages 2 to 5 and 7 to 45 as annexed to the IPER. An annex to the communication included bibliographic data of the patent application, including, *inter alia*,

4 December 2001 as the date of filing of the application. By filing the translations of the claims and by paying the fees for grant and printing, the applicant approved the text intended for grant. The decision to grant was issued on 2 November 2007 and mentioned 4 December 2001 as the date of filing.

The above observations were not contested by the appellant.

- 1.4 From the above, it follows that the International Bureau held that the description as originally filed, i.e. on 4 December 2001, did not include pages 3 to 25 and that, in accordance with the applicant's conditional request, the IPEA took into account the amendments submitted with the Demand, which resulted in the addition to the description as filed of new paragraphs [0005](second part) to [0008] and [0021] to [0068].
- 1.5 In the board's judgement, there can therefore be no doubt that the preliminary examination and the patent in suit were partly based on new description pages which had been submitted in the course of the international preliminary examination procedure by way of amendment and which were missing from the application as originally filed. The board therefore concludes that the application on which the patent in suit is based was not completely filed on the international filing date, i.e. 4 December 2001, in that it did not include description pages 3 to 25.
- 1.6 The question of whether or not the decision given by the International Bureau acting as receiving Office, in which it was held that the description pages 3 to 25 were not filed on the date of filing of the international

application, was correct does not alter the above facts and findings based thereon and, hence, need not be further considered by the board in the present decision. In fact, the board observes that neither before the EPO acting as IPEA in the international phase nor before the EPO examining division in the regional phase did the applicant raise the issue of the missing pages or request a correction of the filing date (cf. J 03/00, not published in OJ EPO). Nor did the applicant contest that the preliminary examination or the patent to be granted was partly based on new description pages which were only submitted in the course of the international preliminary examination procedure by way of amendment and which were missing from the application as originally filed. Nor subsequently did the applicant file a request for correction of an error in the decision to grant.

- 1.7 The appellant's argument that the arguments submitted by the opponent in support of the opposition grounds had to fail for the reason that they were solely based on the wrong assumption that description pages 3 to 25 were not part of the application as filed, is therefore not convincing.

- 1.8 The board concludes that the opposition division was correct when it held that the application as filed did not include the description pages 3 to 25. Further, the board notes that the opposition division gave a detailed reasoning as to why the opposition ground set out in Article 100(c) EPC prejudiced the maintenance of the patent as granted and that in the statement of grounds of appeal the appellant did not submit any arguments against this reasoning. Since the board does not see any reason to deviate from the reasoning given by the opposition

division, it concludes that the opposition ground set out in Article 100(c) EPC prejudices the maintenance of the patent as granted.

- 1.9 The appellant's sole request is therefore not allowable.
2. The sole request not being allowable, 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

A. S. Clelland