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**Datasheet for the decision
of 15 January 2013**

Case Number: T 0008/11 - 3.5.03
Application Number: 96202496.4
Publication Number: 0763960
IPC: H04Q 11/04, H04M 11/00
Language of the proceedings: EN

Title of invention:

Communications system for interactive services with a packet switch interaction channel

Patent proprietor:

Koninklijke KPN N.V.

Opponents/Interveners:

Cisco Systems Inc.
Dipl.Phys. D. Buchetmann
Nokia Deutschland GmbH
Nokia Siemens Networks GmbH & Co. KG
Nokia Oyj
Nokia Siemens Networks Oy

Headword:

Communications system/KPN

Relevant legal provisions:

EPC Art. 100(c), 123(2), (3)

Relevant legal provisions (EPC 1973):

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Keyword:

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

"Added subject-matter and extension of protection conferred - third auxiliary request (no)"

Decisions cited:

G 0002/88

Catchword:

-



Case Number: T 0008/11 - 3.5.03

DECISION
of the Technical Board of Appeal 3.5.03
of 15 January 2013

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Decision under appeal: **Decision of the opposition division of the European Patent Office posted 25 October 2010 revoking European patent No. 0763960 pursuant to Article 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. 0763960 (which is based on European patent application No. 96202496.4) on the grounds that the subject-matter of claim 1 of each one of a main request and fourth to eleventh auxiliary requests extended beyond the content of the application as filed (Articles 100(c) and 123(2) EPC) and claims 1 of second and third auxiliary requests extended the scope of protection (Article 123(3) EPC).

- II. An opposition was filed by Cisco Systems Inc. (USA), but was withdrawn in the course of the opposition proceedings. A further opposition was filed by opponent 2 (respondent I) against the patent as a whole and on the grounds pursuant to Article 100(a), (b) and (c) EPC.

- III. Notices of intervention were filed by opponents/ interveners 3 and 5 (respondents II and III) based on the opposition grounds pursuant to Article 100(a) and (c) EPC. Further notices of intervention were filed by Nokia Siemens Networks GmbH & Co. KG (Germany) and Nokia Siemens Networks Oy (Finland), but were withdrawn in the course of the opposition proceedings.

- IV. The proprietor (appellant) lodged an appeal against the decision. With the statement of grounds of appeal the appellant filed claims of a main request and eight auxiliary requests and submitted arguments in support.

- V. Respondent I (opponent 2) filed a reply to the statement of the grounds of appeal and implicitly requested that

the appeal be dismissed. Oral proceedings were conditionally requested.

- VI. Respondents II and III (opponent/interveners 3 and 5) filed a joint reply and requested that the appeal be dismissed. Oral proceedings were conditionally requested.
- VII. The parties were summoned by the board to oral proceedings. In a communication accompanying the summons, the board drew attention to issues to be discussed at the oral proceedings.
- VIII. In preparation for the oral proceedings, the appellant filed with a letter dated 15 November 2012 a new main request and new first to ninth auxiliary requests and submitted arguments in support.
- IX. In response to the board's communication, respondent I submitted further arguments in support of its request that the appeal be dismissed.
- X. Oral proceedings were held on 15 January 2013 in the absence of respondent I.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or one of the first to ninth auxiliary requests, all as filed with the letter dated 15 November 2012.

Respondents II and III requested that the appeal be dismissed. Respondent I requested in writing that the appeal be dismissed.

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

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

"Communication system (100,100'),
comprising a first communication path for transmission of user information from a services station (101) to a user station (102)
as well as a second communication path for transmission of selection information between the user station (102) and the services station (101),
the user station (102) being arranged for the issuing or receiving of data packets according to a first protocol and
the services station (101) being arranged for the receiving or transmitting of data packets according to the first protocol
the second communication path comprising:
a first network (107) arranged for the transmission of data according to a second protocol,
a first device (106) for receiving data packets from or transmitting data packets to the user station (102) and for supplying said data packets to or receiving said data packets from the first network (107), and
a second device (108) for receiving said data packets from or transmitting said data packets to the first network (107) according to the second protocol and for routing the received data packets to or receiving the data packets from the services station (101) via a second network (103) arranged to [sic] the transmission of data according to the first protocol."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the third paragraph reads as follows:

"as well as a second communication path between the user station (102) and the services station (101), wherein the second communication path is arranged for the transmission of selection information from the user station to the services station or for the transmission of selection information from the user station to the services station and interaction information from the services station to the user station,".

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that, in the third paragraph, the wording "interaction information" is replaced by "for the transmission of information".

Claim 1 of the third auxiliary request reads as follows:

"Communication system (100,100'),
comprising a first communication path for transmission of user information from a services station (101) to a user station (102)
as well as a second communication path for the transmission of selection information from the user station (102) to the services station (101)
the user station (102) being arranged for the issuing of data packets according to a first protocol and
the services station (101) being arranged for the receiving of data packets according to the first protocol
the second communication path comprising:
a first network (107) arranged for the transmission of

data according to a second protocol,
a first device (106) for receiving data packets from the user station (102) and for supplying the data packets to the first network (107), and
a second device (108) for receiving said data packets from the first network (107) according to the second protocol and for routing the received data packets to the services station (101) via a second network (103) arranged to [sic] the transmission of data according to the first protocol."

The claims of the fourth to ninth auxiliary requests are not relevant to the present decision and, hence, are not reproduced here.

Reasons for the Decision

1. *Main request - Article 100(c) EPC*
- 1.1 Claim 1 of the main request differs from claim 1 as granted in that, in the second paragraph, "for the transmission of user information between a services station (101) and a user station (102)" is replaced by "for the transmission of user information from a services station (101) to a user station (102)" (underlining by the board).
- 1.2 It was common ground between the parties that, in view of the plurality of "or"-statements in the claim, claim 1 as granted defined, *inter alia*, a communication system, in which the second communication path is for transmission of data packets exclusively in the downlink direction, i.e. from the services station to the user

station. The board sees no reason to question this.

- 1.3 The appellant argued that the application as filed implicitly provided a basis for an exclusive downlink transmission direction for data packets over the second communication path from the services station to the user station. In support, it referred to page 4, lines 4 to 20, and page 7, lines 12 to 14, of the description as filed as well as claim 15 as filed.

More specifically, the appellant argued that claim 15 defined a method of unidirectionally transmitting data packets over a second communication path, in which a "transmitting end" and a "receiving end" were mentioned, but without reference to a services station or a user station at these ends. This implied that the transmitting end could be located at either end of the second communication path and the same was true for the receiving end. Consequently, data packets were either unidirectionally transmitted from the user station to the services station (the transmitting end being the first device; the receiving end being the second device) or unidirectionally transmitted from the services station to the user station (the transmitting end being the second device; the receiving end being the first device). The latter alternative was the exclusive downlink.

Further, at page 7, lines 12 to 14, it was disclosed that the second communication path was suitable for information transmission "in two directions". This had to be understood as either unidirectionally from the services station to the user station (exclusive downlink) or unidirectionally from the user station to the

services station (exclusive uplink).

The appellant further argued that the problem the invention endeavoured to solve, i.e. transmission of data packets over an existing network which was not arranged for the transmission of such packets (page 4, lines 4 to 20), was independent of the transmission direction of the data packets over the second communication path. The skilled person would therefore have realized that this problem was solved by the use of the first and second devices, independently of the transmission direction over the second communication path.

- 1.4 The board does not find these arguments convincing for the following reasons.

The decisive question in deciding whether or not claimed subject-matter extends beyond the content of the application as filed is whether or not it can be directly and unambiguously derived from the application as filed. A clear distinction must therefore be made between the question of whether the subject-matter was disclosed in the application, be it explicitly or implicitly, and the question of whether it would have been an obvious implementation for a skilled reader.

In the present case, the board notes that claim 15 as filed does not define the presence of a services station and/or a user station, neither explicitly nor implicitly. Hence, whether or not a services station is located at the transmitting end and a user station is located at the receiving end can not be directly and unambiguously derived from this claim. The board further notes that

independent claim 1 as originally filed does refer to a services station and a user station. However, this claim specifies that the second communication path is for transmission of data packets from the user station to the services station, i.e. in the uplink direction. Similar considerations apply to independent claim 19 as originally filed.

The passage at page 7, lines 12 to 14, of the description as filed, as referred to by the appellant, is part of a paragraph which reads as follows:

"As is apparent from Fig. 1, there are in fact two parallel networks present for the two (outward and returning respectively) communication paths: one network for satellite communication on the first (outward) communication path, and one network for telephony on the second (returning) communication path. Apart from that, the second communication path, which forms a so-called interaction channel, can be suitable for information transmission in two directions. Bi-directional traffic can be advantageous, for example, for user identification in case of orders and/or payments.".

The board notes that in connection with Fig. 1 it is stated at page 6, lines 13 to 16, of the description as filed that "The second communication path, for the transmission of selection information (that is, "interaction information", designated by I, for the service concerned) from the user station 102 to the services station 101, comprises a first device 106, a network 107, and a second device 108." (underlining by the board).

In the board's judgement, the above-cited passages may reasonably be understood by the skilled reader such that the second communication path is either a return path for the transmission of selection information in the uplink direction or, alternatively, is suitable for information transmission in two directions, namely in the uplink direction and, in addition, in the downlink direction, thereby constituting a bidirectional link. Consequently, even if, as the appellant argued, the passage at page 7, lines 12 to 14, may alternatively be understood such that a unidirectional downlink is thereby disclosed, it would not be possible to unambiguously arrive at this understanding on the basis of the cited passage, since a different interpretation (namely a bidirectional link) cannot be excluded and is indeed, in the board's view, implied by the sentence following the reference to "information transmission in two directions", which refers to bidirectional traffic (page 7, lines 12 to 15, see the above-cited paragraph).

As to the statement of the problem to be solved (page 4, lines 4 to 20), even if the skilled reader had realized that this problem could be solved by the use of the first and second devices, independently of the transmission direction over the second communication path, this cannot be equated with a direct and unambiguous disclosure of a communication system in which data packets are unidirectionally transmitted over the second communication path from a services station to a user station.

- 1.5 The board therefore concludes that the subject-matter of claim 1 of the main request extends beyond the content of the application as filed (Article 100(c) EPC).

1.6 The main request is therefore not allowable.

2. *First and second auxiliary requests*

2.1 Claim 1 of the first auxiliary request (see point XI above) differs from claim 1 of the main request in that, concerning the transmission via the second communication path in the uplink direction, i.e. from the user station to the services station, it is specified that the second communication path is arranged for the transmission of selection information and, concerning the transmission via the second communication path in both directions, it is specified that the second communication path is arranged for the transmission of selection information in the uplink direction and of interaction information in the downlink direction, i.e. from the services station to the user station.

Further, in claim 1 of the second auxiliary request (see point XI above), the term "interaction information" is replaced by the more general term "information".

2.2 Consequently, in claim 1 of each one of the first and second auxiliary requests, the data for transmission in either the uplink direction or both directions via the second communication path is further specified. This further specification does not however affect the reasoning as set out above in respect of claim 1 of the main request concerning the non-disclosure, in the application as filed, of a communication system, in which the second communication path is for transmission of data packets exclusively in the downlink direction, i.e. from the services station to the user station.

Hence, the reasoning a set out at point 1 above applies, *mutatis mutandis*, to claim 1 of the first and second auxiliary requests.

2.3 The board notes that claim 1 of the present first auxiliary request is identical to claim 1 of a first auxiliary request as filed with the statement of grounds of appeal and that in this statement of grounds the appellant did not present any arguments concerning the above-mentioned non-disclosure issue, other than those already considered above in connection with the main request. The present second auxiliary request was filed with the letter dated 15 November 2012. In this letter, apart from providing a basis for the deletion of "interaction", no further arguments in support of the second auxiliary request were submitted. At the oral proceedings the appellant did not submit further arguments in support of the first and second auxiliary requests.

2.4 The board therefore concludes that the subject-matter of claim 1 of each one of the first and second auxiliary requests extends beyond the content of the application as filed (Article 100(c) EPC).

2.5 The first and second auxiliary requests are therefore not allowable.

3. *Third auxiliary request*

3.1 Due to the deletion of the various "or"-statements, the amendments according to claim 1 of the third auxiliary request (see point XI above) result in a limitation of claim 1 as granted in that it specifies that the first

communication path is for transmission of the user information from the services station to the user station and that the second communication path is for the transmission of the selection information from the user station to the services station, i.e. in the uplink direction, in which the first and second devices are accordingly defined as suitable for receiving data packets from the user station and for the routing the received data packets to the services station, respectively.

- 3.2 Claim 1 is based on claim 1 as filed and page 5, lines 20 to 27, and page 6, lines 13 to 16, of the description as filed.
- 3.3 In their joint reply to the statement of grounds of appeal the respondents II and III argued that claim 1 of a second auxiliary request as pending at the time, which is identical to claim 1 of the present third auxiliary request, violated Article 123(2) EPC, since the application as filed did not provide a basis for a downlink transmission by the services station of data packets according to the first protocol (cf. the reply letter dated 14 September 2011, points IV.3.2 and IV.2.3). The board notes however that the claim defines that the services station is arranged for the receiving of data packets according to the first protocol, which relates to an uplink transmission rather than a downlink transmission.
- 3.4 The board thus concludes that the subject-matter of claim 1 of the third auxiliary request does not extend beyond the content of the application as filed (Articles 100(c) and Article 123(2) EPC).

3.5 In the decision under appeal the opposition division held that claim 1 of a second auxiliary request as pending at the time, which is substantially identical to present claim 1, violated Article 123(3) EPC. The reasons given were as follows (cf. decision under appeal, points 2.4.3 to 2.4.8):

"In order to determine the compliance with Article 123(3) EPC, the extent of protection of the granted claim 1 has to be determined. According to Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC, the description and drawings shall be used to interpret the claims.

When looking at claim 1 as granted, the changes made for the second auxiliary request are a.o. *[sic]* visible in first and second devices which are defined only for receiving and for supplying the data packets in the uplink direction towards the services station.

In granted claim 1 the first device was defined for receiving data packets from **or** transmitting data packets to the user station and for supplying said data packets to **or** receiving said data packets from the first network, and the second device was defined for receiving said data packets from **or** transmitting said data packets to the first network and for routing the received data packets to **or** receiving the data packets from the services station via a second network.

As discussed above, this "or"- combination could be interpreted in different ways - as "either...or" or as "and". If one attempts to determine the scope of this feature in the light of the description, one finds that only a unidirectional uplink or a bidirectional link is disclosed. No unidirectional downlink is defined. Therefore one has to conclude that the extent of protection conferred by the feature of granted claim 1 can only be the "and" option, i.e. that a bidirectional link is foreseen as the second communication path, where the first and second devices are capable of both, sending and receiving from either side.

The scope of claim 1 of the second auxiliary request defines a first device for receiving data packets from the user station and for supplying the data packets to the first network, and a second device for receiving said data packets from the first network according to the second protocol and for routing the data packets to the services station via a second network. The extent of protection of such a claim is thus limited to the unidirectional uplink-case.

Based on the analysis above, however, this case was not within the extend [*sic*] of protection in the granted claim 1. The scope of protection of claim 1 of the second auxiliary request extends over the scope of granted claim 1 and Article 123(3)EPC is violated by the request. As a consequence, the second auxiliary request is not allowable."

Respondents II and III raised the same objection in respect of claim 1 of the present third auxiliary request, citing G 2/88, point 4, in support, and additionally argued that from the description of the patent it followed that a basic function of the second communication path was to provide a return path for selection information from the user station to the services station, which excluded a pure downlink path.

The board does not find the above reasoning and arguments given by the opposition division and respondents II and III convincing. The mere fact that a unidirectional downlink, contrary to the unidirectional uplink and the bidirectional link, is not disclosed in the description of the patent as granted, is not by itself a sufficient ground to conclude that the unidirectional downlink is excluded by claim 1 as granted or, going even further, as the opposition division did, that both the unidirectional downlink and the unidirectional uplink are thereby excluded. If this were the case, it would imply that, at the most, only those embodiments which are actually disclosed in the description of the preferred embodiments would be within the protection conferred by the patent. The European Patent Convention, in particular Article 69 EPC, including the Protocol on the Interpretation of Article 69 EPC, does not impose such a narrow interpretation of the protection conferred by the patent. Further, the board notes that the description does not exclude a unidirectional downlink for the second communication path, as argued by respondents II and III, since, whilst a unidirectional first communication path is shown in Figs 1 and 2, this does not imply that a

bidirectional first communication path is excluded (paragraphs [0023] and [0035] of the patent: "In the case shown, the transmission trajectory 104 is unidirectional" (underlining by the board)).

The board concludes that, even in the light of the description, the scope of protection provided by claim 1 includes at least embodiments of the communication system, in which the second communication path constitutes a bidirectional link or, alternatively, a unidirectional uplink.

It follows that, in the present case, there is no basis for, as the opposition division and respondents II and III did, interpreting claim 1 as granted in the light of the patent description such that the various "or"-statements in claim 1 as granted would imply that the second communication path must be a bidirectional link.

Respondents II and III additionally argued that the term "or" in claim 1 as granted merely expressed the fact that the bidirectionality of the second communication path could not relate to one and the same data packet. However, in the board's view, the term "or" as used in claim 1 as granted (for example, in "for the receiving or transmitting of data packets") is not required in order to express that the bidirectionality can indeed not relate to one and the same data packet, since the alternative wording, i.e. using the term "and" (in the example "for the receiving and transmitting of data packets"), would commonly not be understood as implying that the data packets referred to have to be the same data packets.

Respondents II and III further argued that from the description of the patent, paragraphs [0005] and [0015], it followed that the user station and the services station had to be able to both transmit and receive data packets in the upward and downward directions. The board notes however that paragraph [0015] merely relates to specific embodiments, as follows from the wording "By means of a communication system of this type, it is possible to ..." and "It is further possible to ...".

Respondent I argued in writing that, since claim 1 of the patent defined three alternatives for the three directions in which the operations are performed, i.e. exclusive uplink, exclusive downlink and bidirectional, this was a limitation on the features in question, since the presence of the "or"-statements limited the features to being arranged to perform those operations, which was a technical constraint on the features and therefore a technical constraint on the subject-matter sought for protection. The removal of the "or"-statements extended the protection granted by the patent as the features were arranged in the amended claim 1 to limit, for example, the user station only to an uplink transmission of data packets, which was a narrower constraint on the technical feature. In the board's view, however, by means of the "or"-statements in claim 1 as granted, protection was sought for various, alternative communication systems, each of which included means arranged for performing correspondingly defined operations, without it being necessary that these means were capable of performing other operations concerning other alternatives. Hence, limiting the claim to one of the alternatives does not give rise to an extension of the protection conferred by the patent.

3.6 The board does not see any other reason to object to claim 1 of the third auxiliary having regard to the requirement of Article 123(3) EPC and, hence, concludes that claim 1 of the third auxiliary request complies with the requirement of Article 123(3) EPC.

4. *Fourth to ninth auxiliary requests*

Since, see point 3 above, the board judges that neither the ground for opposition under Article 100(c) EPC nor the requirements of Article 123 EPC prejudice the maintenance of the patent on the basis of the third auxiliary request, it is not necessary to consider any one of the lower ranking auxiliary requests in this decision.

5. *Remittal*

In view of the fact that the decision under appeal is silent on the grounds of opposition pursuant to Article 100(a) and (b) EPC, the board considers it appropriate to remit the case to the department of first instance pursuant to Article 111(1) EPC for further prosecution. This would also permit, if desired, an examination of these opposition grounds by two instances.

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 on the basis of claim 1 of the third auxiliary request as filed with the letter dated 15 November 2012 and claims 2 to 9 as granted.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland