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Datasheet for the decision of 20 April 2016

Case Number: T 0599/12 - 3.5.03

Application Number: 00311576.3

Publication Number: 1111945

IPC: H04Q7/22, H04Q7/38, H04Q7/24

Language of the proceedings: EN

Title of invention:
System and methods for global access to services for mobile telephone subscribers

Patent Proprietor:
Star Home GmbH

Opponents:
Olswang CoSec Limited
Telefonaktiebolaget LM Ericsson (publ)

Headword:
Dialing assistance/STAR HOME

Relevant legal provisions:
EPC Art. 100(c)

Keyword:
Amendments - added subject-matter (yes) (all requests)

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Case Number: T 0599/12 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 20 April 2016

Appellant: (Patent Proprietor)	Star Home GmbH Klausstrasse 4 8034 Zürich (CH)
Representative:	Dennemeyer & Associates S.A. 55, rue des Bruyères 1274 Howald (LU)
Respondent 1: (Opponent 1)	Olswang CoSec Limited 90 High Holborn London WC1V 6XX (GB)
Representative:	Wallis, Helen Frances Mary Olswang LLP 90 High Holborn London WC1V 6XX (GB)
Respondent 2: (Opponent 2)	Telefonaktiebolaget LM Ericsson (publ) 164 83 Stockholm (SE)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 17 January 2012 revoking European patent No. 1111945 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	F. van der Voort
Members:	B. Noll
	P. Guntz

Summary of Facts and Submissions

I. Two oppositions were filed against European patent No. 1111945, inter alia on the ground that the subject-matter of the European patent extended beyond the content of the application as filed (Article 100(c) EPC).

II. The opposition division revoked the patent on the ground that the subject-matter of claims 1 and 24 as granted extended beyond the content of the application as filed (Article 100(c) EPC). Three auxiliary requests filed in the course of the oral proceedings before the opposition division were not admitted to the proceedings.

III. With the statement of grounds of appeal the appellant (patent proprietor) filed sets of claims pertaining to three auxiliary requests.

IV. In a communication accompanying the summons to oral proceedings, the board gave a preliminary opinion, inter alia on added subject-matter (Article 100(c) EPC) in respect of claims 1 and 24 as granted and the independent claims of the auxiliary requests.

V. With a letter dated 21 March 2016, the appellant submitted further arguments and informed the board that it would not be attending the oral proceedings.

VI. With a letter dated 15 April 2016 respondent 1 (opponent 1) informed the board that it would not be attending the oral proceedings.

VII. Oral proceedings before the board were held on 20 April 2016.

The appellant requested in writing that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution, i.e. for considering the grounds for opposition pursuant to Article 100(a) and (b) EPC on the basis of the patent as granted (main request) or, in the alternative, on the basis of one of the first to third auxiliary requests as filed with the statement of grounds of appeal.

Respondent 1 (opponent 1) requested in writing that the appeal be dismissed.

Respondent 2 (opponent 2) requested that the appeal be dismissed and, by way of an auxiliary request, that the case be remitted to the department of first instance for further prosecution.

After closing the debate and deliberation on the case the chairman announced the board's decision.

VIII. Claim 1 as granted (main request) reads as follows:

"An intelligent gateway (32) adapted to provide assistance to a roamer from a home mobile network (20) who is roaming in a roaming mobile network (30) to complete calls when a destination number dialed by said roamer is erroneous as dialed at said roaming network, said gateway being characterized by: an intelligent call assistance means for receiving calls made by roamers where the destination number is erroneous in relation to the roaming network, for electronically analyzing the type of error by applying knowledge of said home network dialing and international dialing

systems, to provide assistance to said roamer to reach the home network."

Claim 24 as granted reads as follows:

"A method of assisting a roaming user on a roaming mobile network (30) and having a home mobile network (20), the method comprising:
receiving from said roaming mobile network an electronic signal indicating that a number dialed by a roamer is erroneous or ambiguous in relation to said roaming mobile network, and
using knowledge of said home mobile network and international dialing systems to provide assistance to said roamer in said mobile network, thereby to complete calls when said destination number dialed by said roamer is erroneous or ambiguous."

Claim 1 of the first auxiliary request is identical to claim 1 as granted.

Claim 1 of the second auxiliary request differs from claim 1 as granted in that the wording "relating to the prefix required in order to make an international call" is inserted between "international dialing systems" and ", to provide".

Claim 1 of the third auxiliary request differs from claim 24 as granted in that the wording "relating to the prefix required in order to make an international call," is inserted between "international dialing systems" and "to provide".

Reasons for the Decision

1. The patent aims at providing support to a mobile subscriber dialling a telephone number when roaming in a visited mobile network. A widely known scenario is that subscribers, temporarily being abroad, recognize that they cannot reach a destination by dialling the number they normally use when starting a call from their home network.

The patent in suit distinguishes between three categories of calls for which support is to be provided by the invention:

(a) The first category is a short-code call, by which subscribers access a "value-added" service, e.g. their voice mailbox. Short-code services are classified in the patent specification according to their geographic accessibility (home, global) or service (emergency service, VPN (Virtual Private Network) service); see paragraphs [0038] to [0044] of the description (reference is made to the B1 publication). The support provided to the subscriber is dependent on the type of the short-code. For example, in one scenario a home short-code number is replaced by a full destination number so that the call may be routed by the visited mobile network to a value-added service platform associated with the subscriber's home mobile network.

(b) The second category is an international call. The support provided to the subscriber consists in automatically adding the required prefix, e.g. "+" or "00" (cf. paragraph [0065]).

(c) The third category is a local call. The patent in suit does not explicitly define which call is understood as being "local". The skilled person however understands that it is a call to a callee who is

registered in the visited mobile network (paragraph [0066]). The support offered to the roaming subscribers consists in this case in providing them with a prompt notifying them about the dialing rules of the specific country in a preferred language.

2. *Claims 1 and 24 as granted - added subject-matter (Article 100(c) EPC)*

2.1 Claim 1 as granted relates to an intelligent gateway which is adapted to provide assistance to a roamer. The roamer is from a home mobile network but roaming in a roaming (or visited) mobile network. The assistance provided by the gateway is to complete calls when a destination number dialed by the roamer is "erroneous as dialed at said roaming network". So far, claim 1 is substantially based on claim 20 as originally filed.

2.2 The claimed gateway is characterized by an intelligent call assistance means which is specified as "for electronically analyzing the type of error by applying knowledge of said home network dialing and international dialing systems, to provide assistance to said roamer to reach the home network." This feature was only introduced as an amendment to claim 1 in the course of substantive examination.

2.3 This characterizing feature does not appear verbatim in the application as filed. Further, the board notes that in the patent specification there is no explanation as to the meaning of the terms "the type of error", "[the] knowledge of said home network dialing [systems]" and "[the] knowledge of international dialing systems" either. The meaning of these terms must therefore be interpreted in the light of the patent specification, read as a whole by the skilled person.

The skilled person would, in the light of the description (cf. point 1 above), understand the term "analyzing the type of error" as meaning that the intelligent call assistance means is, inter alia, configured to identify that the call is "erroneous as dialed at said roaming network" and is configured to identify the category of the call associated with the "destination number dialed by said roamer". The board notes that the patent specification clearly distinguishes between the dialed sequence being a short code or an erroneous destination number (cf. paragraphs [0016] and [0017]). Therefore, the skilled person would understand that the type of error is an erroneous destination number relating to either an international call or a local call.

Further, the skilled person would understand the term "applying knowledge of the home network dialing [system]" as meaning that, for the purpose of error type analysis, the rules and conventions which have to be followed in the home mobile network for dialing a valid destination number are considered by the intelligent call assistance means.

Likewise, the skilled person would understand the term "applying knowledge of (...) international dialing systems" as meaning that, for the purpose of error type analysis, the rules and conventions which have to be followed in the roaming mobile network for dialing a valid destination number for an international call are considered by the intelligent call assistance means.

Hence, the skilled person would understand the feature in question (see point 2.2 above) as meaning that the intelligent call assistance means is configured to

consider, for the purpose of error type analysis, rules and conventions to be followed in the home mobile network for dialing a valid destination number and rules and conventions to be followed in the roaming mobile network for dialing a valid international destination number.

2.4 This feature is however not clearly and unambiguously derivable from the application documents as originally filed:

(a) In the case of the erroneous destination number dialed by the roamer being a local number, the application as filed discloses (cf. paragraph [0066]) that the roamer is notified about the dialing rules of the specific country (i.e. of the country in which the visited mobile network exists). These rules may be considered as requiring knowledge of the visited mobile network dialing system. However, there is no disclosure whatsoever as regards the application of knowledge of the dialing rules of the (roamer's) home mobile network or rules for dialing an international call for analyzing the type of error.

(b) Where the erroneous destination number dialed by the roamer is an international number, the application as filed discloses that the roamer is assisted to complete the call by automatically adding a prefix necessary to make an international call (cf. paragraph [0065]). However, there is no disclosure that in this case the error analysis relies on knowledge of the rules or conventions of the home mobile network of the subscriber.

2.5 The appellant argued that the term "systems" solely related to "international dialing", i.e. not to the

preceding "home network dialing". Consequently, and further considering an example in which call assistance was required to provide the correct country code for a home-dialed erroneous destination number, the intelligent call assistance means must necessarily know which network the home network is so that the correct country code could be provided.

2.6 This argument is not convincing.

The appellant's interpretation only relates to the specific case of subscribers dialling an erroneous destination number which relates to their home country. Claim 1 is however not limited to erroneous destination numbers for calls to the roamer's home country, but encompasses an intelligent gateway which provides support for completing calls to an unspecified, i.e. arbitrary, erroneous destination number. Therefore, even if claim 1 were interpreted as done by the appellant, the subject-matter would constitute an undisclosed intermediate generalization of a specific example.

2.7 For the above reasons, claim 1 as granted includes subject-matter which extends beyond the content of the application as filed.

2.8 Claim 24 as granted seeks protection for a method assisting a roaming user and includes the step of "using knowledge of said home mobile network and international dialing systems to provide assistance to said roamer in said mobile network". Although the wording is slightly different from that in claim 1 ("... knowledge of said home mobile network" instead of "... knowledge of said home network dialing"), this difference in wording is not considered by the board as

introducing any difference in substance. The appellant did not argue otherwise.

2.9 Consequently, the subject-matter of claim 24 extends beyond the content of the application as filed for the same reasons, applied mutatis mutandis, as given in respect of claim 1.

2.10 The ground for opposition pursuant to Article 100(c) EPC therefore prejudices the maintenance of the patent as granted.

3. *The auxiliary requests*

3.1 Claim 1 of the first auxiliary request is identical in wording to claim 1 as granted. Therefore, the reasons given in point 2 above apply, mutatis mutandis, to this claim.

3.2 As regards claim 1 of the second auxiliary request, the appellant argued that the added feature (see point VIII above) "addresses the Opposition Division's reasons for rejection of the "knowledge feature" (cf. page 5 of the statement of grounds of appeal and page 9 of the appellant's letter dated 21 March 2016).

However, the indication "relating to the prefix required in order to make an international call" only substantiates in more detail the content of the "knowledge" to be applied for analyzing the type of error when the erroneous destination number relates to an international call. The prefix required in order to make an international call is, however, an implicit portion of that "knowledge". Therefore, the feature in question does not amend the subject-matter in substance. Since the subject-matter of claim 1 of the

second auxiliary request is otherwise not different from that of claim 1 as granted, the reasons above in point 2 apply, mutatis mutandis, to claim 1 of the second auxiliary request.

3.3 Claim 1 of the third auxiliary request defines a method in terms of steps which essentially correspond to the constructional features of claim 1 of the second auxiliary request. For the reasons set out in points 2 and 3.2 above, applied mutatis mutandis, its subject-matter extends beyond the content of the application as filed.

3.4 In conclusion, none of the auxiliary requests overcomes the outstanding objection of added subject-matter. Therefore, the ground for opposition pursuant to Article 100(c) EPC prejudices the maintenance of the patent on the basis of any one of these auxiliary requests.

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