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**Datasheet for the decision
of 29 August 2017**

Case Number: T 1939/14 - 3.5.05

Application Number: 03739963.1

Publication Number: 1646188

IPC: H04L12/46

Language of the proceedings: EN

Title of invention:

A METHOD FOR ETHERNET NETWORK SERVICE SAFETY ISOLATION

Patent Proprietor:

ZTE Corporation

Former Opponent:

Huawei Technologies Co., Ltd.

Headword:

Virtual Private Network on Ethernet/ZTE

Relevant legal provisions:

EPC 1973 Art. 100(a), 100(b), 100(c), 111(1)
EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (no)
Remittal to the department of first instance

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1939/14 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 29 August 2017

Appellant: ZTE Corporation
(Patent Proprietor) ZTE Building,
South Hi-Tech Road,
Hi-Tech Industrial Park,
Nanshan District,
Shenzhen, Guangdong 518057 (CN)

Representative: Awapatent AB
Junkersgatan 1
582 35 Linköping (SE)

Former Opponent Huawei Technologies Co., Ltd.
Huawei Administration Building
Bantian
Longgang District
Shenzhen, Guangdong 518129 (CN)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 29 July 2014
revoking European patent No. 1646188 pursuant to
Article 101(3) (b) EPC.

Composition of the Board:

Chair A. Ritzka
Members: P. Cretaine
G. Weiss

Summary of Facts and Submissions

- I. This appeal is against the decision of the opposition division, announced at the oral proceedings dated 13 May 2014 and dispatched on 29 July 2014, to revoke European patent No. 1 646 188. The opposition was based on grounds provided for in Article 100(a), (b) and (c) EPC. According to the decision (see Facts and Submissions, points 7 and 8, and Reasons, point 15) the patent was revoked under Article 101(3)(b) on the grounds of Article 100(c) EPC because the amended claims of the then main request MR4 contained subject-matter which extended beyond the content of the application as filed (Article 123(2) EPC). The opposition division further decided that a request filed with letter of 20 August 2012 and requests MR2, MR3 and MR5 filed during the oral proceedings were not admissible (see Reasons, points 10, 12, 13 and 14), and that a request MR1 filed during the oral proceedings did not meet the requirements of Article 83 EPC (see Reasons, point 11.2).
- II. The proprietor's notice of appeal was received on 25 September 2014 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 5 December 2014.

The proprietor (appellant) submitted the following documents:

E13: "Great Chinese Dictionary", second edition, September 2001, published by Century Publishing Group and Great Chinese Dictionary Press, page 939;

E14: "Near-synonym Application Dictionary", second edition, August 1997, published by Language and Literature Press, page 227;

E15: "Modern Chinese Antonym Dictionary", first edition, May 1988, published by Beijing Press, page 122;

E16: "Great Chinese Dictionary", first edition, March 1988, published by Great Chinese Dictionary Press, volume 2, page 1 222;

E17: "Oxford Advanced Learner's English-Chinese Dictionary", sixth edition, September 1997, published by The Commercial Press and Oxford University Press, page 19;

E18: "A Dictionary of Current Idiomatic English", first edition, January 1999, published by Tianjin Science and Technology Press and Foreign Language Teaching and Research Press, page 14;

E19: "A Chinese-English Dictionary of Economics, Commerce and Foreign Trade", first edition, December 1989, published by Xi'an Jiao Tong University Press, page 147;

E20: "Chinese-English Dictionary of Construction Cost Engineering", first edition, October 1994, published by Tianjin University Press, page 696;

E21: "A New English-Chinese Dictionary of Telecommunications", first edition, April 2005, published by Tianjin Science and Technology Press, page 14;

E22: "A New Dictionary of English-Chinese of Finance", first edition, August 2007, published by Shanghai Science and Technology Literature Press, page 8;

E23: Rosen, E. et al., "Multiprotocol Label Switching Architecture", Network Working Group, The Internet Society (2001), www.ietf.org/rfc/rfc3031.txt (available also at <https://web.archive.org/web/20030410085523/www.ietf.org/rfc/rfc3031.txt>, which was publically available as from 10 April 2003);

E24: Gilbert Held, "Quality of Service in a Cisco Networking Environment", John Wiley & Sons, 2002, page 24;

E25: Tony Kenyon, "Data Networks: Routing, Security, and Performance Optimization", Digital Press, 2002, page 588;

E26: Priscilla Oppenheimer, Joseph Bardwell, "Troubleshooting Campus Networks: Practical Analysis of Cisco and LAN Protocols", John Wiley & Sons, 2002, pages 222-223;

E27: Serpanos, Dimitrios N., "Enterprise Networking: Multilayer Switching and Applications", Idea Group Inc. (IGI), 2001, page 52;

E28: Neal Allen, "Network Maintenance and Troubleshooting Guide", Cisco Press, 2000, pages B-4, B-5;

E29: Kevin Dooley, "Designing Large- Scale LANs", O'Reilly Media, Inc., 2001, page 106;

E30: Declaration by Shaofang Gong, PhD, Professor of Communication Electronics at Linköping University, 4 December 2014;

E31: Declaration by Luoming Meng, PhD, Professor, Deputy Chair, Beijing University of Posts and Telecommunications, 4 December 2014;

E32: Declaration by Rentao Gu, PhD, Associate Professor, Beijing University of Posts and Telecommunications, 5 December 2014.

The appellant requested that the decision 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 filed with the statement setting out the grounds of appeal, in respect of the remaining grounds for opposition that were not considered by the opposition division.

III. The response of the opponent as respondent was received on 17 June 2015. The opponent submitted a new document E33 and requested that the appeal be dismissed and the patent be revoked in its entirety. Further, the opponent requested that documents E13 to E30 not be admitted for being filed too late. Oral proceedings were requested on an auxiliary basis.

IV. By letter dated 24 August 2015, the appellant provided further arguments in support of its case and submitted document

E17': "Oxford Advanced Learner's English-Chinese Dictionary", sixth edition, September 1997, published by The Commercial Press and Oxford University Press, page 16.

V. By letter dated 25 January 2017, the opponent withdrew the opposition.

VI. In a short communication sent on 3 February 2017, the board informed the parties that the appeal proceedings would be continued with the appellant/proprietor.

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

"A method for realizing security isolation of Ethernet services, characterized by, comprising:

(1) adding an additional segment in an Ethernet frame for identifying different user services, the segment consisting of n bytes and n having a value related to the format of the segment;

(2) entering a user service into data networks of a service provider, and adding a user ID in the additional segment of the Ethernet frame carrying the user service;

(3) processing switch/route; and

(4) when the user service leaves the data networks performing the following steps:

- deleting the user ID and restoring the Ethernet frame, and

- processing the user service, which leaves the data networks through a certain physical interface, on said certain physical interface, comparing the user ID of the user service leaving the data network with the user ID of said physical interface, and letting the user service go through if the two IDs conform to each other, otherwise discarding the service".

Reasons for the Decision

1. Admissibility of the appeal

The decision indicates that at the end of the proceedings the patent was revoked under Article 101(3)(b) EPC on the grounds that "the single admissible request (MR4)" [sic] filed during oral proceedings was not allowable since it contained subject-matter which extended beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC (see Facts and Submissions, point 7). Further, it is specified that the decision is based on "the single main request on file MR4" [sic] (see Facts and Submissions, point 8). Moreover, the decision mentions as a conclusion (see point 15) that, taking account of the amendments made by the patent proprietor, the patent is revoked on the ground of Article 100(c) EPC because "the amended claims of the main request (MR4)" [sic] contain subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

Thus, it is clear from the text of the decision that the request designated as MR4 has been maintained by the proprietor in the proceedings before the first instance and was decided upon by this instance. The proprietor is thus entitled to prosecute on appeal the set of claims corresponding to MR4, now designated as the main request.

The appeal thus complies with the provisions of Articles 106 to 108 EPC (see also point II above) and is admissible.

2. Withdrawal of the opposition

The opponent (former respondent), having withdrawn its opposition, is no longer party to the appeal proceedings.

3. Admissibility of late-filed documents

With its statement setting out the grounds of appeal, the appellant submitted new documents E13 to E32. Further the appellant submitted a new document E17' with its letter dated 24 August 2015.

The documents are aimed at proving that the wording "adding an additional segment in an Ethernet frame" is a correct translation, in the technical context of the application, of the Chinese wording present in claim 1, step 1, before the first comma, of the originally filed application WO 2004/114605, which is the authentic text for the proceedings before the EPO (Article 70(2) EPC).

In the opposition proceedings before the first instance, the objection that the above-mentioned wording was not originally disclosed, contrary to the requirements of Article 123(2) EPC, was the basis for the revocation of the patent. This objection was raised in the notice of opposition dated 15 March 2012, supported by a certified translation of claim 1 provided by the former opponent wherein the above-mentioned Chinese wording was translated as "expanding a segment in Ethernet frame". With its response to the notice of opposition dated 20 August 2012, the appellant submitted translation documents in which the above-mentioned Chinese wording was translated as "expanding a segment in an

Ethernet frame", thus corroborating the translation provided by the former opponent. In the annex to the summons to oral proceedings dated 8 November 2013, the opposition division holds that the official translation of the international application WO 2004/114605 into English represented the original disclosure for the purpose of examining if the requirements of Article 123(2) EPC were met and expressed the preliminary opinion that the addition of a segment was originally disclosed (see point 4.2). During the oral proceedings before the opposition division, the proprietor did not try to challenge the translation of the Chinese wording into "expanding a segment in an Ethernet frame" but argued that the feature of "adding a segment to an Ethernet frame" was an equivalent feature (see Reasons, point 9.2, in the decision).

In the statement setting out the grounds of appeal, the appellant has provided a thorough analysis of the issue of translating the Chinese wording based on excerpts from dictionaries (E13 to E22 and E17'), technical prior-art documents (E23 to E29) and affidavits from technical experts (E30 to E32). Given that the proper translation of the Chinese wording is a critical issue in the present case, that this issue was not considered by the first instance in the opposition proceedings, and that the request of the appellant is not without prospect of succeeding, the board, exercising its discretion according to Article 12(4) RPBA, decides to admit these documents in the appeal procedure.

4. Articles 100(c) EPC 1973 and 123(2) EPC

4.1 In the proceedings before the first instance, the appellant agreed that the translation of the above-mentioned Chinese wording was "expanding a segment in an Ethernet frame". The opposition division thereupon decided that the feature "adding a segment in an Ethernet" present in claim 1 had no support in the application as originally filed.

4.2 The appellant plausibly argued in the statement setting out the grounds of appeal and in its letter dated 25 August 2015 that the wording "adding a segment in an Ethernet frame" was the appropriate translation of the Chinese wording, taking into account the whole technical context of the patent.

4.3 In that respect, the appellant first showed, based on Chinese-Chinese and English-Chinese dictionaries E13 to E18, that the verb present in the Chinese wording does have the meaning of "add", in addition to, inter alia, "expand", "enrich", and "increase in quantity". The appellant thus argued that said verb can be translated as "add".

Secondly, the appellant pointed out that in practical applications the verb of the Chinese wording was indeed translated as "add". To that aim, the appellant relied on E19, E20 and E22 in the field of economics, and on E21 in the field of telecommunications.

Thirdly, the appellant plausibly argued that in the technical context of the present patent, the only possible interpretation of the original Chinese wording was that of "adding an additional segment in an Ethernet frame". In that respect the board agrees with

the appellant that segments in an Ethernet frame have standardized specific definitions and logic functions attached to them, such as for instance representing a preamble of the Ethernet frame, comprising addresses or data, or defining the type and length of the Ethernet frame (see in that respect the prior-art frames shown in Figures 5 to 7 of the patent). Thus, a translation of the Chinese wording as "expanding a segment of an Ethernet frame" would mean that an already existing Ethernet segment would be provided with a further logic function. This way of proceeding is however not described in the description or the claims of the patent. On the contrary, in order to implement the identification of different user services in an Ethernet frame segment, the description in paragraphs [0019] and [0040] mentions only two possible embodiments, namely the use of a "compatible MPLS format" or of a "stackable VLAN format" for configuring the segment. E23 to E29 are excerpts from prior-art handbooks or prior-art standard documents which disclose that in either the MPLS format (E23) or the stackable VLAN format (E24 to E29), adding an MPLS label or a VLAN tag is exclusively performed by inserting an additional field, i.e. a segment, into the frame, and not by modifying or expanding an existing field.

Fourthly, the appellant submitted three affidavits (E30 to E32) by three native speakers and technical experts in the field, certifying that in their opinion, based on all the application documents, the Chinese wording in question should be translated as "adding an additional segment in an Ethernet frame".

For these reasons the board is convinced that the feature "adding an additional segment in an Ethernet

frame" is supported by the application as originally filed and that, as a consequence, claim 1 does not infringe Article 123(2) EPC in that respect.

4.4 In respect of the other Article 123(2) EPC objections that were raised in the opposition proceedings and not decided upon, the board shares the view expressed by the opposition division in the summons to oral proceedings. The board therefore judges that the comparison of user IDs as defined in step 4 of claim 1 and the features combination of dependent claims 3 to 11 are unambiguously derivable for the skilled person from the originally filed application (see paragraphs [0008] and [0029] to [0036] respectively of the application as published).

4.5 The board therefore judges that the main request does not infringe Article 123(2) EPC and that the ground of opposition under Article 100(c) EPC 1973 does not prejudice the maintenance of the patent as amended according to the main request.

5. Articles 100(a) and (b) EPC 1973

Although the opposition division expressed the opinion (see Reasons, point 9.1, in the decision) that the then request MR4, now designated as the main request, represented a valid attempt to overcome the Article 83 EPC objection occasioned by the ground of opposition under Article 100(b) EPC 1973, no substantiated decision in that respect has been taken.

Similarly, the novelty and inventive step objections underlying the ground of opposition under Article 100(a) EPC 1973 were not dealt with during the oral proceedings before the opposition division and, as

a consequence, no decision in that respect has been taken.

Although it would, in principle, lie within the discretion of a board to decide itself on the merits of the case pursuant to Article 111(1) EPC 1973, the board judges that the appellant's request for a remittal to the first instance for further prosecution on the grounds of opposition under Article 100(a) and (b) EPC is legitimate.

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 claims 1 to 11 filed as main request with the statement setting out the grounds of appeal dated 5 December 2014, on the grounds of opposition under Articles 100(a) and 100(b) EPC 1973.

The Registrar:

The Chair:



P. Cremona

A. Ritzka

Decision electronically authenticated