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**Datasheet for the decision  
of 2 August 2018**

**Case Number:** T 1068/15 - 3.5.03

**Application Number:** 07749997.8

**Publication Number:** 1982500

**IPC:** H04L29/06

**Language of the proceedings:** EN

**Title of invention:**

Triggering migration of a network access agent associated with  
an access terminal

**Applicant:**

Alcatel-Lucent USA Inc.

**Headword:**

Migration of a network access agent/ALCATEL-LUCENT

**Relevant legal provisions:**

EPC Art. 123(2)  
EPC R. 22

**Keyword:**

Amendments - allowable (no)  
Registration of transfer (no)

**Decisions cited:**

G 0002/04, T 0854/12



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Case Number: T 1068/15 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 2 August 2018**

**Appellant:** Alcatel-Lucent USA Inc.  
(Applicant) 600-700 Mountain Avenue  
Murray Hill, NJ 07974 (US)

**Representative:** Richardt Patentanwälte PartG mbB  
Wilhelmstraße 7  
65185 Wiesbaden (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 25 November  
2014 refusing European patent application No.  
07749997.8 pursuant to Article 97(2) EPC**

**Composition of the Board:**

**Chairman** F. van der Voort  
**Members:** A. Madenach  
P. Guntz

## Summary of Facts and Submissions

I. The present appeal is against the decision of the examining division refusing European patent application No. 07 749 997.8, published as WO 2007/094996 A2.

In its decision (points 16 and 17), the examining division held that the amendments in claim 1 of a main request and claim 1 of an auxiliary request introduced subject-matter which extended beyond the content of the application as filed (Article 123(2) EPC).

In an *obiter dictum* it raised a further objection under Article 123(2) EPC and noted, with reference to documents RFC 3344 and RFC 3775, that claim 1 of either request was not clear (Article 84 EPC) and that the skilled person would not be able to carry out the invention (Article 83 EPC).

II. In its statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of a main request or, in the alternative, an auxiliary request, both as filed with its statement of grounds of appeal. As auxiliary measures it requested remittal of the case to the department of first instance for further examination, and oral proceedings.

III. In a communication pursuant to Article 15(1) RPBA accompanying a summons to oral proceedings, the board gave its preliminary opinion, *inter alia*, that the subject-matter of claim 1 of either request extended beyond the content of the application as originally filed (Article 123(2) EPC).

IV. No substantive reply to the board's communication was received.

V. With a letter dated 15 June 2018, the patent firm Boco IP Oy Ap informed the EPO that the application underlying the present appeal had been transferred to Provenance Asset Group LLC.

With a letter dated 26 June 2018, the EPO's Legal Division alerted the applicant to deficiencies in the request for entry of a change in the European Patent Register concerning the identity of the applicant, namely that, *inter alia*, an assignment of the present patent application from Alcatel-Lucent USA Inc. to Provenance Asset Group LLC was missing. The applicant was invited to correct the deficiencies.

VI. Oral proceedings took place on 2 August 2018 in the absence of the appellant.

At the end of the oral proceedings, after due deliberation, the chairman announced the board's decision.

VII. Claim 1 of the main request reads:

"A method involving an access terminal that is served by a first base station router in a distributed wireless communication system, comprising:

determining, at a second base station router in response to receiving a notification that the access terminal is to be re-activated from an idle mode and prior to the access terminal being re-activated from the idle mode, whether to migrate a network access agent to the first base station router based on a

reactivation latency associated with the access terminal, wherein the network access agent provides at least one of point-of attachment or care-of-address functionality for the access terminal."

Claim 1 of the auxiliary request is identical to claim 1 of the main request.

### **Reasons for the Decision**

#### *1. Registration of transfers (Rule 22 EPC)*

1.1 The Legal Division did not register the alleged transfer of the application from Alcatel-Lucent USA Inc. to Provenance Asset Group LLC.

1.2 According to the case law of the Boards of Appeal, the board has to examine the question of party status *ex officio* before dealing with the substance of the case (cf. G 2/04, Reasons 3.2.5). In doing so it is not bound by the assessment of other departments of the EPO or by the state of the register (cf. T 854/12, Reasons 1.2.4 and 1.2.5).

In the case at hand, the board agrees with the Legal Division. Rule 22(1) and (3) EPC stipulates that a transfer has effect vis-à-vis the EPO only at the date when, and to the extent that, documents providing evidence of the transfer have been produced. In the present case, no such evidence has been produced. More specifically, the patent assignment dated 12 September 2017 as submitted with the letter dated 15 June 2018 does not mention the applicant Alcatel-Lucent USA Inc. as one of the assignors. It does not

contain a declaration in the name of that company, nor does the list in Annex A of the assignment contain any patents owned by Alcatel-Lucent USA Inc. Consequently, the persons who signed the assignment did not sign in the name of the present applicant. Nor is there any indication that they had power of attorney to do so. The declaration at the end of the list of assignors - "together with their respective affiliates, subsidiaries and related entities under their control" - on page 1 of the assignment is therefore of no relevance, it being left open whether Alcatel-Lucent USA Inc. is among these entities. The board further notes that, in the absence of a valid debit order, the requirement pursuant to Rule 22(2) EPC regarding payment of the administrative fee does not appear to have been met either.

The board concludes that the proceedings are to be continued with Alcatel-Lucent USA Inc. as the applicant.

2. *Main request: added subject-matter (Article 123(2) EPC)*

2.1 Claim 1 has been amended with respect to claim 1 as originally filed in that *inter alia* it now relates to reactivation of an access terminal from an idle mode and in that it refers to first and second base station routers.

The appellant argued that the embodiment described on page 10, line 18, to page 11, line 4, of the description with reference to Figure 5 provided a basis for these amendments.

The cited passage specifically relates to a method of determining whether or not to migrate a network access

agent while an access terminal is exiting the idle mode. In a first step, a base station router receives notification that the idle terminal is going to be reactivated. This base station router is therefore in the language of claim 1 the "second base station router" (underlining by the board), which receives notification that the access terminal is to be reactivated from an idle mode. This base station router may then determine whether or not the network access agent should be migrated (page 10, lines 26 and 27). Migration will result in the network agent being on a "new serving base station router" (cf. page 10, lines 30 to 33). Hence, the "new serving base station router" corresponds to "the first base station router" in the language of claim 1, to which the network access agent is to be migrated or not.

- 2.2 The cited passage does not however provide a direct and unambiguous disclosure of the feature of claim 1 whereby the access terminal "is served by a first base station router". From the passage on page 10, lines 30 to 33, according to which, after migration of the network access agent, "the network access agent will be on the new serving base station router", it follows that, before migration, it was on an "old" serving base station router. As set out above, this "old" base station router corresponds to the second base station router in the language of claim 1. Hence, the described embodiment involves an access terminal that is first served by the second base station router and is served by the first base station router only after migration has occurred. Hence, as long as no migration has taken place, the access terminal is served by the second base station router in the language of claim 1. The board notes that the actual migration is not part of the claimed method, since the claimed method involves only



the step of determining whether or not migration should be performed. According to the above-mentioned embodiment, at that point the access terminal is still served by the second base station router. Hence, the cited passage does not provide a basis for an access terminal that is served by a first base station router, as defined in claim 1.

2.3 The board considers that the feature "involving an access terminal that is served by a first base station router" in claim 1 may be interpreted differently, in that "served" is interpreted more broadly than merely meaning that the access terminal is associated with the base station router which includes the network access agent. In this respect, the board notes that the passage from page 1, line 34, to page 2, line 3, of the description suggests that the term "served" may be related to a geographic area. However, apart from the fact that this passage relates to an access terminal in an active call session and, hence, not in an idle mode as in present claim 1, it further states that, after migration of the network access agent from the first base station router to the second base station router, the second base station router becomes "the serving base station router" (page 2, line 3). Hence, this passage does not support an interpretation of the term "serving base station router" other than that it is the base station router which includes the network access agent.

2.4 The board concludes that claim 1 has been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed and, hence, does not comply with Article 123(2) EPC.

2.5 The main request is therefore not allowable.

3. *Auxiliary request*

As claim 1 of the auxiliary request is identical to claim 1 of the main request, the auxiliary request is not allowable for the same reasons.

4. Since, for the reasons set out above, neither of the requests is allowable, remittal to the department of first instance would serve no purpose. The further auxiliary request that the case be remitted to the department of first instance is therefore not allowed either. The appeal is thus to 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