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**Datasheet for the decision
of 5 June 2023**

Case Number: T 0075/21 - 3.5.03

Application Number: 15756902.1

Publication Number: 3342222

IPC: H04W68/00, H04W76/02, H04W88/16

Language of the proceedings: EN

Title of invention:
Data routing in cellular communication system

Applicant:
Nokia Solutions and Networks Oy

Headword:
Proactive data forwarding/NOKIA

Relevant legal provisions:
EPC Art. 83
EPC R. 103(1) (a)
RPBA 2020 Art. 11, 12(8)

Keyword:

Decision in written proceedings - (yes): no oral proceedings
necessary or appropriate

Sufficiency of disclosure - (yes)

Reimbursement of the appeal fee - violation of the right to be
heard (no)

Remittal - special reasons (yes): novelty and inventive step
not fully examined yet

Decisions cited:

T 0658/12



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Case Number: T 0075/21 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 5 June 2023

Appellant: Nokia Solutions and Networks Oy
(Applicant) Karakaari 7
02610 Espoo (FI)

Representative: Nokia EPO representatives
Nokia Technologies Oy
Karakaari 7
02610 Espoo (FI)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 10 September
2020 refusing European patent application
No. 15756902.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: J. Eraso Helguera
C. Almberg

Summary of Facts and Submissions

- I. The appeal was lodged against the decision of the examining division to refuse the present European patent application.
- II. In the International Search Report, the following prior-art document was, *inter alia*, cited:

D2: ZTE Corporation: "Summary of email discussion [81bis#15][Joint/MTCe] Initial qualitative analysis of the proposed solutions for SDDTE", R2-131708.
- III. 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** subject to the decision under appeal, or that the case be remitted to the examining division for further prosecution (**auxiliary request**).

In the notice of appeal, the appellant further requested oral proceedings if the board intended not to remit the case for grant or further prosecution.

- IV. In a communication pursuant to Rule 100(2) EPC, the board stated its intention to set the decision under appeal aside and to remit the case to the examining division for further prosecution. The board further invited the appellant to comment on the matter of reimbursement of the appeal fee in view of the requirements of Rule 103(1) (a) EPC.
- V. In response to that communication, the appellant stated that it "accepts the decision not to reimburse the

appeal fee".

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

"An apparatus comprising:

means for receiving, by a first network element from a second network element of a cellular communication system, a paging request for a terminal device;

means for determining, in response to the receiving the paging request, whether or not the terminal device is located in a control area of the first network element, the control area comprising at least one cell of the cellular communication system;

means for causing transmission of a notification message to the second network element upon determining that the terminal device is located in the control area of the first network element, and

means for receiving, in the first network element from a data routing network element, payload data associated with a service after transmission of the notification message and before the service for the terminal device has been fully configured for data transmission in the first network element."

Reasons for the Decision

1. *Sufficiency of disclosure (Article 83 EPC)*

1.1 In point 2 of the annex to the summons to oral proceedings before the examining division, to which the decision under appeal makes reference, the division stated that neither the description nor the claims explained how the signals in step 515 were transmitted

from the "data routing network element" to the "first network element". This lack of disclosure originated three sensible issues that undermined the establishment of a pertinent closest prior art and the assessment of an inventive merit:

- (a) Pushing data over a control channel without having an established data communication channel was already known from the use of SMS. Thus, if the invention was indeed exploiting this idea, the selection of the closest prior art was misled by the indications provided in the description on page 11, last paragraph.
- (b) The presence of a data channel transmission between the "data routing network element" and the "first network element" already in step 515 rendered useless the establishment of a "bearer" in step 530.
- (c) It was not disclosed how the buffered data and the data received in step 532 were handled at the first network element 110 to suit the sequentiality of the transmission at layer 3 of the first network element 110, when the data were collected from the undefined "lower layer 2 connections" and must be delivered in combination to the UE 120.

1.2 The board concurs with the appellant in that the examining division erred in its assessment of the compliance with Article 83 EPC.

In fact, at page 3, lines 17-20, the application as filed states the following:

"The network element 110 may be an evolved NodeB (eNB) as in the LTE and LTE-A, a radio network controller (RNC) as in the UMTS, a base station controller (BSC) as in the GSM/GERAN, or any other apparatus capable of controlling radio communication and managing radio resources within a cell."

and at page 4, lines 13 and 14:

"In the context of the LTE, the data routing network element may be called a System Architecture Evolution Gateway (SAE-GW)."

- 1.3 The application explains that, while the first network element 110 receives proactively downlink data from the data routing network element 134 in step 515 and buffers the data, the RRC connection between the first network element 110 and the UE 120 and/or a bearer service between the UE 120 and the data routing network element 134 may be under configuration (cf. page 10, lines 21-25 of the application as filed). At least for the LTE/EPC elements explicitly mentioned in the application, i.e. an eNB as network element 110 and a SAE-GW as data routing network element 134, the skilled person confronted with the endeavour of "proactively receiving downlink data at the eNB" would have no particular difficulty or burden in adapting, for this purpose, the existing standard-related S1 and S5/S8 interfaces and the associated bearers and procedures which were already defined to enable a communication between the eNB and the SAE-GW components, e.g. the S-GW and the P-GW. This could be done either using *separate* messages sent in addition to the existing ones or *piggybacking* the payload data within the existing messages (see e.g. document **D2**).

1.4 The reasoning provided by the examining division is not convincing, since:

(a) Page 11, last paragraph of the original application states that

"... according to the conventional solution the data routing network element 134 would be able to transmit downlink data to the first network element 110 only in step 532 ...".

According to the examining division, the "conventional solution" known to the then applicant may not correspond to the "closest prior art". However, this conclusion has no bearing on the matter of sufficiency of disclosure under Article 83 EPC.

(b) Whether or not the completion of the RRC connection is "rendered useless" after the first network element 110 proactively receives downlink data from the data routing network element 134 in step 515 will typically depend on the total amount of data to be received (cf. page 11, lines 30 to 31 of the application as filed). Even if the RRC connection turned out to be unnecessary, this fact has no relevance to the matter of sufficiency of disclosure either.

(c) Through the "data connection" established in step 532, the data routing network element 134 routes and forwards user data packets of the UE 120. For instance, a bearer can be established between the UE 120 and the S-GW 134 (cf. page 4, second paragraph, and page 5, last paragraph of the application as filed). Given that the first network

element 110 is not an endpoint of such "data connection", the board cannot see why the examining division imposed a requirement of "sequentiality of transmission at layer 3 of the first network element 110".

1.5 It follows that the main request is allowable under Article 83 EPC.

2. *Right to be heard in the first-instance proceedings (Article 113(1) EPC)*

2.1 In its statement setting out the grounds of appeal, the appellant objected that the examining division had not followed the Guidelines for Examination in the EPO, which prevented it from formulating a more complete response and hence from avoiding the refusal. In particular, objections under Articles 83 and 56 EPC raised with the summons to oral proceedings (i.e. the second communication of the examining division) were entirely new and did not consider or even reflect the then applicant's argumentation presented in the response to the first communication of the examining division. Additionally, it was (still) not clear whether the then applicant should have responded to the objections under Articles 83, 84 and/or 56 EPC. Overall, the appellant raised concerns in its statement of grounds of appeal (page 2) in respect of:

- 1) The first communication under Article 94(3) and Rule 71(1) and (2) EPC.
- 2) The right to be heard under Article 113(1) EPC.
- 3) Sufficiency of disclosure and inventive step (Articles 83 and 56 EPC).
- 4) Objections arising from missing essential features (Article 84 EPC).

In particular, the appellant submitted that a decision which failed to take into account the arguments submitted by a party and which was based on a ground on which the party had had no opportunity to present its comments, contravened Article 113(1) EPC and constituted a substantial procedural violation.

- 2.2 First of all, the board notes that the examining division took its decision "according to the state of the file", i.e. in a particular form of the written procedure relying on a reference to an earlier assessment.
- 2.3 Still, as regards the compliance with Article 56 EPC, in the annex to the summons to oral proceedings (cf. point 3.1), the examining division merely stated its intention "to discuss the inventiveness of the claims during the oral proceedings in view of the assessments made on Art. 83 EPC". Furthermore, the examining division indicated that "[a]dditional documents on which the applicant will be asked to comment, will be eventually introduced by the division after the reply to this invitation and before the date of oral proceedings". There is however no record on file of additional documents being sent to the appellant. The board certainly takes issue with this comment. If anything, it constitutes a veiled threat rather than an actual objection, more so considering that the examining division openly and deliberately withheld the production of additional evidence.
- 2.4 Nonetheless, the procedural behaviour of the examining division in this case, however objectionable, does not constitute a substantial procedural violation justifying a reimbursement of the appeal fee under Rule 103(1) (a) EPC. Although committing an error of

judgment in the sense of being unpersuasive on the merits (cf. e.g. T 658/12, Reasons 4.1), the examining division indeed sufficiently reasoned within the meaning of Rule 111(2) EPC its objection under Article 83 EPC in the annex to the summons to oral proceedings (dated 6 May 2020) to which it later referred when issuing the decision according to the state of the file. Thereafter, the appellant had indeed the chance to counter this objection either in writing or during the oral proceedings which the appellant itself had requested. Instead, the appellant decided to waive this right and requested a written decision without further comments on the substance. Thus, the appellant's right to be heard under Article 113(1) EPC was respected in the first-instance proceedings.

3. *Remittal of the case (Article 111(1) EPC)*

3.1 The board notes that, during the examination proceedings, further comments were made in respect of inventive step and the existence of additional pieces of evidence (see point 2.3 above). However, the examining division did not decide on this issue.

3.2 The board is thus prevented from fulfilling its primary reviewing object in respect of novelty and/or inventive step (see Article 12(2) RPBA 2020). The board considers that the circumstances of the case represent "special reasons" within the meaning of Article 11 RPBA 2020 for remittal.

3.3 Hence, the case is to be remitted to the examining division for further prosecution (Article 11 RPBA 2020).

4. *Decision in written proceedings*

4.1 With the board's intention to remit the case to the examining division, none of the appellant's conditions for requesting oral proceedings is met. Thus, currently, there is no such request.

4.2 Without the occurrence of a substantial procedural violation, there is no entitlement to reimbursement of the appeal fee under Rule 103(1)(a) EPC (as accepted by the appellant when specifically heard on the matter under Article 113(1) EPC, see points IV and V above).

4.3 As the board does not consider holding oral proceedings to be expedient in this case (see Article 116(1) EPC), the requested decision is to be handed down in written proceedings (Article 12(8) RPBA 2020).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated