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File Number: T 476/90 - 3.5.1

Application No.: 83 903 626.6

Publication No.: 0 150 183

Title of invention: Method and apparatus for providing call tracing service

Classification: H04Q 3/72

**D E C I S I O N**  
of 10 April 1991

Proprietor of the patent: American Telephone and Telegraph Company

Opponent: Standard Elektrik Lorenz AG

Headword:

EPC Art. 56

Keyword: "Inventive step (main and auxiliary requests: no)"

**Headnote**



Case Number : T 476/90 - 3.5.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.1**  
**of 10 April 1991**

**Appellant :**  
(Opponent)

Standard Elektrik Lorenz AG  
Lorenzstrasse 10  
7000 Stuttgart 40  
(DE)

**Representative :**

Graf, Georg Hugo, Dipl.-Ing.  
Standard Elektrik Lorenz AG  
Patent- und Lizenzwesen  
Postfach 30 09 29  
7000 Stuttgart 30  
(DE)

**Respondent :**  
(Proprietor of the patent)

American Telephone and Telegraph Company  
550 Madison Avenue  
New York, NY 10022  
(US)

**Representative :**

Watts, Christopher Malcolm Kelway  
AT&T (UK) Ltd.  
AT&T Intellectual Property Division  
5 Mornington Road  
Woodford Green  
Essex IG8 0TU  
(GB)

**Decision under appeal :**

**Decision of Opposition Division of the European  
Patent Office dated 11 April 1990 rejecting the  
opposition filed against European patent  
No. 0 150 183 pursuant to Article 102(2) EPC.**

**Composition of the Board :**

**Chairman :** P.K.J. van den Berg

**Members :** R. Randes  
M.V.E. Lewenton

## Summary of Facts and Submissions

- I. The grant of European patent No. 0 150 183 on the European patent application No. 83 903 626.6, which was filed on 29 August 1983, was published on 11 November 1987.
  
- II. The opposition filed by the Appellant against the granted patent for lack of inventive step was rejected by the Opposition Division on 11 April 1990. The reasons for the decision were, in summary, that although all of the features of Claim 1 were to be found in isolation or in groups in different cited references, none of the references included an indication which would lead a skilled person to combine the teachings of the said documents and so lead to the particular solution claimed by the independent claims.
  
- III. On 13 June 1990 the Appellant lodged an appeal against the Opposition Division's decision, filed grounds of appeal and paid the fee. In the Statement of Grounds he referred to his argumentation in the opposition procedure and was of the opinion that the Opposition Division had not taken into account and not met all of his (Opponent's) arguments.

Moreover the Appellant lodged a request for the reimbursement of the appeal fee, as in his opinion the decision made by the Opposition Division rejecting the opposition without holding oral proceedings was incorrect. The Opponent had in a letter filed on 25 January 1990 in response to a communication by the Opposition Division, dated 22 September 1989, admitted that the best way to continue the procedure would be in writing and thus no oral proceedings would be necessary. The Appellant, however, was of the opinion that the decision made by the Opposition Division and following directly after the said

letter filed on 25 January 1990 could not be considered as a continuation of the procedure in writing.

- IV. After letters from both the Respondent and the Appellant, the Rapporteur in a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal drew for the first time the parties' attention to the description, pages 7, 31 and 32 of D2 (DE-A-2 412 365). This part of the said description of D2, not having been discussed before in the procedure, was said to reveal the idea of the alleged invention. Moreover, having regard to e.g. the teaching of D6 (DE-C-1 301 842) it appeared that the independent Claims 1 and 4 did not involve an inventive step.
- V. Before oral proceedings held on 10 April 1991, the Respondent filed, on 6 March 1991, a main request with amended Claims 1 to 8 and an auxiliary request with amended Claims 1 to 6, in which the claims had been amended in response to the objections raised by the Board in the said communication.

Claim 1 of the main request reads as follows:

"A method for providing a call tracing service for use with a telephone switching system having a communications terminal (181) and serving a plurality of stations (102, 103, 170, 171) CHARACTERISED BY

in response to a call from a calling station to a called station, deriving an identity of the calling station by means contained within the switching system and storing the said identity in a memory dedicated solely to the called station, and

in response to a predetermined code entered at said called station after the termination of said call, sending

the stored identity of the calling station to the communications terminal."

Claim 1 of the auxiliary request reads as follows:

"A method for providing a call tracing service for use with a telephone switching system having a communications terminal (181) and serving a plurality of stations (102, 103, 170, 171) CHARACTERISED BY

in response to a call from a calling station to a called station, deriving an identity of the calling station by means contained within the switching system and storing the said identity in a memory within the switching system dedicated solely to the called station, and

in response to a predetermined code entered at said called station after the termination of said call, sending the stored identity of the calling station to the communications terminal."

The difference of the subject-matter of the main claims according to the main and the auxiliary request is thus that in Claim 1 of the auxiliary request it is not only stated that the identity of the calling station is derived by means contained within the switching system (as in the main request), but also that the said identity is stored in a memory within the switching system.

The requests also include independent Claims 5 and 4, defining switching systems, which relate and correspond fully to the methods defined by cited Claim 1 of the main request and by cited Claim 1 of the auxiliary request respectively.

VI. At the said oral proceedings the Appellant requested that

the decision under appeal be set aside and that the patent be revoked. Additionally he requested that the appeal fee be reimbursed.

The Respondent (Proprietor) requested that the appeal be dismissed and that

1. the patent be maintained on the basis of the main request, or
2. on the basis of the auxiliary request,

whereby both requests included the amendment submitted in oral proceedings concerning column 2, lines 3 to 15 in the patent description as granted, that the words at line 6 "a code after the call" be changed to "a code during the call" and the rest of the paragraph (lines 6 to 15) be deleted.

VII. In support of his request, the Appellant's argumentation during the procedure can be summarised as follows:

D6 represents the closest prior art. The method according to that document is distinguished from the method according to Claim 1 according to the patent principally by the fact that according to D6 the data stored in the central memory means can be identified only by means available from the side of the calling party. Therefore the identification of the calling party can be done only during a call. Document D6 was published before 1970. At the time before the priority date (1983), however, it was self-evident for a skilled man that the said data also was available from the side of the called party. (This statement by the Appellant during oral proceedings was not disputed by the Respondent). Therefore at that time (1983) it was obvious that necessary data could be stored in a

memory dedicated only to the called station and thereby used for identification of the calling station also after the termination of the call.

Under a "communication terminal" is to be understood an arrangement that makes it possible in a telephone switching system to centrally store the identities of the parties of a call. The printer DR in the system disclosed in D6 corresponds to such a communication terminal.

In document D2 it is not explicitly stated that the shown telephone switching system includes a central communication terminal. However, it is apparent that a central terminal must exist, as the identities of the calling parties can be reported to e.g. an office of a court ("Gerichtsbehörde").

Moreover, as also suggested by the Board, D2 discloses the idea of the alleged invention that the calling party can be identified from the side of the called party.

VIII. The Respondent's arguments submitted in support of his requests can be summarised as follows:

D6 represents the closest prior art. The system according to this document tries to solve a problem similar to the present patent, but it does not disclose the idea of the patent. Since the telephone switching system described in D6 does not include a memory dedicated solely to the called party and since the data concerning the parties of a telephone call and stored in a central memory is deleted when the call is terminated, there is no hint in the document that it would be possible to report the identity of the calling station after the termination of the call. As a called party during a nuisance call is probably embarrassed by the call itself, he would have difficulty

to key-in the correct code during the call, which, however, is necessary in a system as identified in D6. By the claimed method and the corresponding system it is possible for the called party to decide after the termination of a call and without being under pressure whether he wants to report the identity of the calling station.

It is true that D2 discloses a telephone station having a memory dedicated solely to the said (called) station and that the said identity is stored in the said memory also after the termination of the call. However this memory is only used for displaying the identity of the calling station at the called station and there is no communication network present that is necessary to send the stored identity to a communication terminal. Also the said memory of the called station is in direct contact with the calling station over voice channels and therefore the content of the memory could be easily tampered with by a malicious caller. The present patent makes use of the fact that the identity of the caller is already available in the memory system within the switching system, so that the subscriber equipment does not need to be changed (as according to D2) and moreover the caller cannot manipulate the system.

#### Reasons for the Decision

1. The appeal is admissible.

#### MAIN REQUEST

2. The Board - like the parties - considers document D6 as representing the closest prior art. D6 discloses a method for providing a call tracing service for use with a



telephone switching system (see the only Figure) having a recording device DR (corresponding to the communication terminal according to Claim 1 of the present patent) and serving a plurality of stations (TS), in which the method (compare especially column 5, second paragraph):

in response to a call from a calling station to a called station, derives an identity of the calling station by means contained within the switching system and stores the said identity in a memory (ZST) and

in response to a predetermined code entered at said called station during the said call, sends the stored identity of the calling station to the communication terminal (DR).

Thus the difference between the known method according to D6 and the method according to Claim 1 of the patent is that the derived identity according to Claim 1 is stored in a memory dedicated solely to the called station (the data in the memory is thus available only for the called party) and that the said code according to Claim 1 is entered after the termination of the call.

Thus the memory according to Claim 1 is designed in such a way that it also after the termination of the call maintains the stored data. This is a clear difference over the teaching of D6, which discloses that the data is stored in the memory only during the call. Also the said memory according to D6 is - contrary to the one of Claim 1 - available for the calling party during the call. Thus the subject-matter of Claim 1 is accordingly novel. Novelty is moreover not disputed by the Appellant.

3. When starting from the teaching of D6 it appears that the objective problem to be solved is, as has repetitively been proposed by the Appellant, that a method is created

that makes it possible for the called party, after the termination of a nuisance call and without being under stress, to report the said call. The calling party should not have any possibilities to influence the behaviour of the called party.

4. However, as already has been shown by the Board (communication pursuant to Article 11(2) of the Rules of Procedure of 11 January 1991), document D2 discloses a system for providing a call tracing service for use with a telephone system serving a plurality of stations with the following features:

a memory 44, dedicated solely to a called station 30,

in said memory 44, in response to a call from a calling station 24, the identity of the latter is stored,

after the termination of a call, the stored identity is maintained in said memory at least until the next call from a calling party (and can be sent to an office, e.g. a court).

Thus said document D2 clearly indicates that a memory can be dedicated solely to the called station and moreover that the stored identity is maintained in the memory even after the termination of the call. Thus it appears that the skilled person, starting from the method according to D6 and trying to solve the said problem, would get the idea to the solution from the teaching of D2. It is true that in D2 it is not explicitly said that a code can be used to send the stored identity to a central terminal, but the fact that the identity is stored in a memory dedicated solely to the called station even after the termination of the call, makes it possible to do so. Thus it would be self-evident to a skilled man to change the

method according to D6 in the way that the said memory is dedicated solely to the called station and that the said identity is maintained in the memory also after the termination of the call, so that the predetermined code can be entered - instead of during the call - after the termination of the call.

In the appeal procedure the Respondent argued that the arrangement according to D2 could be manipulated by the calling party. He pointed out that the said arrangement required that the calling telephone contained a detector for detecting a request signal and a circuit for transmitting the identity of the telephone. Therefore the Appellant felt that it was easy for a malicious caller to tamper with the identification contained in his telephone, as both the request signal and the response signal were sent on voice channels.

However, the Board feels that the said manipulation possibility is not a reason why a skilled man should refrain from the teaching of D2 to improve his method according to D6. According to D6 both the identity deriving means and also all the memory means are within the telephone switching system and the calling party therefore cannot manipulate these means. Thus the skilled person only applies the idea derived from D2 to the method according to D6 in order to solve the said problem.

5. For these reasons, the subject-matter of Claim 1 of the main request is considered to lack an inventive step within the meaning of Article 56 EPC and is therefore not patentable (Article 52 EPC).

AUXILIARY REQUEST

6. Claim 1 according to the auxiliary request is distinguished from Claim 1 according to the main request only by the said addition that the said identity is stored in a memory within the switching system (see paragraph V above). This additional feature cannot, however, contribute to an inventive step. As was shown above (and admitted by the parties) the teaching of D6 discloses that the known switching system contains within the switching system a memory as well as the said means for deriving the identity of the calling station. Thus in accordance with the argumentation in paragraph 4 above it would be obvious to a skilled person to arrive at the method according to Claim 1 of the auxiliary request.
  
7. Thus also the subject-matter of Claim 1 of the auxiliary request is considered to lack an inventive step in the meaning of Article 56 EPC and is therefore not patentable (Article 52 EPC).

REIMBURSEMENT of APPEAL FEE

8. The Appellant's opinion that the decision of the Opposition Division violates the EPC, is not correct.
  
- 8.1 In the Board's view there is no proper basis for the Appellant's (Opponent's) complaint that his letter filed on 25 January 1990 was immediately followed by a decision rejecting the opposition. The Board understands the said letter in the same way as the Opposition Division, see the said decision, paragraph 2.9. Thus no clear indication concerning maintenance of Opponent's original request can be found therein. On the contrary, it is understood that the Opponent at that time agreed with the opinion of the Opposition Division that it would be better to continue

proceedings in writing, although at a later stage it could be necessary to have oral proceedings, cf. the said Appellant's letter under III, third paragraph, last two sentences: "Die Einsprechende stimmt aber der Einspruchsabteilung zu, daß es besser ist, das Verfahren schriftlich weiterzuführen. Als endgültiger Verzicht soll dies aber nicht verstanden werden."

8.2 Thus in the Board's view at the time of the decision no clear and valid request for oral proceedings had been filed. Thus the Appellant's complaint misses the main point that under Article 116 EPC, as emphasised in decision T 229/86 (OJ EPO 1988, 88), "the right of a party to have oral proceedings is dependent upon such party filing a request for such proceedings: in the absence of such a request, a party has no such right, and the EPO can issue a decision, whether adverse or not, without appointing such proceedings". It is moreover said in this cited decision that the statement "I reserve my right to request oral proceedings under Article 116 EPC" (cf. the above-cited last sentence of the third paragraph under III in the said letter) is not in itself an actual request for oral proceedings.

8.3 It appears therefore that the continuation of the proceedings in writing by the Opposition Division was correct. Also the fact that a decision was taken immediately after the said (third) letter filed by the Appellant, then Opponent, thus without a further communication, cannot be considered as incorrect as the Opponent had not filed any further evidence and arguments which could have led to a different assessment of the claimed subject-matter (cf. the said decision under 2.6). So the requirements of Article 113(1) EPC have been fulfilled.

8.4 Thus the Appellant's request for the reimbursement of the appeal fee cannot be accepted (Rule 67 EPC).

**Order**

**For these reasons, it is decided that:**

1. The decision under appeal is set aside.
2. European Patent No. 0 150 183 is revoked.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

M. Beer

P.K.J. van den Berg