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**D E C I S I O N**  
**of 14 December 1999**

**Case Number:** T 0148/97 - 3.5.1

**Application Number:** 87201194.5

**Publication Number:** 0253421

**IPC:** H04M 7/00

**Language of the proceedings:** EN

**Title of invention:**

Communication network, more specifically a telephone network and data communication network composed of a set of nodes, in which specific facilities within optionally determined domains can be offered fully integrated

**Patentee:**

Koninklijke Philips Electronics N.V.

**Opponent:**

Alcatel N.V.  
Siemens AG

**Headword:**

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**Relevant legal provisions:**

EPC Art. 56, 100(a)  
EPC Art. 123(3)

**Keyword:**

"Inventive step (no)"  
"Claim broadening (not decided)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0148/97 - 3.5.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.1  
of 14 December 1999

**Appellant/other party:** Alcatel N.V.  
(Opponent) Strawinskylaan 341  
NL-1077 XX Amsterdam (NL)

**Representative:** Pohl, Herbert, Dipl.-Ing.  
Alcatel Alsthom  
Intellectual Property Department  
P.O. Box 30 09 29  
D-70449 Stuttgart (DE)

**Other party:** Siemens AG  
(Opponent) Postfach 22 16 34  
D-80506 München (DE)

**Representative:** -

**Respondent:** Koninklijke Philips Electronics N.V.  
(Proprietor of the patent) Groenewoudseweg 1  
NL-5621 BA Eindhoven (NL)

**Representative:** Mak, Theodorus Nicolaas  
International Octrooibureau B.V.  
P.O. Box 220  
NL-5600 AE Eindhoven (NL)

**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office posted  
27 November 1996 concerning maintenance of  
European patent No. 0 253 421 in amended form.

**Composition of the Board:**

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

**Members:** A. S. Clelland

P. H. Mühlens

## Summary of Facts and Submissions

- I. This appeal is against the decision of the Opposition Division to reject two oppositions against European patent No. 253 421 and maintain the patent in amended form.
- II. The opposition proceedings were primarily concerned with the grounds of claim broadening, based on amendment of the independent claim, claim 1, in the course of the opposition, and lack of inventive step. For this latter ground both opponents primarily relied on the following document:
- D1: Philips Telecommunication Review, Vol. 43, No. 4, December 1985, pages 237-252, Hilversum, NL;  
J. Van Gelder et al.: "Private networking with SOPHO-TBX and SOPHO S systems".
- III. The objection of claim broadening was based on the amendment of the wording of the granted claim 1 to replace "the control module" by "a control module". It was argued by the opponents that the granted claim was limited to a control module located within its specific local node whereas the amended claim permitted any control module in any node to be used. The claim made technical sense without the amendment and there was no reason for the skilled person to read it in the light of the description. The claim as amended therefore gave rise to objection under Article 123(3) EPC.
- IV. The Opposition Division took the view that claim 1 had not been broadened and that its subject-matter involved an inventive step. Consequently the patent was

maintained in amended form.

V. On the 4 February 1997 the appellant (opponent I) lodged an appeal against the decision and paid the prescribed fee. A statement of grounds of appeal was subsequently filed maintaining the objections of claim broadening and lack of inventive step. The appellant requested that the patent be revoked in its entirety and made an auxiliary request for oral proceedings if the Board was not minded to meet the main request on the basis of the written procedure. The patentee requested that the appeal be dismissed and also made an auxiliary request for oral proceedings. Opponent II took no part in either the written arguments or the oral proceedings.

VI. At the oral proceedings before the Board the parties maintained their requests. The arguments of the parties can be found in the following Reasons for the Decision. Claim 1 of the patent as maintained in amended form reads as follows:

"A communications network, more specifically a telephone network and data communications network, composed of a set of private automatic branch exchanges (KNE1, KNE2, ..., KNE<sub>n</sub>) interlinked through transmission lines through which TDM-transmission is possible, a private automatic branch exchange comprising a switching module (SM), at least one peripheral module (PM) to which user gates are connected, and a control module (CM), whereby local data are available in the private automatic branch exchange,  
characterized in that:

- local data are associated with a specific telephone facility related program for dictating the operation of a control module (CM) to execute a specific telephone facility, the local data comprising an updatable address file (AL1, AL2, ..., ALn) of addresses of those private automatic branch exchanges via which a request for the specific telephone facility to which specific program is related can be met;
- a subset of at least two private automatic branch exchanges provided with the same telephone facility and whose addresses are incorporated in a file of a specific private automatic branch exchange form for such a specific private automatic branch exchange a domain (DB), within which the specific telephone facility is offerable, and
- for different facilities domains can be formed arbitrarily by updating of address files."

## **Reasons for the Decision**

### 1. *Claim broadening (Article 123(3) EPC)*

- 1.1 It was argued in both the opposition and appeal proceedings that the amended claim 1 was broader than the granted claim in that it covered the use of a control module in a remote node whereas the claim as granted was limited to a control module in the specific node in question. Against this argument the patentee maintained that the skilled person, reading the granted claim, would immediately appreciate that a remote node must be meant and, were he to glance at the

description, would see this appreciation confirmed.

1.2 The appellant did not raise this objection in the course of the oral proceedings. In view of the Board's conclusion below on inventive step it has not proved necessary to find on this point since the argument on inventive step applies no matter how the claim is interpreted.

2. *Inventive step*

2.1 It was common ground between the parties that the single most relevant document is D1, acknowledged in the originally filed application and apparently the basis of the delimitation of claim 1. The document describes a telephone network composed of a set of nodes in the form of private automatic branch exchanges (PABX), see Figure 2 at page 239, interlinked through transmission lines. The network also permits data communication, see paragraph 9 at page 249. The protocol for the transmission lines connecting the exchanges is not described in detail but is referred to at page 239, paragraph 2.4 as "digital 2 Mb/s links", implying the well-known time division multiplexed system. It has not been contested by the patentee that a PABX, although loosely referred to as a "switch", comprises not only a switch but also an interface with subscriber lines ("a peripheral module" in the language of the claim) and a controller or control module for controlling the operation of the switch.

2.2 In the course of the present proceedings it was stated by the respondent that the invention went well beyond what was disclosed in D1, as could be seen from the



fact that D1 was discussed in the originally filed application and had always been understood as a starting point for a consideration of the invention but nothing more. D1 was based on a system making use of one main node and a plurality of satellite nodes; This configuration implied that all requests for special services went via the main node, so that each satellite node only needed to look up the address of the main node and would not store any further information. There was therefore neither the need nor the possibility of providing arbitrary domains, nor would the satellite nodes require to hold at least two addresses, only the address of the main node being necessary. Although D1 discussed routing characteristics, this was in the context of efficient transmission of calls through the network and was not related to the provision of special services from an address list.

2.3 D1 is essentially a descriptive document; nevertheless the Board considers that it discloses features which go beyond the appellant's acknowledgement of D1. In the introduction, see the first full paragraph on page 238, it is stated that "facilities that are normally of local relevance only can be made available throughout the entire network". Similarly on the same page at paragraph 2.2 the possibility is mentioned of "implementing main and satellite operation... but also transparency throughout the network for common features such as enquiry and transfer, break-in, automatic ring-back and follow-me". This passage implies that each node or PABX holds addresses for facilities available elsewhere in the network. That the addresses for these facilities are not necessarily stored in a single main node appears from paragraph 3.2, page 239, "main and

satellite operation", which states that "one or more nodes are designated as the "main" system, while the others act as their satellites" (Board's emphasis). The same paragraph states that "some companies may prefer to have operators or PSTN lines ... in satellites as well, and this is always possible". Thus, certain functions may be provided in satellite nodes and more than one main node may be provided; the definition of what constitutes a main node as opposed to a satellite node is therefore fluid, with satellites being capable of taking over functions otherwise reserved for the main node.

2.4 At the oral proceedings the respondent argued that the satellite nodes could provide "route characteristics" but that these could not be equated with an address file, cf the passage at page 245, paragraph 7 which states that "The question of what is the main and what is the satellite switch in a certain situation is defined on the per-call consultation of route characteristics stored in the nodes". D1 described a system in which main nodes provided special facilities, so that if a satellite node needed a special facility it knew to contact the main node and did not need a special address. Moreover, if a node could itself provide a facility there was no need for an address list, merely a list of those facilities available at the node.

2.5 The Board notes that D1 describes three kinds of network: "Non-integrated networks" (paragraph 2.1), "Partially integrated networks" (paragraph 2.2) and "Fully integrated networks" (paragraph 2.3). Non-integrated networks "hardly 'know' that they are

arranged in a network structure. Each node is self-contained (holds local data only)". Such a network cannot perform the claimed functions. The "Partially integrated networks" are stated to have "nodes with local data only" and in which during a call there is an exchange of information which gives the node "temporary knowledge of the relevant external private network parties on a per-call basis". This implies that no external information is stored at a node. The references in this paragraph to common features such as enquiry and transfer are apparently dependent on the presence of specific signalling protocols rather than stored addresses, see also paragraph 8.2 at page 247. However, "Fully integrated networks", see paragraph 2.3 bridging pages 238 and 239, provide "full transparency for user facilities" and "access to global network data in each node", which data can be updated. The respondent argued that this passage referred to a free numbering facility as opposed to a special function facility; the appellant on the other hand argued that the data could be expected to include information about nodes offering special facilities, enabling the source node to choose an appropriate destination for a request. The Board notes that although special telephone functions can indeed be provided by signalling (cf "line signalling" at page 247) this is in the context of a partially integrated network. It appears to the Board that in the context of a fully integrated network in which all network data is available at each node there is no practical distinction to be made between addressing specific subscribers and addressing specific facilities. On such an understanding each node in a fully integrated network includes an updatable "address file" of special

facilities.

2.6 The Board accordingly concludes that D1 discloses the storage in individual nodes of addresses relating specific nodes to specific telephone facility related programs. Since the facility may be provided in the node itself but an access number must be dialled nevertheless, the Board considers that the above analysis applies whether the special facility requires operation of the node's own control module or that of a remote node (i.e. "the" and opposed to "a" control module).

2.7 The following features of claim 1 are not directly derivable from the disclosure of D1:

- (a) the local data held at a node comprises at least two addresses of nodes which can provide a specific facility; and
- (b) the addresses are held in updatable files.

The Board does not consider that forming arbitrary domains within which the specific facility is offerable adds anything to feature (a) since the presence of two differing addresses can be said to imply this, see also the passage at page 242, paragraph 5 which refers to operator positions being "distributed throughout the network", implying a domain for each operator.

2.8 Dealing first with difference (b), the question to be answered is whether D1 is concerned with a system reconfigurable in real time or merely initially configurable at network set-up. Although many passages

could be read as applying to either possibility, the discussion of network management at paragraph 7, page 245 in referring to "day-to-day network management and control" implies a network configuration which is updatable. It was argued by the respondent that this passage only referred to route characteristics, i.e. controlling the path of calls through the network in order to avoid network instability and overloading; however, directing a call to a node which provides a specific facility of itself requires storage of a route characteristic. The Board accordingly concludes that the D1 system is reconfigurable and amongst the information stored in the individual nodes are the addresses of other nodes which provide specific facilities, i.e. address data in accordance with feature (a).

2.9 The only remaining feature of claim 1 is the provision of at least two addresses for every facility. The Board does not consider that any inventive step is involved in providing this feature. In a system with a plurality of operators it would appear to be self-evident that, if an operator is busy, the call must be re-routed to an available operator. In order to achieve this the addresses of both the busy and available operator must be in storage. There are only two possibilities for doing this: either the interrogating node, being informed that an operator is busy, looks for an address of another operator in its own look-up table, or the node containing the busy operator redirects the call. No invention can be seen in choosing the former configuration over the latter.

2.10 Although it was argued by the respondent that in D1

each node merely held a table of its own numbers rather than the addresses of specific facilities, the Board is unable to appreciate the distinction made between numbering facilities and telephone function facilities. In order to connect to a function the address at which the function is performed must be available to the node, so that in practice no genuine distinction exists.

3. The Board accordingly concludes that the subject-matter of claim 1 does not involve an inventive step. There being no other requests, it follows that the patent must be revoked.

## **Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg