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D E C I S I O N
of 25 January 2001

Case Number: T 0758/99 - 3.5.1

Application Number: 88105289.8

Publication Number: 0285164

IPC: H04Q 7/04

Language of the proceedings: EN

Title of invention:

Communication control system capable of searching a called telephone set in a mobile radio telephone network

Patentee:

NEC CORPORATION, et al

Opponent:

ERICSSON BUSINESS MOBILE, NETWORKS B.V.

Headword:

Communication control in a mobile radio telephone network/NEC CORPORATION

Relevant legal provisions:

EPC Art. -

Keyword:

"Remittal for further prosecution"
"Late filed documents - prima facie relevant"
"Apportionment of costs - decision will be taken at a later stage"

Decisions cited:

-

Catchword:

-



Case Number: T 0758/99 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 25 January 2001

Appellant: ERICSSON BUSINESS MOBILE
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Respondent: NEC CORPORATION
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 11 May 1999
rejecting the opposition filed against European
patent No. 0 285 164 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. Randes
H. Preglau

Summary of Facts and Submissions

I. This appeal is against the decision of the Opposition Division rejecting the opposition against European patent No. 0 285 164.

Claim 1 as granted and upheld by the Opposition Division reads as follows:

"A communication control system for use in a mobile radio telephone network comprising a telephone line (10), a plurality of radio telephone sets (11) movable in an area (14) divided into a predetermined number of zones (Z11, Z12, Z13, Z21, Z22, Z23, Z31), and a plurality of radio communication devices (15) assigned to the respective zones, said communication control system including:

a memory (27) for memorizing, in correspondence to said radio telephone sets, location information signals indicative of the radio communication devices assigned to the zones in which said radio telephone sets are present at a time;

selecting means (21, 25, 31) coupled to said telephone line and said memory for selecting, in response to an arrival signal arriving at said telephone line and specifying a specific telephone set among said radio telephone sets, one of said radio communication devices as a specific communication device that is indicated by one of said location information signals that, in turn, is in correspondence to said specific telephone set;

communicating means (22, 25, 32) coupled to said radio communication devices and said selecting means for

sending said arrival signal as a call signal to said specific communication device for transmission to said specific telephone set, said specific telephone set transmitting a response signal to said specific communication device in response to said call signal for reception by communicating means when said specific telephone set is present in one of said zones that is assigned with said specific communication device; said call signal being transmitted to said specific telephone set in a predetermined radio frequency band; wherein:

said zones are classified into a plurality of groups, equal in number to a preselected number which is not less than two and not greater than said predetermined number less one, with said groups given individual numbers, so that at least one of said groups consists of at least two of said zones and that said call signal is never subjected to a radio interference, when transmitted from at least one of said radio communication devices that is assigned to one of the zones of said at least one of the groups, with a radio signal transmitted from another of said radio communication devices that is assigned to another of the zones of said at least one of the groups;

said communication control system comprising searching means (25, 33) coupled to said radio communication devices and said communicating means for searching a different one of said radio communication devices as a searched communication device if the communicating means does not receive said response signal, by transmitting said call signal at first simultaneously to the radio communication devices assigned to the zones of said at least one of the groups, and by

transmitting said call signal subsequently to at least one remaining communication device of said radio communication devices until said communicating means receives said response signal through said searched communication device, said at least one remaining communication device being assigned to the zone of at least one remaining group of said groups with said groups selected in an order predetermined relative to said individual numbers."

II. The Appellant (Opponent) requested that the contested decision be set aside, arguing that the subject matter of claim 1 did not involve an inventive step. The Appellant relied on the following documents cited in opposition proceedings:

D1: GB-A-1 472 212

D2: WO-A-84/00868

D4: Ericsson Doc. Nr. 23/155 16-ANT 219 02 Ue,
"Function description", 23 September 1986,
revision F.

The Appellant also filed and relied upon the following document for the first time:

D5: US-A-4 125 808.

It was also stated that when the reasons for the Opposition Division's decision were communicated to the Appellant they had been accompanied by an EPO form 2327, entitled "Interlocutory decision in opposition proceedings (Article 106(3) EPC)". The Appellant requested re-imbusement of any further appeal fee if

it was necessary to appeal against the "interlocutory decision".

III. The Respondents (Patentees) requested dismissal of the appeal, questioning whether D4 was prior art and requesting that D5 not be admitted into the proceedings due to lack of relevance.

IV. In an annex to a summons to oral proceedings the Rapporteur expressed the preliminary opinion that D4 did not appear to form prior art. D5 was regarded as less relevant than either D1 or D2 so that it appeared unlikely that it would be admitted into the proceedings. Moreover the subject matter of claim 1 appeared to lack inventive step in view of the combination of D1 and D2. As to the "interlocutory decision", given the circumstances as a whole, it must have been clear that no "interlocutory decision" had in fact been taken.

V. In a letter received 21 December 2000 the Respondents filed three auxiliary requests concerning restricting amendments to claim 1. It was also argued that the combination of D1 and D2 did not yield the subject matter of claim 1, since neither document disclosed terminating the search for a mobile user as soon as a response signal was received from the mobile user. There was also no hint in the prior art to add this feature.

VI. In a FAX received on 17 January 2001 the Appellant filed the following documents for the first time:

E1: Information of the "Staatsbedrijf der Posterijen, Telegrafie en Telefonie", three pages in Dutch.

E2: Elsevier Encyclopaedia 1977, published by B.V. Uitgeversmaatschappij Argus Elsevier, chapter on "Mobilofonie" in Dutch with English translation.

E3: DE-A-2 128 204

E4: DE-A-35 07 058.

The Appellant stated that on 15 January 2001 he had become aware that the former Netherlands car telephone network "ATF 1", which had been in operation from about 1980 onwards, had used a search strategy similar to that of the patent in suit. In particular it searched for a mobile user on a zone-by-zone basis, terminating the search once a response signal was received from the mobile user. E1 and E2 related to this system. The Appellant had also established that "ATF 1" comprised systems manufactured by the German company Tekade Felten & Guilleaume Fernmeldeanlagen GmbH. A short search for patent applications made by this company revealed E3 and E4. In the FAX the Appellant also provided English translations of particularly relevant passages of E3 and E4. The Appellant requested that E1 to E4 be admitted into the proceedings, since they were prima facie highly relevant. These documents did not present new evidence going beyond the indication of facts and evidence already presented; they merely supported the view that the patent lacked inventive step in view of D1 or D2 combined with any of E1 to E4 so that the patent should be revoked.

VII. In a FAX received on 22 January 2001 the Respondents requested that documents E1 to E4 be disregarded, giving both formal and substantive reasons.

As to formalities, the Respondents pointed out that the annex to the summons to oral proceedings had indicated that all submissions should be made at least one month before the oral proceedings. These documents had been filed after this date and were thus belated. Moreover, since E3 and E4 were written in German, translations into English would be required for the Respondents, who were four Japanese companies. There had been insufficient time to translate these documents. Consequently the Respondents' representative had been unable to discuss the relevance of the new documents with the inventors in the short time available.

As to substance, the Respondents argued that, following T 1002/92, late filed documents should only very exceptionally be admitted into the proceedings if they were prima facie highly relevant. This was not the case for E1 to E4 since the Appellant had admitted that they did not present new evidence going beyond the indication of facts and evidence already presented. Moreover, the Appellant had not properly substantiated his case, having merely discussed the content of E1 to E4 without comparing their disclosure with claim 1. The Respondents also questioned whether E1 formed prior art, since it lacked any indication of a publication date and related to a planned system which may never have been implemented. It was also questioned whether E1 and E2 concerned the same system, E1 concerning a system in 1984 whilst E2 was published in 1977. Since a "short search" had produced E3 and E4, the Respondents argued that these documents should have been found earlier. The relevance of E3 and E4 was also questioned.

The Respondents also made a request under Rule 63 EPC

for apportionment of the costs incurred by the Respondents' representative in preparing and filing the FAX received on 22 January 2001, since the Respondents had had to respond to unjustifiably belated objections which could have been advanced earlier.

VIII. Oral proceedings were held before the Board on 25 January 2001.

Regarding the request for reimbursement of an appeal fee if an appeal was required against the "interlocutory decision", the Appellant stated that this request had merely been a precaution and that he accepted that no "interlocutory decision" had in fact been taken.

The Appellant argued that the inventive step of claim 1 essentially depended on whether the claimed search procedure was obvious having regard to D2. Two alternative search strategies were possible. Firstly, one could search all zones and then evaluate the results, as taught in D2. This searching scheme is referred to as the "first option" below. Secondly, one could search a group of zones, evaluate the results and only continue to the next group if nothing was found, as claimed in the patent. This searching scheme is referred to as the "second option" below.

The Appellant's representative explained that on 8 January 2001 his colleague Mr Verduin had, in a chance conversation with a colleague, become aware that a "second option" search strategy had been used in the Dutch car telephone network "ATF 1". A minimal form of the "ATF 1" system had been established in 1980, extensions being planned and implemented every year to

add capacity to meet the growing demand. As to the argument that the Appellant, being Dutch, should have been aware of the Dutch "ATF 1" system, the Appellant responded that this may have been known somewhere in the Appellant's organisation. It had not however been known to the Representative. Moreover, it would not have been feasible to find E1 to E4 during the Opposition period by checking all products of all known manufacturers in the market before the priority date, some of which no longer existed.

Mr Verduin had visited the company operating the "ATF 1" network on 11 January 2001. The Appellant subsequently received documents concerning "ATF 1" from the Dutch authorities on 15 January 2001 mentioning Tekade Felten & Guillaume Fernmeldeanlagen GmbH which, after a short patent search, led to E3 and E4. Documents E1 to E4 merely confirmed what had already been argued, namely that the "second option" search strategy was prior art. The EPO, which had a high search quality, had been unable to find E3 and E4. Hence they were not easy to find. Although E3 and E4 did not explicitly mention a communications control system, this was implicitly present in their disclosure. The Appellant stressed that, to save time, he had sent the FAX of 17 January 2001 directly to the Respondents' representative on the same day.

The Appellant pointed out that his FAX of 17 January 2001 contained English translations of the relevant passages of E3 and E4 so that the Respondents had not needed to obtain their own translations. Moreover, every Representative had the means to rapidly contact clients. The FAX of 17 January 2001 had merely been intended to make a prima facie case and so had not

contained a complete substantiation. The Appellant offered to file further documents in Dutch describing the "ATF 1" system which were indisputably prior art.

The Appellant requested that no apportionment of costs be made, since the late filing of E1 to E4 had not caused the Respondents any extra work or costs; the Respondents would have had to study E1 to E4 anyway, regardless of whether they had been filed early or late, and the Respondents' representative had admitted that he had been unable to consult with his clients.

The Respondents' representative stated that the Appellant's FAX containing E1 to E4 had arrived at his office at 18:10 hours on 17 January 2001. Since this was outside working hours, he had only become aware of these documents on 18 January 2001, seven days before the oral proceedings. He had sent a letter to his clients in Japan on 18 January 2001 asking if they required translations of E1 to E4, but had not yet received any instructions on how to proceed. As a precaution the FAX of 22 January had been filed. The Respondents argued that the Appellant could have found E1 to E4 earlier because Tekade Felten & Guilleaume Fernmeldeanlagen GmbH was a well known manufacturer in the field. Also the Appellants were Dutch and could have been expected to know their own national car telephone system. E1 also appeared to be an internal document not intended for publication. If E1 to E4 had been found merely by chance then this indicated that the invention was not obvious.

If E1 to E4 were to be discussed further the Respondents' representative wanted an opportunity to consult with the Respondents.

- IX. After deliberation the Board stated that documents E1 to E4 were sufficiently relevant to be introduced into the proceedings.
- X. The Appellant's final request was that the appealed decision be set aside and the patent revoked. The Respondents requested that the appeal be dismissed and the patent maintained as granted, or according to the first, second and third auxiliary requests received on 21 December 2000.

The parties also made the following procedural requests. The Respondents requested that the case be remitted to the Opposition Division. Auxiliarily, they requested that the procedure be continued in writing before the Board. As to costs, the Respondents requested apportionment of all future costs caused by the late filing of E1 to E4.

The Appellant pointed out that future costs could not be predicted and stated that he could not agree to remittal of the case unless the request for apportionment of costs was withdrawn.

The Appellant consequently requested that proceedings be continued in writing before the Board and auxiliarily, if the request for costs was withdrawn, that the case be remitted to the first instance.

The Respondents did not however withdraw their request for costs.

Reasons for the Decision

1. The appeal is admissible.

2. *Background*

The patent concerns a mobile telephone network covering a service area divided up into a cellular structure of zones. To connect an incoming call to a mobile user in the network, the system control unit ("CU") sends an "incoming call signal" to the radio communication device ("RCD") covering the zone currently occupied by the called mobile telephone. The radio communication device, in turn, passes the incoming call signal to the called mobile telephone. The called mobile telephone responds to the incoming call signal with a "response signal" which is passed to the control unit.

A problem arises when the called mobile telephone is not in the expected zone and it is necessary to search the service area. According to the patent, the service area is divided up into a plurality of groups of zones, at least one group consisting of more than one zone, there being no mutual interference between incoming call signals in zones of the same group. The search strategy involves working through the groups in a predetermined order, transmitting the incoming call signal to all the radio communication devices in a group simultaneously, until a response signal is received from the called mobile telephone.

3. *The admissibility of documents E1 to E4*

In view of Article 114(2) and Rule 71a(1) EPC, the Board may disregard documents E1 to E4, since they were filed after the time limit set by the Board in the annex to the summons to oral proceedings. In exercising

its discretion in this matter the Board has to decide whether these documents are prima facie sufficiently relevant to warrant their admission into the proceedings at this late stage because they could change the outcome of the case.

E1 and E2 relate to the Dutch car telephone network. In the light of the fifth paragraph of the English translation of E2, this network searched the zones of the service area for a mobile telephone user by searching a group of zones at a time, terminating the search as soon as the mobile user was found. A similar search strategy appears to be known from E3 (paragraph bridging pages 2 to 3) and E4 (page 9, line 11 to page 10, line 25).

Hence E1 to E4 seem to disclose what is termed above a "second option" search strategy. In D2 (see Figure 12 continued) all zones are searched and the results then evaluated, this being a "first option" search strategy. The disclosure of documents E1 to E4 thus goes beyond the disclosure of the prior art previously on file, in particular D2, in the sense that they show that at least one feature of the invention, i.e. termination of the search once the mobile user responds, belonged to the prior art, which was not known from the originally cited references. This new evidence has been submitted in order to assess inventive step, the ground of opposition relied upon by the Opponent.

Documents E1 to E4 are consequently prima facie highly relevant to the case. The Board consequently admits these documents to the proceedings.

It is emphasised however that, in admitting these

documents to the procedure, the Board is not taking a final position on whether all of them form prior art.

4. *Remittal*

The submission of the prima facie highly relevant documents E1 to E4 has substantially changed the evidence forming the basis of these appeal proceedings. In effect the Board has been presented with a new case. Under these circumstances the Board is reluctant to allow the Appellant's main procedural request, the continuation of proceedings in writing before the Board, since documents E1 to E4 have been relied upon for the first time in appeal proceedings. Hence the Board refrains from giving a final opinion on the disclosure of these documents. Instead, in order that the parties can benefit from a decision by two instances on this new case the Board allows the Respondents' main procedural request and remits the case to the Opposition Division in accordance with Article 111(2) EPC. Remission under these circumstances is consistent with case law of the Boards of Appeal; see T611/90 (OJ 1993, 50) (point 3 of the reasons) and T18/93 (unpublished) (see point 5 of the reasons).

Remittal of the case will also give the Respondents' representative an opportunity to properly consult with the Respondents.

5. *The request for apportionment of costs*

A decision on apportionment of the future costs in appeal proceedings caused by the late filing of E1 to E4 will, to some extent, depend on the course of the future procedure and, in the absence of the necessary

facts, cannot be decided at present. The Board refrains from such an "open-ended" award of costs, agreeing with the Appellant's objection that the consequences of such an award are unpredictable. For these reasons the Board deviates from the judgement given in T611/90 in which legitimately incurred future costs were apportioned (point 5 of the reasons and point 4 of the order).

Order

For these reasons it is decided that:

1. The case is remitted to the first instance for further prosecution on the basis of the requests of the parties, taking into account that documents E1 to E4 are admitted into the proceedings.
2. A decision on the request for apportionment of costs will be taken at a later stage.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg