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D E C I S I O N
of 11 January 2001

Case Number: W 0015/00 - 3.5.1

Application Number: PCT/EP 98/08512

Publication Number: WO 00/41431

IPC: H04Q 11/04, H04L 12/56

Language of the proceedings: EN

Title of invention:
Packet Transmission method and apparatus

Applicant:
Nokia Networks OY et al

Opponent:
-

Headword:
-

Relevant legal provisions:
PCT Art. 17(3)(a)
PCT R. 13.2, 40.2
EPC Art. 106, 116, 154(3)

Keyword:
"Assessment of unity a posteriori"
"Oral proceedings (no)"
"Time limit for substantiation of protest"

Decisions cited:
W 0004/93, W 0011/93, G 0001/89, G 0002/89

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: W 0015/00 - 3.5.1
International Application No. PCT/EP 98/08512

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 11 January 2001

Applicants:

Nokia Networks OY
P.O. Box 300
00045 Nokia Group (FI)

Kiiski Matti
Mustanlinnuntie 21
90460 Oulunsalo (FI)

Heikkinen Eero
Urpiaisentie 41
90570 Oulu (FI)

Representative:

Pellmann, Hans-Bernd
Tiedtke-Bühling-Kinne
Bavariaring 4
D-80336 München (DE)

Subject of the Decision:

Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicant against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 6 October 1999.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
C. Holtz

Summary of Facts and Submissions

- I. International patent application No. PCT/EP 98/08512 was searched by the European Patent Office, acting in its capacity as an International Search Authority (ISA).
- II. On 6 October 1999 the ISA invited the applicant to pay an additional search fee on the ground that a partial international search had revealed that the subject-matter of each of claims 1, 17 and 29 was known from prior art document EP-A-851 706. It was held that the remaining claims fell into two groups with different special technical features solving different problems, so that these claims were not so linked as to form a single general inventive concept. The groups of claims were held to relate to the following inventions:
- (i) Claims 1 to 4, 7, 11, 17 to 21, 24, 25, 29 to 31
Packet transmission method and apparatus using bit error detection
 - (ii) Claims 5 (as dep. on 1), 6, 12 (as dep. on 10), 13 to 14 (both as dep. on 1), 15, 16, 22 (as dep. on 17), 23, 26 to 27 (both as dep. on 17), 28
Packet transmission method and apparatus using signal strength in a mobile radio network.
- III. The applicant paid the additional fee under protest and in a reasoned statement dated 4 November 1999 argued that the ISA was incorrect in its analysis of the cited document. The document was concerned with tagging an ATM cell based on a priority level determined at the transmission end, whereas feature (a) of claim 1 required that the quality of a **received** data packet be judged. Furthermore, the cited document was concerned with the problem of congestion caused by system users

transmitting in excess of their agreed data rate, whereas the application was concerned with the reduction of traffic when the same data stream was transmitted over a plurality of macro diversity combining (MDC) branches. Since the independent claims were novel and inventive there was no basis for the a *posteriori* allegation of lack of unity by the ISA.

- IV. The protest was reviewed in accordance with Rule 40.2(e) PCT by a review panel of the European Patent Office, which on 28 February 2000 held that the invitation to pay an additional search fee was justified and invited the applicant to pay a protest fee in order that the protest be examined by a "special instance" of the ISA or competent higher authority in accordance with Rule 40.2(c) PCT.
- V. The applicant duly paid the protest fee on 28 March 2000 and submitted further arguments. It was stated that in document EP-A-851 706 the quality of the received traffic as a whole was judged, whereas claim 1 was concerned with the quality of a received individual data packet. The subject-matter of claim 1 was accordingly considered to be novel and involve an inventive step. Additionally, it was argued that the alleged two inventions were linked so as to form a single general inventive concept as required by Rule 13.1 PCT. The technical contribution achieved by the alleged two inventions over the prior art was that of judging the quality not on the basis of traffic parameters but on the basis of each single received data packet.
- VI. The appellant made an auxiliary request for oral proceedings in the event that the protest was not considered to be entirely justified.

VII. Claim 1 reads as follows:

"1. A packet transmission method for transmitting data packets via a telecommunication network, comprising the steps of:

- (a) judging the quality of a received data packet;
- (b) tagging said data packet by adding a dropping information in response to the result of said judging step; and
- (c) dropping said tagged data packet based on said added dropping information, when a predetermined dropping condition is met."

Claim 17 reads as follows:

"17. A transmission apparatus for transmitting data packets via a telecommunication network, comprising:

- (a) judging means (12, 23) for judging the quality of a received data packet; and
- (b) tagging means (13, 22) for adding a dropping information to said data packet in response to a judging result of said judging means (12, 23)."

Claim 29 reads as follows:

"29. A network element for a telecommunication network, comprising dropping means for detecting a dropping information included in a received data packet, and for dropping said data packet based on said detected dropping information, when the predetermined dropping condition is met."

Reasons for the Decision

1. In its invitation to pay additional fees the international searching authority (ISA) argued that prior art document EP-A-851 706 completely disclosed the subject-matter of independent claims 1, 17 and 29. Two inventions were identified in the remaining claims, the one using bit error detection and the other using signal strength in a mobile radio network.
2. It is thus apparent that the ISA's objection is a *posteriori*. In its decisions G 1/89 and G 2/89 (OJ EPO 1990, 152) the Enlarged Board held that such an objection was permissible but that the charging of additional fees under Article 17(3)(a) PCT should be made only in clear cases.
3. The Board has accordingly considered whether in the present case the ISA's finding meets the Enlarged Board' criteria and whether the reasoning is sufficient to substantiate a finding of lack of unity. It has concluded that the invitation is sufficiently reasoned.
4. Rule 40.2(c) PCT states that an applicant may pay an additional search fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. In the present case the protest as filed is accompanied by a statement which discusses at pages 1 and 2 the cited document and at page 3 a further document mentioned in the international search report.
5. However, the statement gives no convincing arguments as to why the ISA's reasoning was wrong. The discussion of EP-A-851 706 in the paragraph bridging pages 1 and 2 of

the statement quotes column 8, lines 42 to 51 of the document as disclosing a logic circuit 84 which decides whether a specific packet should be marked as being transmitted at an excessive transmission rate. The actual passage in EP-A-851 706 is however concerned with resources reservation and makes no mention of tagging. Similarly, the first full paragraph on page 2 of the statement refers to "column 12, lines 26 to 29", and "column 12, last paragraph", passages which are not relevant to the argument being advanced. The final paragraph on page 2 of the statement discusses the object of the invention and its solution. This discussion is only relevant to the second invention identified by the ISA, namely packet transmission method and apparatus using signal strength in a mobile radio network, and the arguments in the paragraph do not deal with the objection raised by the ISA.

6. In conclusion, the Board finds no argument in the statement which casts doubt on the international search authority's finding of lack of unity.

7. The Board has considered whether the subsequent submission of 28 March 2000, according to which in EP-A-851 706 received packets are tagged on the basis of quality of service criteria, should be taken into account in reaching its conclusion. According to Rule 40.3 PCT a time limit is set by the ISA for the payment of additional search fees; in the present case the ISA set a limit of 30 days for payment. Since in accordance with Rule 40.2(c) PCT the reasoned statement must accompany the payment it follows that it must also be received within 30 days. No provision is made for substantiation of the protest at a later date. Thus, any later statement does not form part of the protest and cannot be taken into account. This is consistent with the established case-law of the boards of appeal which also denies to the ISA the right to amplify

inadequate or incomplete reasoning, see for example W 4/93 (OJ EPO 1994, 939) concerning the analogous position of an International Preliminary Examining Authority (IPEA) and W 11/93 (not published).

8. The Board accordingly concludes that the protest as filed on 4 November 1999 is not justified.

9. The appellant has in the submission of 28 March 2000 requested oral proceedings if the protest is not considered to be entirely justified. As noted in W 4/93, discussed at point 7 above, the PCT makes no provision for oral proceedings. The Boards of Appeal act to decide on a protest in accordance with the special provision of Article 154(3) EPC and not by virtue of Article 106 EPC; Article 116 EPC does not therefore apply, so that there is no provision either under the PCT or EPC which would permit oral proceedings to be held.

Order

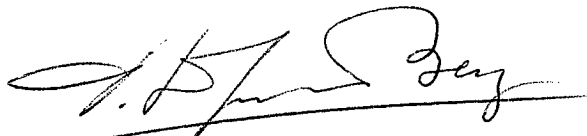
For these reasons it is decided that:

The protest under Rule 40.2(c) PCT is dismissed.

The Registrar:


M. Kiehl

The Chairman:


P. K. J. van den Berg