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**D E C I S I O N**  
**of 7 April 2005**

**Case Number:** W 0024/04  
**Application Number:** PCT/EP03/09974  
**Publication Number:** -  
**IPC:** H04B 1/707  
**Language of the proceedings:** EN

**Title of invention:**  
Advanced Rake Delay Control

**Applicant:**  
Telefonaktiebolaget LM Ericsson (publ)  
SE-12625 Stockholm  
Sweden

**Headword:**  
Advanced Rake Delay Control/ERICSSON

**Relevant legal provisions:**  
PCT Art. 34(3)(a)  
PCT R. 68.2, 68.3

**Keyword:**  
"Protest without reasoned statement (inadmissible)"

**Decisions cited:**  
W 0004/93, W 0006/88

**Catchword:**  
In deciding on a protest the review panel of the IPEA and the competent Board are restricted to reviewing the protest on the merits of the reasons as brought forward by the IPEA with the invitation to restrict the claims or pay additional fees. This implies equally that these instances must base their decision on the claims as filed and not on modified claims which were not subject to the invitation to restrict the claims or pay additional fees.



Case Number: W 0024/04

International Application No. PCT/EP03/09974

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.3  
of 7 April 2005

**Applicant:** Telefonaktiebolaget LM Ericsson (publ)  
SE-12625 Stockholm (SE)

**Representative:** Onslage, Anders  
Ericsson Mobile Platforms AG  
IPR Department  
SE-22183 Lund (SE)

**Subject of this decision:** Protest according to Rule 68.3(c) of the Patent  
Cooperation Treaty made by the applicants  
against the invitation (payment of additional  
fees) of the European Patent Office  
(International Preliminary Examination  
Authority) dated 19 May 2004.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** A. J. Madenach  
C. Holtz

## Summary of Facts and Submissions

- I. On 9 September 2003 the applicant filed the international patent application PCT/EP03/09974. The international search report by the EPO as international search authority (ISA) was issued in accordance with Rule 44.1 PCT on 8 December 2003. A demand for an international preliminary examination under Article 31 PCT was filed with the EPO as international preliminary examination authority (IPEA) on 15 April 2004.
- II. On 19 May 2004 the IPEA issued a reasoned communication under Rule 68.2 PCT informing the applicant that it considered that the international application did not comply with the requirements of unity of invention (Rule 13.1, 13.2 and 13.3 PCT) and invited the applicant to restrict the claims or to pay additional fees.

In this communication, the IPEA cited

D1: WO 02/29994 A

and stated that independent claims 1 and 10 lacked novelty in view of the disclosure of D1. The IPEA furthermore considered that the international application comprised the following five groups of inventions, namely:

Group 1: claims 2, 12: maintaining a minimum spacing between the selected multipath components;  
Group 2: claims 3, 4, 12, 13: a path management stage to determine whether a multipath component has moved;  
Group 3: claims 5, 6, 14, 15: a finger selection stage;

Group 4: claims 7, 8, 16, 17: controlling of search or tuning parameters by a path searcher or tuning placement and scheduler function;

Group 5: claims 9, 18: implementation of a RAKE receiver in a mobile radio terminal.

Claims 1 and 10 were considered to be included in group 1 but also to be part of every group.

The invention group 1 was considered to be the main invention.

This communication also stated that independent claim 19 comprised a combination of preceding claims and that the subject-matter of claims 19-24 was therefore not considered as regards compliance with the requirements of unity.

III. In reply to the communication under Rule 68.2 PCT, the applicant submitted on 14 June 2004 amended claims 1-10 together with arguments as to novelty, inventive step, and the unity of the independent claims. A debiting mandate was given for four additional examination fees, which were stated as being paid under protest. A debiting mandate was also given for a protest fee. Claims 19-24 were cancelled.

IV. A review panel of the IPEA concluded in their review of the protest under Rule 68.3(e) of 10 August 2004 that the reasoning in the IPEA's communication was well founded.

V. Independent claim 1 in the form as originally submitted reads as follows:

"A system of controlling multipath delays in a RAKE receiver, comprising:

    a path searcher configured to search a radio channel for multipath component positions and to provide a low resolution estimate of the multipath component positions;

    a path tuning stage configured to search the channel based on the low resolution estimate of multipath component positions and to provide a high resolution estimate of the multipath component positions;

    a path tracking stage configured to track existing multipath component positions provided by the path tuning stage in a manner such that the existing multipath component positions are known even after they have changed; and

    a path selection stage configured to merge the existing multipath component positions with new multipath component positions provided by the path tuning stage, including selecting one or more multipath components from the existing multipath component positions and the new multipath component positions based on at least one predetermined criteria."

Claim 10 is a corresponding method claim.

With the amendment of 14 June 2004, claim 1 was essentially modified in that it is now directed to a RAKE receiver and in that the path selection stage is configured to merge the tracked existing multipath

component positions supplied by the path tracking stage; claim 10 was amended correspondingly.

### **Reasons for the decision**

1. The present protest relates to an invitation by the IPEA under Rule 68.2 PCT to restrict the claims or to pay additional fees.
  - 1.1 The invitation is based on the IPEA's objection of lack of unity of invention (Rule 13.1 PCT) arising as a result of an objection that the subject-matter of original claims 1 and 10 lacked novelty with respect to the disclosure of D1. It was argued that there was no technical relationship involving one or more of the same or corresponding technical features in the sense of Rule 13.2 PCT between the subject-matter of the groups of claims set out at point II above. The lack of unity of invention is thus a posteriori, i.e. based on the results of the international search report.
  - 1.2 According to Article 155(3) EPC and Rule 105(3) EPC, the Boards of Appeal are responsible for deciding on a protest made by an applicant against additional fees charged by the European Patent Office under the provisions of Article 34(3)(a) of the PCT.
2. Whereas a finding of lack of unity by the ISA is governed by Rule 40 PCT, Rule 68.2 PCT requires the IPEA to invite the applicant either to restrict the claims or to pay additional fees; the IPEA is moreover required to specify at least one possibility of

restriction which, in the opinion of the IPEA, would be in compliance with the applicable requirement.

The IPEA in their communication of 19 May 2004 indicated under point 4 that they considered the invention group 1 to be the main invention. The board considers this indication to satisfy the requirement of specifying one possibility of restriction as required by Rule 68.2 PCT.

3. Together with the protest of 14 June 2004 the applicant submitted modified claims 1-10. The modified claims do not correspond to the invention group 1 suggested by the IPEA since the feature of the maintenance of a minimum spacing between the selected multipath components is not present in the independent claims.

According to established case law, see e.g. W 04/93, not published in the OJ EPO, point 2.1 of the reasons, Rule 68.3(c) PCT as well as Rule 68.3(e) PCT imply that the review panel of the IPEA and the competent Board should only review the justification of the invitation to restrict the claims or to pay additional fees. In deciding on a protest they are restricted to reviewing the protest on the merits of the reasons as brought forward by the IPEA with the invitation to restrict the claims or pay additional fees and may not introduce further reasons and facts (see W 04/93, point 2.2 of the reasons). This implies equally that these instances must base their decisions on the claims as filed and not on modified claims which were not subject to the invitation to restrict the claims or pay additional fees.

Thus, if the protest is accompanied by modified claims, these claims will be disregarded for the purpose of the review of the protest. They will, however, be considered for the subsequent PCT procedure before the IPEA, in particular for a possible written opinion and an eventual international preliminary examination report.

4. The conclusions drawn by the review panel of the IPEA in their review of 10 August 2004 are in line with the above reasoning, the modified claims having been disregarded.
5. According to Rule 68.3(c) payment of the protest fee is to be 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 letter of protest of 14 June 2004, the applicant referred to amended claims 1 and 10 and stated that the amended claims possessed novelty and inventive step over D1 and that, as a consequence, claims 2-9 and 11-18 related to a single inventive concept as defined by amended independent claims 1 and 10. In particular, the subject-matter of claims 1 and 10 was, according to the applicant, rendered novel and inventive over the disclosure of D1 by the introduction into claim 1 of the feature of "merging the tracked existing multipath component positions supplied by the path tracking stage with new multipath component positions provided by the path tuning stage" and of an analogous feature into claim 10. No argument was advanced as to why the features of the original claims 1 and 10 were novel



over the disclosure of D1. On the contrary, the fact that the applicant's arguments were exclusively based on the newly introduced feature suggests that the applicant has tacitly accepted that original claims 1 and 10 lacked novelty with respect to the teaching of D1.

Lack of novelty of the subject-matter of the originally filed claims 1 and 10 with respect to the disclosure of D1 was, however, the crucial finding of the IPEA on which their objection of lack of unity of invention was based.

Since the applicant's statement deals only with unity of invention of the amended claims and does not allow any conclusions to be drawn as to the novelty of the originally filed claims 1 and 10 and thus the unity of invention of the originally filed claims as a whole, it does not address the point at issue and is therefore not reasoned in the sense of Rule 68.3(c).

6. Since the protest does not contain a reasoned statement as required by Rule 68.3(c) PCT, it is, in accordance with established case law (see e.g. W 06/88, not published in the OJ EPO) considered inadmissible.

**Order**

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

The protest is rejected as inadmissible.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland