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D E C I S I O N
of 11 February 1998

Case Number: W 0002/96 - 3.5.1

Application Number: PCT/GB 95/01098

Publication Number: -

IPC: H04B 3/48, H04M 3/30

Language of the proceedings: EN

Title of invention:
Network Termination Equipment

Applicant:
British Telecommunications Plc et al

Opponent:
-

Headword:
-

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

Keyword:
"Lack of unity 'a posteriori' (no)"

Decisions cited:
G 0001/89, G 0002/89

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: W 0002/96 - 3.5.1
International Application No. PCT/GB 95/01098

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 11 February 1998

Applicant: British Telecommunications Plc.
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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 11 January 1995.

Composition of the Board:

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

Summary of Facts and Submissions

- I. The international patent application was searched by the European Patent Office, acting in its capacity as International Search Authority (ISA).
- II. On 25 August 1995 the ISA invited the applicant to pay five additional search fees, on the ground that a partial international search had revealed that the common technical features of the claims, namely the features of claim 1, were known from the prior art. Reference was made to GB-A-2 255 694 (D1) and EP-A-519 795 (D2). It was held that the claims were not so linked as to form a single general inventive concept.
- III. The applicant paid the additional fees under protest and in a reasoned statement dated 15 September 1995 argued that the ISA was incorrect in alleging that the cited documents disclosed all the features of claim 1. Since all the remaining claims were dependent on claim 1, which did not lack novelty or inventive step, there was no basis for the *a posteriori* allegation of lack of unity by the ISA.
- VI. The protest was reviewed in accordance with Rule 40.2(e) PCT by a review panel of the European Patent Office, which on 11 January 1996 held that the invitation to pay additional search fees was completely justified and invited the applicant to pay a protest fee for the examination of the protest by a "special instance" in accordance with Rule 40.2(c) PCT.
- V. In its communication the review panel noted that although D1 did not explicitly disclose "operative means" for transmitting signals to the head end (ie to the switch) the point of the "operative means" was, in

the applicant's words, to provide some intelligence within the network termination equipment to allow control of its operation and associated signalling. The application did not explicitly describe the provision of some intelligence within the network termination equipment and claim 1 should not therefore be construed as being restricted to "operative means" having this feature. D1 referred at pages 4 and 8 to various unspecified line termination components and to additional components which might be needed to adapt the line termination unit for a specific service. The subject-matter of claim 1, to which all the remaining claims were directly or indirectly dependent, was accordingly known from D1; claim 1 did not therefore provide the special technical features referred to in Rule 13.2 PCT as being necessary for a technical relationship between the remaining claims and there was therefore a lack of unity of invention.

- VI. The review panel also indicated that it had considered whether the number of additional search fees was justified and concluded that it was.

- VII. The applicant duly paid the protest fee and maintained his argument that the subject-matter of claim 1 was novel and inventive having regard to the disclosure of D1. This document was said to provide various line termination components such as to allow physical connection of different equipment to the terminal; in the context of Figure 1 of D1 these were either simple passive components for performing functions such as impedance matching and lightning surge protection, whilst in the page 8 embodiment they were passive electro-optic converters. There was no suggestion in D1 that any of these components performed functions which would justify the terminology of the "operative means" feature of claim 1.

VIII. Claim 1 reads as follows:

"A network termination equipment having a first connection point for making connection with the head end of a telecommunications network; at least one second connection point for making connection with a telecommunications apparatus; and operative means for performing terminal functions, wherein the operative means includes means for transmitting signals to the head end."

Reasons for the Decision

1. The boards of appeal are, in the terminology of Rule 40.2(c) PCT, the "special instance" responsible for deciding on an admissible protest made by an applicant where the European Patent Office acting as ISA has charged an additional fee because of non-compliance with unity of invention.

2. The present application is concerned with adapting the standard telecommunications network termination for use with new services, such that any necessary upgrade can be undertaken by the customer himself. From the preferred embodiments it appears that this objective is met by providing a termination box which is adapted to receive plug-in units. For example, in the Figure 1 embodiment, the termination box can be reconfigured by replacement of a blanking plug 31 by a service module 30 for a new service such as ISDN (cf. Figure 3). Additional sockets are provided for telemetry services and a plug-in smart card reader 40.

3. Claim 1, however, does not clearly relate to features which concern the above-mentioned problem and its solution. Indeed, the only substantive feature of the claim is the provision of "operative means for performing terminal functions, wherein the operative means includes means for transmitting signals to the head end". It is therefore necessary to consider how this somewhat obscure feature should be interpreted.

4. The expression "operative means" is not used in the specific description. Claim 2 is directed to "configuration means for configuring the operative means to allow different terminal functions to be made available"; claim 3 specifies that the "configuration means" are in fact "additional connection points for connecting further telecommunication apparatus". However, the expression "configuration means" is not used in the specific description either. Although reference is made to configuring the network termination and to specific configurations - see e.g. page 5 line 26, page 7 line 14 and page 15 line 16 - this is consistently in relation to the mechanical adaptation of the electrical connectors. The Board accordingly takes the view that the reference in claim 1 to "operative means for performing terminal functions" must on balance refer to a terminal connection which is mechanically reconfigurable to permit different terminal functions to be realised, as disclosed in connection with the embodiments.

5. The operative means also includes "means for transmitting signals to the head end". Although it could be argued that any network termination must include such means in order to permit duplex operation, the Board takes this expression to require some device additional to the normally present network connection. It is noted that in each of the described embodiments a signalling device is in fact present. In Figure 1 this

is the diagnostic chip 2. Although in the ISDN configuration shown in Figure 3 the chip 2 is no longer in series with the line, it is nevertheless still present, with two terminals across the line; the Board cannot infer from the description that this necessarily means that it is no longer active, i.e. incapable of "transmitting signals to the head end". In each of the remaining embodiments some means is provided which sends a signal to the "head end", e.g. providing a characteristic terminal signature or restricting access to authorised users.

6. The expression "means for transmitting signals to the head end" must therefore be interpreted as requiring special, additional, means which include as a function "transmitting signals to the head end".

7. The ISA originally relied on D1 and D2, whereas the review panel referred only to D1. It is common ground that D1 discloses a network termination equipment having first and second connection points for making connection with the switch (the "head end") and local apparatus respectively. It also discloses "operative means for performing terminal functions" in that it provides a mechanically reconfigurable terminal connection in the same manner as in the application. However, the Board cannot identify any "means for transmitting signals to the head end" in the sense discussed at point 6 above. Although the review panel asserted that the components 106 and 125 in the Figure 1 embodiment of D1 performed this function, the description is silent as to the function of these components; no evidence has been adduced in support of this assertion.

8. The Board accordingly concludes that the subject-matter of claim 1 is novel having regard to the disclosure of D1.
9. Turning to D2, this document does not concern network termination equipment; it relates to a modem which can be reconfigured for use with different national telephone systems. None of the features of claim 1 can be identified in D2.
10. The Board has also considered whether there is sufficient reasoning in either the invitation to pay additional fees or the review to justify a conclusion that the subject-matter of claim 1 lacks an inventive step having regard to the disclosures of D1 or D2. It has concluded that this is not the case.
11. It is observed that the present decision is in accordance with the principle of G 1/89 and 2/89 (OJ EPO 1991, 155 and 166), in accordance with which the charging of fees should be made only in clear cases.
12. The Board has not considered the prior art cited in the full international search report, this being a matter for the International Preliminary Examination Authority.

Order

For these reasons it is decided that:

Reimbursement of the additional search fees is ordered.

The Registrar:

The Chairman:

N. Maslin

P. K. J. van den Berg