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**Datasheet for the decision  
of 8 September 2010**

**Case Number:** T 0105/08 - 3.5.05

**Application Number:** 01122369.0

**Publication Number:** 1198107

**IPC:** H04L 29/08

**Language of the proceedings:** EN

**Title of invention:**

Method for transmitting data from RLC layer in radio communication system

**Applicant:**

LG Electronics, Inc.

**Headword:**

Two different modes for transmitting discard information/LG

**Relevant legal provisions:**

EPC Art. 54(2), 88(3), 123(2)

EPC R. 53(3)

RPBA Art. 12(2)(4), 13(1)(3)

**Relevant legal provisions (EPC 1973):**

EPC Art. 106, 107, 108, 111(1), 114(1)

**Keyword:**

"Validity of the claimed priorities - no (after amendment)"

"Introduction on the board's own motion of prior art published in the priority interval"

"Remittal to the department of first instance for further prosecution"

**Decisions cited:**

J 0010/07

**Catchword:**

-



Case Number: T 0105/08 - 3.5.05

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.05  
of 8 September 2010

**Appellant:**

LG Electronics, Inc.  
20, Yoido-Dong, Youngdungpo-gu  
Seoul (KR)

**Representative:**

TER MEER - STEINMEISTER & PARTNER GbR  
Patentanwälte  
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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 26 June 2007  
refusing European patent application  
No. 01122369.0 pursuant to Article 97(1) EPC  
1973.

**Composition of the Board:**

**Chairman:** A. Ritzka  
**Members:** M. Höhn  
G. Weiss

## Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dispatched 26 June 2007, refusing European patent application No. 01122369.0, which claims priority of KR 2000059017 of 7 October 2000 and of KR 2001027269 of 18 May 2001, for lack of inventive step (Article 52(1) EPC and Article 56 EPC 1973) having regard to the disclosure of prior art publications:

D1: ETSI: "Universal Mobile Telecommunication System (UMTS); RLC Protocol Specification (3G TS 25.322 version 3.4.0 Release 1999)" XX, September 2000 (2000-09), pages 1-5 and 18-39; and

D2: ETSI: "Universal Mobile Telecommunication System (UMTS); RLC Protocol Specification (3G TS 25.322 version 3.1.2 Release 1999)" XX, XX, 1999, pages 1-48.

II. The notice of appeal was filed with letter received on 30 August 2007. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 5 November 2007. It was requested that the appealed decision be set aside and that a patent be granted on the basis of claims 1 to 38 as filed on 2 May 2007 on which the appealed decision was based (main request), or on the basis of amended claims 1 and 25 submitted with the statement setting out the grounds of appeal and claims 2 to 24 and 26 to 32 as filed on 2 May 2007 (auxiliary request). Oral proceedings were requested on an auxiliary basis.

III. A summons to oral proceedings to be held on 8 September 2010 was issued on 11 May 2010. In an annex accompanying the summons the board expressed the preliminary opinion that the subject-matter of the independent claims of the main request and of the auxiliary request did not fulfil the requirements of Article 56 EPC 1973 having regard to a combination of the disclosures of D2 and D1 with D2 being regarded as the closest prior art. The board gave its reasons for the objection and stated that the appellant's arguments were not convincing. In particular, the board did not see any unexpected combinative effect achieved by the subject-matter of claim 1, going beyond the sum of the individual technical effects of the solutions according to D1 and D2. Such a combination of D1 and D2 appeared to be obvious and did not appear to achieve a synergistic effect. Such an implementation could be regarded as a routine measure of the skilled person when dealing with two known solutions, each with its special advantages and disadvantages. Instead of combining the two solutions of sending discard information, either one or the other was used. In addition, publication

D3: ETSI: "Universal Mobile Telecommunication System (UMTS); RLC Protocol Specification (3G TS 25.322 version 3.7.0 Release 1999)" XX, June 2001 (2001-06), pages 1-59,

which was referred to by the appellant in the statement setting out the grounds of appeal, was introduced into the proceedings by the board on its own motion according to Article 114(1) EPC 1973, since D3 appeared to anticipate the subject-matter of independent claim 1

of the main and the auxiliary request. Reference was made to section 11.6. "SDU discard with explicit signalling procedure", in particular to section 11.6.2.2 on page 53 of D3, which explicitly disclosed the two discard information transmitting schemes sending either information about each discarded SDU or about the last SDU depending on whether 'Send MRW' was configured or not. Since D3 had a publication date after the two claimed priorities and before the filing date of the present application (i.e. 19 September 2001), the validity of the priority claim was relevant to the determination of the patentability of the claimed subject-matter having regard to D3. Since the priority documents which had been submitted to the EPO were in the Korean language and no translation of these documents into one of the official languages of the EPO had been provided so far, the validity of the priority could not be examined. In particular, it would have to be examined with respect to both requests whether a combination of all the features of claim 1 was disclosed in at least one of the two priority applications. If this combination was not disclosed in one of them, the claimed subject-matter would only have the filing date as the earliest effective priority date.

The appellant was therefore invited to file such translations of the two priority applications according to Rule 53(3) EPC within the time limit specified with the board's communication.

IV. With a letter dated 6 August 2010 the appellant submitted translations of the two priority applications into the English language. Furthermore, the appellant submitted three sets of claims 1 to 38 according to a

new first auxiliary request replacing the previous auxiliary request, and according to additional second and third auxiliary requests together with arguments that the claims according the main request and the auxiliary requests involved an inventive step and met the requirements of Article 56 EPC 1973.

- V. At oral proceedings, held on 8 September 2010, the appellant withdrew all the requests on file and submitted a set of claims 1 to 38 according to a new main request.
- VI. Independent claim 1 according to the main request reads as follows:

"1. A method of transmitting data from an RLC layer operating in an acknowledged mode in a radio communication system, comprising the steps of:

- storing service data units SDUs received from an upper layer in a transmission buffer;
- transforming the service data units from the upper layer into protocol data units PDUs to be transmitted to a receiving side;
- discarding at least one service data unit; and
- transmitting discard information of the discarded at least one service data unit to the receiving side;

characterized by

- checking whether an MRW transmission set indicator is configured; and
- if the MRW transmission set indicator is configured, transmitting entire discard information about each discarded service data unit; or
- if the MRW transmission set indicator is not configured, transmitting discard information about the

last service data unit having been tried to transmit among the discarded at least one service data unit, using the sequence number of the PDU corresponding to the SDU having never tried to be transmitted."

Independent claim 14 is directed to a corresponding method of receiving, independent claims 25 and 32 to a corresponding radio transmitter and radio receiver.

VII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 38 filed at the oral proceedings as main request. On an auxiliary basis, it was requested that the case be remitted to the department of first instance for further prosecution.

VIII. After deliberation the board announced its decision.

### **Reasons for the Decision**

1. Admissibility of the appeal

The appeal complies with the provisions of Articles 106 to 108 EPC 1973, which are applicable according to J 0010/07, point 1 (see Facts and Submissions, point II above). Therefore the appeal is admissible.

2. Admissibility of the appellant's request submitted during oral proceedings

Claims 1, 14, 25 and 32 of this request introduce aspects from the description of the present application which have not been claimed before. This was done for

the first time during oral proceedings before the board and therefore at a late stage of the appeal proceedings. According to Article 12(2) RPBA the statement setting out the grounds of appeal shall contain a party's complete case. According to Articles 12(4) and 13(1) RPBA the board therefore has a discretion not to admit such amendments. According to Article 13(3) RPBA amendments sought to be made after oral proceedings have been arranged (as is the case here) shall not be admitted if they raise issues which the board cannot reasonably be expected to deal with without adjournment of the oral proceedings. However, since in the present case the issue of the validity of the claimed priority was raised in the annex accompanying the summons for oral proceedings issued on 11 May 2010 for the first time and the amendment and corresponding arguments supporting the patentability of the amended claims were submitted by the appellant in reaction to the discussion of the validity of the claimed priority at the oral proceedings, the request was admitted into the proceedings according to Article 13(1) RPBA.

3. Amendments (Article 123(2) EPC)

The amendments made to the independent claims 1, 14, 25 and 32 are originally disclosed in figure 9 and on page 34, lines 16 to 19 of the application as filed. The requirements of Article 123(2) EPC are therefore fulfilled.

4. Validity of the priority

4.1 The translations of the two priority applications according to Rule 53(3) EPC were received within the



time limit specified with the annex accompanying the summons for oral proceedings issued on 11 May 2010.

- 4.2 According to Article 88(3) EPC if one or more priorities are claimed in respect of a European patent application, the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed.

With regard to the question of whether a combination of all the features of claim 1 is disclosed in at least one of the two priority applications, the board is of the opinion that the second claimed priority application KR 2001027269 of 18 May 2001 does not provide for a disclosure corresponding to figure 9 and to page 34, lines 16 to 19 of the application as filed referred to by the appellant as an antecedent basis regarding the requirements of Article 123(2) EPC (see point 3 above). Neither the passage cited by the appellant on page 21, line 23 onwards of the translation of this priority application, nor any other passage or drawing provide for a disclosure of the feature of using the sequence number of the PDU corresponding to the SDU having never tried to be transmitted according to claim 1. This was finally admitted by the appellant's representative at the oral proceedings.

With respect to the earlier priority application KR 2000059017 of 7 October 2000, the appellant did not provide the board with an antecedent basis for the claimed subject-matter in this document. In the board's judgement, this document, *inter alia*, fails to disclose

a combination of the two discard information transmitting schemes according to claim 1, sending either entire discard information about each discarded SDU or about the last service data unit having been tried to transmit among the discarded at least one service data unit, depending on whether a 'Send MRW' indicator is configured or not.

Hence, a combination of all the features of claim 1 is not disclosed in one of the two priority applications. The same is the case for the other independent claims corresponding to claim 1 and also for all the dependent claims, since they refer to at least one of those independent claims.

4.3 According to the requirements of Article 88(3) EPC the claimed subject-matter therefore can only take advantage of the filing date of the present application as the earliest effective priority date, i.e. 19 September 2001.

5. D3 has a publication date after the two claimed priorities (i.e. KR 2000059017 of 7 October 2000 and KR 2001027269 of 18 May 2001) and before the filing date of the present application (i.e. 19 September 2001) and is therefore pertinent prior art according to Article 54(2) EPC with respect to claims 1 to 38.

6. Remittal to the department of first instance

According to Article 111(1) EPC 1973 the board may exercise any power within the competence of the examining division (which was responsible for the decision appealed) or remit the case to that department

for further prosecution. It is thus at the board's discretion whether it examines and decides the case or whether it remits the case to the first instance.

Prior art publications D1 to D3 are different versions of the same standard ETSI 3G TS 25.322. As can be seen from page 58 of D3, many further versions of the same standard (e.g. V3.4.0, V3.5.0 and 3.6.0) were published in the period of time between the oldest claimed priority and the filing date of the present application, i.e. between 7 October 2000 and 19 September 2001. These publications, which are not on file, are pertinent prior art and would have to be considered for the assessment of novelty and inventive step of the claimed subject-matter. Moreover, further search might be required with respect to the present priority date, which has not been an issue before in the first instance proceedings.

Under these circumstances, the board makes use of its discretion and remits the case to the first instance for further prosecution according to Article 111(1) EPC.

**Order**

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

1. The decision under appeal is set aside.
  
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 38 filed at the oral proceedings as main request.

The Registrar:

The Chair:

K. Götz

A. Ritzka