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**Datasheet for the decision
of 18 February 2021**

Case Number: T 1127/16 - 3.5.03

Application Number: 06077126.8

Publication Number: 1798872

IPC: H04B7/185

Language of the proceedings: EN

Title of invention:

Multi-network aircraft communication systems and methods

Patent Proprietor:

The Boeing Company

Opponent:

Airbus SAS

Headword:

Aircraft communication method/BOEING

Relevant legal provisions:

EPC Art. 112(1)(a), 123(2), 123(3)

Keyword:

Added subject-matter - main, 1st and 4th to 13th auxiliary requests (yes): unallowable limitation
Extension of protection conferred - 2nd and 3rd auxiliary requests (yes): "inescapable trap"
Referral to the Enlarged Board - inescapable trap (no): not required and no divergence

Decisions cited:

G 0001/93, G 0003/98, J 0016/90, T 0371/88, T 0190/99,
T 0553/99, T 1018/02, T 1279/04, T 1404/05, T 1202/07,
T 1779/09, T 0197/10, T 0310/13, T 0131/15

Catchword:

(1) With respect to the assessment of compliance with Article 123(2) EPC, the fact that a claim of a patent is to be construed by a mind willing to understand and not a mind desirous of misunderstanding does not mean that the description and the drawings have automatically to be consulted when an "ambiguous" feature (i.e. a feature which at least theoretically allows more than one interpretation) occurs in the claim, or where the claim as a whole includes one or more inconsistencies, to resolve that ambiguity or inconsistency. Rather, the claim should essentially be read and interpreted on its own merits (see points 2.6.1 and 2.6.2 of the Reasons).

(2) As to the issue of an "inescapable trap", see point 4 of the Reasons.



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Case Number: T 1127/16 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 18 February 2021

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 2 March 2016
revoking European patent No. 1798872 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: T. Snell
J. Geschwind

Summary of Facts and Submissions

- I. This case concerns the appeal of the patent proprietor (henceforth, appellant) against the decision of the opposition division revoking the patent.
- II. The appellant requests that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of either the **main request** or one of **thirteen auxiliary requests**, all as filed with the submission dated 29 November 2016.

The appellant additionally requests that a question be referred to the Enlarged Board of Appeal (see point 8 of the reasons below).

- III. The opponent (henceforth, respondent) requests that the appeal be dismissed.
- IV. Oral proceedings before the board were held on 18 February 2021 by videoconference, to which both parties consented.

The chair announced the board's decision at the end of the oral proceedings.

- V. Claim 1 of the **main request** reads as follows (feature labelling by the board):

"A method for handling aircraft communications, comprising:

- (a) providing a plurality of respective broadcast communication networks configured to send and receive data to and from an aircraft according to a

plurality of respective protocols each network having a different protocol related to that respective network;

- (b) providing a ground-based computer configured to communicate over the plurality of broadcast networks;
- (c) providing at least one onboard transmission device configured to communicate over the plurality of broadcast networks and an onboard computer hosting a plurality of applications and an onboard communications module in data communication with the plurality of applications;
- (d) generating messages each by an application, wherein each message has a priority associated therewith,
- (e) the method further comprising storing the messages if the preferred network is unavailable and the priority is below a threshold;
- (f) transferring each message to the communications module;
- (g) evaluating a preference to determine a preferred network of the plurality of transmission networks, wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference and identifying the highest in preference of the plurality of broadcast networks in the preference list that is available;

- (h) storing each message in one of a plurality of queues each corresponding to one of the broadcast networks;
- (i) monitoring the availability of the broadcast networks;
- (j) re-evaluating the preferences of the messages according to changes in availability of the broadcast networks to determine a current preferred network corresponding to a highest in preference of the plurality of broadcast networks in the preference lists corresponding to the messages; and
- (k) moving each of the messages to the queue of the plurality of queues corresponding to the current preferred network of the message;
- (l) preparing the messages for transmittal according to the protocol of the preferred network; and
- (m) transmitting the messages over the preferred network."

VI. Claim 1 of the **1st auxiliary request** is the same as claim 1 of the main request except that a comma has been inserted before the wording "and identifying" into feature (g), which reads (board's underlining):

"evaluating a preference to determine a preferred network of the plurality of transmission networks, wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference, and identifying the highest in preference of the plurality of broadcast networks in the preference list that is available".

VII. Claim 1 of the **2nd auxiliary request** is the same as claim 1 of the main request except that feature (g) reads (board's underlining):

"evaluating a preference to determine a preferred network of the plurality of transmission networks, wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference, and wherein evaluating a preference to determine a preferred network comprises identifying the highest in preference of the plurality of broadcast networks in the preference list that is available".

VIII. Claim 1 of the **3rd auxiliary request** is the same as claim 1 of the main request except that feature (g) reads (board's underlining):

"evaluating a preference to determine a preferred network of the plurality of transmission networks, wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference including a highest and lowest in preference of the plurality of broadcast networks and wherein evaluating a preference to determine a preferred network comprises identifying the highest in preference of the plurality of broadcast networks in the preference list that is available".

IX. Claim 1 of the **4th auxiliary request** is the same as claim 1 of the main request except that feature (g) reads (board's underlining):

"evaluating a preference to determine a preferred network of the plurality of transmission networks,

wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference and identifying the highest in preference of the plurality of broadcast networks in the preference list that is found available".

- X. Claim 1 of the **5th auxiliary request** is the same as claim 1 of the main request except that feature (g) reads (board's underlining):

"evaluating a preference to determine a preferred network of the plurality of transmission networks, wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference and identifying the highest in preference of the plurality of broadcast networks in the preference list that is available, and wherein evaluating a preference to determine a preferred network comprises identifying the highest in preference of the plurality of broadcast networks in the preference list that is available".

- XI. Claim 1 of the **6th auxiliary request** is the same as claim 1 of the 5th auxiliary request except that, in feature (g), the word "found" is inserted before the first occurrence of the word "available".

- XII. Claim 1 of the **7th auxiliary request** is the same as claim 1 of the 5th auxiliary request except that the term "the preferred network" in feature (e) is amended to "the first preferred network", and in step (g), the first occurrence of the term "a preferred network" is amended to "a first preferred network" and the second occurrence of the term "a preferred network" is amended to "the first preferred network".

XIII. In view of the lack of relevance to the decision of the amendments made to claim 1 respectively of the **8th to 13th auxiliary requests**, their wording is not reproduced.

Reasons for the Decision

1. Technical context

The opposed patent concerns a method for handling aircraft communications. In essence, communication with the ground is possible via a plurality of broadcast networks arranged in an order of preference stored in a preference list. Before transmitting a message, an evaluation is made of the highest in preference of the broadcast networks which is available.

2. Main request - claim 1 - Article 123(2) EPC

2.1 The question at issue is essentially whether **feature (g)** of present claim 1 infringes Article 123(2) EPC.

2.2 Feature (g) contains three sub-features:

- (g1) "evaluating a preference to determine a preferred network of the plurality of transmission networks,"
- (g2) "wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference"
- (g3) "and identifying the highest in preference of the plurality of broadcast networks in the preference list that is available".

Here it is to be noted that features (g1) and (g2) are separated by a comma, whereas features (g2) and (g3) are included in the same clause.

2.3 The reasoning of the opposition division set out in the impugned decision is essentially that features (g2) and (g3) are to be read together, which means that the list not only comprises information "identifying" a selection of the broadcast networks in order of preference but also information "identifying" the highest in preference of the plurality of broadcast networks in the preference list that is available. However, no such feature was disclosed in the application as filed. Furthermore, the claim including this feature made technical sense so that there was no requirement to resolve any ambiguity by consulting the description and drawings of the application as filed. The board agrees with this reasoning.

2.4 The appellant's counter-arguments presented in the statement of grounds of appeal and at the oral proceedings before the board are based on two separate lines of argumentation:

(i) In the case of ambiguity, it is necessary to interpret the claims in the light of the description and drawings. Ambiguity is present in claim 1 of the main request. Firstly, feature (g) can be read linguistically in two ways, namely interpreting feature (g3) as a step carried out with the evaluating step (g1) ("evaluating ... and identifying the highest in preference of the plurality of broadcast networks in the preference list that is available"), or alternatively associating feature (g3) with the preference list defined in feature (g2) ("a preference

list ... identifying the highest in preference of the plurality of broadcast networks in the preference list that is available"). Secondly, when reading the claim as a whole, the skilled person would notice several instances of a lack of clarity and/or consistency. This concerns in particular inconsistencies between the evaluating and re-evaluating steps (g) and (j), and between the storing step (e) and steps (g) and (j).

The ambiguity present in claim 1 would lead the skilled person, on the basis of the description and drawings, in particular paragraphs [0035] and [0040] and Fig. 6 of the application as filed (referring to the application as published), to conclude that the correct interpretation is that identifying the availability is part of the *evaluating step* and not part of the *list* itself.

(ii) As a second line of argumentation, the appellant argues that even if features (g2) and (g3) were read in association, i.e. in the sense that feature (g3) concerns information identified by the preference list, there is an implicit basis in the description for this subject-matter.

2.5 The board is not convinced by either of these lines of argumentation for the following reasons:

2.6 **Re (i):**

2.6.1 As to the interpretation of claim 1 as granted, the appellant argued that "[i]t is well established case law that the feature in a claim that is not unambiguous has to be interpreted in light of the description and the drawings" (cf. statement of grounds of appeal, section III.1), without providing any further evidence.

The board assumes in that regard that the appellant relies, for example, on decision **T 190/99**, according to which "the skilled person when considering a claim should rule out interpretations which are illogical or which do not make technical sense [and] should try, with synthetical propensity i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent (Article 69 EPC). The patent must be construed by a mind willing to understand not a mind desirous of misunderstanding" (see Reasons 2.4).

However, in the board's view, the fact that a claim of a patent is to be construed by a mind willing to understand and not a mind desirous of misunderstanding does not mean that the description and the drawings of the patent have automatically to be consulted as soon as an "ambiguous" feature (i.e. a feature which at least theoretically allows more than one interpretation) occurs in the claim, or where the claim as a whole includes one or more inconsistencies, to resolve that unambiguity or inconsistency. According to such a logic, an applicant (patent proprietor) could then arguably dispense with providing a clear and unambiguous formulation of claim features, e.g. during the grant proceedings, in order to be able to fall back on a more description-based interpretation at will during a subsequent opposition proceedings. This would however not be compliant with the main purpose of the provisions of Article 123(2) and (3) EPC, which is "to create a fair balance between the interests of applicants and patentees, on the one hand, and competitors and other third parties on the other" (cf.

G 1/93, Reasons 8).

2.6.2 The board follows the established case law that, when assessing compliance with Article 123(2) EPC, a claim should essentially be read and interpreted on its own merits (see e.g. **T 1279/04**, Reasons 3; **T 1404/05**, Reasons 3.6; **T 197/10**, Reasons 2.3). In particular, as stated in decision **T 1018/02** (cf. Reasons 3.8),

"... the description cannot be used to give a different meaning to a claim feature which in itself imparts a clear, credible technical teaching to the skilled reader. This also applies if the feature has not been initially disclosed in the form appearing in the claim. Otherwise third parties could not rely on what a claim actually states (cf. Article 69(1) EPC: The terms of the claims determine the extent of protection whereas the description is only used to interpret the claims) and Article 123(2) EPC would become meaningless in respect of amendments to the claims".

2.6.3 In the present case, in order to determine whether **feature (g)** in itself imparts a clear, credible technical teaching, it is necessary to examine whether this feature *as claimed* is in itself meaningful and plausible from a technical point of view, and if there is, *prima facie*, any inherent incompatibility with the remaining features of the claim (see e.g. **T 1202/07**, Reasons 2.5).

2.6.4 On a linguistic level, the use of the same verb "identifying" in features (g2) and (g3), and the fact that both verbs appear in a single clause of feature (g) without any separating comma, would clearly

lead a reader to associate the second "identifying" sub-clause with the preference list.

The appellant argues that English does not have clear rules for the use of commas. However, if feature (g3) were intended to be separated from feature (g2), a comma would indeed be necessary here in order to even suggest to the reader that each occurrence of the word "identifying" should be interpreted differently. It cannot however be expected that the skilled person reading a claim would speculate as to other possible meanings which might result from inserting commas at various places. This would place an undue burden on the reader of a claim.

- 2.6.5 On a technical level, the skilled person would also conclude that this interpretation is entirely clear, coherent, and consistent with the other features of claim 1.

For example, the following list would be embraced by the wording of feature (g):

Network A
Network B *
Network C
Network D

Here, networks A to D are listed in the order of preference, which is *static*. The asterisk "*" is supposed to indicate the network with the highest preference being available, which is *dynamic*. The evaluating step, consisting of consulting the preference list and identifying the position of the asterisk, would result in determining "Network B" as the preferred network in this example.

2.6.6 Re-evaluating step (j) is also fully consistent with the evaluating step in that, considering the board's example, the preference for a particular message is re-evaluated from the new preference list, e.g:

Network A *
Network B
Network C
Network D

The fact that the re-evaluation determines "a highest in preference of the plurality of broadcast networks in the preference lists [*sic*]" *that is available* can be regarded as implicit.

2.6.7 With respect to this example, the appellant contests the board's assessment that there is consistency between the evaluating and re-evaluating steps in view of the definite article being used for "the preference lists", meaning that the content of the list in those steps is unchanged, contrary to the board's example. Furthermore, the fact that "lists" appears here in the plural form, and that there is no mention of availability as part of the preference list in step (j) leads to further ambiguity. Finally, step (e) would make no sense under the board's interpretation, since there is no possibility in the board's example that a network could be unavailable. The chronological order is also wrong here. In the appellant's view, all these inconsistencies and unclarities must trigger interpretation by the description.

2.6.8 The board finds these arguments unconvincing. In accordance with case law (cf. T 190/99 above), a claim must be read with a mind desirous of understanding

rather than a mind willing to misunderstand. With a mind willing to understand, neither the inconsistent use of the term "list" and "lists" in steps (g) and (j), which could be interpreted simply as an error, nor the lack of any explicit mentioning of availability in the preference list in step (j) would prevent the skilled person from interpreting the claim in a technically meaningful way compatible with a preference list which identifies the highest preferred network which is available, e.g. as illustrated by the board's example. The same applies to the inconsistent chronological order of step (e), which in any case is unconnected with the interpretation of feature (g).

The board further does not agree that the use of the definite article for "lists" in step (j) means that the *information content* of the list must remain the same, i.e. that the list is entirely static, or that the board's example stands in contradiction to the presence of feature (e). With respect to the latter, since the preference list need have no asterisk against one of the preferred networks if none were available, the presence of the storing step of feature (e) still makes sense.

2.6.9 The board concludes that the correct interpretation of feature (g) is that feature (g3) belongs to feature (g2), leading to infringement of Article 123(2) EPC, since no such feature is disclosed in the application as filed (cf. e.g. claims 5 and 6 as filed, which do not associate features (g2) and (g3) either).

2.7 **Re (ii):**

2.7.1 The appellant presents an alternative line of argumentation in their submission dated 15 January 2021

(point II.2). Here, with respect to the board's example given above, the appellant argues that in the re-evaluation step, the highest in preference network is flagged by an asterisk, implying that previously a determination is carried out by checking the network, as for example disclosed in paragraph [0040] of the description. It follows that this determination is also carried out in the evaluating step. The conclusion of this is that the "step of re-evaluating is literally disclosed in the originally filed application documents". The appellant then goes on to state:

"Further, the original disclosure of paragraph [0035] explaining the determination of the highest preference being available and the disclosure of paragraph [0038] referring to Fig. 6 and the embodiment of claim 1 *would also imply the result of the determination in paragraph [0035] being somehow flagged, marked or else - in other words identified - within the preference list.*" (board's italics).

2.7.2 Whilst the board agrees that carrying out a determination of network availability as disclosed in paragraphs [0035], [0038], [0040] and Fig. 6 as filed is not incompatible with flagging an indication of network availability in the preference list, this is not the same as a *direct and unambiguous* disclosure thereof. For example, the availability information may simply be stored in a separate list. The appellant's line of argumentation is therefore unconvincing.

2.8 In conclusion, the fact that no identification of any availability information by the claimed "preference list" is derivable from the underlying application as a whole amounts to an unallowable limitation of the

original disclosure. The subject-matter of claim 1 of the main request therefore does not comply with Article 123(2) EPC.

3. 1st auxiliary request - claim 1 - Article 123(2) EPC

3.1 Claim 1 of the 1st auxiliary request differs from claim 1 of the main request in that a comma has been inserted between features (g2) and (g3).

3.2 However, despite the presence of the comma, the claim may - linguistically and technically - still be given the same meaning as claim 1 of the main request. The objection raised in respect of claim 1 of the main request therefore applies, *mutatis mutandis*, to claim 1 of the first auxiliary request.

3.3 Consequently, claim 1 of the 1st auxiliary request does not comply with Article 123(2) EPC either.

4. 2nd and 3rd auxiliary requests - claim 1 - Articles 123(2) and (3) EPC - "inescapable trap"

4.1 In claim 1 of the 2nd auxiliary request, feature (g) has been amended to read as follows:

"evaluating a preference to determine a preferred network of the plurality of transmission networks, wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference, and wherein evaluating a preference to determine a preferred network comprises identifying the highest in preference of the plurality of broadcast networks in the preference list that is available".

- 4.2 Hence, compared with claim 1 as granted, feature (g) (whose wording is the same as feature (g) of claim 1 of the main request) has been amended to associate feature (g3) with feature (g1), with the aim of overcoming the objection based on Article 123(2) EPC.
- 4.3 With respect to Article 123(3) EPC, the appellant argues that claim 1 as granted does not have a single meaning, and that the amendment merely limits the claim to one of the possible meanings.
- 4.4 However, as explained above, the board considers that claim 1 as granted has only one valid interpretation, namely that features (g2) and (g3) (which are the same in claim 1 as granted and claim 1 of the main request) are associated with each other. Since this association has been removed, the scope of claim 1 of the 2nd auxiliary request has virtually been broadened, contrary to Article 123(3) EPC. This is an example of the well-known "inescapable Article 123(2) and (3) EPC trap" (cf. **G 1/93**, point 1 of the order).
- 4.5 The appellant cited several decisions in support of ways of resolving the so-called "inescapable trap" issue, namely G 1/93, T 371/88, T 553/99, T 1779/09, T 310/13 and finally decision T 131/15. The established "rules" or "workarounds" for resolving such an inescapable trap as regards Article 123(2) and (3) EPC in the case of an originally undisclosed, limiting feature in a claim as granted that could be objected to under Article 123(2) EPC (called "undisclosed feature" henceforth) can be summarised as follows:
- (i) The *undisclosed feature* can be replaced by an originally disclosed feature if there is a basis for such a replacement in the

- application as filed without violating Article 123(3) EPC (**G 1/93, Headnote 1**);
- (ii) The *undisclosed feature* does not violate Article 123(2) EPC if it excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed, without providing any technical contribution to the subject-matter of the claimed invention (**G 1/93, Headnote 2**);
- (iii) The *undisclosed feature* ("term" here), embracing *one* embodiment of the description, can be replaced by a broader feature ("term"), also covering an *additional* embodiment set out in the description, if the undisclosed feature is not so clear in its technical meaning in the given context that it could be used to determine the extent of protection *without* interpretation by reference to the patent's description and the drawings and it is quite clear from the patent's description and the drawings and also from the preceding examination proceedings that the further embodiment belongs to the invention and that it was never intended to exclude it from the protection conferred by the patent (**T 371/88, Reasons 2.5**);
- (iv) The *undisclosed feature* does not violate Article 123(2) EPC provided that a further limiting feature is added to the claim that is properly disclosed in the application as filed, and deprives the undisclosed feature of all technical contribution to the subject-matter of the claimed invention (**T 553/99, Headnote**);

- (v) The *undisclosed feature* can effectively be ignored if it does not add anything over the other features of the respective claim, such that it has to be considered redundant (**T 310/13, Reasons 4, penultimate paragraph**);
- (vi) If the *undisclosed feature* ("expression" here), taken literally and in isolation,
- would have the effect of excluding all of the disclosed embodiments from the scope of protection,
 - but where a definition of the expression may be derived from the patent itself which would locate (at least some of) the disclosed embodiments within the ambit of the claim, and
 - provided this definition is not manifestly unreasonable, having regard to the normal meaning of the words used in the expression,
 - then in judging compliance with the requirements of Article 123(3) EPC, the scope of protection should normally be considered to include at least that which would fall within the terms of the claim understood according to this definition (**T 131/15, Reasons 5.11**).

4.6 The board considers that none of the above situations (i) to (vi) applies to the current one. The association of feature (g3) with feature (g1) does not constitute a replacement in the sense of cases (i) and (iii), or an exclusion of protection without providing any technical contribution within the meaning of case (ii), or an addition depriving feature (g) of all technical contribution as in case (iv), or adding

redundancy as in case (v).

- 4.7 The appellant argues in their submission dated 15 January 2021 that account must be taken of recent case law, in particular **T 131/15** (cf. section II.3 of the submission). In particular, the appellant cites the catchword of this decision (see case (vi) above):

"Where an expression in a granted claim, taken literally and in isolation, would have the effect of excluding all of the disclosed embodiments from the scope of protection, but where a definition of the expression may be derived from the patent itself which would locate (at least some of) the disclosed embodiments within the ambit of the claim, and provided this definition is not manifestly unreasonable, having regard to the normal meaning of the words used in the expression, then in judging compliance with the requirements of Article 123(3) EPC, the scope of protection should normally be considered to include at least that which would fall within the terms of the claim understood according to this definition."

The appellant argues that this decision is applicable in the present case.

- 4.8 The board however does not agree, since T 131/15 concerns an entirely different situation. Irrespective of the fact that such a comprehensive and intricate test as suggested in T 131/15 could arguably place an undue burden on third parties when trying to establish the "true" (i.e. intended) scope of protection conferred by a granted patent, in the underlying case, the issue was that the literal interpretation of the geometric expression "opposite direction" in claim 1 as

granted would exclude all the described embodiments from protection, i.e. there would be no *compatibility at all* between the description and the claim as granted. However, since the description provided a fair basis for interpreting the expression less restrictively in the sense of embracing small deviations, the deciding board considered that Article 123(3) EPC was not infringed.

4.9 This is not comparable to the present situation because feature (g) as interpreted by the board - although undisclosed - provides a clear and credible technical teaching compatible both with the claim as granted and with the described embodiment (in this respect, the board refers to the appellant's comments set out in point 2.7.1 above). The described embodiment is therefore not entirely excluded from the scope of protection. Therefore, case T 131/15 does not apply to the present situation.

4.10 Consequently, claim 1 of the 2nd auxiliary request does not comply with Article 123(3) EPC.

4.11 This objection applies, *mutatis mutandis*, to claim 1 of the 3rd auxiliary request.

5. 4th auxiliary request - claim 1 - Article 123(2) EPC

5.1 Claim 1 of the 4th auxiliary request differs from claim 1 of the main request only in that the term "found" has been added to feature (g3) ("and identifying the highest in preference of the plurality of broadcast networks in the preference list that is found available").

5.2 The board cannot see that it makes any difference to its assessment under Article 123(2) EPC by adding the term "found". Consequently, the objection as to the compliance with Article 123(2) EPC with respect to the main request applies, *mutatis mutandis*. The appellant did not provide any counter-arguments.

**6. 5th to 7th auxiliary requests - claim 1 -
Article 123(2) EPC**

6.1 Claim 1 of each of the 5th to 7th auxiliary requests retains the wording of feature (g) of the main request, but a wording has been added which, in the opinion of the appellant, renders feature (g) technically meaningless. This approach is said to be in conformity with decision G 1/93 of the Enlarged Board of Appeal (see case (ii) above).

6.2 However, the conclusions underlying G 1/93 are moot, since feature (g) is not rendered redundant or "technically meaningless". In this respect, the preference list can still meaningfully include information which identifies the highest preference network which is available.

6.3 Consequently, claim 1 respectively of the 5th to 7th auxiliary requests does not comply with Article 123(2) EPC for the same reasons as given in connection with claim 1 of the main request.

**7. 8th to 13th auxiliary requests - claim 1 -
Article 123(2) EPC**

7.1 These requests are said to have been filed only in case the board were to examine the ground for opposition pursuant to Article 100(a) EPC (here, lack of inventive

step). The amendments are not relevant to overcoming the non-compliance with Article 123(2) EPC set out in connection with the main request. In fact, claim 1 of those claim requests likewise includes feature (g3), namely that the "preference list" identifies the network availability information.

7.2 Consequently, claim 1 respectively of the 8th to 13th auxiliary requests does not comply with Article 123(2) EPC either.

8. Request for referral to the Enlarged Board of Appeal

8.1 The appellant requests conditionally that a question (relating to the conclusions drawn in T 131/15) as formulated in their submission dated 15 January 2021 be referred to the Enlarged Board of Appeal. This request is worded as follows:

"In case there should be a diverging opinion on the question whether a person skilled in the art, even when provided with a technically meaningful claim language, if read literally in in *[sic]* isolation, would nonetheless apply interpretation to bring the claim in line with the description, if otherwise none of the described embodiments would be covered, it is respectfully requested under Art. 112(1)a) EPC to forward such question for decision to the Enlarged Board of Appeal."

8.2 According to Article 112(1)(a) EPC, a board shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a **decision is required** in order to ensure uniform application of the law, or if a

point of law of fundamental importance arises. Moreover, pursuant to Article 21 RPBA 2020, if a Board considers it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier decision or opinion of the Enlarged Board of Appeal, the question shall be referred to the Enlarged Board of Appeal.

8.3 The assessment whether a referral is "required" should be made on objective criteria and should be plausible in order to indicate that the referred question does not have a merely theoretical significance for the original proceedings, as would be the case if the board were to reach the same decision on the basis of the file regardless of the answer to the referred question (cf. **G 3/98**, Reasons 1.2.3). Thus, it is not sufficient for the point to be referred to be of general interest: an answer to it must also be *necessary* to a decision on the appeal in question (cf. **J 16/90**, Reasons 1.2).

8.4 In the present case, the board has given reasons as to why decision **T 131/15** does not apply to the present situation, and has therefore not expressed any diverging opinion as regards the question posed. Hence, it is not necessary to refer this question to the Enlarged Board of Appeal.

8.5 The request for referral to the Enlarged Board of Appeal is therefore refused.

9. Conclusion

As there is no allowable request, it follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated