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**Datasheet for the decision  
of 17 November 2020**

**Case Number:** T 1981/16 - 3.5.03  
**Application Number:** 06828846.3  
**Publication Number:** 1952560  
**IPC:** H04B7/26, H04J3/06, H04W56/00,  
H04W74/08  
**Language of the proceedings:** EN

**Title of invention:**

Technique for performing a random access procedure over a radio interface

**Patent Proprietor:**

Telefonaktiebolaget LM Ericsson (publ)

**Former Opponent:**

Huawei Technologies Co., Ltd.  
Apple Retail Germany GmbH  
Apple Retail Netherlands B.V.  
Apple Sales International  
Wiko SAS  
Wiko Germany GmbH

**Headword:**

Random access procedure/ERICSSON

**Relevant legal provisions:**

EPC Art. 100(c), 111(1), 123(2)

EPC R. 84(2) sentence 2

RPBA 2020 Art. 11

**Keyword:**

Added subject-matter - main request (no)

Remittal to the opposition division for further prosecution -  
(yes): opposition proceedings may be continued even if the  
oppositions are withdrawn



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Case Number: T 1981/16 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 17 November 2020**

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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
15 June 2016 concerning maintenance of the  
European Patent No. 1952560 in amended form.**

**Composition of the Board:**

**Chair** K. Bengi-Akyürek

**Members:** K. Schenkel

J. Geschwind

## Summary of Facts and Submissions

I. The appeal of the patent proprietor lies from the interlocutory decision of the Opposition Division maintaining the present European patent in amended form on the basis of a third auxiliary request filed during the oral proceedings before the Opposition Division.

The higher-ranking requests, a main request and a first and a second auxiliary request, were found to contain added subject-matter and thus not to fulfil the requirement of Article 123(2) EPC.

II. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (**main request**) or, alternatively, maintained as amended on the basis of the claims of **first to fourth auxiliary requests** filed with the statement of grounds of appeal.

III. All interventions invoked during the opposition and appeal proceedings were withdrawn by letter dated 22 December 2015 and 7 June 2019 respectively.

IV. The opponent withdrew their opposition by letter dated 23 September 2016. Consequently, only the appellant is party to the current appeal proceedings.

V. In a communication under Article 15(1) RPBA 2020, the board indicated that claim 1 of the main request appeared to comply with Article 123(2) EPC and that the board was minded to exercise its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of the

main request.

VI. In response to the board's communication, the appellant requested that the opposed patent be maintained without remittal. Furthermore, they indicated that the request for oral proceedings was withdrawn under the condition that the case is remitted to the opposition division.

VII. Oral proceedings before the board were then cancelled.

VIII. Claim 1 of the patent as granted (**main request**) reads as follows (feature labelling (a) to (f) added by the board):

- (a) "A method of performing a random access procedure over a radio interface, the method comprising the following steps in a mobile terminal:
- (b) - transmitting (404) a synchronization request for synchronization information;
- (c) - receiving (406) synchronization information in response to the synchronization request;
- (d) - transmitting (408), based on at least one transmission parameter adjusted in accordance with the synchronization information, a resource request for data transmission resources; and
- (e) - starting a synchronization timer in response to the reception of synchronization information,
- (f) wherein on or after expiry of the synchronization timer, a further synchronization request is transmitted prior to any data transmission."

IX. Independent claim 11 of the main request reads as follows (feature labelling (a) to (f) added by the board):

- (a) "A mobile terminal adapted for performing a random access procedure over a radio interface (106, 202), the mobile terminal (102, 200) comprising:
- (b) - a sync-request component (208) adapted to transmit a synchronization request for synchronization information;
- (c) - a sync-response component (210) adapted to receive synchronization information in response to the synchronization request;
- (d) - a transmission control component (204) adapted to transmit, based on at least one transmission parameter adjusted according to the synchronization information, a resource request for data transmission resources; and
- (e) - a component adapted to start a synchronization timer in response to the reception of synchronization information,
- (f) wherein on or after expiry of the synchronization timer, a further synchronization request is transmitted prior to any data transmission."

## **Reasons for the Decision**

1. Claim 1 as granted - Article 100(c) EPC

1.1 Subject-matter of the patent

Claim 1 of the patent as granted relates to a method of performing a random access procedure over a radio interface from the perspective of a mobile terminal. This method includes the steps of transmitting a synchronisation request and, in response to receiving the synchronisation information, starting a synchronisation timer. On or after the expiration of

this timer, a further synchronisation request is transmitted prior to data transmission.

1.2 Features (a) to (e) have a literal basis in claims 1 and 4 as originally filed.

1.3 A basis for feature (f), i.e.

"on or after expiry of the synchronization timer, a further synchronization request is transmitted prior to any data transmission",

can be found on page 14, lines 16 to 18 of the description as originally filed, stating the following:

*"In one embodiment, on expiry of the timer the uplink transmission parameters are considered to be outdated and a (re)synchronization is required prior to any (further) data transmission."*

1.4 The above wording is included within a paragraph which states at its beginning that a timer may be used to indicate the validity of the uplink transmission parameters or, as it is phrased in lines 16 to 18 of page 14, from which point in time onwards the parameters are considered to be outdated.

From this paragraph, it becomes apparent to the skilled reader that the parameters remain outdated after the expiry of the timer and that not only *on* expiry of the timer but also *after* expiry of the timer (re)synchronisation is required prior to data transmission.

Further, the paragraph describes the provision of an indication related to the validity of the parameters as



the purpose of implementing the timer mechanism. In this context, considering the parameters to be outdated after expiry of the timer is presented as an explanation *why* the process of (re)synchronisation becomes necessary prior to data transmission and not as a step carried out by the mobile device.

- 1.5 The Opposition Division argued that by omitting the wording "transmission parameters are considered to be outdated" an intermediate generalisation had been generated. In addition, they held that the feature of transmitting a further synchronisation request within feature (f) was broader than disclosed in the above lines because the original wording covered more steps ("... a (re)synchronization is required ...") than the single step of transmitting a further synchronisation request.
  
- 1.6 The board does not agree with the Opposition Division's findings, for the following reasons:
  - 1.6.1 The disputed wording ("... considered to be outdated") indicates the rationale behind transmitting a further synchronisation request. This *consideration* is a mental activity and obviously cannot constitute a concrete method step carried out by the mobile terminal. Thus, the skilled person would not derive from the cited lines on page 14 that the *mobile terminal* "considers" the parameters to be outdated. The board therefore concludes that the omission of the phrase "transmission parameters are considered to be outdated" does not result in an unallowable intermediate generalisation.
  
  - 1.6.2 Moreover, the application as filed discloses that, in order to achieve synchronisation, the mobile terminal sends a synchronisation request and receives, in

return, synchronisation information (see claim 1 and the beginning of the section "Summary of the Invention" in the underlying description). The application does not provide an indication that, apart from transmitting the synchronisation request, a further step has to be initiated by the mobile terminal. The skilled reader would therefore understand that, from the perspective of the mobile terminal, synchronisation is meant to refer to the transmission of a synchronisation request.

- 1.6.3 It is further noted that the wording "... a (re)synchronization is required ..." used in lines 16 to 18 of page 14 describes only the technical *conditions* caused by the expiry of the synchronisation timer and not an *effect* which is accomplished by the mobile terminal and which implies that the mobile terminal carries out all necessary steps.
- 1.7 The board therefore concludes that claim 1 as granted does not comprise subject-matter extending beyond the content of the application as filed (Article 100(c) in conjunction with Article 123(2) EPC).
2. Independent claim 11 as granted  
  
The above considerations apply, *mutatis mutandis*, to independent claim 11.
3. Remittal (Article 111(1) EPC)
  - 3.1 For the above reasons, the only ground for opposition based on which the Opposition Division found the patent as granted not to comply with the requirements of the EPC, namely added subject-matter (Articles 100(c) and 123(2) EPC), does not prejudice the maintenance of the patent as granted. Accordingly, the impugned decision

is to be set aside.

- 3.2 Given that the compliance of the present independent claims with the requirements of **novelty and inventive step** (Articles 100(a), 54 and 56 EPC) as well as **sufficiency of disclosure** (Articles 100(b) and 83 EPC) was neither discussed nor decided upon in the decision under appeal (e.g. novelty and inventive step were only discussed for the third auxiliary request in points 4 to 8 of the Reasons), the board considers that a ruling on those issues for the very first time in these appeal proceedings could not be given without undue burden.

In that regard, the board notes that, although the oppositions have been withdrawn, opposition proceedings may still be continued according to the EPC (cf. Rule 84(2), second sentence, EPC).

- 3.3 In view of those "special reasons" within the meaning of Article 11 RPBA 2020, the board decides to remit the case to the opposition division for further prosecution on the basis of the claims as granted (main request).

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated