Internal distribution code:
(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [X] To Chairmen
(D) [-] No distribution

Datasheet for the decision
of 7 July 2022

Case Number:	T 2360/17 - 3.5.03
Application Number:	11003781.9
Publication Number:	2391172
IPC:	H04W72/12
Language of the proceedings:	EN

Title of invention:
Method and apparatus for handling buffer status reporting in a wireless communication system

Patent Proprietor:
Innovative Sonic Corporation

Opponent:
Telefonaktiebolaget L M Ericsson (publ)

Headword:
Buffer status reporting/INNOVATIVE

Relevant legal provisions:
EPC Art. 123(2)
EPC R. 103(4)(a)
RPBA 2020 Art. 12(4), 13(2)

Keyword:

Added subject-matter - main request and auxiliary request 2b
(yes): unallowable intermediate generalisation
Admittance - auxiliary request 1c (no): deletion of claims is
an "amendment" (T 1480/16, T 1857/19 and T 2201/19 not
followed); no cogent reasons + no clear allowability
Partial reimbursement of appeal fee at 25% - (yes): withdrawal
of the proprietor's appeal before announcement of decision

Decisions cited:

J 0014/19, T 1480/16, T 0494/18, T 2091/18, T 2920/18,
T 1857/19, T 2201/19

Catchword:

As to the divergence in the jurisprudence of the Boards of
Appeal concerning the notion of an "amendment" within the
meaning of Article 12(4) RPBA 2020, see point 2.4 of the
Reasons.

Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: **T 2360/17 - 3.5.03**

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 7 July 2022

Appellant: (Patent Proprietor)	Innovative Sonic Corporation 14F, No. 30 Beiping E. Rd. Zhongzheng Dist. Taipei City 10049 (TW)
Representative:	Grünecker Patent- und Rechtsanwälte PartG mbB Leopoldstraße 4 80802 München (DE)
Appellant: (Opponent)	Telefonaktiebolaget L M Ericsson (publ) 164 83 Stockholm (SE)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Decision under appeal:	Interlocutory decision of the Opposition Division of the European Patent Office posted on 11 August 2017 concerning maintenance of the European Patent No. 2391172 in amended form.

Composition of the Board:

Chair	K. Bengi-Akyürek
Members:	K. Schenkel
	C. Almberg

Summary of Facts and Submissions

I.   The appeals by the patent proprietor and the opponent
        lie from the interlocutory decision of the opposition
        division maintaining the present European patent in
        amended form on the basis of an "auxiliary request 2a"
        filed during the oral proceedings before the opposition
        division on 27 June 2022.

II.   Oral proceedings were held before the board on
        7 July 2022 by videoconference during which the patent
        proprietor withdrew its appeal (i.e. implying a partial
        reimbursement at 25% under Rule 103(4)(a) EPC) and a
        number of auxiliary requests.

        The parties' final requests were as follows:

        -   The opponent requested that the appealed decision
            be set aside and that the patent be revoked.

        -   The proprietor requested that the opponent's appeal
            be dismissed, i.e. that the patent be maintained on
            the basis of auxiliary request 2a as maintained by
            the opposition division (**main request**), or that the
            patent be maintained as amended on the basis of one
            of **auxiliary requests 2b and 1c** filed with the
            reply to the board's communication under
            Article 15(1) RPBA 2020.

        At the end of the oral proceedings, the board's
        decision was announced.

III.   Claim 1 of the **main request** reads as follows (board's
        labelling):

(a) "A method of handling buffer status reporting in a wireless communication system, the method comprising:

(b) providing a first buffer size level table having a first maximum buffer size value (402); and

(c) providing a second buffer size level table having a second maximum buffer size value greater than the first maximum buffer size value (404); characterized by

(d) using an indication in a Radio Resource Control message, in the following referred to as RRC message, to indicate whether to use the second buffer size level table or the first buffer size level table (706); wherein the RRC message is an RRCConnectionReconfiguration message."

IV.   Claim 1 of **auxiliary request 2b** differs from claim 1 of the main request in that feature (c) now reads as follows (board's labelling and highlighting of amended text):

(c1) "providing a second buffer size level table having a second maximum buffer size value greater than the first maximum buffer size value (404); wherein the first maximum buffer size value is 150 Kbytes;"

V.   Claim 1 of **auxiliary request 1c** differs from claim 1 of auxiliary request 2b in that feature (d) now reads as follows (board's labelling and highlighting of amended text):

(d1) "the eNode B, eNB, using an indication in one of a Radio Resource Control message, in the following referred to as RRC message, a Medium Access Control Control Element, in the following

referred to as MAC Control Element, or a
corresponding subheader of the MAC Control
Element to indicate whether to use the second
buffer size level table or the first buffer size
level table (706); wherein the RRC message is an
RRCConnectionReconfiguration message."

Reasons for the Decision

1.   *Main request (auxiliary request 2a) and auxiliary
        request 2b - added subject-matter (Article 123(2) EPC)*

1.1   Feature (d) of the **main request** and of **auxiliary
        request 2b** includes the step of using *an indication in
        an RRC message to indicate whether to use the second or
        the first buffer size level table, wherein the RRC
        message is an RRCConnectionReconfiguration message.*

1.2   The underlying description as originally filed refers
        to an *RRCConnectionReconfiguration* message only in
        paragraph [0044] as filed which reads as follows
        (board's underlining):

        "According to another embodiment shown in FIG. 8, a
        method 600 of handling buffer status reporting for
        a UE is shown, which similar to the embodiment of
        FIG. 6, includes providing a first buffer size
        level table at 402 having a first maximum buffer
        size value and providing a second buffer size level
        table at 404 having a second maximum buffer size
        value greater than the first maximum buffer size
        value. The method then includes at 606 using an
        indication in a RRC message to indicate whether the
        second buffer size level table should be used or to
        indicate which buffer size level table should be

used. The RRC message <u>is also used</u> to configure or
reconfigure CA. <u>Also</u>, the RRC message <u>is used</u> to
configure or reconfigure UL MIMO. <u>The</u> RRC message
<u>may be</u> a RRCConnectionReconfiguration message. <u>The</u>
RRC message <u>may be</u> used to enable UL MIMO or enable
CA. Referring to FIG. 5, all of the above
operations of the method 600 may be performed by
the CPU 308 of the UE 300 executing one or more
program codes 312 stored in the memory 310."

1.3   Hence, paragraph [0044] as filed refers to an
        embodiment in which an RRC message is used

        (i)   "to indicate whether the second buffer size
                 level table should be used or to indicate
                 which buffer size level table should be
                 used",
                 wherein the RRC message is further
                 specified in that
        (ii)   "[t]he RRC message is also used to
                 configure or reconfigure CA", that
        (iii)   "[a]lso, the RRC message is used to
                 configure or reconfigure UL MIMO", and that
        (iv)   "[t]he RRC message may be an
                 RRCConnectionReconfiguration message".

1.4   Feature (iv) refers to a specific RRC message ("<u>the</u> RRC
        message may be ..."), namely the RRC message
        characterised by the preceding features (ii) and (iii).
        Paragraph [0044] as filed thus discloses that an
        RRCConnectionReconfiguration message is an RRC message
        invariably comprising features (ii) and (iii). An RRC
        message being an *RRCConnectionReconfiguration* message
        without features (ii) and (iii) therefore amounts to an
        unallowable intermediate generalisation.

1.5   The patent proprietor argued as follows:

- Not too much emphasis was to be put on the
  linguistic analysis of paragraph [0044] but rather
  its strong correspondence with original claims 8 to
  11 was to be considered. First, a concise
  description of the RRC message and its use for
  indicating which table to use was given
  (independent claim 8) and, in the following
  dependent claims, options were provided that could
  be combined with each other or with the teaching of
  claim 8 alone. From claims 8, 10 and 11 as filed,
  it would become obvious that the RRC message for
  indicating which table to use could be employed
  independently for the different uses (features (ii)
  and (iii)) set out in paragraph [0044] as filed
  which correspond to the features of dependent
  claims 10 and 11. Consequently, limiting the RRC
  message to an *RRCConnectionReconfiguration* message
  was just another option.

- The definite article "The" in paragraph [0044] as
  filed referred to the message in method 600 and not
  to the preceding sentences. If weight was given to
  the term "also" in the sentences relating to the
  configuration of CA and UL MIMO, the same weight
  should be given to its absence in the sentence
  relating to the limitation of the RRC message to an
  RRCConnectionReconfiguration message.

- It was also apparent that it made no sense to have
  all of these options included together in the RRC
  message and to require that the RRC message
  indicating which table to use had to be used at the
  same time to configure CA and UL MIMO.

-    Further, if it was intended to link all options
     with the limitation of the RRC message being an
     RRCConnectionReconfiguration message,
     paragraph [0044] would *first* have indicated the
     latter limitation and *then* the other options. From
     this, and Fig. 8, the skilled reader would
     understand that the feature of limiting the "RRC
     message" to an "RRCConnectionReconfiguration"
     message could also be used independently with each
     of these features.

-    Finally, the following teaching in paragraph [0047]
     as filed showed that the indication of which table
     to use was *not* linked to the configuration of CA or
     UL MIMO, and that the intention was to decouple
     them:

          "According to the embodiments shown in FIG. 8 and
          FIG. 9, whether to use the new buffer size level
          table is not coupled to CA or UL MIMO. Compared
          with the alternative proposed in R2-102805, the
          embodiments of FIGS. 8 and 9 provide more
          flexibility to let network to control which table
          should be used."

1.6   The board is not convinced by these arguments for the
       following reasons:

-    In view of the structure of original claims 8 to
     11, the features of dependent claims 10 and 11 as
     filed, i.e. the use of the RRC message for
     (re)configuring CA and UL MIMO (features (ii) and
     (iii)), are indeed not linked firmly to the use of
     the RRC message for indicating which table to use.
     Thus, the above claims as filed could arguably be
     regarded as a "direct" disclosure for the feature

in question. This, however, does not imply or provide a basis for the conclusion that also feature (iv) is optional. In other words, even if feature (d) was considered to be "directly" disclosed in view of the original claims, it would not be "unambiguously" disclosed having regard to the original description.

- Furthermore, features (ii) and (iii) relate to the (re)configuration of the radio resources. If paragraph [0044] as filed *first* specifies that the RRC message is used for the (re)configuration according to features (ii) and (iii) and *then* optionally limits the RRC message to the specific type of *RRCConnectionReconfiguration* message, it is conclusive for the skilled reader that an RRC message of the type *RRCConnectionReconfiguration* is also used for the respective (re)configurations according to features (ii) and (iii). In view of the relation between the type of message and its use, there is no reasonable doubt that the RRC message according to paragraph [0044] as filed is indeed limited by all features (i) to (iv). In particular, the board sees no reason why the appearance of feature (iv) at the end could cast doubts on the link between features (ii) and (iii) to the specific RRC message which is used for indicating which table to use and to which feature (iv) refers.

- As to the teaching of paragraph [0047], the board understands that it implies that the indication which table to use is *not* coupled to the (re)configuration of CA or UL MIMO rather than to the way of communicating that indication, i.e. by which message this is to be done.

1.7   Hence, the main request and auxiliary request 2b are
        not allowable under Article 123(2) EPC.

*2.   Auxiliary request 1c – admittance (Article 13(2) RPBA
        2020)*

2.1   **Auxiliary request 1c** was filed in response to the
        board's communication pursuant to Article 15(1) RPBA
        2020. Hence, its admittance is in principle subject to
        Article 13(2) RPBA 2020.

2.2   The single method claim of this request is identical to
        method claim 1 of auxiliary request 1b pending during
        the opposition proceedings and "maintained" without
        further substantiation with a letter dated 15 May 2018.
        More specifically, new claim 1 no longer requires that
        the RRC message is an *RRCConnectionReconfiguration*
        message but now includes feature (d1), i.e. requiring
        that it is the "eNode B" that indicates via an RRC
        message whether to use the second or first buffer size
        level table (cf. point V above). The other claims of
        auxiliary request 1b, i.e. claims 2 to 12, among them
        apparatus claims including features not included in
        method claim 1, were <u>deleted</u>.

2.3   The crucial issue here is therefore whether the filing
        of the claim set according to auxiliary request 1c
        constitutes an "amendment" of the proprietor's appeal
        case within the meaning of Article 12(4) in conjunction
        with Article 12(2) RPBA 2020. In other words, the first
        question to be answered is whether the board has any
        discretion at all to disregard that claim request under
        Article 13(2) RPBA 2020 ("Any **amendment** to a party's
        appeal case ...").

2.4   The board is aware of the current divergence in the
        jurisprudence of the Boards of Appeal as to whether or
        not deletions of claims in certain claim requests
        amount to such an "amendment". One strand of
        jurisprudence holds that, if the deletions of claims in
        a previously filed claim request do not change the
        "factual and legal framework of the case" or "the
        subject of the discussions" and does not lead to a
        "re-weighting of the subject of the proceedings", such
        deletions are not to be considered an "amendment"
        within the meaning of Article 12(4) RPBA 2020 (see as
        representatives of that strand e.g. T 1480/16-3.2.01,
        T 1857/19-3.3.05 or T 2201/19-3.5.05; also labelled
        "non-applicability approach"). According to another
        strand of jurisprudence, any deletion of claims from a
        previous set of claims amounts to an "amendment" of the
        applicant's or proprietor's appeal case and thus
        confers discretion to a board to disregard the claim
        request at issue. This discretion has then to be
        exercised in a reasonable manner according to a
        so-called "two-step examination approach" (see as
        representatives of that strand e.g. J 14/19-3.1.01,
        T 494/18-3.3.06, T 2091/18-3.2.05, T 2920/18-3.3.03).

        This board endorses the conclusions drawn by the latter
        line of jurisprudence on the basis of a systematic
        interpretation of the notion of "amendment", mainly for
        the reasons indicated in the above-cited decisions. In
        addition, this board holds that neither from the
        wording of Article 12(2) RPBA 2020 nor from the
        explanatory remarks to the RPBA 2020 can it be deduced
        that a party's appeal case has to be directed to the
        "factual and legal framework" or the "subject of the
        discussions" relating to the party's submissions (such
        as claim requests) on which the decision under appeal
        was based, or that "re-weighting of the subject of the

proceedings" shall not entail. This provision rather requires simply that a party's appeal case is directed to the "**requests**, facts, objections, arguments and evidence on which the decision under appeal was based". As a consequence, the submission of auxiliary request 1c constitutes an "amendment" to the proprietor's appeal case, and Article 13(2) RPBA 2020 indeed applies here.

2.5   According to Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are **exceptional circumstances**, which have been justified with **cogent reasons** by the party concerned. Furthermore, in the application of Article 13(2) RPBA 2020, the criteria applicable under Article 13(1) RPBA 2020 may be relied on. In accordance with Article 13(1) RPBA 2020, "[the] Board shall exercise its discretion in view of, inter alia, the current state of the proceedings, the suitability of the amendment to resolve the issues which were [...] raised by the Board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has **demonstrated** that any such amendment, prima facie, **overcomes the issues raised** by [...] the Board and does not give rise to new objections" (board's emphasis).

2.6   In the present case, as to the reasons for this late amendment, the patent proprietor maintained and referred to the related arguments concerning previous auxiliary request 1b, and argued that there was no necessity to add more at this stage, in particular, since the opponent did not raise an objection under Article 123(2) EPC with respect to this claim request.

However, the maintenance of the arguments related to auxiliary request 1b does not address the late-filing of auxiliary request 1c, let alone constitutes a justification for this amendment (see Article 13(1), first paragraph, RPBA 2020). Moreover, the mere lack of an objection under Article 123(2) EPC by the opponent cannot justify such late-filing either. The patent proprietor thus failed to provide "cogent reasons" for the belated submission of auxiliary request 1c.

2.7   Furthermore, claim 1 of auxiliary request 1c includes the feature that it is the "eNode B" that indicates whether to use the *second* or the *first* buffer size level table. The term "eNode B" or its abbreviation "eNB" appears in the application as filed solely in paragraphs [0020], [0040], [0041], [0046] and [0047]. However, none of these paragraphs discloses that added feature. Claim 12 and paragraph [0047] as filed may provide a basis for a *downlink* transmission of the indication which table to use, and a respective control by the network, but, contrary to the patent proprietor's arguments, not necessarily for the "eNode B" performing this transmission. Auxiliary request 1c is therefore, *prima facie*, not allowable under Article 123(2) EPC.

2.8   In view of the above, the board, in exercising its discretion, decided not to admit auxiliary request 1c into the appeal proceedings (Article 13(2) RPBA 2020).

3.   As there is no allowable set of claims on file, the patent is to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chair:

U. Bultmann   K. Bengi-Akyürek

Decision electronically authenticated