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Datasheet for the decision of 18 October 2022

Case Number: T 2700/18 - 3.5.03

Application Number: 12159399.0

Publication Number: 2485514

IPC: H04W16/00, H04J11/00

Language of the proceedings: EN

Title of invention:
Self configuring and optimisation of cell neighbours in wireless telecommunications networks

Patent Proprietor:
Unwired Planet International Limited

Opponents:
Google LLC ("opponent 1" until 18 May 2015)
Huawei Technologies Düsseldorf GmbH ("opponent 2" until 6 April 2020)
HTC Germany GmbH ("opponent 3")
Samsung Electronics Co., Ltd. ("opponent 4" until 2 August 2016)
Samsung Electronics GmbH ("opponent 5" until 2 August 2016)
LG Electronics Deutschland GmbH ("opponent 6" until 13 March 2017)

Headword:
Non-unique cell ID II/UNWIRED PLANET

Relevant legal provisions:
EPC Art. 76(1), 100(c)
EPC R. 80, 139
RPBA Art. 12(4)
RPBA 2020 Art. 13(2)

Keyword:
Added subject-matter - main request and auxiliary requests 6, 12, 18, 24 (yes)
Admittance of requests not admitted by opposition division - auxiliary requests 2 to 5, 7 to 11, 13 to 17, 19 to 23 and 25 to 29 (no): discretion correctly exercised
Amendments occasioned by ground for opposition - auxiliary requests 30 to 32 and B1 to B7 (no)
Admittance of requests after summons - auxiliary requests of the F, G and FG series (no): no exceptional circumstances justified with cogent reasons
Correction of error - (no): not immediately evident that nothing else could have been intended

Decisions cited:
T 1869/17

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Case Number: T 2700/18 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 18 October 2022

Appellant: (Patent Proprietor)	Unwired Planet International Limited 70, Sir John Rogerson's Quay Dublin 2 (IE)
Representative:	Grünecker Patent- und Rechtsanwälte PartG mbB Leopoldstraße 4 80802 München (DE)
Respondent: (Opponent 3)	HTC Germany GmbH Zeil 83 60316 Frankfurt am Main (DE)
Representative:	Braun-Dullaeus, Karl-Ulrich Braun-Dullaeus Pannen Emmerling Patent- und Rechtsanwaltspartnerschaft mbB Platz der Ideen 2 40476 Düsseldorf (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 September 2018 revoking European patent No. 2485514 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chair	K. Bengi-Akyürek
Members:	J. Eraso Helguera
	C. Almberg

Summary of Facts and Submissions

I. This case concerns the appeal filed by the proprietor against the decision of the opposition division revoking the opposed patent under Article 101(2) and (3)(b) EPC.

II. Opponent 1, opponent 4, opponent 5 and opponent 6 withdrew their respective oppositions during the opposition proceedings.

III. Opponent 2 withdrew its opposition after having sent a reply to the statement of grounds of appeal. The board has also considered the arguments in this reply.

IV. Oral proceedings before the board were held on 18 October 2022. The final requests of the parties were:

- The proprietor (appellant) requested, as a **main request**, that the decision under appeal be set aside and that the patent be maintained in its granted form (i.e. that the opposition be rejected), or that the patent be maintained in amended form on the basis of the claims of one of sixty-seven auxiliary requests: **auxiliary requests 1 to 32**, subject to the decision under appeal, **auxiliary requests B1 to B7**, filed with the statement of grounds of appeal, and **auxiliary requests 6F, 12F, 18F, 24F, 30F, 31F, 32F, B1F, B2F, B3F, B4F, 30G, 31G, 32G, B1G, B2G, B3G, B4G, B5G, B6G, B7G, 30FG, 31FG, 32FG, B1FG, B2FG, B3FG** and **B4FG**, filed with the proprietor's response to the board's communication under Article 15(1) RPBA 2020.

- Opponent 3 (respondent) requested that the appeal be dismissed.

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

V. Claim 1 as granted (**main request**) reads as follows:

"A method for operating a mobile terminal in a wireless telecommunications system which defines a plurality of communications cells in which a non-unique cell identity and a unique cell identity are transmitted, the method comprising:

communicating with a radio base station which serves a first communications cell;
receiving (113) a request from the radio base station to retrieve the unique cell identity of a second communications cell among the plurality of communications cells;
retrieving (115) the unique cell identity of the second communications cell; and
reporting (117) the unique cell identity of the second communications cell to the radio base station of the first communications cell."

Claim 11 as granted (**main request**) reads as follows:

"A method for self configuring of cell neighbours in a wireless telecommunications system which comprises a plurality of communications cells in which a non-unique cell identity and a unique cell identity are transmitted, the method comprising:

communicating with a mobile terminal operating in a first communications requesting (111) the mobile

terminal to retrieve the unique cell identity of a second communications cell;
receiving (119) the unique cell identity of the second communications cell from the mobile terminal; and
establishing a transport connection by finding in a lookup map a mapping of the unique cell identity of the second communications cell with a network address of the radio base station that serves the second communications cell."

Claim 1 of **auxiliary request 1** (labelled "AUXILIARY REQUEST 0.A") is identical to claim 1 as granted.

Claim 1 of **auxiliary request 2** (labelled "AUXILIARY REQUEST 0.B") is identical to claim 1 as granted, except for the addition of

"; and

wherein retrieving and reporting the unique cell identity is performed in response to receiving the request from the radio base station of the first communications cell"

at the very end of the claim.

Claim 1 of **auxiliary request 3** (labelled "AUXILIARY REQUEST 0.C") is identical to claim 1 as granted, except for the insertion of

", wherein the second communications cell is a non-serving cell for the mobile terminal"

right after "among the plurality of communications cells".

Claim 1 of **auxiliary request 4** (labelled "AUXILIARY REQUEST 0.D") is identical to claim 1 as granted, except for the insertion of

"for the mobile terminal"

right after "receiving (113) a request from the radio base station".

Claim 1 of **auxiliary request 5** (labelled "AUXILIARY REQUEST 0.E") is identical to claim 1 as granted, except for the addition of

", wherein the second communications cell is a new neighbour cell identified by the mobile terminal"

right after "retrieving (115) the unique cell identity of the second communications cell".

Claim 1 of **auxiliary request 6** (labelled "Auxiliary Request 1") reads as follows:

"A method for operating a mobile terminal in a wireless telecommunications network which defines a plurality of communications cells in each of which a non-unique cell identity and a unique cell identity are transmitted, the network storing a neighbour cell set, the neighbour cell set comprising known neighbours of a first communications cell, the method comprising:

communicating with a radio base station which serves the first communications cell;

subsequent to determining and reporting the non-unique cell identity of a second communications cell to the radio base station that serves the first communications cell, receiving (113) a request from the radio base station to also retrieve the unique cell

identity of the second communications cell among the plurality of communications cells if the second communications cell is not included in the neighbour cell set of the first communications cell;

retrieving (115) the unique cell identity of the second communications cell; and

reporting (117) the unique cell identity of the second communications cell to the radio base station of the first communications cell."

Claim 1 of **auxiliary request 6F** is identical to claim 1 of auxiliary request 6, except for the insertion of ", in response to the reporting of the non-unique cell identity of the second communications cell," right after "receiving (113)".

Claim 1 of **auxiliary request 7** (labelled "AUXILIARY REQUEST 1.A") is identical to claim 1 of auxiliary request 6.

Claim 1 of **auxiliary request 8** (labelled "AUXILIARY REQUEST 1.B") is identical to claim 1 of auxiliary request 6, except for the addition of

"; and

wherein retrieving and reporting the unique cell identity is performed in response to receiving the request from the radio base station of the first communications cell"

at the very end of the claim.

Claim 1 of **auxiliary request 9** (labelled "AUXILIARY REQUEST 1.C") is identical to claim 1 of auxiliary request 6, except for the addition of

", wherein the second communications cell is a non-serving cell for the mobile terminal"

right before "; retrieving (115)".

Claim 1 of **auxiliary request 10** (labelled "AUXILIARY REQUEST 1.D") is identical to claim 1 of auxiliary request 6, except for the insertion of

"for the mobile terminal"

right after "receiving (113) a request from the radio base station".

Claim 1 of **auxiliary request 11** (labelled "AUXILIARY REQUEST 1.E") is identical to claim 1 of auxiliary request 6, except for the insertion of

", wherein the second communications cell is a new neighbour cell identified by the mobile terminal"

right before "; and reporting (117)".

Claim 1 of **auxiliary request 12** (labelled "Auxiliary Request 2") reads as follows:

"A method for operating a mobile terminal in a wireless telecommunications network which defines a plurality of communications cells in each of which a non-unique cell identity, which is a physical layer cell identity that is not unique within the wireless communications network, and a unique cell identity, different to the non-unique cell identity, which uniquely identifies a neighbouring cell within the wireless telecommunications network, are transmitted, the non-unique cell identity being transmitted in a

cell at a first interval and the unique cell identity being transmitted in a cell at a second interval, the first and second intervals being arranged such that the unique cell identity is transmitted less frequently than the non-unique cell identity, the network storing a neighbour cell set, the neighbour cell set comprising known neighbours of a first communications cell, the method comprising:

communicating with a radio base station which serves the first communications cell;

subsequent to determining and reporting the non-unique cell identity of a second communications cell to the radio base station that serves the first communications cell, receiving (113) a request from the radio base station to also retrieve the unique cell identity of the second communications cell among the plurality of communications cells if the second communications cell is not included in the neighbour cell set of the first communications cell;

retrieving (115) the unique cell identity of the second communications cell; and

reporting (117) the unique cell identity of the second communications cell to the radio base station of the first communications cell."

Claim 1 of **auxiliary request 12F** is identical to claim 1 of auxiliary request 12, except for the insertion of ", in response to the reporting of the non-unique cell identity of the second communications cell," right after "receiving (113)".

Claim 1 of **auxiliary request 13** (labelled "AUXILIARY REQUEST 2.A") is identical to claim 1 of auxiliary request 12.

Claim 1 of **auxiliary request 14** (labelled "AUXILIARY REQUEST 2.B") is identical to claim 1 of auxiliary request 12, except for the addition of

> "; and
>
> wherein retrieving and reporting the unique cell identity is performed in response to receiving the request from the radio base station of the first communications cell"

at the very end of the claim.

Claim 1 of **auxiliary request 15** (labelled "AUXILIARY REQUEST 2.C") is identical to claim 1 of auxiliary request 12, except for the insertion of

> ", wherein the second communications cell is a non-serving cell for the mobile terminal"

right before "; retrieving (115)".

Claim 1 of **auxiliary request 16** (labelled "AUXILIARY REQUEST 2.D") is identical to claim 1 of auxiliary request 12, except for the insertion of

> "for the mobile terminal"

right after "receiving (113) a request from the radio base station".

Claim 1 of **auxiliary request 17** (labelled "AUXILIARY REQUEST 2.E") is identical to claim 1 of auxiliary request 12, except for the addition of

", wherein the second communications cell is a new neighbour cell identified by the mobile terminal"

right before "; and reporting (117)".

Claim 1 of **auxiliary request 18** (labelled "Auxiliary Request 3") reads as follows:

"A method for operating an LTE mobile terminal in an LTE wireless telecommunications network which defines a plurality of LTE communications cells in each of which a non-unique cell identity, which is a physical layer cell identity that is not unique within the LTE wireless communications network, and a unique cell identity different to the non-unique cell identity, which uniquely identifies a neighbouring cell within the LTE wireless telecommunications network, are transmitted, the non-unique cell identity being transmitted in an LTE cell at a first interval and the unique cell identity being transmitted in an LTE cell at a second interval, the first and second intervals being arranged such that the unique cell identity is transmitted less frequently than the non-unique cell identity, the LTE network storing a neighbour cell set, the neighbour cell set comprising known neighbours of a first LTE communications cell, the method comprising:

communicating with a radio base station which serves the first LTE communications cell;

subsequent to determining and reporting the non-unique cell identity of a second LTE communications cell to the radio base station that serves the first LTE communications cell, receiving (113) a request from the radio base station to also retrieve the unique cell identity of the second LTE communications cell among the plurality of communications cells if the second LTE

communications cell is not included in the neighbour cell set of the first LTE communications cell;

retrieving (115) the unique cell identity of the second LTE communications cell; and

reporting (117) the unique cell identity of the second LTE communications cell to the radio base station of the first LTE communications cell."

Claim 1 of **auxiliary request 18F** is identical to claim 1 of auxiliary request 18, except for:

- the insertion of a comma between "a unique cell identity" and "different to the non-unique cell identity" (at the fourth line of the claim);
- the insertion of ", in response to the reporting of the non-unique cell identity of the second communications cell," right after "receiving (113)".

Claim 1 of **auxiliary request 19** (labelled "AUXILIARY REQUEST 3.A") is identical to claim 1 of auxiliary request 18, except for the insertion of a comma between "a unique cell identity" and "different to the non-unique cell identity" (on the fourth line of the claim).

Claim 1 of **auxiliary request 20** (labelled "AUXILIARY REQUEST 3.B") is identical to claim 1 of auxiliary request 19, except for the addition of

"; and

wherein retrieving and reporting the unique cell identity is performed in response to receiving the request from the radio base station of the first LTE communications cell"

at the very end of the claim.

Claim 1 of **auxiliary request 21** (labelled "AUXILIARY REQUEST 3.C") is identical to claim 1 of auxiliary request 19, except for the insertion of

", wherein the second LTE communications cell is a non-serving cell for the mobile terminal"

right before "; retrieving (115)".

Claim 1 of **auxiliary request 22** (labelled "AUXILIARY REQUEST 3.D") is identical to claim 1 of auxiliary request 19, except for the insertion of

"for the mobile terminal"

right after "receiving (113) a request from the radio base station".

Claim 1 of **auxiliary request 23** (labelled "AUXILIARY REQUEST 3.E") is identical to claim 1 of auxiliary request 19, except for the insertion of

", wherein the second LTE communications cell is a new neighbour cell identified by the mobile terminal"

right before "; and reporting (117)".

Claim 1 of **auxiliary request 24** (labelled "Auxiliary Request 4") is identical to claim 1 of auxiliary request 18, except for the addition of

", to enable a transport connection to be

established with the newly discovered second communications cell"

at the very end of the claim.

Claim 1 of **auxiliary request 24F** is identical to claim 1 of auxiliary request 24, except for:

- the insertion of a comma between "a unique cell identity" and "different to the non-unique cell identity" (at the fourth line of the claim);

- the insertion of ", in response to the reporting of the non-unique cell identity of the second communications cell," right after "receiving (113)".

Claim 1 of **auxiliary request 25** (labelled "AUXILIARY REQUEST 4.A") is identical to claim 1 of auxiliary request 24, except for the insertion of a comma between "a unique cell identity" and "different to the non-unique cell identity" (at the fourth line of the claim).

Claim 1 of **auxiliary request 26** (labelled "AUXILIARY REQUEST 4.B") is identical to claim 1 of auxiliary request 25, except for the addition of

"; and

wherein retrieving and reporting the unique cell identity is performed in response to receiving the request from the radio base station of the first LTE communications cell"

at the very end of the claim.

Claim 1 of **auxiliary request 27** (labelled "AUXILIARY REQUEST 4.C") is identical to claim 1 of auxiliary request 25, except for the addition of

> ", wherein the second LTE communications cell is a non-serving cell for the mobile terminal"

right before "; retrieving (115)".

Claim 1 of **auxiliary request 28** (labelled "AUXILIARY REQUEST 4.D") is identical to claim 1 of auxiliary request 25, except for the insertion of

> "for the mobile terminal"

right after "receiving (113) a request from the radio base station".

Claim 1 of **auxiliary request 29** (labelled "AUXILIARY REQUEST 4.E") is identical to claim 1 of auxiliary request 25, except for the insertion of

> ", wherein the second LTE communications cell is a new neighbour cell identified by the mobile terminal"

right before "; and reporting (117)".

Claim 9 of **auxiliary request 30** (labelled "AUXILIARY REQUEST 5") reads as follows:

"A method for self configuring of cell neighbours in a wireless telecommunications system which comprises a plurality of communications cells in which a non-unique cell identity and a unique cell identity are transmitted, the method comprising:

communicating with a mobile terminal operating in a first communications cell requesting (111) the mobile terminal to retrieve the unique cell identity of a second communications cell;

receiving (119) the unique cell identity of the second communications cell from the mobile terminal; and

establishing by the first communications cell a transport connection by finding in a lookup map a mapping of the unique cell identity of the second communications cell with a network address of the radio base station that serves the second communications cell;

wherein the step of requesting the unique cell identity is preceded by the step of:

receiving (107) from the mobile terminal a non-unique cell identity of the second communications cell."

Claim 9 of **auxiliary request 30F** is identical to claim 9 of auxiliary request 30.

Claim 9 of **auxiliary requests 30G** and **30FG** is identical to claim 9 of auxiliary request 30, except for the deletion of "cell" right before "requesting (111)".

Claim 9 of **auxiliary request 31** (labelled "AUXILIARY REQUEST 6") reads as follows:

"A method for self configuring of cell neighbours in a LTE wireless telecommunications system which comprises

a plurality of LTE communications cells in which a non-unique cell identity and a unique cell identity are transmitted, the method comprising:

communicating with a LTE mobile terminal operating in a first communications cell requesting (111) the mobile terminal to retrieve the unique cell identity of a second communications cell;

receiving (119) the unique cell identity of the second communications cell from the mobile terminal; and

establishing by the first communications cell a transport connection by finding in a lookup map a mapping of the unique cell identity of the second communications cell with a network address of the LTE radio base station that serves the second communications cell;

wherein the step of requesting the unique cell identity is preceded by the step of:

receiving (107) from the mobile terminal a non-unique cell identity of the second communications cell."

Claim 9 of **auxiliary request 31F** is identical to claim 9 of auxiliary request 31.

Claim 9 of **auxiliary requests 31G** and **31FG** is identical to claim 9 of auxiliary request 31, except for the deletion of "cell" right before "requesting (111)".

Claim 5 of **auxiliary request 32** (labelled "AUXILIARY REQUEST 7") is identical to claim 9 of auxiliary

request 31, except for the addition of the following features at the very end of the claim:

";

wherein the non-unique cell identity as received has tied to it at least one operating parameter of the second communications cell comprising one or more of a signal strength measurement, a signal quality measurement, and timing information;

further comprising receiving unique cell identities for a plurality of further communications cells from the mobile terminal;

wherein said network address is an IP address;

wherein the method is performed by a LTE radio base station."

Claim 5 of **auxiliary request 32F** is identical to claim 5 of auxiliary request 32.

Claim 5 of **auxiliary requests 32G** and **32FG** is identical to claim 5 of auxiliary request 32, except for the deletion of "cell" right before "requesting (111)".

Claim 9 of **auxiliary request B1** is identical to claim 9 of auxiliary request 30, except for the addition of

", but not the unique cell identity of the second communications cell"

at the very end of the claim.

Claim 9 of **auxiliary request B1F** is identical to claim 9 of auxiliary request B1.

Claim 9 of **auxiliary requests B1G** and **B1FG** is identical to claim 9 of auxiliary request B1, except for the deletion of "cell" right before "requesting (111)".

Claim 9 of **auxiliary request B2** is identical to claim 9 of auxiliary request B1, except for the insertion of

> ", wherein the second communications cell is a new neighbour cell identified by the mobile terminal"

right after "receiving (119) the unique cell identity of the second communications cell from the mobile terminal".

Claim 9 of **auxiliary request B2F** is identical to claim 9 of auxiliary request B2.

Claim 9 of **auxiliary requests B2G** and **B2FG** is identical to claim 9 of auxiliary request B2, except for the deletion of "cell" right before "requesting (119)".

Claim 9 of **auxiliary request B3** is identical to claim 9 of auxiliary request B2, except for the insertion of "LTE" right before each of "wireless telecommunications system", "communications cells" and "mobile terminal operating" (at the first, second and fourth line, respectively).

Claim 9 of **auxiliary request B3F** is identical to claim 9 of auxiliary request B3.

Claim 9 of **auxiliary requests B3G** and **B3FG** is identical to claim 9 of auxiliary request B3, except for the deletion of "cell" right before "requesting (111)".

Claim 5 of **auxiliary request B4** is identical to claim 5 of auxiliary request 32, except for the insertion of:

", wherein the second communications cell is a new neighbour cell identified by the mobile terminal"

right after "receiving (119) the unique cell identity of the second communications cell from the mobile terminal" and the insertion of

", but not the unique cell identity of the second communication cell"

right after "receiving (107) from the mobile terminal a non-unique cell identity of the second communications cell".

Claim 5 of **auxiliary request B4F** is identical to claim 5 of auxiliary request B4.

Claim 5 of **auxiliary requests B4G** and **B4FG** is identical to claim 5 of auxiliary request B4, except for the deletion of "cell" right before "requesting (111)".

Claim 1 of **auxiliary request B5** is identical to claim 9 of auxiliary request 30.

Claim 1 of **auxiliary request B5G** is identical to claim 1 of auxiliary request B5, except for the deletion of "cell" right before "requesting (111)".

Claim 1 of **auxiliary request B6** is identical to claim 5 of auxiliary request 32.

Claim 1 of **auxiliary request B6G** is identical to claim 1 of auxiliary request B6, except for the deletion of "cell" right before "requesting (111)".

Claim 1 of **auxiliary request B7** is identical to claim 5 of auxiliary request B4.

Claim 1 of **auxiliary request B7G** is identical to claim 1 of auxiliary request B7, except for the deletion of "cell" right before "requesting (111)".

Reasons for the Decision

1. MAIN REQUEST

Claim 1 as granted comprises the following limiting features (board's outline):

A method for operating a mobile terminal in a wireless telecommunications system which defines a plurality of communications cells in which a non-unique cell identity and a unique cell identity are transmitted, the method comprising:

(a) communicating with a radio base station which serves a first communications cell;

(b) receiving a request from the radio base station to retrieve the unique cell identity of a second communications cell among the plurality of communications cells;

(c) retrieving the unique cell identity of the second communications cell;

(d) reporting the unique cell identity of the second communications cell to the radio base station of the first communications cell.

1.1 Claim 1 - added subject-matter (Articles 100(c) and 76(1) EPC)

1.1.1 In point II.A.3 of the decision under appeal, the opposition division considered that the earlier application as filed required the retrieval and reporting by the mobile terminal of the "non-unique cell identity" of the second communications cell as a necessary *pre-condition* for the subsequent determination by the network (i.e. the base station in the serving first cell) whether or not to instruct the mobile terminal to detect and report the unique cell identifier. The omission of the corresponding features in the independent claims extended their subject-matter beyond the content of the earlier application as filed, contrary to Article 76(1) EPC.

1.1.2 Opponent 2 and opponent 3 agreed with the opposition division that there was no basis in the earlier application for the steps involving the "request" and the "unique cell identity" without the following three preconditions: (i) the non-unique cell ID of the second communications cell is retrieved, (ii) the non-unique cell ID is reported by the mobile terminal to the base station, and (iii) the detected non-unique cell ID is not included in a neighbouring cell set.

1.1.3 The proprietor argued as follows:

i) Pre-conditions not in "summary section" of earlier application

The sentence "The present invention ... is based on an extra step ..." in the "summary section" of the earlier application (cf. page 2, lines 26-27) directly and unambiguously emphasised the "step" as such, which was indeed explicitly defined as involving "to identify uniquely neighbouring cells in the radio network and that the identities are reported from the mobile terminal to the network". This sentence did not provide details regarding the mentioned "extra step", and even less that whatever features or steps were meant by "extra step" were then to be understood as contributing to the solution or even constituting mandatory pre-conditions for the actual "step". In this particular case, the *summary section* did not mention the acquisition and reporting of the non-unique cell IDs at all, let alone as *mandatory* pre-conditions.

ii) Pre-conditions not in original independent claims of earlier application

The original independent claims 1, 9, 16 and 20 did not include a feature directed to the non-unique cell ID at all. Even less did these original independent claims disclose the acquisition and reporting of the non-unique cell ID. Even more so, these original independent claims failed to define these non-disclosed steps related to the non-unique cell ID as being mandatory pre-conditions for any of the features of the subject-matter of these original independent claims. In addition, a "scrambling code", which was an exemplary implementation of a non-unique cell ID (cf. page 2, lines 1-3 of the earlier application), was only mentioned in an original dependent claim of the earlier application, such as in dependent claim 10. Consequently, the skilled person would have obtained the direct and unambiguous disclosure that a non-unique

cell ID was not central to the solution, but rather a possibly advantageous, but non-mandatory, additional feature.

iii) Pre-conditions not essential for solving technical problem

The underlying problem of reducing the cost of planning and maintaining neighbour cell sets and manual intervention (cf. page 2, lines 26-30 of the earlier application) was solved based on the unique cell ID and in fact independently from the non-unique cell ID (cf. page 5, lines 4-6 and page 2, lines 19-22). The acquisition and reporting of the non-unique cell ID might contribute to another advantage of facilitating an efficient resource usage for the mobile terminals, because the non-unique cell ID was fast and demanding less resources (cf. page 5, lines 6-11). However, this was a different problem than the one identified by the earlier application for the solution described in the "summary section" and in the original independent claims. The actually underlying problem of reducing the manual intervention would have been solved by the use of the unique cell ID, not by the use of the non-unique cell ID.

iv) No pre-conditions for audit or relation between non-unique and unique cell IDs

The earlier application also disclosed requesting the mobile terminal to retrieve the more cumbersome unique cell ID

> "when an audit of the relation between the non-unique and unique cell identity seems appropriate".

For such an audit, the previous determining and reporting of the non-unique cell ID was not a mandatory pre-condition. The earlier application did not disclose that, for an audit, the previous determining and reporting of the non-unique cell ID was a *mandatory* pre-condition for receiving a request to retrieve the unique cell ID. Furthermore, for an audit, there was no technical reason that determining and reporting of the non-unique cell ID were pre-conditions for the (transmission or receiving) of the request for retrieving the unique cell ID. Rather, the audit might be initiated at a suitable point in time, independently from, e.g. without, the alleged previous determining and reporting of the non-unique cell ID.

v) Pre-condition (iii) not to be admitted in appeal proceedings

The proprietor also submitted that the "allegation" of opponents 2 and 3 in their respective reply to the statement of grounds of appeal of an absence of "the third pre-condition" in the claims of the main request constituting added subject-matter was new in the sense that it had not been raised before in the proceedings. The proprietor requested that this "objection" not be admitted into the appeal proceedings.

1.1.4 The board concurs with the opposition division and with opponents 2 and 3, for the following reasons:

The board notes upfront that, in the assessment of compliance with Article 76(1) EPC, the board applies the "gold standard" rather than the superseded "essentiality test". Thus, whether or not the features in question are relevant or essential for the claimed invention is not the decisive criterion for such an

assessment. What counts is whether the skilled reader is presented with new technical information following the amendment (see e.g. T 1869/17, Reasons 3.4).

The starting point in the earlier application as filed is an existing system, such as a WCDMA system, in which (cf. page 2, lines 32-33 of the earlier application as filed):

> "[...] the mobile terminal detects Common Pilot Channel (CPICH) transmissions from surrounding cells, in order to determine id (scamble code) and timing information.
>
> When the mobile reports the neighbour cell signal quality measurements to the network, the cells' respective identities become important. Currently, cell identities (scramble code) are reused for more than one cell. The reuse of identities means that cells may be confused with one other, since the serving cell may have neighbour cells having the same identity information."

The earlier application as filed identifies a number of technical problems in this specific context, as correctly identified by the proprietor: to reduce manual intervention (cf. page 2, line 30) and to facilitate efficient resource usage within mobile terminals and rapid handover to the neighbour cells (cf. page 5, lines 7-8). All of these problems are intrinsically related to the fact that (non-unique) cell IDs, such as the "scramble code", are reused for more than one cell. This is made apparent at page 2, lines 19-22 of the earlier application:

> "Since the cells' physical layer identifiers are non-unique, populating and maintaining the neighbour cell sets can never be fully automatic. Human efforts are needed to resolve conflicts where the serving cell has multiple neighbours using the same non-unique identifier."

It is only because serving cells may have neighbour cells having the same (non-unique) ID information that human efforts are needed, resource usage within mobile terminals becomes inefficient and handover slow. The invention as disclosed by the earlier application as filed cannot be reduced to having a mobile terminal report the unique cell ID of neighbouring cells to the base station with which it communicates. Rather, the invention lies in the combined use of non-unique and unique cell IDs under specific circumstances in accordance with the disclosure of page 4, line 5 to page 5, line 2 and Figs. 4 to 6. Specifically, as far as the method carried out *by the mobile terminal* is concerned, page 4, lines 11-13 discloses that:

> "A method embodying the present invention will now be described with reference to the flowcharts of Figures 3 to 6 as well as Figure 2. Figure 3 illustrates steps to be carried out by the mobile terminal 4. The first step of the method is step 101 in which the mobile terminal 4 determines parameter measurements for surrounding cells. Next, the mobile terminal reports the measurement information to the base station (step 103). [...]
>
> When the unique cell identity has been retrieved (step 115), this information is transmitted to the serving cell (step 117) [...]".

Accordingly, the steps carried out by the mobile terminal are depicted as: "DETERMINE SURROUNDING CELL MEASUREMENTS 101" and "TRANSMIT DETERMINED MEASUREMENTS 103" in Fig. 3 as well as "DETERMINE IDENTITY INFORMATION 115" and "TRANSFER IDENTITY INFORMATION 117" in Fig. 5.

The earlier application as filed discloses a method in which the content of the information reported by the mobile terminal causes the base station to request the retrieval of the unique cell ID, see Fig. 5: "RECEIVE MONITOR INSTRUCTION 113" and page 4, lines 13-16:

> "[...] If the information from the mobile terminal 4 contains measurements from a cell identity that previously is not a member of the neighbouring cell set, the mobile terminal 4 may be requested to also retrieve the unique cell identity (step 113) [...]",

as well as an example in which an instruction to do so is not needed, cf. page 4, lines 28-30:

> "The mobile terminal 4, in another example, may provide the unique identity information to the base station 2, without the need to receive an instruction to do so from the base station 2."

This confirms that the earlier application as filed focuses on how *non-unique* and *unique* cell IDs are combined rather than on an isolated retrieval of the unique cell IDs. Conversely, claim 1 as granted merely proposes a method in which a mobile terminal communicating with a base station which serves a first communications cell receives a request from the base station to retrieve the unique cell ID of a second

communications cell, retrieves it and reports it to the radio base station of the first communications cell. The omission of the original context in claim 1 as granted thus results in subject-matter that the skilled person would not directly and unambiguously derive from the earlier application as filed.

1.1.5 With respect to the proprietor's arguments, the board makes the following observations:

i) The summary of the invention

The "SUMMARY OF THE PRESENT INVENTION" starting at page 2, line 24 of the earlier application as filed is immediately preceded by the "BACKGROUND OF THE INVENTION" and, in particular, by the statements relating to the WCDMA technology discussed in point 1.1.4 above (cf. page 1, line 33 to page 2, line 22 of the earlier application as filed). In this context, it is immediately apparent that both "extra step" and "additional effort" refer to the technologies previously introduced.

ii) The claims of the earlier application as filed

The claims of the earlier application as filed taken alone cannot provide a basis for claim 1 as granted. If anything, the fact that some of the features of claim 1 of the earlier application as filed are not present in claim 1 as granted, i.e. "determining at least one operating parameter for a second communications cell" and "reporting parameter information relating to the or each operating parameter for the second communications cell to the radio base station of the first communications cell" corroborates that the original context is missing from claim 1 as granted. Besides,

claim 1 of the earlier application as filed discloses "detecting unique cell identifier information", whereas claim 1 as granted refers to "retrieving the unique cell identity".

iii) The technical problem

As explained in point 1.1.4 above, all the technical problems mentioned in the earlier application as filed are intrinsically related to the fact that (non-unique) cell IDs, such as the "scramble code", are reused for more than one cell.

iv) The "audit embodiment"

The board is not convinced that the mention of the possibility to retrieve the unique cell ID "when an audit of the relation between then non-unique and unique cell identity seems appropriate" at page 5, lines 10-11 of the earlier application as filed should automatically qualify as "an embodiment of the invention". This sentence can also mean that, in addition to the known possibility of requesting the unique cell ID for audit purposes, the earlier application proposes to retrieve it "when a new neighbour is detected", in accordance with the preceding disclosure of page 4, lines 13-15 ("... If the information from the mobile terminal 4 contains measurements from a cell identity that previously is not a member of the neighbouring cell set ..."). Even if considered as "an embodiment", this sentence is the only mention of an "audit" in the earlier application as filed. It cannot be inferred therefrom whether the non-unique cell ID to be audited is determined and reported by the mobile terminal beforehand or whether this information is obtained from elsewhere.

v) Admittance of opponents' "allegation" into the appeal proceedings

The "allegation" of opponents 2 and 3 that the absence of "the third pre-condition" in the claims of the main request constituted added subject-matter (cf. written reply to the appeal, points 12 and 13) is, in the board's view, nothing more than support for the conclusion already drawn by the opposition division in its appealed decision (see points II.A.3.1.4 and II.A. 3.1.5). The opponents' submissions in this respect thus form part of the basis of these appeal proceedings which the board takes into account (cf. Article 12(1) (a) and (c) RPBA 2020).

1.1.6 In conclusion, the subject-matter of claim 1 extends beyond the content of the earlier application as filed, contrary to the requirements of Article 76(1) EPC.

1.2 It follows that the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted (main request).

2. AUXILIARY REQUESTS 6, 12, 18, 24

In claim 1 of each of auxiliary requests 6, 12, 18 and 24, **feature (c)** has been replaced as follows (board's outline and highlighting indicating amendments):

(e) subsequent to determining and reporting the non-unique cell ID of a second [LTE] communications cell to the radio base station that serves the first [LTE] communications cell, receiving (113) a request from the radio base station to also retrieve the unique cell ID of the second communications cell among the plurality of

communications cell if the second [LTE] communications cell is not included in the neighbour cell set of the first [LTE] communication cell;

2.1 Claim 1 - Added subject-matter (Article 76(1) EPC)

2.1.1 **Feature (e)** merely establishes a *temporal* relationship between the determination and reporting of the non-unique cell ID and the receipt of a request to retrieve the unique cell ID, rather than a *causal* one. The objection set out in point 1.1.4 above applies *mutatis mutandis* to claim 1 of each of **auxiliary requests 6, 12, 18 and 24.**

2.1.2 The proprietor submitted the following arguments:

i) No causal relationship disclosed in earlier application

The "summary section" did not even disclose the acquiring and reporting of the non-unique cell ID. In addition, the "summary section" of the earlier application also failed to disclose the request from the radio base station for retrieving the unique cell ID. In addition, the detailed description also failed to disclose such a causal relationship between the determining/reporting of the non-unique cell ID and the receipt of the request to retrieve the unique cell ID. For instance, the detailed application disclosed at least two cases where the request to retrieve the unique cell ID was transmitted by the radio base station to the mobile terminal, including page 4, lines 11-16 and page 5, lines 8-11. In neither of those sections of the earlier application, a *causal* relationship between the determining and reporting of

the non-unique cell ID and the receipt of the request was disclosed. On the contrary, a *temporal* relationship was disclosed in the sense that the determining and reporting of the non-unique cell ID explained at lines 11-13 of page 4 occurred before the request to the mobile terminal to retrieve the unique cell ID explained at lines 13-16. This temporal relationship was reflected by feature (e)'s expression "subsequent to".

ii) Causal relationship not technically essential

Furthermore, such a causal relationship was also neither technically accurate nor essential. In the above-mentioned two cases, the radio base station caused the transmission of the request to the mobile terminal, but not the mobile terminal. For the case of a new neighbour cell, the previous determination and reporting of the non-unique cell ID was a possible previous step, but failed to be an actual cause of the transmittal of the request to retrieve the unique cell ID. Rather, the transmission of the request to retrieve the unique cell ID could be caused e.g. by the result of the determination at the radio base station that a cell is a new cell of the "neighbouring cell set". The determination and reporting of the non-unique cell ID by the mobile terminal did not need to result in a receipt of a request. In the case where the non-unique cell ID was transmitted to the radio base station, but where said non-unique cell ID identified a communications cell that was already a member of the neighbour cell set, no request to retrieve the unique cell ID would be received by the mobile terminal. Therefore, the alleged causal relationship in fact did not exist according to the earlier application. For the other disclosed scenario of an audit, the previous

receipt of a non-unique cell ID was not even a pre-condition according to the earlier application, let alone a cause of the transmittal of the request. Rather, the decision (e.g. at the radio base station) to perform an audit could be considered as the cause of transmitting the request to retrieve the unique cell ID. From the view point of the mobile terminal, the mobile terminal simply did not know whether the determining and reporting of the non-unique cell ID indeed would result in the receipt of the request to retrieve the unique cell ID, because the transmission of the request by the radio base station was based on further requirements, such as the receipt of the non-unique cell ID at the radio base station and the further decision of the radio base station (e.g. deciding that the cell is a new cell). Consequently, there was no direct cause-effect relationship in addition to the conditional relationship between the determining and reporting of the non-unique cell ID and the receipt of the request, for the operation of a mobile terminal.

2.1.3 These arguments are not convincing, for the following reasons:

According to the disclosure of page 4, line 5 to page 5, line 2 and Figs. 4 to 6 of the earlier application as filed, in the method carried out by the mobile terminal, the receipt of a request from the radio base station to retrieve the unique cell ID of the second communications cell (corresponding to **feature (b)** in claim 1) must be preceded by the determination and reporting of specific information, i.e. *measurements from a (non-unique) cell ID that previously is not a member of the neighbouring cell*. This specific information comprises at least the third

pre-condition mentioned by opponents 2 and 3. As far as the mobile terminal is concerned, it is a fact that the report contains specific information which establishes the causal link with an ulterior receipt of the request by the mobile terminal. As acknowledged by the proprietor, if this specific information is not reported by the mobile terminal, no request is received by the mobile terminal. In the earlier application as filed, the first base station, and not the mobile terminal, determines whether or not the second communications cell is included in the neighbour cell set of the first communications cell and whether a request to retrieve the unique cell ID of the second communications cell should be sent. The result of this determination at the base station is not arbitrary. Rather, it is a *direct* consequence of the specific information received from the mobile terminal.

Moreover, **feature (e)** does not convey the same technical content as the earlier application as filed. On the contrary, the fact that the condition "if the second [LTE] communications cell is not included in the neighbour cell set of the first [LTE] communication cell" is included as part of the method carried out at the mobile terminal suggests that, after an arbitrary subsequent receipt of the request from the basis station, it is the mobile terminal which determines whether or not the unique cell ID of the second communications cell is to be retrieved. Furthermore, the arguments relating to the "audit embodiment" are not convincing for the reasons already set out in point 1.1.5 iv) above.

2.2 None of auxiliary requests 6, 12, 18 and 24 is thus allowable under Article 76(1) EPC.

3. AUXILIARY REQUESTS 1-5, 7-11, 13-17, 19-23, 25-29

3.1 Admittance into the appeal proceedings (Article 12(4) RPBA 2007)

3.1.1 **Auxiliary requests 1 to 5, 7 to 11, 13 to 17, 19 to 23** and **25 to 29** were not admitted into the opposition proceedings, and this non-admittance was contested by the proprietor when, in 2019, re-submitting them with the statement of grounds of appeal.

3.1.2 In accordance with Article 12(4) RPBA 2007, applicable according to Article 25(2) RPBA 2020, the board has the power to hold inadmissible requests which were not admitted in the first instance proceedings. The proprietor submitted that the opposition division's conclusions regarding Articles 76(1) and 84 EPC were not justified and erroneous.

3.1.3 The admittance of those requests was at the opposition division's discretion pursuant to Article 123(1) EPC and Rules 79(1) and/or 81(3) EPC (rather than Article 114(2) EPC). A board should overrule such a discretionary decision only if the wrong principles were applied or if the decision was taken in an unreasonable way.

This is not the case here. In respect of all claim requests in issue, the opposition division assessed "*prima facie* allowability" which is an established criterion as regards admittance (cf. appealed decision, points II.B.4, II.D.6.3, II.E.7 and II.F.8).

As regards the right to be heard, the opposition division informed the proprietor that auxiliary requests 1 to 5 did not seem to overcome the

outstanding objection under Article 76(1) EPC, and the proprietor acknowledged that those auxiliary requests presented the same deficiencies as the main request (cf. pages 5 and 6 of the minutes of the oral proceedings). With respect to auxiliary requests 7 to 11, 13 to 17, 19 to 23 and 25 to 29, the proprietor was additionally given the opportunity to refute the objections under Article 84 EPC raised by opponent 2 (cf. minutes, page 9, first paragraph).

3.1.4 The board sees therefore no reason to overrule the opposition's discretionary decision.

3.2 Consequently, auxiliary requests 1 to 5, 7 to 11, 13 to 17, 19 to 23 and 25 to 29 were not admitted into the appeal proceedings (Article 12(4) RPBA 2007).

4. AUXILIARY REQUEST 30

Claim 9 of auxiliary request 30 includes *inter alia* the following amendment vis-à-vis claim 11 as granted (board's highlighting indicating amendments):

(1) "communicating with a mobile terminal operating in a first communications cell requesting (111) the mobile terminal to retrieve the unique cell identity of a second communications cell;"

(2) "establishing by the first communications cell a transport connection by finding in a lookup map a mapping of the unique cell identity of the second communications cell with a network address of the radio base station that serves the second communications cell;".

4.1 Claim 9 - amendments (Rule 80 EPC)

4.1.1 The opposition division stated in point II.G.9, third bullet point, page 28 of the decision under appeal the following:

> "*former Claims 11 and 12 are combined in the amended independent* ***Claim 9****, which is additionally modified to specify that the transport connection is established 'by the first communication* [sic] *cell', as required by the disclosure of the (parent) application as filed (on page 4, lines 21-23; see the above paragraph 4.2), and to provide an antecedent for 'the first communication* [sic] *cell' with the addition of the word 'cell' in the 'communicating'-step, so to avoid a clarity problem;*",

and concluded in point II.G.9.1, page 28 that specifying in independent claim 9 that the transport connection was established by the first communication cell addressed outstanding issues under Article 76(1) EPC. Thus, an "attempt to overcome a ground of opposition" could be recognised in connection with the amendments introduced in this auxiliary request.

4.1.2 The board agrees with opponents 2 and 3 that the addition of the word "cell" in the first step of claim 9 is indeed not occasioned by a ground of opposition, contrary to the requirements of Rule 80 EPC. A clarity problem was already present in the first step of granted claim 11, which reads as follows:

> *"communicating with a mobile terminal operating in a first communications requesting (111) the mobile*

terminal to retrieve the unique cell identity of a second communications cell;"

The formulation of this step rendered the claim unclear, since "operating in a first communications" is syntactically confusing and ambiguous as regards its interpretation. It follows that the addition of "cell" does not constitute a further technical limitation that could be deemed "occasioned by a ground for opposition", but rather a mere *clarification* of an expression which was already unclear in the granted claim on which the amendments were made.

4.1.3 The proprietor's arguments were as follows.

The disputed amendment had the two results that

1) it provided the required antecedence basis for the subsequently introduced feature of "the first communications cell", and

2) it clarified the feature "first communications" as such, which was already unclear in the granted claims.

Without any doubt, the proprietor's intention was the *first* result, as clearly apparent from the decision. Thus, the disputed amendment was occasioned by the introduction of the subsequent feature and, as a result, by a ground for opposition under Article 100(c) EPC. Rule 80 EPC did not prohibit a further result, namely the clarification of an expression that was already unclear in the granted claims. In the present case, the amendment to the communications step, i.e. "first communications cell", arose clearly from the introduction of the "by the first communications cell"

in the establishing step, which in turn arose clearly out of a ground for opposition.

4.1.4 The board is not persuaded, for the following reasons:

The board does not dispute that amendment (2) is occasioned by a ground for opposition. The board also concedes that amendment (1) prevents a potential clarity problem of the claim as a whole. However, these two facts do not lead to the proprietor's conclusion that amendment (1) must therefore *also* be occasioned by a ground for opposition. The "clarity problem to be avoided" is not inherent to the ground of opposition occasioning amendment (2). Rather, it originates exclusively from the specific formulation chosen by the proprietor for the amendment, which requires the presence of an antecedent to be clear. In consequence, amendment (1) merely seeks to *tidy up* and *improve* the disclosure of the patent without being actually demanded by any ground for opposition mentioned under Article 100(c) EPC.

4.2 It follows that auxiliary request 30 is not allowable under Rule 80 EPC.

4.3 Claim 9 - request for correction under Rule 139 EPC

4.3.1 The proprietor further submitted that it was obvious that the expression "first communications" in the second sentence of granted claim 11 was incomplete and therefore erroneous, as apparent from the expression as such and from the structure of the sentence. In particular, granted claim 11 introduced "a plurality of communications cells" as well as "a second communications cell". However, granted claim 11 did not include the complete expression "first communications

cell", but rather only the incomplete expression "first communications". Consequently, the skilled person would have concluded immediately that the expression "first communications" was intended to mean "first communications cell" so as to be in accordance with the remaining features of claim 11. The skilled person would also have taken into account the patent disclosure as a whole, including the remaining granted claims. Independent claim 17, for instance, corresponded to claim 11 and included the same corresponding feature "communicate with a mobile terminal operating in a first communications cell". The proprietor then requested to correct the above mistake to read "first communications cell", in accordance with the amendment of claim 9 introduced by auxiliary request 30.

4.3.2 The board is not convinced. Rule 139, second sentence, EPC requires the following:

> "However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction."

In the case at hand, the board does not consider the alleged correction as being obvious within the meaning of Rule 139 EPC. For instance, paragraph [0003] of the opposed patent mentions that:

> "[...] The controller of the mobile terminal 4 serves to control communications with the base station 2 via the transceiver 46 and antenna 48, over the air interface 6 [...]".

In this respect, "a first communications" could also have been intended e.g. to refer to "a first communication (with a first communications cell)", "a first communications connection (with a first communications cell)" or "a first communications session (with a first communications cell)", to name a few. It is irrelevant which of the possibilities should be considered more likely, as long as there is a reasonable expectation that something else could have been intended.

4.4 Consequently, the proprietor's request for correction of claim 9 under Rule 139 EPC was refused.

5. AUXILIARY REQUESTS 31, 32, B1, B2, B3, B4, B5, B6 and B7

5.1 Amendments (Rule 80 EPC)

The objection set out in point 4.1 above applies *mutatis mutandis* to claim 9 of **auxiliary request 31**, to claim 5 of **auxiliary request 32**, to claim 9 of each of **auxiliary requests B1**, **B2** and **B3**, to claim 5 of **auxiliary request B4** and to claim 1 of each of **auxiliary requests B5**, **B6** and **B7**.

5.2 None of the auxiliary requests 31, 32, B1, B2, B3, B4, B5, B6 and B7 is thus allowable under Rule 80 EPC.

5.3 Requests for correction under Rule 139 EPC

5.3.1 The proprietor also requested correction of the mistake in granted claim 11 (cf. point 4.3.1 above) to read "first communications cell" under Rule 139 EPC also made in claim 9 of auxiliary request 31, claim 5 of auxiliary request 32, claim 9 of each of auxiliary

requests B1, B2 and B3, claim 5 of auxiliary request B4 and claim 1 of each of auxiliary requests B5, B6 and B7.

5.3.2 However, the reasoning set out in point 4.3 above applies *mutatis mutandis* to each of those requests.

5.4 Therefore, the proprietor's requests for correction under Rule 139 EPC concerning the auxiliary requests 31, 32, B1, B2, B3, B4, B5, B6 and B7 were also refused.

6. AUXILIARY REQUESTS 6F, 12F, 18F, 24F, 30F, 31F, 32F, B1F, B2F, B3F, B4F, 30G, 31G, 32G, B1G, B2G, B3G, B4G, B5G, B6G, B7G, 30FG, 31FG, 32FG, B1FG, B2FG, B3FG AND B4FG

6.1 Admittance into the appeal proceedings (Article 13(2) RPBA 2020)

6.1.1 The claim sets of the following auxiliary requests:

- 6F, 12F, 18F, 24F, 30F, 31F, 32F, B1F, B2F, B3F, B4F ("the **F series**"),

- 30G, 31G, 32G, B1G, B2G, B3G, B4G, B5G, B6G, B7G ("the **G series**"), and

- 30FG, 31FG, 32FG, B1FG, B2FG, B3FG and B4FG ("the **FG series**")

were filed after notification of the summons to oral proceedings before the board.

6.1.2 Hence, the matter of their admittance is governed by Article 13(2) RPBA 2020, according to which any

amendment to a party's appeal case is, in principle, not taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned. Additionally, at the stage of appeal proceedings when Article 13(2) RPBA 2020 applies, the board may, in its exercise of discretion, also rely on criteria mentioned in Article 13(1) RPBA 2020, such as *prima facie* allowability, and in Article 12(4) RPBA 2020, e.g. the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy.

6.1.3 As to auxiliary requests 6F, 12F, 18F, 24F, it is immediately apparent that the mere insertion in claim 1 of ", in response to the reporting of the non-unique cell identity of the second communications cell," right after "receiving (113)" does not change the fact that the condition "if the second [LTE] communications cell is not included in the neighbour cell set of the first [LTE] communication cell" is still included as part of the method carried out at the mobile terminal (cf. point 2.1.3 above). It follows that these claim requests are not clearly allowable under Article 76(1) EPC.

6.1.4 In the other requests of the F series,

- claim 9 of auxiliary request 30F is identical to claim 9 of auxiliary requests 30,

- claim 9 of auxiliary request 31F is identical to claim 9 of auxiliary request 31,

- claim 5 of auxiliary request 32F is identical to claim 5 of auxiliary request 32,

- claim 9 of auxiliary requests B1F is identical to claim 9 of auxiliary request B1,

- claim 9 of auxiliary requests B2F is identical to claim 9 of auxiliary request B2,

- claim 9 of auxiliary requests B3F is identical to claim 9 of auxiliary request B3,

- claim 5 of auxiliary requests B4F is identical to claim 5 of auxiliary request B4.

Thus, none of these requests is clearly allowable under Rule 80 EPC (cf. points 4.1 and 5.1 above).

6.1.5 As regards the G and FG series, "cell" has been deleted from "operating in a first communications cell" in the respective independent claim addressing "a method for self configuring of cell neighbours".

The proprietor submitted that:

- these claim requests constituted a legitimate response to, *inter alia*, the objection under Rule 80 EPC raised by the board in its preliminary opinion,

- the proprietor could not have been reasonably expected to submit amended set of claims to address the objection under Rule 80 EPC in the statement of grounds of appeal, because the appealed decision was favourable to the proprietor in said respect,

- the amendment involved low complexity, and how to overcome the objection under Rule 80 EPC was immediately apparent, which would not create an undue burden on the opponent and the board, and

- no further objections were caused and the admittance of these requests would not be detrimental to the procedural economy.

6.1.6 During the opposition proceedings, the proprietor filed no less than thirty-two auxiliary requests. With the statement of grounds of appeal, the proprietor filed seven additional auxiliary requests. In response to the board's preliminary opinion, and without withdrawing any of the **forty** claim requests already on file, the proprietor filed another **twenty-eight** auxiliary requests. Eleven of those claim requests (the F series) ostensibly fail to address all the objections raised, as indicated above.

The board does not consider the filing of twenty-eight auxiliary requests in response to the board's preliminary opinion as an appropriate reaction. The proprietor's piecewise approach in the course of the appeal proceedings put opponent 2 and the board under an undue burden and held back a complete discussion of all the pending topics within a reasonable time frame. Those topics could have been addressed much earlier in the appeal proceedings, had the proprietor filed and/or maintained less, and more focused, claim requests at an earlier stage. Rather than overcoming *all* the issues raised in the appeal proceedings without giving rise to *new* objections, the new claim requests fanned out so as to create a complex matrix of fallback positions. This is clearly contrary to procedural efficiency, approaching "abuse", even more so if account is taken

that every single claim of each claim request should ultimately meet the requirements of the EPC. Furthermore, claim requests B5G, B6G and B7G contain *network*-side claims exclusively, for which novelty and inventive step where never discussed during opposition proceedings. If admitted into the appeal proceedings, they would constitute a "fresh case".

6.2 Thus, the board did not admit any of the auxiliary requests of the F, G and FG series into the appeal proceedings (Article 13(2) RPBA 2020).

7. Since there is no allowable claim request on file, 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