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**Datasheet for the decision  
of 21 January 2021**

**Case Number:** T 1081/19 - 3.5.03

**Application Number:** 07713807.1

**Publication Number:** 1989829

**IPC:** H04W76/00

**Language of the proceedings:** EN

**Title of invention:**

Communication apparatus and method

**Applicant:**

CANON KABUSHIKI KAISHA

**Headword:**

Controlling participation in a wireless network/CANON

**Relevant legal provisions:**

EPC Art. 123(2), 116(1)

**Keyword:**

Decision in written proceedings: no oral proceedings requested  
Added subject-matter - (yes): unallowable generalisation

**Decisions cited:**

G 0002/10



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Case Number: T 1081/19 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 21 January 2021**

**Appellant:** CANON KABUSHIKI KAISHA  
(Applicant) 3-30-2, Shimomaruko  
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Tokyo 146-8501 (JP)

**Representative:** Canon Europe Limited  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 6 December 2018  
refusing European patent application  
No. 07713807.1 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chair** K. Bengi-Akyürek  
**Members:** J. Eraso Helguera  
R. Winkelhofer

## Summary of Facts and Submissions

- I. The appeal was lodged by the applicant against the decision of the examining division refusing the present European patent application for added subject-matter (Article 123(2) EPC) with respect to the claims of a main request.
- II. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the **main request** subject to the decision.
- III. No oral proceedings were requested, so that the decision can be handed down in writing (cf. Article 116(1) EPC).
- IV. Claim 1 of the **main request** reads as follows:

"A communication apparatus comprising:

a first probing unit adapted to probe (S602) for a predetermined communication partner;

a second probing unit adapted to probe for another communication apparatus that transmits a signal including a predetermined network identifier (SSID) in a case that the predetermined communication partner is not detected;

a comparison unit adapted to compare (S610 to S611) an identifier (BSSID) received from said another communication apparatus and an identifier (BSSID) regarding said communication apparatus in a case that said another communication apparatus is detected by said second probing unit; and

a control unit adapted to control participation (S613) in a first wireless network formed

by said another communication apparatus in a case that a value represented by the identifier (BSSID) regarding said communication apparatus is smaller than a value represented by the identifier (S611, YES) received from said another communication apparatus, and to perform a predetermined communication with said another communication apparatus in a second wireless network formed by said communication apparatus in a case that a value represented by the identifier (BSSID) regarding said communication apparatus is larger than a value represented by the identifier (BSSID) received from said another communication apparatus (S611, NO)."

## Reasons for the Decision

### 1. MAIN REQUEST

Claim 1 of the **main request** comprises the following limiting features (board's outline and emphasis):

A communication apparatus comprising:

- (a) a first probing unit adapted to probe for a predetermined communication partner;
- (b) a second probing unit adapted to probe for another communication apparatus that transmits a signal including a predetermined network identifier in a case that the predetermined communication partner is not detected;
- (c) a comparison unit adapted to compare an identifier received from said another communication apparatus and an identifier regarding said communication apparatus in a case that said another communication apparatus is detected by said second probing unit; and

- (d) a control unit adapted to control participation in a first wireless network formed by said another communication apparatus in a case that a value represented by the identifier regarding said communication apparatus is smaller than a value represented by the identifier received from said another communication apparatus, and
- (e) to perform a predetermined communication with said another communication apparatus in a second wireless network formed by said communication apparatus in a case that a value represented by the identifier regarding said communication apparatus is larger than a value represented by the identifier received from said another communication apparatus.

1.1 *Added subject-matter (Article 123(2) EPC)*

1.1.1 In the decision under appeal, the examining division considered that the generalisation resulting from the use of the expressions "network identifier" and "identifier" in claim 1 instead of "SSID" and "BSSID" as disclosed in the description, in particular in Figure 6 and the associated text, infringed Article 123(2) EPC.

1.1.2 The appellant submitted that the use of "predetermined network identifier", "identifier received from said another communication apparatus" and "identifier regarding said communication apparatus" in claim 1 found basis in paragraph [0157], which explicitly referred to a wider application outside of IEEE 802.11 networks, and in the claims of the application as originally filed, where the BSSID and SSID were referred to as "a first network identifier and a second network identifier", which mirrored the "identifier"

language used in the description when introducing the BSSID and SSID.

Looking at the claims of the present application as filed and in particular at paragraph [0157], the skilled person would not think that the invention was intended to be limited to an IEEE 802.11 system. Further, the skilled person knew, using common general knowledge as regards network communication protocols, that identifiers were referred to differently in different standards.

- 1.1.3 This is not convincing. Whilst it is true that the original claims of the present application generally refer to a first and a second network identifier, present claim 1 has been further amended by introducing features which appear only in one embodiment of the underlying description, namely the probe units of features (a) and (b) and the specific conditions imposed on the identifiers in features (d) ("smaller than") and (e) ("larger than").

In line with the "gold standard" according to G 2/10 (OJ 2012, 376), the question at stake is whether the skilled person would derive this subject-matter directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application documents as filed; in other words, whether the skilled person would directly and unambiguously understand that the probe units of features (a) and (b) and the conditions of features (d) and (e) are generally applicable, or rather whether those specific features are only disclosed in combination with specific instances of the claimed identifiers, i.e. the SSID and BSSID of IEEE 802.11 networks.

1.1.4 Paragraph [0157] of the original application reads:

"Further, the present invention is applicable also to all wireless communication schemes such as a 802.11 wireless LAN, Bluetooth, UWB, wireless USB, wireless 1394 and Wimax. In addition, the present invention is applicable not only to wireless communication but also to wired communication."

The above question can only be answered affirmatively if the general applicability explicitly mentioned in this paragraph reveals itself as a direct and unambiguous task for every choice of known technology to which this teaching should be applied. At the very least, it should be directly and unambiguously derivable which identifiers, other than SSID and BSSID, should be used when the claimed subject-matter is embodied in one of the additional technologies specifically mentioned in paragraph [0157], i.e. Bluetooth, UWB, wireless USB, wireless 1394, Wimax. Otherwise, the disclosure of the above paragraph [0157] is to be deemed purely speculative. The appellant's assertions are not supported by detailed examples showing how this teaching should be extended to other technologies.

1.1.5 The task of adapting the specific teachings of the embodiment in the present description to other technologies requires a series of considerations which go beyond what is directly and unambiguously derivable for the skilled person, such as recognising whether the claimed identifiers can be mapped to identifiers already *existing* in the other technology or rather whether *new* ones should be added for this purpose. In the latter case, it is to be further decided whether this addition would require adding *new* fields to the

respective packet structure or whether existing fields could be *re-used* instead. The use of common technical knowledge would not directly and unambiguously lead to a direct mapping of features between alternative technologies, secondary considerations being additionally needed.

- 1.2 In conclusion, the board concurs with the impugned decision that the main request is not allowable under Article 123(2) EPC.
2. As there is no allowable claim request, 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