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**Datasheet for the decision  
of 14 February 2025**

**Case Number:** T 1021/23 - 3.5.07

**Application Number:** 18206048.3

**Publication Number:** 3467666

**IPC:** G06F15/16, H04N21/234,  
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H04N7/00

**Language of the proceedings:** EN

**Title of invention:**

Video distribution system including progressive playback

**Patent Proprietor:**

DIVX, LLC

**Opponents:**

Netflix International B.V.  
Amazon EU S.à.r.l.

**Relevant legal provisions:**

EPC Art. 76(1), 84, 100(c), 105, 112, 112a(2)(c), 113(1)  
EPC R. 106  
RPBA 2020 Art. 12(4), 13(2), 13(3), 15(1), 15(5), 17(2)

**Keyword:**

Claims - claim interpretation - clarity  
Amendments - added subject-matter  
Amendment after notification of Art. 15(1) RPBA communication  
- exceptional circumstances  
Obligation to raise objections - objection dismissed  
Right to be heard - opportunity to comment (yes)

**Decisions cited:**

G 0012/91, G 0001/94, G 0003/14, T 0577/11, T 0367/20,  
T 1924/20, T 0439/22



**Beschwerdekammern**

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**Case Number:** T 1021/23 - 3.5.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.07**  
**of 14 February 2025**

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**Decision under appeal:**                      **Decision of the Opposition Division of the  
European Patent Office posted on 15 May 2023  
revoking European patent No. 3467666 pursuant to  
Article 101(3) (b) EPC**

**Composition of the Board:**

<b>Chairman</b>	J. Geschwind
<b>Members:</b>	P. San-Bento Furtado
	M. Jaedicke

## **Summary of Facts and Submissions**

- I. The patent proprietor appealed against the opposition division's decision of 15 May 2023 to revoke European patent No. 3 467 666 (hereinafter "the patent"). The corresponding patent application 18206048.3 is a divisional of European application 08705745.1, which was filed as an international application and published as WO 2008/086313.
- II. The opposition division decided that:
- claim 1 of the patent infringed Article 76(1) EPC;
  - auxiliary requests 1.1, 1.2 and 1.2' did not comply with Article 76(1) EPC;
  - auxiliary request 1.2'' infringed Article 123(3) EPC;
  - auxiliary request 1.2''' infringed Article 76(1) EPC;
  - auxiliary request 1.2<sup>(xii)</sup> infringed Articles 76(1) and 123(3) EPC;
  - auxiliary requests 1.2<sup>(xvi)</sup>, 1.2<sup>(iv)</sup> to 1.2<sup>(xi)</sup>, 1.2<sup>(xiii)</sup> to 1.2<sup>(xv)</sup> and 1.3 were not admitted into the proceedings;
  - auxiliary requests 1 to 7 infringed Article 76(1) EPC for the same reasons as for the main request;
  - the 90 "unordered auxiliary requests filed electronically on 24.11.2022" did not address the Article 76(1) or 123(3) EPC objections raised in connection with feature c2 in the context of the main request and auxiliary requests 1.2'', 1.2''' and 1.2<sup>(xii)</sup> and consequently were not allowable.
- III. The opposition had been filed by Netflix International B.V. (opponent/respondent I) based on the grounds for opposition of Article 100(a) and (c) EPC.

IV. By a notice of opposition filed on 24 April 2023 after announcement of the decision to revoke the patent, an intervention by the assumed infringer Amazon EU S.à.r.l. (opponent/respondent II) was filed under Article 105 EPC. In addition to endorsing the opponent I's grounds for opposition, opponent/respondent II invoked a new ground for opposition based on Article 100(b) EPC.

V. With its statement of grounds of appeal, the appellant requested, as main request, that the decision under appeal be set aside and that the oppositions be dismissed. As auxiliary requests, the appellant requested that the patent be maintained in amended form on the basis of

- one of the following auxiliary requests considered in the decision under appeal: 1.1, 1.2, 1.2', 1.2'', 1.2''', 1.2<sup>(xii)</sup>, 1.2<sup>(xvi)</sup>, or
- auxiliary request 1.2<sup>(xvii)</sup> submitted with the grounds of appeal, or
- one of the following auxiliary requests considered in the decision under appeal:  
1.2<sup>(iv)</sup> to 1.2<sup>(xi)</sup>, 1.2<sup>(xiii)</sup> to 1.2<sup>(xv)</sup>, 1 to 4, as well as the auxiliary requests described by the appellant as "8, 8.1a, 8.1b, 8.2a, 8.2b, 8.3.1a, 8.3.1b, 8.3.1.1a, 8.3.1.1b, ..., 8.3.1.4a, 8.3.1.4b, 8.3.1.5, 8.3.2a, 8.3.2b, 8.3.2.1a, 8.3.2.1b, ... , 8.3.2.4a, 8.3.2, ..., 11.5.1".

The appellant explicitly maintained "all auxiliary requests on which the decision under appeal was based [...] except for auxiliary request 1.3 and auxiliary requests 5 through 7".

VI. In a short communication dated 2 October 2023, the board agreed to accelerate these proceedings under

Article 10(3) RPBA 2020 as requested by respondent II and the appellant.

- VII. In their replies to the statement of grounds of appeal, both dated 22 December 2023, respondents I and II requested that the decision under appeal be upheld and that the contested patent be revoked in its entirety. They submitted that auxiliary request 1.2<sup>(xvii)</sup> should not be admitted into the appeal proceedings.
- VIII. In its letter dated 12 January 2024, the appellant provided further arguments regarding the interpretation of features c2 and b4 and the question of whether claim 1 of the patent as granted should be construed by reference to the description.
- IX. Respondent I replied to these submissions in a further letter of 27 February 2024, in which it commented the case law and referred to the claim interpretation in parallel infringement proceedings before the Mannheim District Court.
- X. The parties were summoned to oral proceedings to take place on 6 and 7 June 2024. In a subsequent communication dated 8 March 2024 sent in advance of the oral proceedings, the board expressed its preliminary opinion on the requests on file. The board noted that at least auxiliary requests 8 and 8.3.2 listed in the grounds of appeal did not appear to exist on file.
- XI. In reply to the board's communication of 8 March 2024, the parties made further submissions and filed new requests with their respective letters, all three letters being dated 8 May 2024.

The appellant provided a corrected list of auxiliary requests 8 to 11.5.1 mentioned in the grounds of appeal. The list included the 90 auxiliary requests 8.1-a to 11.5.1 considered in the decision under appeal without auxiliary requests 8 and 8.3.2. The appellant maintained all the (clarified) auxiliary requests, but proposed to change their order and to limit the discussion at the oral proceedings to only the following nine highest-ranked auxiliary requests 1.1, 1.2', 1.2'', 1.2<sup>(xii)</sup>, 11.1-b, 9.2-b, 9.1.1-b, 9.2.5 and 2.

XII. Oral proceedings took place as scheduled on 6 and 7 June 2024 (hereinafter "first oral proceedings").

At the beginning of the first oral proceedings, the appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or in the form of any of the auxiliary requests maintained with its letter of 8 May 2024, i.e. auxiliary requests 1.1, 1.2, 1.2', 1.2'', 1.2''', 1.2<sup>(xii)</sup>, 1.2<sup>(xvi)</sup>, 1.2<sup>(xvii)</sup>, 1.2<sup>(iv)</sup> to 1.2<sup>(xi)</sup>, 1.2<sup>(xiii)</sup> to 1.2<sup>(xv)</sup>, 1, 2, 3, 4, and the 90 requests 8.1a to 11.5.1 considered in the decision under appeal. The appellant further requested that the board decide on the current appeal to the extent the opposed decision was concerned (i.e. Article 100(c) EPC), and to remit the case to the first instance insofar as no decision had yet been taken (i.e. Article 100(a) EPC).

Respondent I requested that the appeal be dismissed. It further requested

- a stay of the appeal proceedings until a decision by the Enlarged Board of Appeal was issued in the referral announced in case T 439/22, or



- a referral to the Enlarged Board of Appeal, pursuant to Article 112(1)(a) EPC, of a question on how to interpret the claim wording and on the relevance of the description to claim interpretation.

Respondent II had the same requests as respondent I and additionally requested that the oral proceedings be rescheduled.

During the first oral proceedings, the appellant submitted auxiliary request 1.2"-b and each respondent raised an objection under Rule 106 EPC. The board dismissed both objections under Rule 106 EPC.

- XIII. At the end of the second day scheduled for the first oral proceedings, the board suggested continuing the proceedings in writing since not all the requests on file had been dealt with. The parties agreed. The Chair informed the parties that the debate on the main request and auxiliary requests 1.1, 1.2, 1.2', 1.2'', 1.2''' and 1.2'''-b and on the issue of a remittal was closed, with the exception that, for auxiliary request 1.2'''-b, the debate on the issues of novelty and inventive step was not closed.
- XIV. In reply to requests by the respondents to amend the minutes, the board informed the parties that it was not minded to grant the requests for correction.
- XV. The parties were summoned to oral proceedings to be held by video conference (hereinafter "second oral proceedings"). After several requests by the parties to change the date, the second oral proceedings were finally scheduled to take place on 14 February 2025.

XVI. In the communication pursuant to Article 15(1) RPBA dated 31 July 2024 the board provided a summary of its opinion after the first oral proceedings. The board stated that it did not intend to stay the proceedings awaiting decision G 1/24 (for the referring decision T 439/22) or refer a question to the Enlarged Board of Appeal. The board presented the results of the discussion on claim interpretation. The board expressed its opinion that claim 1 of the patent as granted and of auxiliary requests 1.1, 1.2, 1.2', 1.2'' and 1.2''' did not comply with Article 76(1) EPC.

Auxiliary request 1.2''-b filed during the first oral proceedings was admitted into the appeal proceedings. With regard to the objections raised by the respondents against auxiliary request 1.2''-b, the Article 76(1) EPC objections relating to the amendment introduced, the Article 84 EPC objections and the objections raised exclusively by respondent II were admitted into the proceedings. The board discussed whether the clarity objections could be raised following G 3/14 and expressed the opinion that claim 1 of auxiliary request 1.2''-b did not fulfil the requirements of Article 84 EPC regarding lack of clarity.

The board also provided a summary of the points to be discussed at the second oral proceedings. The parties were informed that objections against the requests already dealt with at the first oral proceedings could apply to one or more of the remaining requests and that the admissibility of new claim requests submitted in response to the communication would have to be assessed.

- XVII. With its letter of 16 August 2024 the appellant submitted four new auxiliary requests, a "new main request" and "new auxiliary requests" I, II and III. The appellant maintained the main request and auxiliary requests 1.1, 1.2, 1.2', 1.2'', 1.2''' and 1.2'''-b dealt with in the first oral proceedings and replaced all its remaining auxiliary requests with the new main request and new auxiliary requests I, II and III.
- XVIII. In their letters of 2 and 4 October 2024, respondents I and II argued that the new main request and new auxiliary requests I, II and III should not be admitted into the proceedings and did not fulfil the requirements of the EPC. The respondents raised, *inter alia*, objections under Articles 84, 76(1) and 123(3) EPC.
- XIX. In its letter of reply of 29 October 2024, the appellant questioned the admissibility of at least some of the objections raised by the respondents.
- XX. In the communication pursuant to Article 15(1) RPBA dated 9 January 2025, the board provided its preliminary opinion on the new main request and the new auxiliary requests I, II and III. The board was minded to admit the appellant's four new requests into the appeal proceedings. The Article 123(3) EPC objection raised by respondent II did not appear to be convincing. The board identified three objections of lack of clarity, cl.1 to cl.3, and seven objections of added subject-matter, ad.1 to ad.7, raised by the respondents against the new main request. Objections cl.1 and cl.3 and at least four of objections ad.1 to ad.7 appeared to be inadmissible, but objection cl.2 appeared to be admissible and valid and objections ad.1 and ad.2 raised by the respondents could be considered admissible and appeared to be valid. New auxiliary

requests I to III did not appear to fulfil the requirements of Articles 84 and 76(1) EPC. The board informed the parties that, in view of its preliminary opinion, the patent was likely to be revoked.

- XXI. With its letter of 17 January 2025, the appellant replied to the board's preliminary opinion, withdrew new auxiliary requests I and II and filed two new auxiliary requests, "new main request A" and "new auxiliary request III-A". The appellant requested that objections cl.2, ad.1 and ad.2 not be admitted into the proceedings.
- XXII. In its letter of 24 January 2025, respondent II argued that new main request A and new auxiliary request III-A should not be admitted into the proceedings, did not fulfil the requirements of Articles 84, 83 and 76(1) EPC, introduced new deficiencies and did not overcome the problem of lack of inventive step.
- XXIII. The second oral proceedings took place on 14 February 2025.

During the oral proceedings, the appellant submitted the following objection under Rule 106 EPC:

"We hereby raise a procedural objection based on Art. 112a(2)(c) EPC. The Board explained that the objections in the official communication of 31 July 2024 were preliminary and could be debated during the oral proceedings and that the debate was not concluded on the second day of the oral proceedings. Against this background, the Board should have allowed us to defend the patent on the basis of auxiliary request 1.2''-b."

The appellant made a formal request to reopen the debate on auxiliary request 1.2''-b. After hearing the appellant on its reasons for this request and having duly deliberated, the board dismissed the appellant's request to re-open the debate on auxiliary request 1.2''-b. The board was of the opinion that no violation of the right to be heard had occurred and dismissed the appellant's objection under Rule 106 EPC.

The respondents stated that they did not maintain their objections under Rule 106 EPC submitted in the first oral proceedings held on 6 and 7 June 2024.

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

XXIV. The appellant's final requests were that the decision under appeal be set aside and that the patent be maintained as granted (main request) or in amended form according to any of auxiliary requests 1.1, 1.2, 1.2', 1.2'', 1.2''', 1.2''-b, the new main request filed on 16 August 2024, new main request A filed on 17 January 2025, new auxiliary request III filed on 16 August 2024 or the auxiliary request III-A filed on 17 January 2025.

The appellant further requested that

- the debate on auxiliary request 1.2''-b be re-opened;
- some of the objections raised by the respondents, including objections cl.2 and ad.1 (see the board's communication dated 9 January 2025, points 10.2 and 11.2), not be admitted into the proceedings;
- the case be remitted to the department of first instance to assess novelty and inventive step.

XXV. The final requests of respondents I and II were that the appeal be dismissed and the new main request filed on 16 August 2024, new main request A filed on 17 January 2025, new auxiliary request III filed on 16 August 2024 and new auxiliary request III-A filed on 17 January 2025 not be admitted.

XXVI. Claim 1 of the patent as granted reads as follows (references a to d3 added by the board):

- a "A method of progressively playing back, by a client, a media sequence stored as a media file on a remote server (12),
- b the method comprising:
  - b1 obtaining (42) information concerning the content of the media file from the remote server;
  - b2 identifying (44), by the client, a starting location within the media sequence;
  - b3 identifying (46), by the client, byte ranges of the media file corresponding to media required to play the media sequence from the starting location;
  - b4 requesting (46), by the client from the remote server (12), the byte ranges required to play the media sequence from the starting location;
  - b5 buffering (94) received bytes of information pending commencement of playback;
  - b6 playing back the buffered bytes of information;
- c receiving (50) a 'trick play' user instruction;
  - c1 identifying (54), by the client, byte ranges of the media file corresponding to media required to play the media sequence in accordance with the 'trick play' user instruction;
  - c2 when previously requested byte ranges are no longer required, flushing (114) the previous byte range requests; and

- c3 requesting (46), by the client from the remote server (12), the byte ranges required to play the media in accordance with the 'trick play' user instruction,
- d wherein the method further comprises:
- d1 maintaining, by the client, a mask indicating the portions of the media file that have been downloaded;
- d2 identifying, using the mask, whether at least a portion of a byte range required to play the media in accordance with the 'trick play' user instruction has already been downloaded; and
- d3 requesting (46), by the client from the remote server (12), only the portions of byte ranges that have not already been downloaded from the remote server to play the media in accordance with the 'trick play' user instruction."

XXVII. Claim 1 of auxiliary request 1.1 differs from granted claim 1 in that the text c2 above has been replaced with the following text

"when previously requested byte ranges are no longer required, flushing (114), by the client, the previous byte range requests; and".

XXVIII. Claim 1 of auxiliary request 1.2 differs from granted claim 1 in that the text c2 above has been replaced with the following text

"when previously requested byte ranges are no longer required, flushing (114), by the client, the previous byte range requests, wherein the flushing includes to flush a request queue and to establish a new queue of byte range requests;".

XXIX. Claim 1 of auxiliary request 1.2' differs from granted claim 1 in that the text c2 above has been replaced with the following text

"when previously requested byte ranges are no longer required, flushing (114), by the client, a queue of the previous byte range requests, and establishing a new queue of byte range requests; and".

XXX. Claim 1 of auxiliary request 1.2'' differs from granted claim 1 in that the following text has been inserted before the text b4

"establishing, by the client, a connection with the remote server;

placing, by the client, the identified byte ranges in a request queue;"

and in that the text c2 above has been replaced with the following text

"when previously requested byte ranges are no longer required, flushing (114), by the client, the previous byte range requests by flushing the request queue and closing the connection with the remote server;

opening, by the client, a new connection with the remote server; and".

XXXI. Claim 1 of auxiliary request 1.2''' differs from claim 1 of auxiliary request 1.2'' in that the text "by flushing the request queue and closing the connection with the remote server" has been replaced with the following text:

"by flushing the connection with the remote server (12) by flushing (114) the request queue and closing (116) the connection".



- XXXII. Claim 1 of auxiliary request 1.2''-b differs from claim 1 of auxiliary request 1.2'' in that the text "and closing the connection with the remote server; opening, by the client, a new connection with the remote server" has been deleted.
- XXXIII. Claim 1 of the new main request differs from claim 1 of auxiliary request 1.2''-b in that the text "from the request queue that are" has been inserted after the text "requesting (46), by the client from the remote server (12), the byte ranges".
- XXXIV. Claim 1 of new main request A differs from claim 1 of the new main request in that the text "requesting (46), by the client from the remote server (12), the byte ranges required to play the media in accordance with the 'trick play' user instruction," has been replaced with
- "establishing, by the client, a new queue of byte range requests using the byte ranges identified in response to the 'trick play' user instruction; and requesting (46), by the client from the remote server (12), the byte ranges from the new request queue that are required to play the media in accordance with the 'trick play' user instruction," and in that text d3 at the end of the claim has been replaced with the following text
- "placing, by the client, only the portions of byte ranges in the new request queue that have not already been downloaded from the remote server to play the media in accordance with the 'trick play' user instruction; and requesting (46), by the client from the remote server (12), the portions of byte ranges from the new request queue that have not already been downloaded from the remote server to play the media

in accordance with the 'trick play' user instruction."

- XXXV. Claim 1 of new auxiliary request III reads as follows:
- "A method of progressively playing back, by a client, a media sequence stored as a media file on a remote server (12), wherein the media file includes an index to the media sequence, and the client and the remote server communicate via multiple network connections, the method comprising:
- obtaining (42) information concerning the content of the media file from the remote server, wherein the information concerning the content of the media file comprises the index and the index is used by the client to identify byte ranges within the media file to request as the media sequence is played;
  - identifying (44), by the client, a starting location within the media sequence;
  - identifying (46), by the client, byte ranges of the media file corresponding to media required to play the media sequence from the starting location;
  - establishing, by the client, a connection with the remote server;
  - placing, by the client, the identified byte ranges in a request queue;
  - requesting (46), by the client from the remote server (12) using the HTTP 1.1 protocol, the byte ranges from the request queue that are required to play the media sequence from the starting location;
  - buffering (94) received bytes of information pending commencement of playback;
  - playing back the buffered bytes of information;
  - receiving (50) a 'trick play' user instruction;
  - identifying (54), by the client, byte ranges of the media file corresponding to media required to play the

media sequence in accordance with the 'trick play' user instruction;

when previously requested byte ranges are no longer required, flushing (114), by the client, the previous byte range requests by flushing the request queue, and breaking, by the client, at least one of the multiple network connections to the remote server in response to the receipt of the 'trick play' user instruction;

establishing, by the client, a new queue of byte range requests using the byte ranges identified in response to the 'trick play' user instruction; and

requesting (46), by the client from the remote server (12) using the HTTP 1.1 protocol, the byte ranges from the new request queue that are required to play the media in accordance with the 'trick play' user instruction,

wherein the method further comprises:

maintaining, by the client, a mask indicating the portions of the media file that have been downloaded;

identifying, using the mask, whether at least a portion of a byte range required to play the media in accordance with the 'trick play' user instruction has already been downloaded; and

requesting (46), by the client from the remote server (12) using the HTTP 1.1 protocol, only the portions of byte ranges that have not already been downloaded from the remote server to play the media in accordance with the 'trick play' user instruction."

XXXVI. Claim 1 of new auxiliary request III-A differs from claim 1 of new auxiliary request III in that the term "multiple network connections" has been replaced with "multiple connections" in the two occurrences in the claim, the text "establishing, by the client, a connection with the remote server;" has been deleted

and the text in the last paragraph has been replaced with the following text:

"placing, by the client, only the portions of byte ranges in the new request queue that have not already been downloaded from the remote server to play the media in accordance with the 'trick play' user instruction; and

requesting (46), by the client from the remote server (12), the portions of byte ranges from the new request queue that have not already been downloaded from the remote server to play the media in accordance with the 'trick play' user instruction."

## **Reasons for the Decision**

### *Intervention of the assumed infringer*

1. Following decision G 1/94, an intervention of the assumed infringer under Article 105 EPC is admissible during pending appeal proceedings and may be based on any ground for opposition under Article 100 EPC. The notice of opposition of 24 April 2023 filed by respondent II (see section IV. above) satisfies the requirements of Article 105(1) EPC in combination with those of decision G 1/94. This has not been contested by the appellant.

### *Main request - patent as granted*

2. In the decision under appeal, the opposition division decided that granted claim 1 did not fulfil the requirements of Article 76(1) EPC. The opposition division decided that in the method of granted claim 1, the "previous byte range requests" flushed according to feature c2 corresponded to the "byte ranges" requested "by the client from the remote server" in feature b4.

There was no basis in the parent application as filed for flushing requests that had already been requested by the client from the server. Paragraph [0055] of the parent application as filed explicitly taught that the flushed requests were still pending. Paragraph [0061] was about a distinct queue of chunk requests. Original claim 2 of the parent application (hereinafter "PCT claim 2"), including the features of PCT claim 1 on which it was dependent, was alone not a basis, since it did not include all the limitations of granted claim 1. Furthermore, claim 1 as granted added subject-matter beyond the parent application because feature c2 did not specify that flushing was performed by the client.

In the decision under appeal, the opposition division did not agree with the opponent's Article 76(1) EPC objections against features b2, b3 and d1.

3. In the assessment with regard to the requirements of Article 76(1) EPC, a major point of the discussion throughout the opposition and appeal proceedings was how to interpret claim 1 of the patent as granted, especially features b4 and c2, and to what extent the description should be taken into account when interpreting a claim.
4. *Claim interpretation for assessing the requirements of Article 76(1) EPC*
- 4.1 Both respondents were of the opinion that claim 1 of the patent as granted was clear and unambiguous. When construing a claim, primacy should be given to the claim wording.

With regard to features b4 and c2, the respondents argued that feature b4 referred to requests which had already been sent to the server (i.e. to "external

requests"). The expression "previously requested byte ranges" in c2 referred to the "byte ranges" of b4. The expression "flushing the previous byte range requests" of c2 thus referred to flushing the external requests.

- 4.2 The appellant argued that a claim should always be interpreted in line with the description. Construing the claim without reference to the description was inconsistent with recent case law.

At the first oral proceedings, the appellant argued that there were no "internal" and "external" requests. The expression "flushing the previous byte range requests" of c2 referred to flushing the queue of requests at the client. Flushing occurred only at the client. The purpose of the queue was to maximise available network bandwidth by using multiple TCP/IP connections. In this way, the invention tried to maximise the amount of data downloaded. The respondents' interpretation of granted claim 1 was "technical nonsense". The invention was based on stateless HTTP connections with the server. At the priority date of the patent, it was technically not feasible to flush or delete requests at the server.

- 4.3 The board is of the opinion that claim 1 of the granted patent is unclear. Claim 1 is directed to a "method of progressively playing back, by a client, a media sequence". However, some of the steps are not performed progressively and others are. Steps b4 to b6 cannot be read as being performed at once (otherwise, in step b6 the whole media would have been played back and a "trick play" could not occur). This means that at a given point in time some of the requests mentioned in feature b4 may not yet have been sent to the remote server. This raises the questions of whether and how feature c2 relates to feature b4. Feature c2 is thus

unclear in combination with feature b4. In addition, feature c2 is unclear by itself. The expression "flushing the previous byte range requests" of feature c2 does not have a precise technical meaning, since it is not clear what it means to flush a request. Furthermore, it is unclear whether "the previous byte range requests" of feature c2 correspond to the "previously requested byte ranges" of feature c2 which are no longer required and whether and how they relate to the byte ranges (progressively) requested in step b4.

4.4 This raises the question of how to interpret claim 1 of the patent.

5. *Claim interpretation and requests for stay of the proceedings and for a referral*

5.1 In their replies to the grounds of appeal, both respondents expressed the opinion that the description could not be invoked to give the claim a different meaning if the claim was clear in itself. Respondent I cited decisions T 1018/02, T 1195/01, T 2221/10 and T 197/10 (letter of 22 December 2023, page 3). In reply to the board's preliminary opinion, respondent I further argued that, in the case of a claim with unclear features, the description should not be used to change the meaning of a different claim feature which itself was not unclear and was not related to the identified lack of clarity.

Respondent II further submitted that if the patent proprietor wished to put a specific meaning on a certain term in view of the patent specification, it was its obligation to include this meaning into the claim by amending the wording of said claim. Otherwise, it would be impossible to guarantee the necessary legal

certainty and avoid difficulties in construing the claim in later infringement proceedings (decisions T 1578/13, T 2589/11 and T 1279/04 were cited). Respondent II further submitted that this was especially true in the context of Articles 76(1) and 123(2) EPC since otherwise these provisions would become meaningless in respect of claim amendments. Decision T 1018/02 was cited in this regard (see letter of 22 December 2023, page 3).

The respondents further argued that it was common sense in the case law of the Boards of Appeal that the description could not be used to give the claim wording a different meaning than it actually had, even if taking the description into account was necessary to resolve an ambiguity (decisions including T 1127/16, T 2769/17 and T 431/03 were cited). Justification for taking the description into account when interpreting the claim only applied to the extent necessary for the person skilled in the art to resolve any potential ambiguity of the claim wording.

- 5.2 In reply to the board's preliminary opinion of 8 March 2024, both respondents stated that there were diverging Boards of Appeal decisions regarding the legal standards to be applied for claim interpretation. This had been recognised by the board of appeal in case T 439/22. In their submissions before decision T 439/22 had been issued (which later led to case G 1/24), the respondents argued that the decision of the Enlarged Board of Appeal on the questions to be referred to it by T 439/22 was also relevant to the case at hand because the outcome of the present proceedings depended on the interpretation of the claim with respect to both added subject-matter and patentability. In the first oral proceedings, the respondents requested stay of the



appeal proceedings or referral of a question to the Enlarged Board of Appeal (see section XII. above).

- 5.3 The appellant argued that a claim should always be interpreted in line with the description. Construing the claim without reference to the description was inconsistent with recent case law. The appellant cited decision T 367/20, Reasons 1.3.2 to 1.3.8. At the first oral proceedings, the appellant was against suspending the proceedings in view of the referral in case T 439/22 or referring a question to the Enlarged Board of Appeal.
- 5.4 Regarding the question of the role of the description and drawings when interpreting the claims, in its communication of 31 July 2024 the board noted that the questions referred by decision T 439/22 did not arise in the context of a decision regarding added subject-matter of an unclear claim. All three questions referred by T 439/22 to be decided in G 1/24 concerned the situation of assessment of patentability of an invention under Articles 52 to 57 EPC. The specific issue dealt with in decision T 439/22 was that a term in the claim which had a clear and agreed meaning in the technical field was explicitly defined more broadly in the description (see T 439/22, Facts and Submissions Section I, last paragraph; Reasons 1.1, last two paragraphs, 1.4, 3.3.7 and 3.4.7). The board found this quite different from the present case in which the board considers that a number of features, including features b4 and c2, are unclear.

Therefore, during the appeal proceedings the board considered that the possibility that decision G 1/24 would be relevant to the present case was only hypothetical. Furthermore, it would be unsuitable to suspend every appeal where claim interpretation is

necessary. Any considerations on staying the proceedings in the present case had to be balanced with the need for procedural efficiency in the proceedings, which were accelerated due to parallel proceedings in national courts, and the request of the appellant not to suspend the proceedings.

- 5.5 Regarding the question of claim interpretation, even though some decisions state that the claims should essentially always be interpreted on their own merits (see T 439/22, Reasons 3.3.6), it is generally accepted that the description and figures may be consulted when interpreting a claim which is unclear or ambiguous when read in isolation. In the board's opinion, this is reflected in the discussions of this topic in Reasons 3.3 and 4.3 of T 439/22.

In the board's view, it is established case law that the patent claims need to be construed in the context of the whole document to which they belong (T 367/20, Reasons 1.3.3). Even decision T 1924/20, one of the few decisions listed in T 439/22, Reasons 3.3.6, as going so far to state that the claims should be interpreted "based essentially on their own merits", admits that the description and figures determine "the view point from which the claims are interpreted" (T 1924/20, Reasons 2.7).

Unclear features of a patent claim have to be interpreted taking the description into account. In addition, the board agrees with the respondents that lack of clarity of a feature should not be a reason for using the description to change the meaning of a different claim feature which itself is not unclear and not related to the lack of clarity. Whenever possible, any mismatch between claims and a definition or the like in the description should be resolved by amending

the claims (see also T 439/22, Reasons 3.3, Reasons 3.4.3 (b), (c) and (f) and the decisions cited there).

- 5.6 Taking the above into account, a referral of a question to the Enlarged Board, or a decision on the questions to be dealt with in G 1/24 was not required in the present case to ensure uniform application of the law (Article 112(1) and (1)(a) EPC). For these reasons, in the course of the appeal proceedings the board did not suspend the proceedings awaiting decision G 1/24 and did not refer questions to the Enlarged Board concerning claim interpretation. In their final requests, the respondents did not maintain their requests to stay the proceedings and for a referral (see section XXV. above).

6. *Claim interpretation - features b4 and c2*

- 6.1 Applying the principles of point 5.5 above to the present case, the board agrees with the appellant that "flushing the ... requests" of feature c2 refers to flushing a queue of requests, as mentioned in granted claim 10 and disclosed throughout the description, even though granted claim 1 does not mention a queue of requests. The board agrees with the appellant that, within the technical context of the invention, it would technically not make any sense to assume that in step c2 a queue of requests is flushed at the server. Therefore, feature c2 refers to flushing a queue of requests at the client. However, the board is not convinced that the expression "the previous byte range requests" of feature c2 necessarily refers to the byte ranges mentioned in b4.

7. *Main request - Article 100(c) and 76(1) EPC*

- 7.1 At the first oral proceedings before the board, respondent I raised the objection that granted claim 1 added subject-matter beyond the parent application as filed as it did not specify creating the byte range requests and putting the requests in the queue. The parent application disclosed feature b4 only in connection with the download manager placing the requests in the queue. These features, which corresponded to features 94 and 96 of Figure 5 and were described in paragraphs [0051] and [0055] of the PCT publication of the parent application, were technically inseparable.
- 7.2 The appellant protested against this objection, which in its opinion was being raised for the first time, and argued that the objection was not valid. Claim 1 did not specify an intermediate generalisation as it was not restricted to an embodiment with the download manager. There was a basis for the claimed subject-matter for instance in paragraphs [0044] and [0057], and in claim 9 of the parent application.
- 7.3 In the proceedings up to the first oral proceedings, compliance of granted claim 1 with Article 76(1) EPC was discussed, but not this particular objection. The circumstances that this objection is related to the then ongoing discussions on Article 76(1) EPC, that new insights resulted from the discussions on claim interpretation at the first oral proceedings and that this objection is *prima facie* relevant, constitute exceptional circumstances under Article 13(2) RPBA. For these reasons, during the first oral proceedings this objection was admitted into the appeal proceedings.

7.4 In the method as disclosed in the parent application, the byte ranges are identified and placed in a request queue. The byte ranges in the queue are then requested from the remote server (Figure 5, paragraph [0051]). Granted claim 1 does not specify a step of placing byte ranges in a queue or that the byte ranges requested in step b4 are in a request queue.

7.5 None of the passages cited by the appellant discloses an embodiment including a queue, byte range requests and a "trick play" instruction, without the steps of creating the byte range requests and putting these requests in the queue from which the byte ranges are requested.

PCT claim 9 does not specify a queue and thus cannot serve as a basis. The PCT claims dependent on PCT claim 9 mention a queue (PCT claim 11), but none of them relates to handling "byte range requests" or a "trick play" user instruction. Therefore, PCT claim 9 and its dependent claims cannot serve as a basis either.

Paragraph [0044] does not mention a queue and paragraph [0057] is about receiving data, not about requesting byte ranges. Paragraphs [0044] and [0057] thus cannot serve as a basis either.

7.6 Therefore, granted claim 1 specifies an unallowable intermediate generalisation and does not fulfil the requirements of Article 76(1) EPC.

8. *Auxiliary requests 1.1, 1.2 and 1.2' - Article 76(1) EPC*

- 8.1 Claim 1 of auxiliary requests 1.1, 1.2 and 1.2' differ from granted claim 1 in that feature c2 has been amended to specify (see sections XXVII. to XXIX. above)
- that flushing is performed by the client (all three requests);
  - that flushing includes flushing a request queue and establishing a new queue of byte range requests (auxiliary request 1.2);
  - a queue of the previous byte range requests and that a new queue is established (auxiliary request 1.2').

- 8.2 None of these requests specifies that the byte ranges requested in step b4 are first placed in a queue and then requested from the queue. Therefore, for essentially the same reasons as given for granted claim 1, auxiliary requests 1.1, 1.2 and 1.2' do not fulfil the requirements of Article 76(1) EPC.

9. *Auxiliary requests 1.2'' and 1.2''' - Article 76(1) EPC*

- 9.1 Claim 1 of auxiliary request 1.2'' differs from granted claim 1 in that (see section XXX. above):
- the following features are specified immediately before feature b4:
    - b3.1 "establishing, by the client, a connection with the remote server;"
    - b3.2 "placing, by the client, the identified byte ranges in a request queue;"
  - c2 has been amended to specify that flushing is by the client and performed "by flushing the request queue and closing the connection with the remote server", and

- the following step has been added: "opening, by the client, a new connection with the remote server".

- 9.2 Claim 1 of auxiliary requests 1.2''' differs from claim 1 of auxiliary request 1.2'' in that feature c2 has been amended to (see section XXXI. above, underlining added by the board to show the amendments) "when previously requested byte ranges are no longer required, flushing (114), by the client, the previous byte range requests by flushing the connection with the remote server (12) by flushing (114) the request queue and closing (116) the connection;".
- 9.3 The respondents argued that the parent application did not disclose that flushing byte ranges, let alone a queue of requests at the client, could be done by closing the connection with the remote server, which instead was a distinct mechanism. Paragraph [0036] described the process shown in Figure 6 as flushing a connection, wherein flushing the request queue and closing the connection were two different steps of this process.
- 9.4 The appellant argued that the parent application disclosed, in paragraphs [0036] and [0055] and in Figure 6, that flushing a connection encompassed flushing the request queue and closing the connection.
- 9.5 The parent application refers to the process depicted in Figure 6, which includes "flushing [114] the request queue and closing [116] the connection with the media server", as both "flushing a request queue" (paragraph [0056]) and "flushing a connection with a media server" (paragraph [0036]). However, the two steps of flushing the request queue and closing the connection are clearly described in those paragraphs and depicted

in Figure 6 as two separate steps 114 and 116. Besides, step c2 refers to flushing requests kept in the queue at the client, and there is no flushing of requests at the client by closing the connection with the server. The board thus agrees with the respondents that closing a connection is a separate step from that of flushing the queue.

9.6 Therefore, auxiliary requests 1.2'' and 1.2''' do not comply with Article 76(1) EPC.

10. *Auxiliary request 1.2''-b*

10.1 Claim 1 of auxiliary request 1.2''-b differs from claim 1 of auxiliary request 1.2'' in that the text "and closing the connection with the remote server; opening, by the client, a new connection with the remote server" has been deleted (see section XXXII. and point 9.1 above).

11. *Auxiliary request 1.2''-b - admissibility*

11.1 The appellant argued that auxiliary request 1.2''-b should be admitted into the proceedings because the board had reverted the interpretation of the claim by the opposition division. Besides, at the oral proceedings, the board had deviated from its preliminary opinion, which came as a surprise to the appellant. The requests on file had been drafted based on a completely different interpretation. According to decisions T 1623/20, T 2465/19 and T 1906/19, these were exceptional circumstances justifying admittance of the request under Article 13(2) RPBA. The appellant further argued that auxiliary request 1.2''-b did not introduce complex amendments. It merely deleted an amendment and overcame all the objections raised. The appellant maintained its request for accelerated



proceedings, but the right to be heard should be respected.

11.2 The respondents objected to the admission of this request. Auxiliary request 1.2''-b was late filed. The board's change of interpretation was not a reason for admitting a new request. The appellant had already submitted an unreasonable number of auxiliary requests. The objection concerning the feature "closing the connection" had always been a point of discussion. The respondents argued that such a request should have been filed earlier at the first instance proceedings.

11.3 The board recognises that during the first oral proceedings it deviated from its preliminary opinion. In its preliminary assessment of claim 1 of auxiliary request 1.2'', the board dismissed the respondents' argument that the parent application did not disclose flushing byte ranges by closing the connection with the remote server (see the board's communication of 8 March 2024, points 36.6 to 36.9).

In addition, at the first oral proceedings the board came to the conclusion that granted claim 1 infringed Article 76(1) EPC based on a fresh objection against granted claim 1 raised by the respondents for the first time at the oral proceedings before the board (see points 7.1 to 7.3 above). This same objection was found by the board to also apply to auxiliary requests 1.1, 1.2 and 1.2'.

11.4 In the board's opinion, these are exceptional circumstances justifying admittance of a claim request under Article 13(2) RPBA. For these reasons, during the first oral proceedings auxiliary request 1.2''-b was admitted into the proceedings.

12.     *Auxiliary request 1.2''-b - admissibility of objections raised by the respondents*

12.1     At the first oral proceedings before the board, there were extensive discussions on claim interpretation and allowability of the main request and auxiliary requests 1.1, 1.2, 1.2', 1.2'' and 1.2'''. The parties were then heard on the questions of admissibility of auxiliary request 1.2''-b and a remittal of the case for further prosecution. In the context of the discussion of whether the case should be remitted, respondent I argued that there were still issues to be discussed under Articles 76(1), 84 and 123 EPC with regard to auxiliary request 1.2''-b. In case of remittal, these issues would be revisited in the first instance proceedings. Respondent I would prefer the board to deal with these issues, but would not vigorously oppose to a remittal.

12.2     The appellant argued that the board should not admit new objections, especially not those not caused by the amendment introduced by auxiliary request 1.2''-b. The appellant had submitted the request on the assumption that all the objections would be overcome except for those under novelty and inventive step. The respondents had had three opportunities to present their objections.

12.3     The board noted that the appellant had argued that auxiliary request 1.2''-b overcame all the objections except for novelty and inventive step. The respondents had not responded to this. Since *prima facie* allowability was an important criterion for admitting a request, the board had expected the respondents to raise any further objections at the latest when they had argued whether auxiliary request 1.2''-b should be admitted into the proceedings. Any objections raised in

this late phase would thus have to be admitted by the board.

12.4 The respondents raised several objections regarding claim 1 of auxiliary request 1.2''-b, including the following:

I.2-A76(1) Respondent I argued that claim 1 infringed Article 76(1) EPC because feature c3 did not mention a request queue;

I.2-A84 Respondent I argued that claim 1 infringed Article 84 EPC because feature c3 did not mention a request queue;

I.4 It was unclear what the relationship between features b3 and b4 was and whether steps b3 and b4 took place simultaneously. Feature b4 did not mention that requests were taken from the queue.

The respondents argued that objection I.4 had been raised in the decision under appeal, on page 14, paragraph 7.3. Some of the objections could not have been raised before because the respondents had assumed a different interpretation of the claim.

The respondents further stated that they did not have the impression that the discussion of auxiliary requests 1.2'' and 1.2''' had been exhaustive and there had been no suggestion from the board to this effect. The focus of the discussion had so far been on the relationship between features b4 and c2 and whether feature c2 related to internal or external requests which had been sufficient to draw a conclusion regarding Article 76(1) EPC. There had been no reason for respondent II to make submissions with regard to further added features nor, in view of the more than one hundred auxiliary requests on record, would it have been practically possible to plead exhaustively.

12.5 Following the discussions at the first oral proceedings, the board accepted that in the course of the hearing the respondents had not understood, when admissibility of auxiliary request 1.2''-b was being discussed, that their submissions should also have dealt with clarity. With regard to the higher ranking requests, added subject-matter had been discussed, but not clarity. Furthermore, objections caused by the amendment introduced by a new request could not have been raised before and are thus admissible. In view of this, the board decided to admit the objections under Article 76(1) EPC relating to the amendment made in auxiliary request 1.2''-b (i.e. omission of the feature specifying that the connection is closed) and the objections under Article 84 EPC.

12.6 Applying these criteria, objection I.2-A 76(1) was not admitted into the proceedings (Article 13(2) RPBA). Objections I.2-A84 and I.4 concern clarity and were thus admitted into the proceedings (Article 13(2) RPBA).

13. *Auxiliary request 1.2''-b - clarity*

13.1 In objection I.4, respondent I argued that it was unclear what the relationship between features b3 and b4 was and whether steps b3 and b4 took place simultaneously. Feature b4 did not mention that requests were taken from the queue.

13.2 The appellant argued that objection I.4 was not triggered by the amendments. There had been no clarity objection against claim 1 of auxiliary request 1.2''. Claim 1 of auxiliary request 1.2''-b was clear. It was illogical to conclude that claim 1 of the main request lacked basis and, at the same time, that claim 1 of auxiliary request 1.2''-b was unclear. It was clear

from feature b4 that "the" byte ranges of the queue were being requested.

- 13.3 Features b3 and b4 of auxiliary request 1.2''-b have not been amended compared to granted claim 1.

In opposition proceedings, examination of whether an amended claim complies with Article 84 EPC is restricted because compliance with Article 84 EPC is not a ground for opposition under Article 100 EPC. In decision G 3/14, the Enlarged Board held that, for the purposes of Article 101(3) EPC, an amended claim may be examined for compliance with Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC.

The appellant's argument that the objection could not be raised because it had not been caused by the amendments is not convincing. Whether objection I.4 was caused by the amendment in relation to auxiliary request 1.2'' is not decisive since, as explained above, the discussion on clarity with regard to the higher ranking requests was incomplete and the board did not decide on it. Whether the objection was caused by the amendments in relation to the granted claims is relevant to the question of whether the clarity objection can be raised in accordance with decision G 3/14.

Compared to the granted claims, claim 1 of auxiliary request 1.2''-b introduces step b3.2 of placing the byte ranges (identified in step b3) in a request queue. Feature b4 then specifies that "the byte ranges required to play the media sequence" are requested from the starting location. The board does not agree with the appellant that it is clear from feature b4 that "the byte ranges required ..." refers to the byte

ranges placed in the queue in feature b3.2. The introduction of feature b3.2 mentioning that the identified byte ranges are introduced in a request queue renders unclear the relationship between features b3 and b4.

- 13.4 Therefore, claim 1 of auxiliary request 1.2''-b is unclear (Article 84 EPC).

*New main request*

14. Claim 1 of the new main request differs from claim 1 of auxiliary request 1.2''-b in that the text "from the request queue that are" has been added to feature b4, as follows (see also section XXXIII. above):

"requesting (46), by the client from the remote server (12), the byte ranges from the request queue that are required to play the media sequence from the starting location".

15. *New main request - admissibility*

- 15.1 The new main request was submitted after the first oral proceedings by letter of 16 August 2024, in which the appellant maintained the requests dealt with in the first oral proceedings and replaced all other requests with four new auxiliary requests: the new main request and new auxiliary requests I, II and III.

- 15.2 The respondents requested that these new auxiliary requests, including the new main request, not be admitted into the appeal proceedings. They argued that the appellant, in its letter of 16 August 2024, had not provided a justification and cogent reasons for filing these new auxiliary requests so late. The new auxiliary requests were *prima facie* not allowable. No exceptional circumstances pursuant to Article 13(2) RPBA were

apparent for the new main request and new auxiliary request III, which would justify their admission.

15.3 However, in view of the history of the case, including developments in the first oral proceedings, the board recognises that there are exceptional circumstances under Article 13(2) RPBA for admitting the new main request. At the first oral proceedings, the respondents raised for the first time objections which, for the reasons given above, were nevertheless admitted into the proceedings. In addition, the four new auxiliary requests submitted with the letter of 16 August 2024, including the new main request and new auxiliary request III, replaced more than one hundred auxiliary requests previously on file and both respondents and the board had requested the proprietor to reduce the number of its claim requests. Their submission can thus be seen as contributing to procedural economy (Article 12(4) RPBA).

15.4 In view of this, the new main request is admitted into the proceedings (Article 13(2) RPBA).

16. *New main request - admissibility of objections cl.2 and ad.1*

16.1 The respondents raised various objections of lack of clarity and added subject-matter against claim 1 of the new main request. In its preliminary opinion of 9 January 2024 and at the second oral proceedings, the board considered objections cl.2 and ad.1 the most relevant (see also section XX. above):

cl.2 the relationship between amended feature b4 and features c3 and d3 is unclear because c3 and d3 do not refer to a queue, establishing a difference between normal play and trick play (Article 84 EPC);

ad.1 feature c3 does not refer to a queue and there is no basis in the parent application as filed for an embodiment in which the queue is used in normal playback and not in trick play (Article 76(1) EPC).

16.2 The appellant argued against the admission of objections cl.2 and ad.1. In its letter of 17 January 2025 and at the second oral proceedings, the appellant referred to point 8.4 of the board's communication of 31 July 2024, in which the board had listed all objections raised by the opponents against auxiliary request 1.2''-b. This list had included items I.2 and I.4, according to which respondent I had objected that neither feature c3 nor feature b4 mentioned that requests were taken from the request queue. The board had allowed objection I.4 and had refused objection I.2 in points 9.3 to 9.5, which included the following text

"With regard to feature c3, the board has doubts that a lack of clarity as mentioned in objection I. 2 above was introduced by the amendment. In view of this, following decision G 3/14 and taking into account Article 100 EPC, it seems that the objection I.2 of lack of clarity of feature c3 cannot be raised".

The appellant had followed the convergent path outlined by the board and had amended claim 1 accordingly. Objection cl.2 was a reiteration of objection I.2, but the board had changed its assessment with regard to this objection. By allowing objection I.4 and refusing objection I.2, the board had created the expectation that amending the claim to address objection I.4 alone would suffice.



The appellant further argued that the application as filed disclosed that both requesting steps b4 and c3 involved the byte ranges being requested from a request queue. If it were to be assumed that only the new establishing step b3.1 and the new placing step b3.2 introduced after the identifying step b3 (i.e. placing the identified byte ranges in a request queue) would have caused the requesting step b4 to become unclear, then amending feature b4 would resolve the issue.

There was no reason why the amendment of feature b4 in the new main request justified such an abstract additional requirement that would lead to new added matter (ad.1) and clarity (cl.2) objections. Were such an abstract requirement to exist, then it ought to have led objection I.2 being admitted due to new steps b3.1 and b3.2. The appellant argued that it would have then immediately responded and amended claim 1 accordingly.

- 16.3 In its letter of 24 January 2025 respondent II argued that objections cl.2 and ad.1 were specifically caused by the introduction of the expression "from the request queue" in feature b4, which caused ambiguity as to whether the byte ranges in "trick play" mode according to feature c3 were requested corresponding to the playback in the standard mode or differently thereto. In auxiliary request 1.2''-b the same wording was used for features b4 and c3. In reply to the appellant's argument that it had the expectation that it could solve objection I.4 by adding "from the request queue", respondent II argued that it was irrelevant whether the proprietor had this expectation, bearing in mind that it was the proprietor's responsibility to form a patentable claim (decision T 516/06 was cited). The board's findings on auxiliary request 1.2''-b did not raise any expectations with respect to the substance of

a potentially allowable claim wording. The underlying principles of procedural fairness and the right to be heard, which were fundamental to the RPBA, established exceptional circumstances for the admission of objections cl.2 and ad.1. If the proprietor filed more than one hundred auxiliary requests and was then allowed not only to reduce the number of auxiliary requests but also to replace them with entirely new requests, the opponents should be given the opportunity to object comprehensively to the new requests under Article 13(3) RPBA.

- 16.4 The board notes that the reasoning and objections raised in its communications pursuant to Article 15(1) RPBA are preliminary, as explained in the introductory paragraph used in those communications. This is also clear from the passage cited in point 16.2 above in which the board expresses its preliminary opinion by means of expressions such as "has doubts" and "seems that". The appellant cannot base its expectations on preliminary opinions. The board further notes that the appellant did consider the need to use a similar text for feature c3 since, in claim 1 of new auxiliary request III filed together with the new main request, the appellant amended feature c3 to include the text "from the new request queue" in accordance with feature b4.

In addition, the board does not agree that its admission of objections cl.2 and ad.1 contradicts its findings and procedural decisions with regard to the higher ranking requests. In its communication of 31 July 2024 cited above, with regard to auxiliary request 1.2''-b, the board was of the preliminary opinion that objection I.2-A84 could not be raised in view of decision G 3/14. Objection I.2-A76(1) was not

admitted because it should have been raised before and objection I.4 was considered admissible and valid (see also point 13. above).

However, claim 1 of the new main request differs from that of auxiliary request 1.2''-b in that it explicitly mentions in amended feature b4 that the byte ranges are requested from the request queue. Due to this amendment the text used to define step b4 is different from that used for step c3, even though step c3 corresponds to step b4 in "trick play" mode. Since this difference is at the core of objections cl.2 and ad.1, the objections were caused by the amendment.

- 16.4.1 The appellant's argument that the amendment of feature b4 did not change the interpretation of the features of group c3 because the queue was already implicit in feature b4 is not convincing. Even though the board interpreted feature b4 of granted claim 1 in the light of the description, amended claims have to satisfy the requirements of Article 84 EPC.
- 16.4.2 Objection ad.1 is similar to objection I.2-A76(1) against auxiliary request 1.2''-b, which was not admitted into the proceedings. However, objection ad.1 is specifically caused by the addition of "from the request queue" to feature b4 and therefore is a legitimate response to the amendment made in feature b4 of the new main request.
- 16.4.3 The board also agrees with the respondents that the admission of the late filed new main request creates exceptional circumstances with regard to the admission of objections by the respondents.

16.4.4 For the reasons given above, objections cl.2 and ad.1 are admitted into the proceedings (Articles 13(2) and (3) RPBA).

17. *New main request - clarity and added subject-matter*

17.1 The appellant argued that the amendment of feature b4 had no impact on the interpretation of feature c3. There was no abstract requirement of symmetry. Claim 1 of the new main request was clear and had a basis in the parent application.

At the second oral proceedings, the appellant cited original claim 1 of the parent PCT application, Figure 5, and paragraphs [0005], [0052] and [0054] as the basis for claim 1 of the new main request. According to the appellant, the specification did not require that the same techniques be used in feature groups b and c. It was evident from the patent specification that "trick play" mode was different from normal mode. The features of groups b and c did not have to be symmetric.

17.2 The board is however of the opinion that the inconsistent wording used in claim 1 of the new main request to specify step b4 and corresponding step c3 renders the claim unclear. In particular, it is unclear from claim 1 of the new main request whether or not a queue is used in step c3. Since this particular defect is present in amended claim 1 but not in granted claim 1, objection cl.2 satisfies the requirements of decision G 3/14 and can be raised.

17.2.1 Therefore, claim 1 of the new main request does not satisfy the requirements of Article 84 EPC.

- 17.3 In view of the wording used, claim 1 can be interpreted as encompassing a method for progressively playing back a media sequence in which a queue is used for normal play in step b4 but not for "trick play" in step c3.
- 17.3.1 Paragraph [0005] of the parent application is about the background art, not the invention, and describes the "trick play" mode in general browser-based players. Paragraphs [0052] to [0055] describe the method of playing back media depicted in Figure 5. According to paragraph [0055], when a user provides a "trick play" instruction, download managers in accordance with the invention "possess the ability to flush the queue of pending byte range requests and establish a new queue of byte range requests". Figure 5 discloses a "process for flushing a request queue". Paragraph [0056] discloses that "other processes can be used to reduce latency when 'trick play' requests are received that eliminate the immediate need for portions of a media file previously requested and create an immediate need for portions of a remote media file that have not been previously requested". However, this passage does not mention that a queue is not used in these circumstances. None of these passages clearly and unambiguously disclose that a queue is used in normal play mode but not in "trick play" mode.
- 17.3.2 Claim 1 of the parent application does not mention a queue in either of the steps of requesting the byte ranges in normal or in "trick play" modes and thus covers embodiments in which a queue is used in either of the two steps. However, this does not mean that the specific combination of using a queue in step b4 but not in step c3 can be considered to be clearly and directly derivable from claim 1 of the parent application under Article 76(1) EPC. According to

established case law, the combination of one item from each of two lists of features disclosed in the application adds subject-matter if there is no clear pointer to it in the application as filed (see Case Law, II.E.1.6.2 a)). Furthermore, claim 1 of the new main request includes other features, for example steps b4 and c3 being performed by the client, which were not present in claim 1 of the parent application.

- 17.3.3 It follows from the above that claim 1 adds subject-matter beyond the content of the parent application as filed and that the new main request does not satisfy the requirements of Article 76(1) EPC.

*New main request A*

18. Claim 1 of new main request A differs from claim 1 of the new main request in that the following two features have been added to the claim:

- c2A establishing, by the client, a new queue of byte range requests using the byte ranges identified in response to the "trick play" user instruction;
- d2A placing, by the client, only the portions of byte ranges in the new request queue that have not already been downloaded from the remote server to play the media in accordance with the "trick play" user instruction.

In addition, features c3 and d3 have been amended to specify that the byte ranges are requested "from the new request queue" (see also section XXXIV. above).

19. *New main request A - admissibility*

- 19.1 The respondents argued that new main request A and new auxiliary request III-A were in any case not admissible. They were not admissible even if the new

main request and new auxiliary requests I to III were admitted. No exceptional circumstances within the meaning of Article 13(2) RPBA were apparent that would justify the admissibility of new main request A and new auxiliary request III-A. The appellant had not provided any cogent reasons which would justify exceptional circumstances. The appellant's contention that the board had shifted its position by expressing an inclination to admit objections ad.2 and cl.2 was incorrect since previous requests had not removed the consonance between features b4, c3 and d3. The considerations regarding the course of the proceedings referred to by the board when assessing the admissibility of the previous requests were not applicable to new main request A and new auxiliary request III-A. The purpose of the appeal proceedings was not to give the proprietor the opportunity to repeatedly modify its requests until an acceptable set of claims was found (T 1617/08, Reasons 20 was cited). There was no right, in particular not under Article 13(2) RPBA, "to file an endless succession of new requests in substitution for requests found inadmissible or unallowable by the board. Proceedings must come to an end some time." Otherwise, the procedure could be misused to test which claim is considered patentable by the board and to shape the claim accordingly. In such cases, the board would be "the ghost-writer of what is ultimately claimed", which is not one of the board's duties (T 516/06, Reasons 4 was cited).

In addition, respondent II argued that claim 1 of new main request A was *prima facie* not allowable. New features c2A and d2A contradicted each other in terms

of the byte ranges pending in the request queue, this resulting in lack of clarity.

- 19.2 The appellant argued that new main request A was a response to objections cl.2, ad.1, and ad.2. It amended feature group c in the same manner as auxiliary request III and feature group d following a similar approach to that used for feature group b. The amendments were fully consistent with prior amendments and did not introduce new subject-matter. The board had shifted its position by admitting objections ad.2 and cl.2 and objection ad.1 could not have been reasonably anticipated. Given these exceptional circumstances and the unpredictable progression of the appeal proceedings, new main request A should be admitted into the proceedings. In the first oral proceedings the board had re-opened the debate to allow the respondents to raise new objections on auxiliary request 1.2''-b. In recognition of the exceptional courtesy extended to the respondents, the board had assured the appellant that it would be permitted to respond should the re-opened debate lead to further accepted objections.
- 19.3 The board does not agree with the appellant's depiction of the course of the proceedings. At the first oral proceedings, there was no re-opening of the debate, but a mere return to the discussion of clarity and added subject-matter before closing the debate. The board did not assure the appellant of anything but generously decided to recognise that admission of the respondents' objections created exceptional circumstances in favour of the appellant. This led the board to preliminarily admit the new main request and new auxiliary requests I to III submitted by the appellant after the first oral proceedings. But this does not mean that the appellant is allowed to repeatedly file a succession of requests



to overcome objections that may be raised against the new admitted requests. Therefore, the board does not recognise any exceptional circumstances under Article 13(2) RPBA justifying admittance of new main request A.

19.4 Furthermore, the board agrees with the respondents that the claim is *prima facie* not allowable. Due to the contradictory wording of features c2A and d2A, it is *prima facie* unclear whether the whole byte ranges or only portions are included in new queue.

19.5 Therefore, new main request A is not admitted into the proceedings (Article 13(1) and (2) RPBA).

#### *New auxiliary request III*

20. Claim 1 of new auxiliary request III adds to higher ranking requests features specifying the use of an index to the media sequence, the HTTP 1.1. protocol and multiple connections (see section XXXV. above).

#### 21. *New auxiliary request III - admissibility*

21.1 New auxiliary request III and the new main request were both submitted with the appellant's letter of 16 August 2024. The admissibility of the requests submitted with that letter was discussed together, the arguments being essentially the same. Therefore, for the same reasons as given above for the new main request, new auxiliary request III is admitted into the proceedings (Article 13(2) RPBA).

#### 22. *New auxiliary request III - clarity*

22.1 In claim 1 of new auxiliary request III, feature a (of the new main request, most of the higher ranking

requests and claim 1 as granted) has been amended as follows:

a' "A method of progressively playing back, by a client, a media sequence stored as a media file on a remote server, wherein the client and the remote server communicate via multiple network connections".

The claim specifies, in feature b3.1, the step of "establishing, by the client, a connection with the remote server" (as in the new main request).

Furthermore, the feature corresponding to feature c2 of granted claim 1 has been amended as follows:

c2' "when previously requested byte ranges are no longer required, flushing (114), by the client, the previous byte range requests by flushing the request queue, and breaking, by the client, at least one of the multiple network connections to the remote server in response to the receipt of the 'trick play' user instruction".

22.2 Claim 1 does not explain how the "multiple network connections" of feature a', the "connection" of feature b3.1 and the "at least one of the multiple network connections" of feature c2' relate to one another and how the connections are used in the claimed method.

22.3 The appellant argued that the terms "network connection" and "connection" in claim 1 referred to the same feature and meant a communication link between the client and the server, enabling the exchange of data over a network. The details of establishing and closing a connection were not described in the application, as these techniques were well-known to those skilled in the art and were not central to the invention. Multiple connections could be used in the method. An additional

connection might need to be opened in step b3.1 and before step c2'. As explained in paragraph [0052] of the parent application, the process could open multiple connections to increase the download data rate and/or accommodate servers that limit the number of byte requests that can be made via one connection. It would be incorrect to assume that the connection mentioned in feature b3.1 is the connection that is being used in step c2'. It would be inappropriate to require the appellant to limit the claim.

22.4 A claim should be clear when read by the skilled person without any reference to the content of the description (Case Law of the Boards of Appeal, 10th edition, 2022, II.A.3.1). In claim 1 of new auxiliary request III, it is not clear whether the terms "connection" and "network connection" correspond to the same technical feature. Furthermore, claim 1 does not specify how the connections are used in the claimed method, for example which data is transferred using which of the multiple connections.

Even if the skilled person assumes that, as the appellant suggested, the two terms refer to the same technical feature, it is unclear how the multiple connections of feature a', the connection of feature b3.1 and the at least one connection of feature c2' relate, and what their purpose is in the context of the claimed method.

Only previously opened or established connection(s) can be broken in step c2', but claim 1 does not specify when the "at least one of the ... connections" broken in step c2' have been established or opened. From the text of the claim the skilled reader understands that the "at least one of the ... connections" mentioned in step c2' refers to the multiple connections of

feature a'. Therefore, the combination of feature a' and step c2' indicates that the multiple connections mentioned in feature a' are already open or established from the beginning. However, it is then unclear why or for what purpose a connection is established in step b3.1 given that the client and server are already communicating via the multiple established connections of feature a'.

22.5 It is therefore unclear from the claim how the connections are used in the claimed method and what purpose they serve. It cannot be derived from the claim that the connections serve to increase the data rate or cope with the limit of requests per connection.

22.6 Therefore, claim 1 of auxiliary request III does not satisfy the requirements of Article 84 EPC.

*New auxiliary request III-A*

23. *New auxiliary request III-A - admissibility*

23.1 New auxiliary request III-A and new main request A were both submitted with the appellant's letter of 17 January 2025. The reasons given in point 19. above regarding admissibility of new main request A apply *mutatis mutandis* to new auxiliary request III-A.

23.2 Therefore, new auxiliary request III-A is not admitted into the proceedings (Article 13(2) RPBA).

*Request to re-open the debate and objection under Rule 106 EPC*

24. At the second oral proceedings, the appellant requested that the debate on auxiliary request 1.2''-b be re-opened and submitted the following objection under Rule 106 EPC:

"We hereby raise a procedural objection based on Art. 112a(2)(c) EPC. The Board explained that the objections in the official communication of 31 July 2024 were preliminary and could be debated during the oral proceedings and that the debate was not concluded on the second day of the oral proceedings. Against this background, the Board should have allowed us to defend the patent on the basis of auxiliary request 1.2''-b."

- 24.1 The appellant submitted that its initial understanding had been that the final decision on auxiliary request 1.2''-b had already been taken as expressed on page 2, section I, of its letter dated 16 August 2025, for example.

The appellant further argued that it had not had an opportunity to respond to the objections that the board had found convincing for auxiliary request 1.2''-b. The Chair had dismissed the appellant's request to reopen the debate made at the beginning of the oral proceedings on 14 February 2025.

- 24.2 Both respondents opposed the appellant's request to re-open the debate. They argued that it was clear that the communication of July 2024 did not constitute a decision. The proprietor had submitted new requests and had stated that no further debate was needed. There were no reasons to re-open the debate.

24.3 A communication pursuant to Article 15(1) RPBA is issued by a board in order to help concentration on essentials during the oral proceedings. It draws attention to matters that appear to be of particular significance to the decision to be taken. The board may also provide a preliminary opinion.

As explained in decision T 577/11, a decision given orally by a board becomes effective and binding by virtue of being pronounced (see also G 12/91, Reasons 2) and excludes any re-opening of the debate. For this reason, the boards are generally very careful about what they announce in the course of oral proceedings and whether they render an interlocutory decision on a particular point which would prevent them from reconsidering that point at a later stage, should the need arise (T 577/11, Reasons 3.1).

According to Article 15(5) RPBA, when a case is ready for decision during oral proceedings, the Chair shall state the final requests of the parties and declare the debate closed. No submissions may be made by the parties after closure of the debate unless the board decides to re-open the debate. As a rule, closing the debate takes place after the parties have been given the opportunity to present any facts, evidence or arguments they consider relevant. In view of this, re-opening a debate is exceptional. There is no right of a party to have the debate re-opened. Depending on the circumstances, the debate can be re-opened for specific points (Case Law of the Boards of Appeal, III.C.7.8; G 12/91, Reasons 3; T 577/11, Reasons 3.1).

In exceptional circumstances, re-opening the debate may be necessary, for example if the board establishes that a fundamental procedural deficiency constituting a

ground for petition for review has occurred (T 577/11, Reasons 3.1).

24.4 During the first oral proceedings in the present case, the parties were heard on the questions of claim interpretation and allowability, mainly clarity and added subject-matter, of the main request and auxiliary requests 1.1, 1.2, 1.2', 1.2'', 1.2''' and 1.2'''-b. On the second day, the appellant was heard on the objections raised by the respondents against auxiliary request 1.2'''-b. These topics were extensively discussed and the parties were given sufficient opportunity throughout the two days of oral proceedings to present any facts, evidence or arguments they considered relevant. In particular, the appellant was given enough time to present its arguments with regard to the objections under Articles 76(1) and 84 EPC against auxiliary request 1.2'''-b.

In view of this, at the end of the first oral proceedings the board found that the parties' right to be heard under Article 113(1) EPC with regard to these topics and requests had been observed. Accordingly, the Chair informed the parties that the debate on the main request and auxiliary requests 1.1, 1.2, 1.2', 1.2'', 1.2''' and 1.2'''-b and on the issue of a remittal was closed, with the exception that for auxiliary request 1.2'''-b the debate for the issues of novelty and inventive step was not closed. The parties agreed to continue the proceedings in writing (see also minutes of the oral proceedings of 6 and 7 June 2024).

In accordance with established practice, at this point in time, the board had not announced a decision on auxiliary request 1.2'''-b, but considered that the debate on clarity and added subject-matter was closed and that it was hence in a position to decide on these

issues. In order to assist the parties in preparing their case, especially in view of the extremely large number of pending requests to be dealt with in the second oral proceedings, the board prepared the communication pursuant to Article 15(1) RPBA dated 31 July 2024.

- 24.5 The board's communication of 31 July 2024 provided a summary of the results of the first oral proceedings, including the results concerning auxiliary request 1.2''-b. As usual, and in accordance with Articles 15(1) and 17(2) RPBA, the observations in this communication pursuant to Article 15(1) RPBA were merely intended to assist the parties in preparing for oral proceedings and were made without prejudice to the final decision of the board, as explained in the introductory paragraph of the communication. However, since the board had closed the debate on clarity and added subject-matter with regard to auxiliary request 1.2''-b, the board's preliminary opinion that auxiliary request 1.2''-b infringed Article 84 EPC could only be changed if the debate was re-opened by the board.

- 24.6 In its letters of 16 August 2024, page 2, and 17 January 2025, page 3, the appellant stated that although it did not withdraw the previous main request and auxiliary requests up to and including auxiliary request 1.2''-b, it acknowledged that "decisions on these requests have already been made, and any further discussion on them is unnecessary".

In these statements, the appellant did not express the need to re-open the debate with regard to auxiliary request 1.2''-b and did not object either that it had not been given sufficient opportunity to be heard on the objections against auxiliary request 1.2''-b.



Nevertheless, in the second oral proceedings, the appellant submitted an objection under Rule 106 EPC in respect of a procedural defect based on Article 112a(2)(c) EPC stating that the board "should have allowed us to defend the patent on the basis of auxiliary request 1.2''-b", and submitted a formal request that the debate be re-opened. The parties were heard on this request.

The board notes that it is not relevant whether, as alleged by the appellant, the Chair dismissed the request to reopen the debate made at the beginning of the second oral proceedings. At the end of the second oral proceedings, and even though a party does not have the right to have the debate re-opened, the board heard the parties on the appellant's formal request to re-open the debate which the appellant submitted at the end of the second oral proceedings.

- 24.7 Taking into account that, as explained in point 24.4 above, the appellant was given ample opportunity to present all the arguments it thought relevant, and its submissions have been discussed during oral proceedings, the board does not recognise that the appellant's right to be heard under Article 113(1) EPC has been violated in any way. The board sees no reason to re-open the debate on auxiliary request 1.2''-b.

Therefore, the appellant's request to re-open the debate is dismissed.

For the same reasons, the appellant's objection in respect of a procedural defect based on Article 112a(2)(c) EPC is dismissed (Rule 106 EPC).

### *Conclusion*

25. Since the patent cannot be maintained as granted or in amended form on the basis of any of the appellant's requests on file, the appeal is to be dismissed.

### **Order**

#### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chair:



G. Nachtigall

J. Geschwind

Decision electronically authenticated