

**Internal distribution code:**

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

**D E C I S I O N**  
**of 25 July 2003**

**Case Number:** T 0146/01 - 3.5.1

**Application Number:** 95114264.5

**Publication Number:** 0689113

**IPC:** G05B 19/418

**Language of the proceedings:** EN

**Title of invention:**

Numerically controlled machine tool management system

**Applicant:**

mitsubishi denki kabushiki kaisha

**Opponent:**

-

**Headword:**

Numerical control system/MITSUBISHI

**Relevant legal provisions:**

EPC Art. 111(1)

**Keyword:**

"Remittal for further prosecution"

**Decisions cited:**

-

**Catchword:**

-



Case Number: T 0146/01 - 3.5.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.1  
of 25 July 2003

**Appellant:**

MITSUBISHI DENKI KABUSHIKI KAISHA  
2-3, Marunouchi 2-chome  
Chiyoda-ku  
Tokyo 100 (JP)

**Representative:**

Popp, Eugen, Dr.  
MEISSNER, BOLTE & PARTNER  
Widenmayerstrasse 48  
D-80538 München (DE)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 12 September 2000  
refusing European application No. 95114264.5  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** S. V. Steinbrener  
**Members:** R. Randes  
E. Lachacinski

## Summary of Facts and Submissions

I. This is an appeal against the decision by the Examining Division to refuse the present European patent application because independent claim 1 of the single request lacked an inventive step in view of the following documents:

D1: EP-A-0 236506

D3: PATENT ABSTRACTS OF JAPAN vol. 012, no. 214  
(P -718), 18 June 1988 & JP-A-63010202 (HITACHI),  
16 January 1988

The Examining Division held that the basic principle of executing work directive data stored on an external portable storage means was disclosed in D1, where process control data was loaded into an NC-machine by means of a removable ROM cassette. The technical problem could be seen in finding an improved management system to manage process data of an NC-machine. The skilled person would thereby arrive at the technical field of process management and at the process operation managing system disclosed in D3. By combining the teachings of the two documents the skilled person would arrive at the invention.

II. In response to the statement of the grounds of appeal, in which the Appellant defended the refused claim 1, the Board in an annex to the summons to oral proceedings expressed the opinion that it was inclined to agree with the decision of the Examining Division.

III. Before the oral proceedings the Appellant filed a main request and four auxiliary requests with amended claims to replace the refused set of claims. In the oral proceedings, held before the Board on 25 July 2003, the Appellant filed an English translation D3<sub>tr</sub> of the Japanese application document corresponding to the Japanese abstract D3. The Board accepted the translation D3<sub>tr</sub> being introduced into the proceedings and provisionally considered its content. The Appellant argued that the teaching of D3<sub>tr</sub> could not affect the inventive step of the invention defined in the requests. However at the end of the oral proceedings, taking into account the observations of the Board, the Appellant filed a single request, containing a new claim 1.

Thus the Appellant finally requested that the decision under **appeal be set aside** and that a **patent be granted on the basis of the single request**, containing claims 1 to 5, submitted at the oral proceedings.

Independent claim 1 of the single request reads as follows:

"A numerical control system for controlling a machine tool (14) in a machine tool management system comprising:

control means (10, 12) and external portable storage means (1) for storing operation data;

adapting means (20), operable when said external portable storage means (1) is connected thereto, for reading data from said external portable storage means

(1), the storage means (1) containing operator identification data;

wherein

said adapting means (20) are also adapted to write data into said external portable storage means (1), and

said control means (10,12) including a batch processor means (8), for providing parameters and tool information, for carrying out a sequence of operation for running work directives, including a cutting program a predetermined number of times in accordance with batch processing data provided in said storage means (1) including said work directive data (37), and wherein

a cutting program processor (9) is provided for performing ordinary processing, said control means (10,12) adapted to allow an operator to switch from said ordinary processing with said cutting program processor (9) to batch processing with said batch processor (8) and vice versa, and wherein further

a message display unit (17) is provided, said control means (10, 12) adapted to cause displaying of work directive data for batch processing or to cause displaying of work directive data for ordinary processing and guiding the operator correspondingly".

IV. At the end of the oral proceedings the Chairman of the Board announced the decision.

## Reasons for the Decision

1. The appeal satisfies the requirements mentioned in Rule 65(1) EPC and is consequently admissible.
  
2. Although in the Board's view the filing of new evidence at a very late stage, as in the present case during oral proceedings, should be avoided as far as possible, in exercising its discretion to admit late filed documents the Board has to take account of the specific facts of the case under consideration, in particular of the complexity of the new subject-matter submitted, the nature and the current state of the proceedings, and the need for procedural economy. In the present case concerning ex parte proceedings the Board found in the oral proceedings that the content of document D3<sub>tr</sub> submitted by the Appellant/Applicant could not be considered to be too complicated, since it related to the corresponding Japanese abstract already taken into account by the Examining Division. Moreover, since the text of the abstract was somewhat unclear as to how the IC card was used and what kind of information was read from the card and/or written into its memory, it appeared that it would be wrong to take a final decision relying on the short text of the abstract only, in particular in a case where a complete translation of the original document was offered and was immediately available. Finally it appeared to the Board that D3<sub>tr</sub> probably could be considered as a more relevant document than D1 and therefore certainly should not be rejected in view of its possible importance with respect to patentability.

3. Since claim 1 of the final single request has been amended, mainly by addition of the features of claims 4 and 5 which were appended to refused claim 1, it is apparent that amended claim 1 identifies new aspects of the invention which were not considered by the Examining Division in the appealed decision. It is true that the Examining Division at the end of its decision stated that dependent claims 2 to 6 were not inventive, since their subject-matter was obvious to a skilled man. A detailed examination of the added features has however not been made and their impact on the other features of the claim and the overall effect of the new subject-matter has not been analysed. Thus a reasoned decision in a case where the application is based on the subject-matter of amended claim 1, and in particular an assessment of the inventive step in this respect, has not yet been provided.
4. The submission of the translation D3<sub>tr</sub> of the Japanese application document and the filing of amended claim 1 has substantially changed the case to be considered compared to the case as it stood before the Examining Division. Since it is not usual for a Board of Appeal to consider a new case as sole instance, the Board, in the present circumstances, considers it appropriate to exercise its discretion to remit the case to the Examining Division pursuant to Article 111(1) EPC for further prosecution. In the present case it also appears appropriate, should a decision favourable for the Appellant be taken, that the Examining Division investigate, whether the present divisional application meets the requirements for divisional applications mentioned in the Guidelines, C-VI, paragraph 9, in particular paragraph 9.6.

**Order**

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

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

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener