

Decision of Technical Board of Appeal 3.5.01 dated 20 October 2006**T 1242/04 - 3.5.01**

(Translation)

Composition of the board:

Chairman: S. Steinbrener

Members: R. Wibergh

G. Weiss

Applicant: MAN Nutzfahrzeuge Aktiengesellschaft**Headword: Provision of product-specific data/MAN****Article: 52(2), (3), 56, 111(1), 112(1)(a) EPC****Rule: 44(1), 45, 86(4) EPC****Guidelines for Examination in the European Patent Office, B-VIII, 3****"Notice from the European Patent Office dated 26 March 2002 concerning business methods" (OJ EPO 2002, 260)****Keyword: "Declaration under Rule 45 EPC" - "Additional search" - "Enlarged Board of Appeal - referral by board of appeal (no)" - "Remittal (yes - on basis of "further" auxiliary request)"***Headnote:**I. Rule 45 EPC relates only to the practicability of a search and not to the potential relevance of its results in subsequent substantive examination (Reasons 8.3).**II. Where the application's subject-matter has non-technical aspects, a declaration under Rule 45 EPC may be issued only in exceptional cases in which the claimed subject-matter, i.e. the entire set of claims including all independent and dependent claims, clearly has no technical character (Reasons 8.4).***Summary of facts and submissions**

I. The appeal lies from the decision of the examining division to refuse European patent application No. 02 026 715.9 for lack of technical character in accordance with Article 52(2) and (3) EPC.

II. In the search phase a declaration under Rule 45 EPC was sent, to the following effect:

"The claims relate to subject-matter which is excluded from patentability under Article 52(2) and (3) EPC. Given that they refer either only to such non-technical matter or to commonly known features for their technological implementation, the search examiner has been unable to identify any technical problem whose solution might possibly involve an inventive step. Hence it has not been possible to carry out a meaningful search into the state of the art (R. 45 EPC and EPO Guidelines, Part B, Chapter VIII, 1-6).

The applicant is reminded that a search may be carried out during examination if the deficiencies that necessitated a Rule 45 declaration have been corrected (see EPO Guidelines C-VI, 8.5)".

No such "additional" search was carried out during the examination phase.

III. The notice of appeal was filed on 9 July 2004, and the fee for the appeal was paid on the same day. The statement of grounds was filed on 10 September 2004, together with amended claims 1 to 16 according to an auxiliary request. According to the main request, a patent was to be granted on the basis of the valid claims as filed by letter of 5 March 2004. The appellant maintained that the subject-matter of independent claims 1 and 10 had technical character under Article 52(2) and (3) EPC, in the absence of any known prior art it was new, and it also involved an inventive step.

IV. In a communication dated 3 March 2006 the Board issued a summons to oral proceedings and set out its provisional opinion on the appeal, which was that the objection of lack of technical character in the subject-matter of the two independent claims 1 and 10 of the main request would not be maintained, but that the subject-matter in question probably did not involve an inventive step.

The auxiliary request, on the other hand, required a prior art search; but as none had been conducted during the first-instance proceedings, where only a declaration under Rule 45 EPC had been issued, the Board would remit the auxiliary request to the examining division.

V. In a letter dated 14 September 2006 the appellant set out further arguments and requested that the application documents be remitted to the search division to be searched in respect of the claims of the main request as well.

VI. By letter of 20 September 2006 the Board announced that the appointed date for the oral proceedings would not be changed, and the case could not be remitted to the first-instance department without oral proceedings unless the main request was withdrawn.

VII. On 20 October 2006 the Board held oral proceedings, in the course of which the appellant requested that the following point of law be referred to the Enlarged Board of Appeal:

"Is it necessary to perform an additional search and record its result in a search report if an objection of lack of technical character (Art. 52(2) EPC) initially results in a declaration under Rule 45 EPC taking the place of the search report but subsequently is not maintained during the examination or appeal proceedings?"

VIII. The appellant also submitted an amended set of claims 1 to 16 as "first" auxiliary request. The previous auxiliary request filed with the statement of grounds thereby became the "further" auxiliary request.

IX. Independent claim 10 according to the main request reads:

"10. System for providing product-specific data in a service station for recognition and editing of design and function states, characterised by

- a central database (1) for storing and providing equipment data for product components of all product types and the different variants, the equipment data being updated by the manufacturer;

- an archive store (3) in which is archived for each delivered product at least one dedicated data file (2) which can be retrieved via an identification code assigned thereto and which contains the individual equipment data of the particular delivered product (7), wherein

- multiple user interfaces (5) are to be connected to the archive store (3) by telecommunication;
- a computer-assisted program (4) which communicates with the central database (1) and the archive store (3) to generate new and/or updated data files and store them in the archive store (3);
- multiple service stations with at least one user interface (5) via which a data file (2) allocated to the particular product (7) can be retrieved from the archive store (3) for editing of that product (7); and
- equipment data for the product (7), comprising information on product components, hardware and software and on individual settings of product components, with changes to the individual product being stored in sequential data file versions (2) in the archive store (3); and
- data file versions (2_(1-n)) stored in the archive store (3) reflecting the chronological sequence of changes to the particular product (7)."

Claim 1 is for a corresponding method.

X. The version of independent claim 10 filed as the "first" auxiliary request during oral proceedings differs from the wording of claim 10 according to the main request by the addition of a further sub-feature at the end of the claim:

"wherein the computer-assisted program (4) has access to the updated equipment data stored in the central database (1) and on the one hand during product manufacture co-ordinates the generation of the associated data file (2) as per the assembly order and the resultant production control and on the other hand during product servicing makes only the updated equipment data stored in the central database (1) available in the service station (6) for product editing."

Claim 1 is for a corresponding method.

XI. Independent claim 10 according to the "further" auxiliary request filed with the statement of grounds reads:

"10. System for providing product-specific data in a service station for recognition and editing of design and function states, characterised by

- a central database (1) for storing and providing equipment data for product components of all product types and the different variants, the equipment data being updated by the manufacturer;
- an archive store (3) in which is archived for each delivered product a dedicated data file (2) which can be retrieved via an identification code assigned thereto and which contains the individual equipment data of the particular delivered product (7), wherein
- multiple user interfaces (5) are connectable to the archive store (3) by telecommunication;
- a computer-assisted program (4) which communicates with the central database (1) and the archive store (3) to generate new and/or updated data files and store them in the archive store (3);
- at least one user interface (5) located in a service station (6) via which the data file (2) allocated to the particular product (7) can be retrieved from the archive store (3) and the current status of a serviced product (7) can be identified for editing of that product (7);
- the computer-assisted program (4) has access to the updated equipment data stored in the central database (1) and on the one hand during product manufacture co-ordinates the generation of the associated data file (2) as per the assembly order and the resultant production control and on the other hand during product servicing makes only the updated equipment data stored in the central database (1) available in the service station (6) for product editing; wherein
- the serviced product is to be connected to the interface (5) via a converter (8) for data transmission."

Claim 1 is for a corresponding method.

XII. With regard to non-performance of the search, the appellant maintained that there should not have been a Rule 45 declaration. The search report was a cornerstone of the procedure. Search had to be carried out independently of substantive examination. Rule 86(4) EPC might otherwise act as a trap: if a board of appeal remitted a case for further examination on the basis of limited claims but a search report drawn up later showed that a broader scope of protection would have been possible, the applicant might in some circumstances no longer be able to amend the claims accordingly. Thus the state of the art had to have been established in time for the beginning of the examination procedure so that an applicant could, as a result of an inventive step objection based on common general knowledge, assess which restrictions to the protection sought were demanded by the documented prior art.

XIII. The appellant requested that the decision to refuse be set aside and that a patent be granted on the basis of the main request as filed on 5 March 2004,

with an auxiliary request that the case be remitted to the department of first instance for resumption of the proceedings, or that otherwise the point of law raised at oral proceedings be referred to the Enlarged Board of Appeal,

with a further auxiliary request that a patent be granted on the basis of the claim version filed as "first" auxiliary request during oral proceedings, or that otherwise the case be remitted to the department of first instance for resumption of the proceedings,

and with a further auxiliary request that a patent be granted on the basis of the claim version filed with the statement of grounds of appeal and maintained as "further" auxiliary request, or that otherwise the case be remitted to the department of first instance for resumption of the proceedings.

XIV. At the end of the oral proceedings the Board pronounced its decision.

Reasons for the decision

1. Admissibility of the appeal

The appeal meets the requirements mentioned in Rule 65(1) EPC and is therefore admissible.

Main request

2. The appellant requests that the decision to refuse be set aside and that a patent be granted on the basis of the main request as filed on 5 March 2004.

3. Technical character - Article 52(2) and (3) EPC

3.1 The objection of lack of technical character in the subject-matter of the two independent claims 1 and 10 does not bear scrutiny in the light of the case law of the boards of appeal in T 931/95 (OJ EPO 2001, 441) and T 258/03 (OJ EPO 2004, 575).

3.2 Apart from the fact that, in keeping with T 931/95, even the apparatus category of claim 10 implies the presence of physical features and hence a technical character, both of the independent claims feature at least a central database for recording the required status and an archive store for recording the actual status which communicate with each other by computing means, which implies the use of a computer. Thus independent method claim 1 also uses technical means and in keeping with T 258/03 involves more than a purely abstract concept. Thus independent claims 1 and 10 both have a technical character and constitute inventions within the meaning of Article 52(1) EPC.

4. Inventive step - Article 56 EPC

4.1 The appellant has argued that the object of the invention is to guarantee the product's functionality and quality throughout its lifetime, and that this constitutes a technical contribution.

In the Board's view, however, this object is not achieved by the subject-matter of claim 10. Higher functionality and quality throughout the product's lifetime are not the consequence of the method or system of the invention; they are the consequence of using the best possible components. The stored data itself has no direct technical effect on product quality, this in fact being provided by the improved components themselves, to which the equipment data in the central database merely refers. Hence the guarantee of maintenance quality is also dependent upon the service personnel and is not automatic, which means that errors in maintenance continue to be possible.

4.2 Even if the object is simply held to be the provision of product-specific data so that the product's required status can be compared with its actual status (see also col. 6, l. 26-28 of the A1 document: "This results in the automatic supply of updated product-specific data to the service station"), it is still essentially administrative in nature. What is definitely technical, though, is the realisation or implementation of this concept by technical means; and that must be held to constitute the technical problem in this case.

4.3 In assessing inventive step, only the features which contribute to the solution of the technical problem need to be taken into account (see T 641/00, OJ EPO 2003, 352). In independent claim 10 these are:

- a central database for storing and providing data
- an archive store for archiving data files retrievable via their assigned identification codes which comprise changes to the specific product in sequential data file versions
- user interfaces assigned to service stations and connectable to the archive store by telecommunication for the retrieval of data files, and
- a computer-assisted program which communicates with the central database and the archive store in order to generate new and/or updated data files and store them in the archive store.

In contrast, the data file data sequentially stored in the archive store, like the equipment data in the central database, has no functional character within the meaning of T 1194/97 (see in particular paragraph 3.3; OJ EPO 2000, 525), since a defect in this data has no effect on the functional capacity of the system. The data in question merely describes a condition of the serviced product and thus does not contribute to the technical character of the claimed system.

4.4 In the Board's view, communication between the central database and the archive store is simply a form of client-server architecture, which was indisputably already part of the common general knowledge before the date of priority of the present application. The sequential data files in the archive store constitute an obvious implementation of a conventional maintenance manual in the form of an electronic database. Another related factor is that, in database systems in general, the data is accessed through unique index fields, which are comparable with the assigned identification codes in the present case. Client computers in particular have equivalent user interfaces and communicate with the server computer by telecommunication (e.g. computer networks). The object of all data processing is to create or modify data in the form of data files and store it in the database. Storage processes may

take the form of overwriting old files or of continuous updating in the style of a history. The use of known client-server technology is also linked to the idea of central data maintenance in order to avoid inconsistency, with the obvious bonus effect, as it were, of uniform product service (see p. 4, first paragraph, of the grounds of appeal).

Thus in the Board's view such an implementation only requires measures which are obvious from the common general knowledge in conjunction with basic programming skills.

4.5 Similar considerations apply to the corresponding method claim 1.

4.6 Hence for lack of an inventive technical contribution to the state of the art, independent claims 1 and 10 according to the main request do not involve an inventive step.

First auxiliary request

5. In this auxiliary request the appellant asks that the case be remitted to the department of first instance for resumption of the proceedings, or that otherwise the point of law raised at oral proceedings be referred to the Enlarged Board of Appeal.

6. As set out above, the Board, duly exercising its discretion under Article 111(1) EPC, has in the present case identified the common general knowledge as the state of the art, which is considered sufficient to assess the inventive step of the main request. In such circumstances remittal is neither necessary nor appropriate.

7. With regard to the request for Enlarged Board referral (see point VII above) the first things that need to be established are how Rule 45 EPC is to be construed and when an additional search is necessary.

8. Declaration under Rule 45 EPC

8.1 Rule 45 EPC reads:

"If the Search Division considers that the European patent application does not comply with the provisions of the Convention to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims, it shall either declare that search is not possible or shall, so far as is practicable, draw up a partial European search report. The declaration and the partial report referred to shall be considered, for the purposes of subsequent proceedings, as the European search report."

8.2 The search is an essential element of the grant procedure, being designed to identify prior art relevant to the application. The intention is to make it possible to determine, on the basis of the documents mentioned in the search report, whether and to what extent the invention is patentable (see R. 44(1) EPC). Knowledge of the prior art forms the basis for examination of the application by the examining divisions. It is also important for applicants, giving them a basis for deciding whether to continue prosecuting their applications and have them examined. Lastly, it is also important for the public and especially for competitors, enabling them to gain an idea of the scope of any protection that might be granted. For that reason the legislator has also stipulated that the results of the duly performed search must be published together with the European patent application eighteen months after the date of filing or priority (see Art. 93(2) EPC).

The fundamental importance of the search is also evident from the facts that it constitutes a chargeable service of the European Patent Office, that the search fee must be paid within one month after the filing of the application

(Art. 78(2) EPC) and that failure to pay the search fee means that the application is deemed to be withdrawn (Art. 90(3) EPC). Likewise, the Guidelines for Examination in the European Patent Office in B-III 2.1 (in the version dated June 2005) stress that the European search is a thorough, high-quality, all-embracing search.

Thus it is clear that Rule 45 EPC constitutes an exception and as such must be interpreted narrowly.

8.3 Rule 45 EPC applies to cases which do not comply with the provisions of the Convention to such an extent that it is not "possible" to carry out a "meaningful search" into the state of the art on the basis of all or some of the claims. Thus a Rule 45 declaration is allowed only where a search is not possible. In other cases the search division draws up a partial search report, "so far as is practicable".

In the Board's view, Rule 45 EPC relates only to the practicability of a search and not to the potential relevance of its results in subsequent substantive examination. That is clear from the actual wording of the rule, which refers to the impossibility of carrying out a meaningful search in the event of serious violations of the provisions of the Convention, for example a fundamental lack of clarity or the absence of any technical character whatsoever. If these criteria are not met, searching cannot be refused by reference to Rule 45 EPC, regardless of whether the search in the search division's view would not produce any result of significance to subsequent proceedings. In the final analysis, the search is the basis for substantive examination (and now also for the extended European search report under Rule 44(a) EPC) and not vice versa. Moreover, it is not evident that claims directed only to technical features that the search division deems "trivial" could prevent a meaningful search into the state of the art, which in fact ought to be particularly simple in such a case.

8.4 In this light the Board deems that where the application's subject-matter has non-technical aspects, a declaration under Rule 45 EPC may be issued only in exceptional cases in which the claimed subject-matter, i.e. the entire set of claims including all independent and dependent claims, clearly has no technical character.

8.5 As the wording used for the Rule 45 declaration in the present case shows (see point II above), the search division seems to have considered a search not so much impossible as unnecessary. This opinion, which the examining division evidently adopted as well, is also expressed in the "Notice from the European Patent Office dated 26 March 2002 concerning business methods" (OJ EPO 2002, 260) and in Guidelines for Examination B-VIII, 3. However, for the reasons given above, the Board does not agree with the approach taken in the Notice and the Guidelines.

8.6 The search division's interpretation of Rule 45 EPC is particularly dubious in the present case because the rule also provides for a partial search. Some of the original claims, in particular claims 5 and 16, include clearly technical features (see also point 15 below). Thus it was foreseeable from the outset that documented prior art might be needed in the subsequent examination proceedings.

9. Additional search

9.1 Provision is made in the Guidelines for Examination, B-II, 4.2, for an "additional search" to be performed in certain circumstances. The appellant in the present case has objected that no additional search was carried out even though the objection of lack of technical character that was set out in the Rule 45 declaration was not maintained during subsequent proceedings.

9.2 In the Board's view, however, it is not always necessary in such circumstances to carry out an additional search in the documented prior art. The examining division is responsible for examining an application (Art. 18(1) EPC). It decides what objections there are to the granting of a patent (Art. 96(2) EPC). According to the established case law of the boards of appeal it is possible to raise an objection of lack of inventive step without documented prior art (see e.g. T 939/92, point 2.3, OJ EPO 1996, 309). That should be allowable where the objection is based on "notorious knowledge" or indisputably forms part of the common general knowledge. In such cases it would be inappropriate to

carry out an additional search for documented prior art on purely formal grounds. Hence even if an initially raised objection of lack of technical character under Article 52(2) EPC has been abandoned, an additional search is not necessarily required if the claimed subject-matter is already anticipated by the common general knowledge or is obvious from that knowledge in terms of its technical contribution. It is necessary, however, if the claim features do not form part of the common general knowledge and the appellant also does not acknowledge them to be known. Arguing on the basis of invented examples, as the examining division did in the course of the current proceedings (see the decision, point 4 of the summary of facts), is of course no substitute for a search.

9.3 The appellant has further asserted that under the prevailing circumstances Rule 86(4) EPC may act as a trap: if the applicant restricts the scope of protection during the appeal proceedings but discovers after an additional search that the state of the art would have allowed broader protection, Rule 86(4) EPC might make it difficult to amend the claims accordingly.

The Board finds this argument unconvincing. An applicant must as a rule be expected to take the essential aspects of the invention into account when amending claims and not replace the whole of the claimed subject-matter, for example, in order to bring about a remittal to the examining division. Thus there can be no talk of a "trap". However, the appellant is right to say that an amendment made by an applicant who was not aware of all the prior art might later prove pointless, since highly relevant individual publications (e.g. having an identical content) can only be discovered by means of a systematic search of the search documentation.

10. Referral to the Enlarged Board of Appeal

10.1 Under Article 112(1)(a) EPC, the board of appeal may, during proceedings on a case, refer any question to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law, or if an important point of law arises.

10.2 A referral to ensure uniform application of the law is required if the board deems it necessary to depart from an interpretation of the EPC in an earlier board of appeal decision. The present Board however is not aware of any decision that takes a different line to the above legal opinion.

10.3 An important point of law is one which is relevant in a substantial number of similar cases and is therefore of great interest not only to the parties to the appeal at issue but to the public at large (see T 271/85, OJ EPO 1988, 341). Yet even with a fundamentally important point of law, it remains at the discretion of the board whether or not to refer it to the Enlarged Board (see T 390/90, OJ EPO 1994, 808). In this context one of the applicable criteria is whether the question can be answered beyond all doubt by the board itself (see T 198/88, OJ EPO 1991, 254). A question to which no generally applicable answer can be given will not be referred (see T 972/91, not published in OJ EPO). The same applies if the requested referral is not a point of law but a technical issue (see T 181/82, OJ EPO 1984, 401).

In the situation to which the referral relates, the need for an additional search after the abandonment of an initially raised objection of lack of technical character under Article 52(2), (3) EPC must be assessed on a case-by-case basis, as appropriate to the specific circumstances. This assessment is primarily technical in nature because it requires the skilled person to interpret technical information. In that light a generally applicable answer to the referred question would not be possible.

10.4 Hence the Board sees no reason for the point of law raised by the appellant to be referred to the Enlarged Board of Appeal.

Second auxiliary request

11. The appellant requests that a patent be granted on the basis of the claim version filed as "first" auxiliary request during oral proceedings, or that otherwise the case be remitted to the department of first instance for resumption of the proceedings.

12. Inventive step

12.1 In the Board's view, the further partial feature added relative to claim 10 according to the main request (see point X above) does not add any technical means which contribute to the technical character. Hence the technical means that are used are limited to those already discussed in relation to the main request (see point 4.3 above).

The further partial feature in question relates to an assembly order and the resultant production control, although the prior art portion of claim 10 is directed only to the subsequent service area. No assembly and production control measures are claimed or developed, but more details are given about data file generation, although the data files have no functional character in relation to the claimed system for providing product-specific data (see point 4.3 above). Even if the assembly order and production control are involved in data file generation, the data file data thus generated still only represents the product-specific data itself, but defects in that data have no effect on the functional capacity of the claimed system for providing product-specific data.

12.2 Even a conventional maintenance manual features production-related information about the specific product, e.g. chassis number or special equipment. The sequential data files thus generated in the archive store therefore still merely constitute an obvious implementation of a conventional maintenance manual in the form of an electronic database.

12.3 Thus for want of an inventive technical contribution to the common general knowledge, independent claim 10 according to this auxiliary request likewise does not involve an inventive step.

13. As the common general knowledge in this context is considered sufficient prior art for the assessment of inventive step, the Board, duly exercising its discretion under Article 111(1) EPC, again finds that remittal under these circumstances is neither necessary nor appropriate.

Third auxiliary request

14. The appellant requests that a patent be granted on the basis of the claim version filed with the statement of grounds ("further" auxiliary request; see point XI above), or that otherwise the case be remitted to the department of first instance for resumption of the proceedings.

15. In the Board's view, the last partial feature of claim 10, a connection between the serviced product and the interface via a converter for data transmission (the subject-matter of the original claim 16), in the prevailing configuration goes beyond the mere common general knowledge (for example the commonly encountered use of a computer, a network, an electronic database) and thus cannot be definitively assessed without knowledge of the relevant documented prior art. Thus this auxiliary request requires a search for relevant prior art. Hence the matter must be remitted for an additional search and further examination.

Order

For these reasons it is decided that:

1. The contested decision is set aside.
2. The case is remitted to the department of first instance for resumption of examination proceedings on the basis of the "further" auxiliary request filed with the statement of grounds of appeal.
3. The higher-ranking requests are refused.