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**Datasheet for the decision
of 13 May 2011**

Case Number: T 0494/07 - 3.4.03

Application Number: 02253587.6

Publication Number: 1367546

IPC: G07D 7/20

Language of the proceedings: EN

Title of invention:

Currency Validator

Applicant:

MEI, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 52(1)

Relevant legal provisions (EPC 1973):

EPC Art. 64(2), 111(2), 84

EPC R. 67

Keyword:

"Method involving technical means is an invention within the meaning of Art. 52(1) EPC"

"Reimbursement of appeal fee (no)"

"Clarity (yes)"

"Remittal fo further prosecution"

Decisions cited:

T 0410/96, T 0258/03, J 0027/94

Catchword:

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Case Number: T 0494/07 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 13 May 2011

Appellant: MEI, Inc.
1301 Wilson Drive
West Chester, PA 19380 (US)

Representative: Peterreins, Frank
Fish & Richardson P.C.
HighLight Business Towers
Mies-van-der-Rohe-Strasse 8
D-80807 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 7 November 2006
refusing European patent application
No. 02253587.6 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: G. Eliasson
Members: T. Häusser
T. Bokor

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing the European patent application No. 02 253 587.

The examining division held that pursuant to Article 52(2)(c) EPC 1973 the subject-matter of claims 20 and 21 of the application could not be regarded as an invention within the meaning of Article 52(1) EPC 1973, and furthermore that the application did not meet the requirements of Article 84 EPC 1973, because claim 22 was not clear.

- II. The appellant requests that the decision be set aside and the case be remitted to the examining division for further prosecution. The appellant also requests a refund of the appeal fee because the examining division committed a substantial procedural violation.

- III. The wording of claims 20 to 22 reads as follows:

"20. A method of programming a currency tester (50) comprising storing data for executing a method as claimed in any preceding claim in a currency tester.

21. A method as claimed in claim 20 comprising deriving an acceptance threshold for a currency item using a Hotelling test.

22. A currency tester comprising means for executing a method as claimed in any one of claims 1 to 19."

IV. The examining division argued essentially as follows:

Both the subject-matter of claims 20 and 21, which related to a method of programming a currency tester, and the final product being protected under Article 64(2) EPC 1973 were excluded from patentability under Article 52(2)(c) EPC 1973 with reference to programs for computers.

Claim 22 was unclear, because it could be interpreted on the one hand to comprise means corresponding to all claims 1 to 19 and on the other hand to be shorthand for 19 different claims.

V. The appellant argued essentially as follows:

Claims 20 and 21 related to a method of programming a currency tester rather than to a program for computers and were therefore not excluded from patentability.

Claim 22 referred to method claims 1 to 19 in a "short format" which was regarded to be clear in the decision T 410/96 of the boards of appeal. Furthermore, the language regarding the claim dependencies in claim 22 was conventional and clear.

Refund of the appeal fee was requested because the decision T 410/96 was not followed even though the relevant facts were the same, which amounted to a substantial procedural violation.

Reasons for the Decision

1. Admissibility

The appeal is admissible.

2. Patentable inventions (Article 52 EPC)

According to Article 52(1) EPC, European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application. Patent protection is thus available for technical inventions of all kinds. The term "invention" in Article 52(1) EPC is therefore to be construed as "subject-matter having technical character" (see Case Law of the Boards of Appeal of the EPO, 6th edition, section I.A.1.1).

Claim 20 relates to a method of programming a currency tester. The claimed method therefore involves technical means, namely a currency tester, and is therefore regarded to have technical character (see the decision T 258/03 of the Boards of Appeal, reasons 4). In particular, the claimed method involves the step of storing data in a currency tester, with the effect that the data are in fact stored in the currency tester once the step has been carried out. This is to be contrasted to a sequence of computer-executable instructions, i.e. a computer program, which merely have the potential of achieving an effect when loaded into and executed by a computer. Thus, the claim category of the claimed method is distinguished from that of a computer program.

The question whether Article 64(2) EPC 1973 should be taken into consideration when assessing whether the claimed subject-matter is an invention in the sense of Article 52(1) EPC does not appear relevant as the result of performing the method of claim 20 is not a computer program but a programmed currency tester, which is a technical device.

Claim 21 is dependent on claim 20 and as such includes all features of claim 20, so that the comments above also apply to that claim. The method defined in claim 21 is therefore also considered as an invention within the meaning of Article 52(1) EPC.

Therefore the board considers the method defined in claims 20 and 21 as an invention within the meaning of Article 52(1) EPC.

3. Clarity (Article 84 EPC 1973)

The features of the independent apparatus claim 22 are defined by reference to method claims 1-19 (see T 410/96, reasons 7 to 11). It might be argued that claim 22 allows different interpretations, namely on the one hand that a single means carries out all steps and on the other hand that respective means are provided. This is however also the case for a claim directed to an apparatus and including as features explicit "means for" carrying out each of the specified steps, as such a formulation does not exclude the possibility that it is in fact the same means which carry out several or all steps. The above-mentioned possibility of different interpretations is therefore

regarded to be a sign of adequate scope of protection rather than indicating a lack of clarity.

The manner in which the reference to claims 1-19 is formulated is also regarded to be adequate as shorthand for 19 separate references to claims 1-19, respectively.

Therefore the board considers claim 22 to be clear.

4. Remittal to the department of first instance (Article 111(1) EPC 1973)

The board notes that the novelty and inventive step of the subject-matter of claims 20 and 22 depend on the novelty and inventive step of the subject-matter of claims 1-19. The examining division has indicated in the appealed decision as obiter dictum that claims 1-19 seemed to fulfil the requirements of the EPC. However, the board has doubts regarding inventive step of the subject-matter of claim 1 in view of document D1 (EP 0 924 658 A2), specifically paragraph [0057].

In order to preserve the right of the appellant to argue before two instances, the board considers it therefore appropriate under these circumstances to remit the case to the department of first instance for further prosecution, as requested by the appellant.

5. Reimbursement of the appeal fee (Rule 67 EPC 1973)

Article 111(2) EPC 1973 states that the department whose decision was appealed is bound by the ratio decidendi of the Board of Appeal, if the Board of Appeal remits the case for further prosecution to that

department. However, the strict legal obligation to follow the ratio decidendi of a decision of a board is limited to the same application and the same instance whose decision has been contested in the appeal, but does not extend to other applications (or even to other instances in the same application). This is so even if the subject-matter of the two applications is highly similar (see J 27/94, OJ EPO 1995, 831, point 3 of the reasons). At most, it can only be regarded as an error of judgement if two apparently similar case constellations are decided differently. Not following T 410/96 does therefore not constitute a substantial procedural violation within the meaning of Rule 67 EPC 1973 and reimbursement of the appeal fee is not justified.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

S. Sánchez Chiquero

G. Eliasson