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**Datasheet for the decision
of 20 May 2010**

Case Number: T 0993/07 - 3.5.03

Application Number: 99115001.2

Publication Number: 0962845

IPC: G05B 19/042

Language of the proceedings: EN

Title of invention:

System for use in a field device management

Patentee:

Fisher-Rosemount Systems, Inc.

Opponent:

Endress + Hauser (Deutschland) AG + Co. KG

Headword:

Field device management system/FISCHER-ROSEMOUNT

Relevant legal provisions:

EPC R. 80

EPC Art. 105a, 123(2)

Relevant legal provisions (EPC 1973):

EPC R. 57a

Keyword:

"Amendments occasioned by a ground for opposition - main and first auxiliary requests (no)"

"Added subject-matter - second and third auxiliary requests (yes)"

Decisions cited:

G 0001/84, G 0001/91, G 0009/91, G 0009/93, G 0003/97,
G 0003/98, G 0002/04, G 0001/05, J 0005/81, T 0079/91,

T 0246/91, T 0610/95, T 0674/96, T 0223/97, T 0181/02,
T 1138/02, T 1416/04

Catchword:

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Case Number: T 0993/07 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 20 May 2010

Appellant 1: Fisher-Rosemount Systems, Inc.
(patent proprietor) 8301 Cameron Road
Austin
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Representative: Bohnenberger, Johannes
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Appellant 2: Endress + Hauser (Deutschland) AG + Co. KG
(opponent) Colmarer Strasse 6
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Representative: -

Decision under appeal: Interlocutory decision of the opposition
division of the European Patent Office posted
4 April 2007 concerning maintenance of European
patent No. 0962845 in amended form.

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
R. Moufang

Summary of Facts and Submissions

- I. Appeals were filed by both the proprietor and the opponent against the decision of the opposition division finding European patent No. 0 962 845 in amended form to meet the requirements of the EPC.
- II. The opposition was against the patent as a whole and on the ground that the claimed subject-matter did not involve an inventive step, Article 100(a) EPC.
- III. Following oral proceedings, the opposition division held that the patent in amended form according to a seventh auxiliary request met the requirements of the EPC. With respect to a main request and first to sixth auxiliary requests the opposition division held that these requests did not comply with Rule 57a EPC 1973.
- IV. In its statement of grounds of appeal, the proprietor (hereinafter appellant 1) requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 39 of a main request or, alternatively, claims 1 to 29 of a first auxiliary request, both requests as annexed to the statement of grounds of appeal, or on the basis of claims 1 to 20 as annexed to the interlocutory decision of 4 April 2007 (second auxiliary request). For each of these requests, description pages and drawings were also specified. Claims 14, 24, 26 and 33 of the main request were said to include clerical amendments (by implication to the corresponding claims as granted) which the appellant requested be dealt with as requests for correction under Rule 89 EPC 1973 or, alternatively, Rule 88 EPC 1973.

Further, appellant 1 requested that, prior to any decision by the board on the main and auxiliary requests, the following four questions be referred to the Enlarged Board of Appeal:

"1. If a patentee is occasioned by grounds for oppositions to amend a granted independent claim, is patentee prohibited by Rule 57a EPC from presenting, in lieu of the validly opposed independent claim, several independent claims that each fall within the scope of the opposed independent claim?

2. If the answer to question 1 is yes, is patentee prohibited by Rule 57a EPC from presenting, in lieu of the validly opposed independent claim, several independent claims, one or more of which contains amending limitations not found verbatim in the granted claims?

3. If the answer to question 2 is yes, is patentee restricted by Rule 57a EPC to presenting, in lieu of the validly opposed independent claim, several independent claims, each of which is limited solely via inclusion of all features recited in one or more of the granted dependent claims dependent from the opposed independent claim?

4. If the answer to question 2 is no, is there any restriction to the number of independent claims that may be presented in lieu of the validly opposed independent claim?"

Appellant 1 requested oral proceedings.

- V. In its statement of grounds of appeal, the opponent (hereinafter appellant 2) requested that the decision under appeal be set aside and that the patent be revoked in its entirety. It was argued that the claims as maintained by the opposition division did not comply with the requirements of Articles 83, 84 and 123(2) EPC. Oral proceedings were conditionally requested.
- VI. The board summoned the parties to oral proceedings. In a communication accompanying the summons, the board drew attention to issues to be discussed at the oral proceedings. More specifically, the question was raised as to whether or not the amendments made to the claims according to the main and first auxiliary requests complied with the requirement of Rule 80 EPC, *i.e.* whether or not the amendments were occasioned by a ground for opposition. The parties were also informed that if at the oral proceedings the board were to hold that one of these requests complied with the requirement of Rule 80 EPC, it would subsequently be necessary to discuss the question of whether or not the amendments made to the claims as granted complied with the requirements of Articles 83, 84 and 123 EPC. If neither the main request nor the first auxiliary request were held to comply with these provisions, it would subsequently be necessary to discuss the same question in connection with the claims of the second auxiliary request.

The parties were also informed that the appeals were consolidated in accordance with Article 10(1) RPBA.

- VII. In a letter in response to the summons to oral proceedings, appellant 1 stated that a multiplicity of independent claims was presented with a view to testing

the extent to which they could replace a single independent claim whose validity had come into question in opposition proceedings. This appellant further requested that claims 4, 14 and 16 of the "Druckexemplar", which was indirectly referred to in the original decision to grant, be corrected under Rule 140 EPC by the examining division or, in the alternative, that the applicant's response to the communication under Rule 51(4) EPC be corrected under Rule 139 EPC in order to reflect the clerical amendments to claims 4, 14 and 16.

VIII. In a letter in response to the summons to oral proceedings, appellant 2 requested that the pending main and auxiliary requests be rejected, in particular since they did not comply with Rule 80 EPC and, given the extremely high number of independent claims, did not comply with Article 84 EPC and Rule 43 EPC.

IX. Oral proceedings were held on 20 May 2010.

Appellant 1 requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request or, alternatively, the first auxiliary request, both requests as filed with the statement of grounds of appeal on 14 August 2007. As a second auxiliary request, appellant 1 requested that the appeal of appellant 2 be dismissed. As a third auxiliary request, appellant 1 requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claim 1 submitted at the oral proceedings as part of a third auxiliary request and claims 2 to 20 as annexed to the decision under appeal. The requests for correction under

Rule 139 and 140 EPC were withdrawn.

Appellant 2 requested that the decision under appeal be set aside and that European patent No. 0 962 845 be revoked.

At the end of the oral proceedings, after deliberation, the board's decision was announced.

- X. The main request includes thirty nine claims, of which twenty claims, *i.e.* claims 1 to 11 and 31 to 39, are formulated as independent claims.

Claim 1 of the main request corresponds to claim 1 as granted with the addition of three features and reads as follows (added features underlined by the board):

"A computer-based management system (10, 46) for configuring a field device (16, 18, 20, 22) having a configuration including at least one adjustable parameter, the system comprising:

setting means (10, 46) for setting the adjustable parameter to a first value at a first time and for setting the adjustable parameter to a second value at a second time;

a transaction database (200) which is responsive to the setting means (10, 46) and which stores data (202) representing each change made to the adjustable parameter and a corresponding time indication of the time when the adjustable parameter is set to each value;

means for storing an expected state of said field device;

means for retrieving an actual state of said field device; and

means for adding a record of unexpected change to said transaction database if said expected state does not match said actual state."

Independent claim 2 defines a combination of all of the features of claim 1 and the following feature:

"wherein said system is configured and adapted to add a record of unexpected change to said transaction database prior to effecting a change to said configuration if said expected state does not match said actual state when said system attempts to make said change".

Independent claim 3 corresponds to claim 1 as granted with the addition of the following feature:

"means for reconstructing an expected state of said field device based on transaction records of said transaction database".

Independent claim 4 corresponds to claim 3 with the addition of the following feature:

"means for retrieving an actual state of said field device, wherein said system is configured and adapted to add a record of unexpected change to said transaction database prior to effecting a change to said configuration if said expected state does not match said

actual state when said system attempts to make said change".

Independent claim 5 defines a combination of all of the features of claim 1 and the following feature:

"wherein said record of unexpected change is representative of the change that would have to have been made to said field device in order to change the state of said field device from said expected state to said actual state".

Independent claim 6 defines a combination of all of the features of claim 1 and the following feature:

"wherein said record of unexpected change is indicative of the fact that said change represented by said record of unexpected change is unexpected".

Independent claim 7 defines a combination of all of the features of claim 1 and the following features:

"wherein said computer-based management system is a computer-based management system (10, 46) for configuring at least one field device including an off-line field device as said field device; and

said means (46) for retrieving an actual state of said field device are housed in a hand-held device that is separate from an apparatus (10) housing said transaction database".

Independent claim 8 defines a combination of all of the features of claim 1 and the following features:

"wherein said computer-based management system is a secondary computer-based management system configured and adapted for transient connection with said field device and for transient connection with a primary computer-based management system having a transaction database for storing information pertaining to a plurality of field devices including said field device; and

said secondary computer-based management system comprises means for reporting transaction records from said transaction database to said primary computer-based management system such that said transaction database of said primary computer-based management system can be reconciled to accurately reflect both the actual state and the complete configuration history of said field device as known to said transaction database of said secondary computer-based management system and said transaction database of said primary computer-based management system".

Independent claim 9 defines a combination of all of the features of claim 1 and the following feature:

"wherein said computer-based management system is portable".

Independent claim 10 defines a combination of all of the features of claim 1 and the following feature:

"wherein said transaction database includes at least one transaction record indicative of a future change to be effected to said configuration of said field device".

Independent claim 11 defines a combination of all of the features of claim 1 and the following feature:

"wherein said computer-based management system is a computer-based management system (10, 46) for configuring at least one field device including an off-line field device as said field device".

Claims 12 to 30 are dependent claims and correspond to claims 2 to 20 as granted, respectively, in which, however, in claims 12 to 16 and 18 to 21 the wording "The system of claim 1" is replaced by "The system of any of the preceding claims" and in claims 23 to 26 and 28 to 30 the wording "The system of claim 11" is replaced by a reference to several of the previous claims, *i.e.* claim 21 and higher. Further, in claims 17, 22 and 27 the reference to claim 6, 11 and 16 is replaced by a reference to claims 16, 21 and 26, respectively.

Independent claims 31 to 39 correspond to combinations of claim 1 as granted and claims 2 to 10 as granted, respectively.

At the oral proceedings appellant 1 suggested a further amendment to claim 1, namely that in the last paragraph the term "match" be replaced by "equal". It did not however make this suggestion the subject of a formal request. The board nevertheless considered it, see below, point 2.7.

XI. The first auxiliary request includes twenty nine claims, of which ten claims, *i.e.* claims 1 and 21 to 29, are

independent claims. The independent claims 1 and 21 to 29 are, apart from the renumbering, identical to claims 1 and 31 to 39 of the main request. The additional features as specified in the dependent claims 2 to 20 correspond to those as specified in claims 2 to 20 as granted.

XII. The second auxiliary request, namely that the appeal of appellant 2 be dismissed, corresponds to the seventh auxiliary request which the opposition division in the decision under appeal held to meet the requirements of the EPC. This seventh auxiliary request includes twenty claims, including a single independent claim 1. This claim differs from claim 1 of the present main request (see point X) only in that, in the last paragraph, the term "match" is replaced by "equal".

XIII. The third auxiliary request includes twenty claims, including a single independent claim 1.

Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that the last three features are amended to read as follows (amendments underlined by the board):

"means for storing an expected state of said field device said expected state being the state that said computer-based management system believes to be the state of said field device based on said data;

means for connecting to said field device and retrieving an actual state of said field device by obtaining values from the device for all of said adjustable parameters of a particular block of said field device where a change

to one of said adjustable parameters is to be made;

means for adding a record of unexpected change to said transaction database if said expected state does not equal said actual state; and

means for storing transaction records in said transaction database representing changes made to said field device by an operator as expected changes."

Reasons for the Decision

1. *Rule 80 EPC*

1.1 Rule 80 EPC (previously Rule 57a EPC 1973) stipulates that "the description, claims and drawings may be amended, provided that the amendments are occasioned by a ground for opposition under Article 100, even if that ground has not been invoked by the opponent". It is a *lex specialis* for amendments during opposition proceedings, analogous to Rule 137 EPC (previously Rule 86 EPC 1973) for amendments during examination proceedings. These rules place limitations on the right to amend the patent specification and the patent application, respectively.

1.2 The board interprets Rule 80 EPC such that in opposition proceedings the proprietor's right to amend the patent, for example the claims as granted, is limited to making amendments in order to overcome an objection based on a ground for opposition as specified in Article 100 EPC, thereby possibly avoiding a revocation of the patent. In the board's view, this

interpretation is in accordance with the general principles concerning opposition proceedings as set out by the Enlarged Board of Appeal. More specifically, the purpose and intention of opposition proceedings is to give the public the opportunity to challenge the validity of the patent in question (G 1/91, OJ EPO 1992, 253, point 4.2; G 9/93, OJ EPO 1994, 891, point 3). The opposition procedure is not designed to be, and is not to be misused as, an extension of the examination procedure (G 1/84, OJ EPO 1985, 299, point 9). Rather, opposition proceedings are conceived as a simple, speedily conducted procedure in which, on the one hand, relevant objections to patentability should be given appropriate consideration and, on the other hand, a decision on the validity of the patent should be reached as quickly as possible, in the interests of both parties (G 3/97, OJ EPO 1999, 245, point 3.2.3; G 2/04, OJ EPO 2005, 549, point 2.1.4).

1.3 In line with the above interpretation of Rule 80 EPC, the board notes that it is common practice that a proprietor is allowed to make amendments to the patent specification, in particular in order to overcome an inventive step objection against the subject-matter of an independent claim, by adding one or more features to the independent claim, either by combining the claim with one or more of the dependent claims as granted or by taking features from the description.

1.4 Following a consistent line of decisions, including T 674/96 (not published in OJ, point 3.10) and T 223/97 (not published in OJ, point 2), it would however contravene the requirement of Rule 80 EPC and the above principles set out by the Enlarged Board of Appeal if a

patent proprietor were allowed to amend the claims as granted during opposition proceedings by adding one or more dependent claims, since the addition of one or more (truly) dependent claims leaves the subject-matter of the independent claim to which they refer unchanged and is therefore not in order to overcome an objection based on a ground for opposition against the claims as granted. For example, if the subject-matter of the independent claim is held to involve an inventive step, this would necessarily also apply to the subject-matter of any of its dependent claims, whereas if the subject-matter of the independent claim is held to lack an inventive step, the request as a whole is not allowable, *i.e.* irrespective of the addition of dependent claims.

- 1.5 In the board's view, analogous considerations apply to the case in which one or more further independent claims are added to an opposed independent claim as granted, if the latter claim is maintained, either as granted or in amended form, since the addition of one or more further independent claims leaves unimpaired the question of whether or not arguments submitted by the proprietor and/or amendments made to the opposed independent claim overcome an objection based on a ground for opposition against that claim.

The above case is to be clearly distinguished from the case in which the proprietor amends the claims as granted by completely deleting the opposed independent claim, e.g. claim 1 as granted, in order to overcome an objection based on an opposition ground against that claim, and by explicitly including all of the features of the deleted independent claim in each one of the dependent claims as granted which were dependent on the

deleted claim. In this case, the amendments to the dependent claims, which are thereby reformulated as independent claims, are merely in consequence of the complete deletion of claim 1 (see also T 1416/04, not published in OJ, point 5.1).

- 1.6 Appellant 1 argued that Rule 57a EPC 1973 (now Rule 80 EPC) did not require that an amendment must provide a contribution to avoid the revocation of the patent and, hence, did not prohibit the presentation of several independent claims in lieu of a single, opposed independent claim, where the respective differences between the several claims and the single claim could be seen as being occasioned by grounds for opposition. It argued that Rule 57a EPC 1973 could simply be interpreted as prohibiting amendments which fall outside the legal framework of the opposition, e.g. amendments that merely tidy up dependent claims unaffected by the opposition.

Further, appellant 1 argued that the rights of the proprietor would be unduly curtailed if the proprietor's options were limited to either claiming the specific embodiments of the granted dependent claims or a single embodiment taken from the patent specification, since he would thereby be forced to accept a sub-optimal strategy for overcoming the opposition, instead of saving the commercially relevant scope of the patent by a parallel presentation of several specific embodiments disclosed in the specification. For example, where the parallel solutions screws, bolts or rivets, in lieu of "fastening means", disclosed in the patent specification constituted the commercially most viable

amendments, the option of choosing solely one of these solutions was unappealing, as it would open the door for competitors to pursue the other parallel solutions, even though these solutions fell within the scope of the granted patent, were originally disclosed, and could have been claimed had the proprietor been aware of the necessity to claim such solutions prior to grant. Such awareness could not have been expected if a so-called "accidental" anticipation was cited for the first time in opposition proceedings.

Appellant 1 also noted that after grant, *i.e.* during opposition proceedings, divisional applications could not be filed.

- 1.7 The board does not find these arguments convincing. The opposition procedure is not designed to be an extension of the examination procedure, see point 1.2 above. In examination proceedings, it is the applicant's task and responsibility to draft the claims on the basis of which the grant of a patent is requested, Articles 78 and 113(2) EPC. This involves, *inter alia*, determining for which matter protection is to be sought, how many independent claims and of which category are required in order to adequately define the matter to be protected, and whether or not dependent claims are to be included and, if so, which particular embodiments these claims should be concerned with. The latter, in turn, involves considerations as to the commercial relevance of each of these embodiments. As to the number of dependent claims, additional costs caused, such as claims fees and translation costs, are to be taken into account as much as the question of whether or not dependent claims are important as valuable

fall-back positions for the case that the corresponding independent claim is found unallowable, for whatever reason, in opposition proceedings or national revocation proceedings. It also has to be considered whether or not it is necessary to file separate patent applications, e.g. in parallel or by way of divisional applications, in order to obtain exclusive rights for different aspects of the invention as comprehensively as possible.

In the board's view, for the same reasons as set out above, see point 1.2, opposition proceedings are not to be understood as an opportunity for the proprietor to, fix any, from his perspective, shortcomings in the patent, such as an insufficient number of independent and/or dependent claims in order to define all commercially valuable embodiments. The fact that the addition of one or more independent and/or dependent claims may improve the fall-back positions in any future revocation proceedings before a national court is clearly not the purpose and design of either Rule 80 EPC or the opposition procedure, as set out above.

The board observes that, whereas Rule 80 EPC is a *lex specialis* for amendments during opposition proceedings, a limitation procedure pursuant to Article 105a EPC, which offers the proprietor the opportunity to limit the patent by amending the claims, is not subject to the same requirement as set out in Rule 80 EPC.

As to the example of replacing "fastening means" by "screws, bolts or rivets", the board notes that Rule 80 EPC does not prohibit making amendments in opposition proceedings to an opposed independent claim,

e.g. in order to overcome an inventive step objection, by replacing a general term in the claim by a number of specific alternatives disclosed in the specification. It is however noted that the examination as to whether or not the amendments comply with the requirements of Article 84 EPC (see G 9/91, point 19, OJ 1993, 408) that the claims shall be clear and, both individually and in their entirety, be concise, is a different matter. The examination of these requirements clearly depends on the specific facts of the case, cf. T 79/91, points 2.2 to 2.5, and T 246/91, point 7 (both not published in OJ).

- 1.8 In connection with the interpretation of Rule 57a EPC 1973 (now Rule 80 EPC) appellant 1 referred to decisions T 1138/02, T 181/02, T 223/97, T 610/95, G 1/84, G 9/93, and G 1/05.

It was argued that T 1138/02 and T 181/02 were inconclusive as regards the presentation of numerous independent claims in lieu of a single, opposed independent claim. Further, it was argued that T 610/95 misinterpreted the wording of Rule 57a EPC 1973.

The board notes however that, even if appellant 1's understanding of T 1138/02, T 181/02 and T 610/95 were followed, on the facts of the present case, this would not affect the board's own considerations as set out above at points 1.1 to 1.7. In any case, the board is of the view that the considerations made in T 610/95 are fully in line with the considerations set out above at points 1.1 to 1.7, see T 610/95, points 2.1 and 2.2, the relevant passages of which read as follows:

"The EPC does not guarantee a patent proprietor the right to have proposed amendments incorporated in opposition or subsequent appeal proceedings."

"Opposition proceedings are not an opportunity for the patentee to propose amendments to the text of a patent for purposes which are not clearly related to meeting a ground of opposition raised under Article 100 EPC.

In particular, the addition of claims to the text of the granted patent during opposition or subsequent appeal proceedings, which have no counterpart in the granted version of the claims of the patent in suit, cannot normally be regarded as an attempt to respond to an objection under Article 100 EPC and is, therefore, not admissible (see T 295/87, especially reasons, end of point 3)." and

"In this respect reference should also be made to decision G 1/84 (OJ EPO 1985, 299, see especially reasons point 9). In that decision the Enlarged Board of Appeal made it clear that the opposition procedure is not designed to be, and is not to be misused as, an extension of the examination procedure. It would, in the board's opinion, contravene those principles set out in G 1/84, if it was considered admissible to amend the text of a granted patent during opposition proceedings, while maintaining the sole independent claim under opposition, by incorporating an additional new independent claim which as such has no counterpart in the granted patent and, accordingly, was neither the subject of substantive examination in the examination procedure nor open to opposition

owing to its non-existence in the granted patent."

As to T 223/97, appellant 1 noted that two independent claims directed to respective specific embodiments covered by the independent claim as granted, in lieu of a single opposed independent claim, were allowed. The board notes however this relates to an auxiliary request which was considered in T 223/97, in which two independent claims were filed as a replacement of claim 1 as granted, without any further claims being maintained or filed. In the present case, the facts are significantly different. According to the main and first auxiliary requests, claim 1 as granted is not deleted but amended by the inclusion of further features from the description, whilst nineteen, respectively nine, independent claims, are added, see points X and XI above. These requests are more similar to the main request considered in T 223/97, which included, in addition to an amended independent claim 1, two new independent claims. As to this request the board held that (see T 223/97, point 2.2):

"Il est clair que l'ajout de deux nouvelles revendications indépendantes ne saurait être recevable puisque cette addition, qui ne modifie en rien le sort de la revendication 1 mise en cause, ne saurait être considérée comme une restriction apportée à la revendication 1 elle-même pour répondre au motif d'opposition invoqué à son encontre."

In the present board's view, this consideration is fully in line with those set out above at points 1.1 to 1.7 with reference to G 1/84 and G 9/93.

G 1/05 referred to by appellant 1 is not concerned with the interpretation of Rule 57a EPC 1973 (now Rule 80 EPC) but with amendments in examination proceedings concerning divisional applications.

With reference to the travaux préparatoires as regards earlier proposals for Rule 57 EPC appellant 1 argued that the chosen formulation of Rule 57a EPC 1973 (now Rule 80 EPC) differed significantly from the stricter wording of earlier proposals for Rule 57 EPC. In the board's view, however, even if this argument were accepted, it would not affect the board's interpretation of Rule 80 EPC (previously Rule 57a EPC 1973) as set out above.

1.9 The arguments submitted by appellant 1 as to how Rule 80 EPC should be interpreted are therefore not convincing.

2. *Main request*

2.1 *Claim 1*

In the notice of opposition the opponent argued that the subject-matter of claims 1 to 20 as granted lacked an inventive step. This objection is based on a ground for opposition, cf. Article 100(a) EPC 1973.

In respect of the main request, the amendments made to the independent claim as granted, *i.e.* claim 1, are fully in line with the above-mentioned interpretation and practice. More specifically, claim 1 as granted is amended by the inclusion of three features, see point X

above, in which these additional features, in the proprietor's view, are taken from the description.

Hence, the amendments to claim 1 as granted meet the requirement of Rule 80 EPC.

2.2 *Claims 2 and 5 to 11*

Claims 2 and 5 to 11 of the main request, see point X above, each define a combination of all of the features of claim 1 of the main request and one or more additional features, which, in the proprietor's view, are taken from the description. Hence, even though these new claims are cast in the form of independent claims in that they do not refer back to another claim, they effectively constitute dependent claims in the sense that they include all the features of another claim, cf. Rule 43(4) EPC.

The introduction of these new claims does not comply with the requirement of Rule 80 EPC for the reasons set out above at point 1.4.

2.3 *Claims 3 and 4*

Independent claim 3 corresponds to claim 1 as granted with the addition of a feature which is different from any of the additional features of claim 1 of the main request, see point X above, and which, in the proprietor's view, is taken from the description.

The introduction of this new independent claim does not comply with the requirement of Rule 80 EPC for the reasons set out above at point 1.5.

Claim 4 includes all the features of claim 3 and, hence, is effectively a dependent claim in the sense that it includes all the features of another claim. Its introduction does not comply with the requirement of Rule 80 EPC for the reasons set out above at point 1.4.

2.4 *Claims 12 to 30*

2.4.1 The patent as granted includes a single independent claim 1 and nineteen dependent claims 2 to 20, in which each of these dependent claims is single-dependent, *i.e.* claims 2 to 6 and 8 to 11 each refer back to claim 1 only, claim 7 refers back to claim 6 only, claims 12 to 16 and 18 to 20 each refer back to claim 11 only, and claim 17 refers back to claim 16 only.

2.4.2 Claims 12 to 30 of the main request specify the additional feature(s) of claims 2 to 20 as granted, respectively.

However, further amendments are made in that in claims 12 to 16 and 18 to 21 the wording "The system of claim 1" is replaced by "The system of any of the preceding claims". Consequently, each one of the claims 12 to 16 and 18 to 21 not only defines a combination of the features of independent claim 1 and the additional feature(s) of the dependent claim in question, but also new combinations of the additional feature(s) of the dependent claim in question and the features of any one of the new independent claims 2 to 11, including combinations which are supplemented by further additional feature(s) as specified in one or more of the previous dependent claims.

Similarly, in claims 23 to 26 and 28 to 30 the wording "The system of claim 11" is replaced by a reference to several previous claims, resulting in dependent claims which define further combinations other than the combination of the features of claim 11 as granted and the additional feature(s) as specified in the dependent claim in question. The same applies to claims 17, 22 and 27 due to their dependency on claims 16, 21 and 26, respectively.

2.4.3 The above further amendments to claims 2 to 20 as granted, which thus result in claiming further combinations of features, are not directly occasioned by the opposition ground on which the opposition is based, *i.e.* lack of inventive step, or any other ground for opposition for the same reasons, applied *mutatis mutandis*, as set out above in respect of the introduction of further dependent claims, see point 1.4. Hence, claims 12 to 30 do not meet the requirement of Rule 80 EPC.

2.5 *Claims 31 to 39*

The introduction of these independent claims does not comply with the requirement of Rule 80 EPC for the reasons as set out above at point 1.5, it being noted that claim 1 as granted is not deleted, but is limited by the introduction of further features from the description, see point X above.

2.6 The board therefore concludes that the introduction of the new claims 2 to 11 and 31 to 39 and the amendments in accordance with claims 12 to 30 of the main request

do not meet the requirement of Rule 80 EPC.

2.7 Whether or not in claim 1 of the main request the term "match" is replaced by "equal", as suggested by appellant 1 in the course of the oral proceedings, see point X above, is not relevant to the above objections under Rule 80 EPC. Nor did appellant 1 argue otherwise.

2.8 The main request is therefore not allowable.

3. *First auxiliary request*

3.1 Claims 1 and 21 to 29 of the first auxiliary request correspond to independent claims 1 and 31 to 39 of the main request, respectively. Hence, the objections raised above in respect of claims 31 to 39 of the main request, see point 2.5, apply, *mutatis mutandis*, to claims 21 to 29 of the first auxiliary request.

3.2 Consequently, the introduction of new claims 21 to 29 does not meet the requirement of Rule 80 EPC.

3.3 The first auxiliary request is therefore not allowable.

4. *Second and third auxiliary requests*

4.1 The second auxiliary request, namely that the appeal of appellant 2 be dismissed, corresponds to the seventh auxiliary request which the opposition division in the decision under appeal held to meet the requirements of the EPC, see point XII above.

4.2 Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that the last

three features are amended, see point XIII above. The board's comments below are directed to claim 1 of the third auxiliary request but apply equally to claim 1 of the second auxiliary request.

- 4.3 In connection with claim 1 of the third auxiliary request appellant 1 argued that the amendments to claim 1 as granted complied with Article 123(2) EPC and in support it referred to paragraphs [0097], [0108], [0109] and [0119] to [0121] and Figs 5 and 7 of the patent specification.

In the board's view, these paragraphs and figures, which appear to have a basis in the application as filed, do not provide a basis for the amendments according to the third auxiliary request to claim 1 as granted for the following reasons:

- 4.3.1 Paragraphs [0119] to [0121] relate to Fig. 7 which is a flowchart illustrating the process by which a Field Management Solutions (FMS) system makes one or more changes to one or more parameters in a smart field device, cf. paragraph [0118], and read as follows (underlining by the board):

"The change-making process begins at a block 220 where the FMS system 10 or 46 connects to the smart field device to which a change is to be made and retrieves the actual state of that device by obtaining values from the device for all of the parameters of the particular block to which the change is to be made. A block 222 then compares the actual state of the device to the expected state of the device, which, as described above, was stored in

the FMS system 10 before the FMS system 10 was connected to the device. When the primary FMS system 10 instructs a secondary FMS system 46 to make a change to a device, the primary FMS system 10 communicates the expected state of that device to the secondary FMS system 46.

If the block 222 determines that the actual state of the device equals the expected state, then a block 224 causes the FMS system 10 to apply the next change to the device, and a block 226 adds a record of that change to the transaction database 200 (Fig. 5). If the block 222 determines that the actual state of the device is not equal to the expected state of the device, then, before the block 224 applies the change to the device, a block 228 calculates an "unexpected" change and adds a record of the unexpected change to the transaction database 200 so that the transaction database 200 accurately reflects the present state of the device as it exists before the FMS system 10 makes the change.

Specifically, the unexpected change is the change that necessarily must have been made (unbeknownst to the FMS system 10) to change the state of the device from the state in which the FMS system 10 expected the device to be, on the one hand, to the actual state in which the FMS system 10 found the device, on the other hand. After the "unexpected" change record is added to the transaction database 200, a block 230 permits the operator of the FMS system 10 to make additional changes to the device and, if any such additional changes are made, the FMS system 10 stores transaction records in its transaction database 200

representing the additional changes. These additional changes are identified in the transaction database 200 as "expected" changes."

Fig. 7 and its corresponding paragraphs thus disclose the different steps (blocks 220 to 232) of a process of making at least one change to a parameter of a smart field device by the FMS system, in which these process steps are arranged in a particular order as shown in the flowchart and in which a distinction is made between a situation in which the actual state of the field device is equal to an expected state of the device and a situation in which it is not. If it is determined (block 222) that the actual state is not the expected state, then a further transaction record is added, which describes the change which, without the FMS system knowing, must apparently have been made in the past to the field device, *i.e.* a change from the expected to the actual state (block 228), see also paragraphs [0108] and [0109]. In both situations, the FMS system 10 subsequently makes the change (block 224) and a transaction record for this change is (also) added (block 226).

Claim 1 of the third auxiliary request is however directed to a system rather than a process, in which some of the means which are suitable for use in the above process are specified, but in which no means are specified for controlling these means in order to carry out the process in the specific order as shown in the flowchart of Fig. 7.

Hence, claim 1 defines a combination based on the system of claim 1 as granted and some but not all features of

the system as described in paragraphs [0119] to [0121] in connection with Fig. 7, *i.e.* an intermediate generalisation.

4.3.2 Paragraph [0097] merely describes details of an FMS database 40 per se, which includes a transaction database 200. Fig. 5 is a diagrammatic view of the FMS database.

4.3.3 Paragraphs [0108] and [0109] describe a particular field of the transaction record, namely the "Expected field 213", as illustrated in Fig. 6, which may take one of two values, depending on whether or not the change represented by the transaction record was expected or unexpected. This field thus corresponds to what is referred to in claim 1 as "record of unexpected change". In connection with what is called an "expected state", however, paragraph [0108] states that "an FMS system 10 can use the transaction records 202 of the transaction database 200 of the present invention to reconstruct, for any particular time, an expected state of any block of any device in the process 12". Claim 1 does not however include any means for reconstructing an expected state, but only specifies a means for storing it. Further, paragraph [0109] states that (underlining by the board):

"Before an FMS system 10 (or a hand-held communicator) makes a change to a device (*e.g.*, the device containing the block B), the FMS system 10 determines whether the device is in the state that the FMS system 10 "expects" or some other "unexpected" state. If the device is in the state expected by the FMS system 10, then the FMS system

10 makes the change, and stores a one (or other suitable "true" value) in the Expected field 213 of the transaction record 202 corresponding to the change (indicating that the change was expected). If, on the other hand, the FMS system 10 finds the device to be in a state other than the state in which the FMS system 10 expected the device to be, then the FMS system 10 knows that a change has been made which was not reconciled into the transaction database 200 of the FMS system 10. (The procedures by which changes are reconciled into an FMS transaction database 200 are explained in detail below.) In that case, the FMS system 10 enters a transaction record 202 in its transaction database 200 which represents the change that would have to have been made to the device in order to change the state of the device from the state expected by the FMS system 10 to the actual state in which the FMS system 10 found the device. The FMS system 10 also stores a zero (or other suitable "false" value) in the Expected field 213 for the transaction record 202 corresponding to that change, indicating that the change was unexpected."

The time sequence and the conditions referred to in the above-quoted passage are however not reflected in claim 1 of the third auxiliary request. Nor does the claim specify that the record of unexpected change represents the change that would have to have been made to the device in order to change the state of the device from the state expected by the FMS system 10 to the actual state in which the FMS system 10 found the device.

Hence, these paragraphs do not provide a basis for the

amendments to claim 1 as granted.

- 4.4 The board did not find a basis for the amendments to claim 1 in any other passages of the description, in any of the drawings, and/or any of the claims as filed. Nor did appellant 1 argue otherwise.
- 4.5 As already mentioned before, the above considerations apply equally to claim 1 of the second auxiliary request.
- 4.6 The board therefore concludes that claim 1 of the second and third auxiliary requests does not comply with the requirement of Article 123(2) EPC.
- 4.7 In consequence, as claim 1 of each request is not allowable, each of the second and third auxiliary requests as a whole is not allowable.
5. *Referral of questions to the Enlarged Board of Appeal*
- 5.1 Appellant 1 requested that, having regard to the severity of the consequences an inappropriate application of Rule 57a EPC 1973 (now Rule 80 EPC) could have on the proprietor's right to amend the patent in defence of an opposition, questions concerning the interpretation of the rule be referred to the Enlarged Board of Appeal as important points of law in advance of any decision by the present board on the main and auxiliary requests, see point IV above.
- 5.2 Article 112(1)(a) EPC states that, in order to ensure uniform application of the law or if an important point of law arises, a board of appeal shall, during proceedings on a case and either of its own motion or

following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes.

5.3 It is well-established case law of the boards of appeal that a question, even if it is regarded as relating to an important point of law, does not need to be referred to the Enlarged Board of Appeal if the question can be answered beyond all doubt by the board itself (see J 5/81, OJ EPO 1982, 155, point 11, and G 3/98, OJ EPO 2001, 62, point 1.2.3).

5.4 In the present case, for the reasons set out above, the board was in a position to decide on the question of whether or not the main request and the first auxiliary request complied with the requirement of Rule 80 EPC. The four questions proposed by appellant 1 for a referral to the Enlarged Board of Appeal, all relating to the interpretation and application of Rule 57a EPC 1973 (now Rule 80 EPC), could thus be answered by reference to the EPC and the case law of the Enlarged Board of Appeal in such a way as to leave the board in no doubt, see point 1 above. Further, the board sees no reason for a referral of the proposed questions in order to ensure uniform application of the law. Nor did appellant 1 argue otherwise. The second and third auxiliary request were rejected for other reasons. The board therefore does not see any reason to refer the questions proposed by appellant 1 to the Enlarged Board of Appeal.

5.5 The request by appellant 1 that questions be referred to the Enlarged Board of Appeal is therefore rejected.

6. The board therefore concludes that none of appellant 1's requests is allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request that questions be referred to the Enlarged Board of Appeal is rejected.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland