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**Datasheet for the decision
of 11 July 2011**

Case Number: T 1614/08 - 3.5.06

Application Number: 98953963.0

Publication Number: 1034474

IPC: G06F 9/44

Language of the proceedings: EN

Title of invention:

A method of providing access to object parameters within a simulation model

Applicant:

Entelos, Inc.

Headword:

Simulation model/Entelos

Relevant legal provisions:

EPC R. 103(1)(a), 111(2)
RPBA Art. 11

Keyword:

Decision on the state of the file: reasoned (no)
Substantial procedural violation (yes)
Reimbursement of appeal fee

Decisions cited:

T 0963/02, T 0265/03, J 0017/05, T 1365/05

Catchword:

See reasons 2-9.



Case Number: T 1614/08 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 11 July 2011

Appellant: Entelos, Inc.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 March 2008
refusing European patent application
No. 98953963.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: D. H. Rees
Members: M. Müller
W. Sekretaruk

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse the European patent application no. 98953963.0.
- II. The proceedings before the examining division can be summarized as follows (at the time, all explicit references to the EPC were to the EPC 1973).
- a) The application was filed as an International application and entered the European phase with amended claims.
- b) In the first communication during examination in the European phase, dated 8 July 2004, the examining division objected that the amended claims violated Article 123(2) EPC (1973) due to the use of expressions including "parameter values", "detecting user selection" and "multiple object parameters" and stated that, as a consequence, examination of "the application and the set of claims as originally filed [was] carried out instead".

It further argued that the claims lacked conciseness due to the presence of two independent method claims 1 and 13, in violation of Rule 29(2) and Article 84 EPC 1973.

It went on to state that "considering the extent of the above conciseness objections ... it is not considered feasible at the present stage of the procedure to carry out a full examination of the application with regard to ... novelty and inventive step." However, "for the

efficiency of the procedure" a number of comments were given, including short summaries of the invention and of D1 (Lin Yi-Bin et al., "A Flexible Graphical User Interface for Performance Modeling", Software Practice and Experience, Vol. 25(2), pp. 193-216, February 1995) and the observation that the "use [of] the GUI of D1 on a computer system seems to have the same technical effects as the one of the present application."

c) In response to this communication, the applicant filed amended claims 1-23 on 18 January 2005, argued with reference to the description that they had basis within the specification as filed, and provided arguments in favour of novelty and inventive step over D1. *Inter alia*, the applicant referred to fig. 13 of the application as displaying "two separate access panels ..., one containing a set of object parameters from multiple objects all relating to the 'rabbit' aspect of [a] simulation ..."

d) In a communication dated 31 January 2007 the examining division stated with regard to Article 123(2) EPC (1973) that the preceding objections were maintained "mutatis mutandis". Moreover, it argued that further objections under Article 123(2) EPC (1973) arose since the expressions of "assigning ... values to object parameters", "user input", "detection user identification of a set of object parameters" and "object parameters associated with multiple objects" in amended claims 1 and 13 would not find "clear support ... in ... claim 1 as originally filed nor in the indications provided in the applicant's reply letter", and that amended dependent claims would "not ... be

exactly and undoubtedly derived from" original dependent claims as the applicant had suggested.

The objection under Rule 29(2) EPC was also maintained, now because claims 1 and 11 on the one hand and claims 13 and 23 on the other would constitute independent claims in the method and apparatus category, respectively. It was stated that the expression "comprising: assigning ... in accordance with any preceding claim; ..." would not make claims 11 and 23 dependent claims.

Regarding novelty and inventive step, the examining division stated that "[t]he comments as in section 3 of the previous communication" would "still hold". It then considered why, according to the applicant, the invention would be new over D1, what problem the invention would hence solve and concluded that "[t]he solution proposed by the applicant ... would ... not be considered allowable" for lacking an inventive step over D1 in view of common knowledge.

e) In response to the second communication, the applicant submitted a letter dated 12 April 2007 in which it argued that the objection under Article 123(2) EPC (1973) was void because "there is no obligation on an applicant to use phraseology appearing in a specification as originally filed", that claims 11 and 23 had to be considered as dependent claims because they contained all features of claims 1 and 13, respectively, reference being made to Guidelines for Examination C-III section 3.4, that the examining division had failed to formulate an appropriate objective technical problem according to

the problem-solution-approach and that, if this were done, the claimed invention would emerge as inventive over D1.

f) The applicant requested that the examiner consider these arguments and allow the application or issue a reasoned decision which could be appealed to a Board of Appeal.

g) With a letter 26 February 2008 the applicant requested "the examining division ... to issue a decision on the basis of the current state of the file". The request was made "[f]urther to the telephone conversation between the examiner ... and undersigned the attorney". No minutes of this telephone conversation are on file.

III. The refusal was delivered on 13 March 2008 in the form of a so-called decision according to the state of the file. The grounds for the decision read as follows:

"In the communication(s) dated 08.07.2004, 31.01.2007 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein. The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 27.02.2008."

IV. The refusal relates to claims 1-23 as filed with letter dated 18 January 2005. Amongst these, claims 1 and 11 read as follows.

"1. A method of assigning, via a graphical user interface, values to object parameters (70,72) of objects (54) of a simulation model (30), the method comprising:

displaying a diagram panel (401) within a user interface, the diagram panel (401) including respective graphical representations (152-164) of objects (54) of the simulation model(30);

displaying an access panel (260; 262) within the user interface enabling user input of values to be assigned to object parameters (70, 72) of objects (54) of the simulation model (30), the access panel (260; 262) being distinct from the diagram panel (401);

assigning user input values received via the access panel (260; 262) to object parameters (70, 72) of the simulation model (30), characterized in that displaying (284) an access panel (260; 262) and assigning (292) user input values received via the access panel (260; 262) comprises:

detecting user identification of a set of object parameters (70, 72) for inclusion within an access panel (260; 262), the set of object parameters including object parameters (70, 72) associated with multiple objects (54) of the simulation model (30);

in response to the user identification of a set of object parameters (54) of the simulation model (30) for inclusion in an access panel (260; 262), displaying (288) an identifier (264; 266) for each object parameter (70, 72) of the user identified set of object parameters within the access panel (260; 262);

receiving user input via the access panel (260; 262) of values (268) for one or more of the object parameters (70, 72) represented by identifiers (264, 266) in the access panel (260; 266); and

assigning the respective values received via the access panel (260; 262) to said one or more object parameters (70, 72)."

"11. A method of performing a simulation utilizing a simulation model (30), comprising:

assigning, via a graphical user interface, values to object parameters (70, 72) of objects (54) of a simulation model (30) in accordance with any preceding claim; and

utilizing the values assigned to the object parameters as initial input values for object parameters (70, 72) in the simulation model (30)."

Claims 13 and 23 relate to "apparatus for assigning" and "apparatus for performing a simulation" comprising means which correspond closely to the method steps of claims 1 and 11.

- V. The applicant filed a notice of appeal on 23 May 2008 and paid the appeal fee on the same day. Grounds of appeal were filed on 23 July 2008 along with a new set of claims 1-6 and amended description pages 1 and 3.
- VI. The appellant requests that the decision under appeal be set aside, that the application be remitted to the examining division, "[t]hat the appellant be given an opportunity to respond in writing to any observations of the Board of Appeal", and conditionally that oral proceedings be held.

Reasons for the Decision

1. The appeal is admissible (see points III and V above).
2. The decision under appeal issued as a so-called "decision according to the state of the file" as sanctioned by the Guidelines for Examination E-X, 4.4 (in the versions of June 2005 or April 2010 alike). Such decisions normally issue on a standard form and for their reasons merely refer to previous communications of the examining division. The board therefore endorses the opinion that it would be preferable to call such a decision a "decision by reference" (see e.g. T 1356/05, reasons 5, not published).
3. As a matter of principle, the board deems it acceptable for the examining division to issue a decision by reference to speed up the examination procedure, especially if the applicant explicitly agrees with this course of action. However the applicant's request cannot discharge the examining division of its duty to give reasons why the examination of the application led to its refusal.
4. In particular, according to Rule 111(2) EPC decisions of the European patent office which are open to appeal shall be reasoned. For a decision to be reasoned it must contain, in addition to the logical chain of facts and legal provisions on which the decision is based, a discussion of the crucial points in dispute, in order to give the party concerned a fair idea of why its submissions were not considered convincing (cf. J 17/05, reasons 6, unpublished). The board also endorses the

- corresponding statement in the Guidelines E-X, 5 that in a reasoned decision "it is particularly important that special attention should be paid to important facts and arguments which may speak against the decision made", so as not to give "the impression ... that such points have been overlooked".
5. The fundamental requirement for a decision to be reasoned also applies to decisions according to the state of the file. Furthermore, it is established jurisprudence that an applicant by requesting a decision according to the state of the file does not waive the right to a reasoned decision (cf. e.g. T 265/03, reasons 6, unpublished). Even a statement of the parties to the proceedings that they do not want a reasoned decision would not have a different result. A decision which for its reasons merely refers to previous communications satisfies the requirements of Rule 111(2) EPC only if these communications themselves do. This means that the decisive arguments for the decision must be clear from these references (cf. T 963/02, reasons 2.1, not published).
6. In the only communications referred to in the decision, those of 8 July 2004 and 31 January 2007, objections under Articles 123(2), Rule 29(2), Article 84, and Article 56, then all EPC 1973, were raised. The decision under appeal states *inter alia* that "[t]he applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file ..." This statement is factually incorrect because the applicant had indeed replied to the second communication with letter dated 12 April 2007 and filed comments to each of the

- objections of added subject matter, lack of conciseness, and lack of inventive step.
7. The applicant's submission dated 26 February 2008 also mentions a telephone conversation with the first examiner. In such a situation it is essential that a telephone conversation be minuted, since otherwise it is left for speculation what was discussed. It is possible that the first examiner replied to the applicant's arguments and argued that some or all of the pending objections were upheld and why. But it is also possible that the first examiner only explained the nature of a decision according to the state of the file.
 8. As a consequence, the decision under appeal gives the impression that the appellant's arguments filed with letter of 12 April 2007 may have been overlooked and, even if they were not, leaves open which of the previously raised objections were waived and which were not and why.
 9. For this reason alone the board has to conclude that the decision does not satisfy the requirement of Rule 111(2) EPC.
 10. The board finds it appropriate to point out some further irregularities which confirm this conclusion.
 - 10.1 *Ad Article 56 EPC 1973*: In the second communication under point 3 the examining division expressed that the "comments as in section 3" of the first communication would "still hold". These comments include the

statement that no examination of novelty and inventive step was carried out.

In the second communication the examining division refutes an argument by the applicant: It observes why "the applicant states that the system of the application is new over D1", derives a problem solved from that difference and concludes that "the solution proposed by the applicant" is "not considered allowable" for lack of an inventive step. The examining division does not express that it endorses the applicant's analysis nor does it give an own analysis of any of the claims.

Also the observation in the first communication (point 3, last par.) that the GUIs according to D1 and the invention seem to have the same technical effects does not constitute a reasoned objection of a lack of inventive step.

The board therefore concludes that the communications referred to in the decision under appeal do not contain a sufficiently reasoned objection under Article 56 EPC 1973.

- 10.2 *Ad Rule 29(2) and Article 84 EPC 1973:* Claims 1 and 13 as filed on 18 January 2005 relate, respectively, to a "method of assigning ... values to object parameters ..." and a corresponding apparatus. Claims 11 and 23 relate, respectively, to "a method of performing a simulation ... comprising: assigning ... values to object parameters ... in accordance with any preceding claim" and again a corresponding apparatus. In the second communication, the examining division considers claims 11 and 23 as independent claims, the reference to preceding claims notwithstanding.

According to Rule 29(3) EPC 1973 (and, equivalently, Rule 42(3) EPC) "[a]ny claims which includes all the features of any other claim" is considered a dependent claim. This formulation is reproduced in the Guidelines for Examination C-III, 3.4. In view of this the examining division's position is at least unconventional and the applicant, when referring to the standard interpretation of what constitutes a "dependent claim", must have had a fair expectation of having overcome this objection.

- 10.3 *Ad Article 123(2) EPC (1973)*: The first communication raised concerns against several expressions in the claims as amended during the International phase. With the submission of 18 January 2005, the claims were considerably amended and at least some of the criticized expressions (e.g. "parameter panel") were replaced by the original wording (e.g. "access panel"). Under these circumstances the board considers it dubious to state, as the examining division did in the second communication, that the previous objections were maintained "mutatis mutandis".
- The examining division then mentioned a number of expressions in the amended claims and stated that no clear support for these amendments had been found in original claim 1 or in the "indications provided in the applicant's reply letter". These indications were however not specifically discussed to show why they failed to provide the due support. For example, the examining division found dubious the reference to "object parameters associated with multiple objects" (second communication, p. 2, 1st par.), although the applicant referred to figure 13 (reply of 18 January 2005, par. bridging pp. 3-4) which in the board's view

clearly discloses access panels with object parameters associated with multiple objects (see esp. no. 264 in fig. 13 and the corresponding description, p. 21, lines 3 ff.).

In the reply dated 12 April 2007 the applicant insisted that basis had been given and asked the examining division to reconsider its previous submission, bearing in mind that literal support is not required by Article 123(2) EPC. While the board agrees that Article 123(2) EPC does not require literal support it can be left open whether the basis given by the applicant was sufficient. In the board's view the applicant's reply constituted at least a fair reply to the brief argument by the examining division. The board also considers that the applicant has a right that any basis which allegedly supports amendments under Article 123(2) EPC be specifically considered by the examining division. Therefore, the board judges that the applicant would have had the fair expectation that a refusal would not be based on Article 123(2) EPC (1973).

10.4 In summary, the board concludes that the applicant's submission dated 12 April 2007 is a reasonable response to the examining division's objections which puts into question on which objections the decision under appeal was - and, indeed, could have been - actually based. This supports the conclusion that the decision under appeal is not sufficiently reasoned as required by Rule 111(2) EPC.

11. An insufficiently reasoned decision constitutes a substantial procedural violation in view of which reimbursement of the appeal fee is equitable according

to Rule 103(1)(a) EPC. Furthermore, the board decides to admit into the procedure claims 1-6 and description pages 1 and 3 as submitted with the grounds of appeal and, according to Article 11 RPBA, to remit the case to the department of first instance, absent special reasons for doing otherwise.

Order

For these reasons it is decided that:

The decision is set aside.

The application is remitted to the examining division for further prosecution.

The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees