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**Datasheet for the decision
of 10 October 2011**

Case Number: T 1769/08 - 3.5.02

Application Number: 98947411.9

Publication Number: 1031119

IPC: G08B 1/08

Language of the proceedings: EN

Title of invention:

A signalling system and a method for controlling the service
at a restaurant

Patent Proprietor:

P. Jørgensen Holding ApS

Opponent:

AB Superbus

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Added subject-matter (yes) - main request"

"Remittal for further prosecution"

Decisions cited:

G 0001/93

Catchword:

-



Case Number: T 1769/08 - 3.5.02

DECISION
of the Technical Board of Appeal 3.5.02
of 10 October 2011

Appellant:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 July 2008
revoking European patent No. 1031119 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: M. Ruggiu
Members: R. Lord
P. Mühlens
M. Léouffre
R. Moufang

Summary of Facts and Submissions

I. This is an appeal of the proprietor against the decision of the opposition division to revoke European patent No. 1 031 119. The reasons given for the decision were *inter alia* that the subject-matter of claim 1 of the main request extended beyond the content of the application as filed (Article 100(c) EPC).

II. Oral proceedings before the board took place on 10 October 2011.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained unamended (main request) or on the basis of claims 1 to 7 of the first auxiliary request filed at the oral proceedings of 10 October 2011.

The respondent (opponent) requested that the appeal be dismissed.

III. Claim 1 of the patent in suit as granted and according to the first auxiliary request reads as follows:

"A signalling system for controlling the service at a restaurant where a guest at e.g. a counter can order a product, such as a hot meal for later handing over, the system comprises at least one transmitter (4) arranged to, upon operation, emit wireless signals that represent a number of predetermined codes, a number of indicators (5), and each having its own receiver (7) which is precoded individually with one of the codes for, upon receipt of a wireless signal representing the respective code, activating a caller (8) belonging to

the indicator to, with a sound and/or light signal, call a guest who has been given the indicator in question in connection with his order, each indicator (5) comprises a preferably flat housing (11), and the said receiver (7) and the said caller (8) are built into the said housing (11), characterised in that a text (12) and/or an illustration at least comprising the mark of the respective code is placed on the exterior of the housing (11) such that the indicator is arranged as a coupon, which by means of the code of the indicator uniquely links the guest to the ordered product."

Claim 8 of the patent in suit as granted reads as follows:

"A method for controlling the service at a restaurant where a guest at e.g. a counter can order a product, such as a hot meal for later handing over, that the guest upon ordering receives an indicator (5) with an individually permanently precoded wireless receiver, that the staff, when the product is ready for handing over, by means of a transmitter (4) emits a wireless signal which represents the code of the handed-over indicator (5), that the receiver (7) thereby activates a caller (8) which belongs to the indicator (5) by means of e.g. a sound and/or light signal which calls the guest, characterised in that the called guest identifies the ordered product by linking it to a text and/or an illustration placed at the indicator, said text and/or an illustration at least comprising the mark of the respective code and in that the guest receives the ordered product in return for the indicator (5) acting as a coupon."

IV. The appellant's arguments, in so far as they are relevant for the present decision, are as follows:

The introduction of the word "permanently" in claim 8 of the main request did not result in added subject-matter because the clearly disclosed requirement that the receivers of the indicators be individually precoded implied that this precoding be permanent, and because such permanent precoding was clearly essential for the functioning of the method. In particular, the skilled person would have understood that the term "permanent" applied only to the period between the placing of the order and the handing over of the ordered product, and it was inherent in the application as filed that the code could not change during this period.

The feature of claim 8 of the main request that it is the guest who identifies the product was disclosed in the application as filed, in particular at page 1, lines 8 to 13. This disclosure was not restricted to the prior art, because in the context of the method as claimed and as described in the detailed embodiments, if more than one product became available for handing over at a particular time, then the guest would be able to identify which of them corresponded to his order. Moreover, even if this argument were not accepted, the introduction of this definition would have been allowable, following the reasoning of decision G 1/93, because the identification by the guest is a mental act, so that the definition did not add any technical teaching to the claim.

Claim 1 according to both requests represented a combination of the original claims 1, 5 and 7 together with an added definition of the manner in which the system operated, as disclosed in the description of the application as filed. Specifically, this added definition had to be interpreted in the light of the remainder of the claim, which established the link between the code on the indicator given to the guest on placing the order and the presentation of that indicator to the staff when the order was ready. In this context, the skilled person would have understood that the word "uniquely" had the same meaning as "individually". The wording of this definition made clear that the link is established with the help of the code. The alternative interpretation that it was established solely by the code did not make sense in the context of the remainder of the claim.

- V. The arguments of the respondent which are relevant for the present decision can be summarised as follows:

The definition in claim 8 of the main request that the precoding was permanent had no basis in the application as filed, and was not implied by the disclosure of individual precoding, because it was entirely plausible that the coding would need to be changed. As an example, if a similar system, using radio signalling, was set up in nearby premises, it might have been necessary to reconfigure the codes to mitigate interference between the two systems. Such reconfiguring could easily be done so as to maintain the individual precoding. Moreover, this amendment could not be considered to be allowable on the basis that "permanent" applied only to the period from placing of the order to receipt of the

product, because this was not defined in the claim, either explicitly or implicitly, nor was it disclosed in the description as filed.

The disclosure in the application as filed of the feature of claim 8 that the guest identifies the product referred to by the appellant related only to the prior art. By contrast, it was clear from the application (for instance page 3, lines 15 to 17 and page 7, line 25 to page 8, line 9) that the invention required the product to be identified by the restaurant staff. The appellant's argument in this context that the guest could identify his ordered product when more than one product was ready at a time was not relevant, firstly because there was no disclosure of this in the application, and secondly because this would not correspond to the definition in the claim, since the identification would be made on the basis of the guest's knowledge of what he had ordered, not on the basis of the code. Moreover, the definition could not be considered to be devoid of technical character, because it was not clear that it had no implications for the technical aspects of the method.

The definition in claim 1 of the link between the code and the ordered product was not allowable, because it covered undisclosed embodiments in which the link is established by the code alone, i.e. in which the code itself included information allowing both the guest and the ordered product to be identified, and thus added technical teaching to the claim.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request*
 - 2.1 Claim 8 according to the appellant's main request differs from claim 10 as originally filed *inter alia* in that the definition that the indicator includes an "*individually precoded wireless receiver*" has been amended to define that this receiver is "*individually permanently precoded*", and in that it additionally defines that "*the called guest identifies the ordered product by linking it to a text and/or an illustration placed at the indicator, said text and/or an illustration at least comprising the mark of the respective code*".
 - 2.2 The board is of the opinion that the first of these differences, i.e. the insertion of the word "permanently", represents a technical limitation of the subject-matter of the claim which has no basis in the application as filed.
 - 2.2.1 The application as filed contained no explicit disclosure that the receiver was permanently precoded. The board is not convinced by the appellant's argument that the (undisputed) disclosure that the receivers are individually precoded implies that they are permanently precoded, because that would be the only way in which individual precoding could be ensured. To the contrary, the board considers that, in the absence of any explicit teaching in the application that the coding could not be changed, the skilled person would find it

entirely plausible that such a change could be carried out, provided that it is done so in a manner which ensures individual coding. For example, as argued by the respondent, when using a system in which the wireless signals are radio signals, it would be possible that the installation of a similar system in nearby premises would lead to interference problems, which would then require a reconfiguration so as to mitigate those problems. This reconfiguration could involve a change to the precoding.

2.2.2 The appellant has also argued that the term "permanently" should be understood as referring only to the period between the placing of an order and the handing over of the ordered product, since it was inherent in the application that the code of an indicator must remain unchanged over that period. The board is not convinced by this argument, because the claim contains no suggestion that the term should be interpreted in this manner. Indeed the fact that the word qualified by this term is "*precoded*" suggests that it relates to a coding which is applied before the steps expressly recited in the claim, i.e. before the placing of the order. Thus, and since the application does not contain any other relevant disclosure, the board concludes that the skilled person would interpret the claim as meaning that the term "permanently" is not restricted in the manner suggested by the appellant.

2.3 The board is also of the opinion that the second difference identified in paragraph 2.1 above defines a step which was not disclosed in combination with the other features of the claim in the application as filed.

2.3.1 This addition to the claim defines that it is the guest who makes the link between the mark of the code on the indicator given to him and the ordered product. The appellant has correctly stated that methods in which the ordered product is identified by the guest are disclosed on pages 1 and 2 of the application as filed. However, that disclosure related to the prior art using conventional coupons, which exhibits problems which are addressed in the application. The invention as described requires that the link between the code and the ordered product be made by the restaurant staff, not by the guest (see for instance page 3, lines 15 to 17 and page 7, line 25 to page 8, line 9). This distinction is most clearly apparent from the alternative described at page 8, lines 11 and 12, in which the called guest identifies himself to the staff, who then serve him at his table.

2.3.2 The fact that there are circumstances in which a guest would be able to identify his ordered product (for instance when a number of products become ready for handing over at the same time), as argued by the appellant, does not invalidate this argument, because these were not disclosed in the application as filed. Moreover, such an identification by the guest would not correspond to the definition at issue in the claim, because it would rely only on the guest's recollection of what he had ordered, and would thus not involve linking the ordered product to a mark on the indicator as defined in the present claim 8.

2.3.3 The appellant has additionally argued that the definition that it is the guest who identifies the product does not represent added subject-matter within

the meaning of Article 100(c) EPC, because it defines only a mental act, so adds no technical content (referring to decision G 1/93). The board accepts that the act of identifying the product *per se* is a mental act, but is not convinced that, in the context of the claimed method as a whole, this step of identification has no consequences for the technical aspects of the method, i.e. that it does not imply any technical features.

- 2.4 Therefore, for both of the above reasons, the subject-matter of claim 8 of the appellant's main request extends beyond the content of the application as filed. The opposition ground under Article 100(c) EPC thus prejudices the maintenance of the patent as granted.

3. *Auxiliary request*

- 3.1 Claim 1 according to the appellant's auxiliary request (which is identical to that of the patent as granted) comprises a combination of claims 1, 5 and 7 of the application as filed, followed by the phrase "*such that the indicator is arranged as a coupon, which by means of the code of the indicator uniquely links the guest to the ordered product*".

- 3.2 The board considers that the skilled person would, in the context of the claim as a whole, understand that the phrase "*such that the indicator is arranged as a coupon*" is merely an indication of the intended function made possible by the technical feature of the immediately preceding definition in the claim (i.e. the placing of the mark of the code on the housing), so that, in the context of a claim for a system, it adds

no further technical teaching to the claim. The board is not convinced by the respondent's argument that this definition implies further structural features of the indicator, which appears to be a mere assertion that this would be the case. In particular, the board notes that the respondent has not provided any suggestion as to the nature of these implied features.

3.3 Similarly, the board considers that the skilled person, again in the context of the claim as a whole, would understand that the phrase "*which by means of the code of the indicator uniquely links the guest to the ordered product*" merely defines the manner in which the system defined in the remainder of the claim, and in particular the indicator, is intended to be used, without implying any further technical features of the system.

3.3.1 Thus, the unique link between the guest and the ordered product is established purely by the combination of the fact that the indicator is in the possession of the guest from when the order was placed (as defined in the pre-characterising portion of the claim) with the fact that the mark of the code corresponding to that order is placed on the exterior of the housing (as defined in the characterising portion of the claim). Specifically, in the embodiments of the patent, the link is made by the staff member when the called guest presents the indicator bearing the code.

3.3.2 The board is not convinced by the respondent's argument that this definition implies that the unique link is established solely by means of the code of the indicator, because that does not reflect the normal

meaning of the expression "by means of", which the board considers to be "by making use of" or "with the help of", i.e. not excluding that other elements are also used. More particularly, the board considers that the specific interpretation suggested by the respondent, in which the code includes information specifically identifying both the guest and the ordered product, is not consistent with the claim as drafted. This is apparent from the fact that the claim defines that each receiver is precoded with one of the codes before the ordering process starts, thus precluding the code containing any information about the guest or the ordered product, together with the clear reference to that specific code implied by the use of the expression "the respective code" in the remainder of the claim.

3.3.3 Thus, even when taking into account that this claim defines a system for carrying out the method discussed above, and not the method as such, the interpretation proposed by the respondent is not consistent with the wording of the claim. By contrast the interpretation described in paragraphs 3.3 and 3.3.1 above is consistent with the wording of the claim and with the description of the patent.

3.4 Thus, neither of the definitions in claim 1 extending beyond the combination of the originally filed claims 1, 5 and 7 (i.e. those objected to by the respondent under Article 100(c) EPC) can be considered to define any additional technical features of the claimed system. Therefore the subject-matter of claim 1 according to the appellant's auxiliary request does not extend beyond the content of the application as filed, so that this claim meets the requirements of Article 123(2) EPC.

4. The board considers it to be appropriate to remit the case to the department of first instance for further prosecution, in particular for consideration of the opposition grounds under Article 100(a) EPC, since the decision under appeal dealt only with issues under Article 123(2) and (3) EPC, and given that neither party has objected to this course of action.

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.

The Registrar:

The Chairman:

C. Moser

M. Ruggiu