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**Datasheet for the decision  
of 16 July 2013**

**Case Number:** T 1562/09 - 3.5.02

**Application Number:** 07110984.7

**Publication Number:** 1862982

**IPC:** G08B 13/24, G07F 7/00,  
G06K 19/077, G07G 1/00

**Language of the proceedings:** EN

**Title of invention:**  
Method of interrogating a package bearing an RFID tag

**Applicant:**  
3M Innovative Properties Company

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 76(1), 111(1)

**Keyword:**  
"Added subject-matter (main request) - no"  
"Remittal - yes"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 1562/09 - 3.5.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.02  
of 16 July 2013

**Appellant:** 3M Innovative Properties Company  
(Applicant) 3M Center  
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**Representative:** Vossius & Partner  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 25 February 2009  
refusing European patent application  
No. 07110984.7 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** M. Ruggiu  
**Members:** R. Lord  
P. Mühlens

## Summary of Facts and Submissions

I. This is an appeal of the applicant against the decision of the examining division to refuse European patent application No. 07 110 984.7. The reason given for the refusal was that the application did not meet the requirements of Article 76(1) EPC.

II. The following documents cited during the procedure before the first instance are relevant for this decision:

D1: US 4 688 026 A;

D4: US 5 768 140 A; and

D5: WO 98/35237 A1.

III. In the notice of appeal the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the application as originally filed.

In a communication accompanying a summons to oral proceedings, dated 4 April 2013, the board informed the appellant *inter alia* of its preliminary opinion that it would be appropriate to remit the case to the department of first instance for further prosecution, and that it would not seem to be necessary to hold oral proceedings if the appellant agreed to that course of action.

In a letter dated 12 June 2013 the appellant indicated his agreement to that course of action.

With a communication dated 21 June 2013 the board cancelled the oral proceedings scheduled for 16 July 2013.

IV. Claim 1 of the appellant's sole request reads as follows:

" A method of interrogating a package bearing an RFID tag, and multiple items inside the package each bearing its own RFID tag, the RFID tag associated with the package including information about the RFID tags associated with the multiple items, comprising the steps of:

- (a) interrogating the RFID tag associated with the package to identify the package and the items in the package;
- (b) interrogating the RFID tags associated with the items in the package substantially simultaneously to identify the items; and
- (c) comparing the information obtained in steps (a) and (b) to verify the contents of the package."

V. Claim 5 of the appellant's sole request reads as follows:

"A method of interrogating a package bearing an RFID tag having information identifying the package, and multiple items inside the package each bearing its own RFID tag, comprising the steps of:

- (a) interrogating the RFID tag associated with the package to identify the package and, from a software database, the items in the package;
- (b) interrogating the RFID tags associated with the items in the package substantially simultaneously

to identify the items; and  
(c) comparing the information obtained in steps (a)  
and (b) to verify the contents of the package."

Claims 2 to 4 are dependent on claim 1 and claims 6  
to 8 are dependent on claim 5.

VI. The appellant essentially argued as follows:

The skilled person would have understood that the disclosure of the first paragraph of section II, B of the description of the parent application (i.e. the section entitled "Use of RFID Device with Multiple Items" at page 20, lines 5 to 12) applied to each of the embodiments described in the following three paragraphs of that section. The combination of that disclosure with the embodiment of page 21, lines 17 to 25 provided a basis for the independent claims of the present divisional application.

The description of the parent application contained a number of passages relating to library systems, which provided a basis for the dependent claims of the present application.

The issues of novelty and inventive step were not addressed in the decision under appeal, so that remittal of the case to the examining division was appropriate.

## Reasons for the Decision

1. The appeal is admissible.
  
2. The decision under appeal was based on the conclusion that the feature (b) of each of the independent claims 1 and 5 of the present divisional application had no basis in the earlier application of which it is a divisional application (i.e. the international application published as WO 00/10144 A1, which is referred to here as the parent application). In particular, the examining division did not accept the applicant's argument that the teachings of the passages at page 20, lines 5 to 12 and page 21, lines 17 to 25 of the parent application were clearly linked, and when thus combined provided a basis for the claimed combination of features.
  - 2.1 In this respect, the board agrees with the appellant that the skilled person reading the parent application would have understood that the first of these two passages is the introductory paragraph of a section of that application entitled "Use of RFID Device with Multiple Items", and that the teaching of that passage applied to each of the following three paragraphs of that section, since each of those paragraphs describes an embodiment of the general concept of the introductory paragraph. The second of the passages cited above is the description of the third of those embodiments. Since the introductory paragraph describes the concept of interrogating RFID tags essentially simultaneously, and since the embodiment of page 21, lines 17 to 25 comprises, in different alternatives, the remaining technical features of the present claims

- 1 and 5, the board concludes that when properly read together, these passages of the parent application as originally filed provide a basis for the independent claims of the present divisional application.
- 2.2 Moreover, the board agrees with the appellant that the many references throughout the description of the parent application to the use of such methods in library systems provide a basis for the dependent claims of the present divisional application.
- 2.3 The board therefore concludes that the claims of the present divisional application meet the requirement of Article 76(1) EPC.
3. The board notes that during the examination procedure the division presented a number of objections of lack of novelty or lack of inventive step, all of which were based on the understanding that the document D1 disclosed the concept of simultaneous reading of multiple RFID tags. The board does not find this line of argumentation convincing, because that document seems to describe that the user moves around a building, reading tags on items one at a time as they come within range of the reader. The board therefore concludes that this document does not represent a promising starting point for the assessment of novelty or inventive step.
4. On the other hand, in the annex to the summons to oral proceedings dated 23 September 2008, the examining division referred to two further documents (identified above as D4 and D5), which had not previously been introduced into the procedure, and which appear to the board to be highly relevant for the assessment of

inventive step. Since these two documents were not discussed at all during the first instance proceedings (indeed it is not clear whether they were formally introduced into the procedure), the board considers it to be appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the department of first instance so that the issue of inventive step in the light of these documents can be discussed, noting also that the appellant has indicated his agreement to that 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:

U. Bultmann

M. Ruggiu