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**Datasheet for the decision  
of 24 July 2012**

**Case Number:** T 2158/09 - 3.5.03

**Application Number:** 99952962.1

**Publication Number:** 1115413

**IPC:** A61K 38/00

**Language of the proceedings:** EN

**Title of invention:**

Robust steady-state target calculation for model predictive control

**Applicant:**

Aspen Technology, Inc.

**Opponent:**

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**Headword:**

Model predictive control/ASPEN TECHNOLOGY INC.

**Relevant legal provisions:**

EPC R. 103(1)a, 111(2)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Decision reasoned - no"

"Substantial procedural violation - yes"

**Decisions cited:**

G 0009/91, G 0010/91, T 1366/05, T 0641/00

**Catchword:**

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Case Number: T 2158/09 - 3.5.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.03  
of 24 July 2012

**Appellant:** Aspen Technology, Inc.  
(Applicant) 200 Wheeler Road  
Burlington, MA 01803 (US)

**Representative:** Driver, Virginia Rozanne  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 16 June 2009  
refusing European patent application  
No. 99952962.1 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** A. J. Madenach  
R. Menapace

## **Summary of Facts and Submissions**

- I. The present appeal is against the decision of the examining division to refuse application No. 99952962.1, prima facie on the ground that the subject-matter of claim 1 of the main request does not involve an inventive step (Articles 52(1), 56 EPC, see the minutes of the oral proceedings before the examining division). The claims of an auxiliary request were not allowed into the proceedings in view of Rule 137(3) EPC.
  
- II. The appellant requests that the decision of the examining division be set aside and a patent be granted on the basis of a set of claims 1-18 which, as far as the independent claims are concerned, is identical to the set of claims according to the main request before the examining division, or, as an auxiliary measure, on the basis of a set of claims 1-18, both as filed with the statement of grounds of appeal. An auxiliary request was made for oral proceedings.
  
- III. With a communication of 25 May 2012, the board informed the appellant of its preliminary opinion that the decision of the examining division was insufficiently reasoned, that this deficiency amounted to a substantial procedural violation and that it was minded to remit the case to the department of first instance.
  
- IV. With a letter filed on 28 June 2012, the appellant withdrew its request for oral proceedings on the condition that the case be remitted, if possible to an alternate examining division, and requested the refund of the appeal fee.

## Reasons for the decision

### 1. *Decision insufficiently reasoned (Rule 111(2) EPC):*

1.1 The decision of the examining division does not comply with the requirement of Rule 111(2) EPC in that it is not sufficiently reasoned in the sense that the reader of the decision can identify why the application has been refused.

1.2 First of all, the board notes that the decision as such does not specify a ground on which the application is refused. The only mention of the requirements of the EPC in the Reasons is at page 2, penultimate paragraph, where it is stated that "The possible restriction ... was discussed, despite it being clear that the objection raised by the division in the summons was one of Article 56 EPC, not Article 52(2)(3) EPC". The decision does not make clear whether this statement still applied to the decision itself and whether the application was in fact refused on the basis of Article 56 EPC as discussed in the summons. Only the minutes of the oral proceedings held before the examining division allow the board to infer that the refusal was indeed based on an objection of lack of inventive step (minutes, page 2, penultimate paragraph).

1.3 Assuming on the basis of the statement in the minutes that the refusal was based on a lack of inventive step (Article 56 EPC), the board is unable to find a logical chain of reasoning in the decision which would allow it to identify the reasons for the refusal.

To begin with, the decision does not state what is considered as being the closest prior art and what the difference between the claimed subject-matter and any prior art might be. The state of the art lies, however, at the heart of Article 56 EPC. Furthermore and as a consequence, the decision does not explain why it would have been obvious for the skilled person to arrive at the claimed invention. In fact, the terms "skilled person", "state of the art" and "obvious" do not occur in the decision.

Instead, the decision mentions at several instances that the operation of the (claimed) method is defined mathematically and is only loosely related to an industrial system, the industrial system being defined only in general terms. The examining division therefore apparently concluded that the invention is rather concerned with a mathematical problem.

Even if this is the case, the board cannot follow the conclusions the examining division has drawn from this finding as regards inventive step. It is clear, albeit from the above mentioned summons and not from the decision itself, that the examining division did not consider that the claimed subject-matter fell under one of the exclusions from patentability specified in Article 52(2) and (3) EPC. It remains, however, unclear if the examining division for example intended to base their decision on the Comvik approach, *i.e.* the principles developed in T 641/00 (OJ 7/2003, 352) and outlined in the Guidelines CIV-11.7.1 and CIV-11.7.2 in the version of April 2009 relevant to the decision of the examining division; the decision does not mention any prior art as a starting point and also fails to

establish in an objective way the technical problem to be solved. Nor does it indicate which features cannot be seen to make a contribution, either independently or in combination with other features, to the technical character of the invention and which are thus not relevant for assessing inventive step.

1.4 In conclusion, the board cannot reconstruct why the examining division has refused the present application.

1.5 In the board's opinion and following established practice (e.g. T 1366/05, not published in the OJ, see headnote) the above deficiency under Rule 111(2) EPC amounts to a substantial procedural violation requiring the decision under appeal to be set aside and the case to be remitted.

1.6 The appeal is thus deemed to be allowable and the board considers it equitable by reason of a substantial procedural violation to reimburse the appeal fee (Rule 103(1)a).

1.7 However, the board cannot accede to the appellant's request to remit the case to an alternate examining division. Proceedings before the department of first instance are separate from appeal proceedings, the function of the latter being to give a judicial decision on the correctness of a separate earlier decision taken by the department of first instance (G 9/91, OJ EPO 1993, 408 and G 10/91 OJ EPO 1993, 420). There is no provision in the EPC under which a board upon remittal can order an alternate composition of an examining division and the board does not see any other

legal basis for allowing the request, which was not further substantiated.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar

The Chairman

G. Rauh

A. S. Clelland