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**Datasheet for the decision
of 21 January 2016**

Case Number: T 1701/10 - 3.4.01

Application Number: 97122695.6

Publication Number: 0856812

IPC: G06K17/00

Language of the proceedings: EN

Title of invention:

Portable shopping and order fulfillment system

Patent Proprietor:

Symbol Technologies, Inc.

Opponent:

DATALOGIC S.p.A.

Headword:

Relevant legal provisions:

EPC Art. 123(3), 123(2)

RPBA Art. 13(1)

Keyword:

Late filed requests - justification for late filing (yes; main request and first auxiliary request)

Amendments - broadening of claim (yes; main request and first auxiliary request)

Late filed requests - late-filed auxiliary request - request clearly allowable (no; second auxiliary request)

Decisions cited:

Catchword:



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Case Number: T 1701/10 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 21 January 2016

Appellant: DATALOGIC S.p.A.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
15 June 2010 concerning maintenance of the
European Patent No. 0856812 in amended form.

Composition of the Board:

Chairman G. Assi
Members: H. Wolfrum
J. Geschwind

Summary of Facts and Submissions

- I. The appeal of the opponent lies from the interlocutory decision of the opposition division dispatched on 15 June 2010 maintaining European patent No. 0 856 812 in amended form on the basis of a second auxiliary request then on file. Claim 1 of this request was based on claim 4 of the patent as granted, amendments concerning the terminology and the addition of features arising from the patent specification.

The notice of appeal was received on 10 August 2010 and the prescribed fee was paid on the same day. On 25 October 2010 a statement of grounds of appeal was filed by which revocation of the patent was requested. The appellant raised objections under Articles 100(b) and 100(c) EPC and pointed to the fact that the contested decision did not deal with any of these issues which had already been raised during opposition.

Furthermore, the appellant disputed the presence of an inventive step for the claimed subject-matter (Articles 52(1) and 56 EPC) and submitted in this context further documents (D25 to D28) as evidence for the common general knowledge in the technical field at issue.

- II. In its response by letter of 14 March 2011, the respondent (patentee) requested to dismiss the appeal and to maintain the decision of the opposition division. Moreover it was requested that documents D25 to 28 not be admitted into the proceedings because they were late filed and prima facie not more relevant than the other prior art on file.

The appellant's arguments were refuted by a brief assertion that the present case and the claimed

subject-matter had been properly assessed in the opposition proceedings and that the decision by the opposition division was not insufficient or defective.

In case the Board of Appeal considered certain issues to be debatable, it was requested that a corresponding preliminary opinion was issued.

III. According to respective requests, the parties were summoned to oral proceedings by a notification dated 4 November 2015.

In an accompanying communication the Board of Appeal noted that in the absence of any substantive argument from the side of the respondent against the objections raised in the statement setting out the grounds of appeal, there would be no reason not to adopt the appellant's positions, to the extent that these appeared reasonable.

Inter alia, the Board noted that the absence of any recognizable basis of disclosure for the combination of the various features and functionalities comprised in claim 1 of the patent as maintained gave rise also to an objection of added subject-matter (Article 123(2) EPC) and that it would be up to the respondent to point to convincing evidence in the application documents as originally filed which would provide a proper basis of disclosure for the claimed subject-matter.

Moreover, the Board pointed to a potential infringement of the requirement of Article 123(3) EPC due to the use of the term "*indicia*" in said claim 1 instead of the term "*data file*" used in claim 4 of the patent as granted.

IV. By a letter received on 21 December 2015, the respondent filed amended sets of claims 1 and 2 according to a main request and a first auxiliary request. Moreover, second and third auxiliary requests were filed only including claim 1 of the main request and first auxiliary request, respectively.

V. Oral proceedings were held on 21 January 2016.

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the patent be maintained in amended form on the basis of one of the sets of claims 1 and 2 according to the main request or the first auxiliary request, both filed with the letter of 21 December 2015, or a set of claims 1 and 2 according to a second auxiliary request filed at the oral proceedings before the Board.

VI. Claim 1 of the respondent's **main request** reads as follows :

"1. A portable shopping system for selecting a set of items for purchase in a retail facility wherein each of said set of items includes machine coded indicia having a product information address, said portable shopping system comprising:

a plurality of portable terminals (12A-E, 22A, 70, 100, 240) having a machine code reader (75, 120) for reading the product information address from the machine coded indicia, a radio (80, 108) for communicating the product information address over a wireless communication network (30, 130), a display (72, 110, 244)[,] a telephony control circuit (706), a speaker

(74, 104) coupled to said telephony control circuit (706), a microphone (71, 105) coupled to said telephony control circuit (706), a telephone activation means coupled to the control circuit (706) for establishing a voice communication connection over the wireless communication network using the radio wherein each portable terminal (12A-E, 22A, 70, 100, 240) is provided with a unique IP address for the wireless communication network, and data processing software for displaying at least one page of graphical data on the display, wherein said at least one page of graphical data includes at least one link to a data file associated with the selected item, and the selection of the link on the display (72, 110, 244) generates a data request command transmission for the data file over the radio (80, 108); and

a central controller (14, 24, 150) having an access point (13, 13A, 13B) for communicating data over the wireless communication network, and a central database including a set of product data corresponding to the product information address, said set of product data including a price data portion and a product identifier, and a customer preferences database comprising one or more customer preferences,

wherein at least a portion of the set of product data is transmitted to the portable terminal by the central controller (14, 24, 150) in response to communication of said product information address from said portable terminal (12A-E, 22A, 70, 100, 240) and the product information address is a uniform resource locator for a file stored on the central controller in a predetermined location; and

further wherein the portion of product data transmitted to the portable terminal is selected based on one or more customer preferences before transmission to the portable terminal (12A-E, 22A, 70, 100, 240)."

The wording of claim 1 of the respondent's **first auxiliary request** differs from that of claim 1 of the main request in that the expressions "*includes machine coded indicia*" and "*from the machine coded indicia*" are respectively replaced by the expressions "*includes a machine coded data file*" and "*from the machine coded data file*".

Claim 1 of the respondent's **second auxiliary request** differs from claim 1 of the first auxiliary request in that the indefinite article "a" in the phrase "*wherein said at least one page of graphical data includes at least one link to a data file associated with the selected item*" is replaced by the definite article "the" and the expression "*the product information address*" is replaced by the expression "*product information addresses*".

In all three of the respondent's requests claim 2 is a dependent claim.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is, therefore, admissible.

2. Admissibility of the respondent's main request and first auxiliary request (Article 13(1) RPBA)

2.1 In the oral proceedings of 21 January 2016, the appellant objected to the admission of the respondent's main request and first auxiliary request filed by letter of 21 December 2015 as being late-filed. The appellant noted in this respect, that the respondent had had ample opportunity to file such requests with its reply to the statement setting out the grounds of appeal but had chosen not to avail itself of this opportunity.

The respondent argued that the main request and the first auxiliary request on file corresponded in essence to the request which was granted by the opposition division. The few amendments that were proposed constituted a reaction to the objection under Article 123(3) EPC, which had been raised for the first time in the proceedings with the Board's summons to the oral proceedings.

2.2 According to Article 13(1) RPBA *"Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion ..."*.

In the present case, the issue of extension of protection conferred was brought to the respondent's attention for the first time by the Board's communication of 4 November 2015. In such a situation, the right to be heard and procedural fairness demand that the respondent be given an opportunity to react to this situation and to try to overcome the deficiency by corresponding amendment.

This purpose is served by the appellant's main request and first auxiliary request, filed by letter of 21 December 2015.

For these reasons, the Board exercised its discretion in favour of the respondent and admitted these requests into the appeal proceedings.

3. Main request - extension of protection conferred (Article 123(3) EPC)

3.1 According to the respondent, claim 1 of the main request was based on claim 4 of the patent as granted. This fact is not disputed by the appellant or the Board of Appeal.

The wording of claim 1 of the main request differs from that of claim 4 of the patent as granted in the following aspects :

- (i) the expression "*includes machine coded indicia*" replaces the expression "*includes a machine coded data file*";
- (ii) the expression "*from the machine coded indicia*" replaces the expression "*from the machine coded data file*";
- (iii) the feature "*wherein each portable terminal (12A-E, 22A, 70, 100, 240) is provided with a unique IP address for the wireless communication network*" is added after the phrase "*for establishing a voice communication connection over the wireless communication network using the radio*";
- (iv) the indefinite article "a" in the phrase "*wherein said at least one page of graphical data includes at least one link to a data file associated*

with the selected item" [emphasis added] replaces the definite article used in patent claim 4;

(v) the phrase "*corresponding to the product information address*" replaces the expression "*corresponding to product information addresses*"; and

(vi) the feature "*and a customer preferences database comprising one or more customer preferences*" is added to the definition of the "*central controller*" after the term "*product identifier*".

3.2 The critical amendments are amendments (i), (ii) and (iv).

3.2.1 Having regard to amendments (i) and (ii), the respondent argued that the terms "*data file*" (claim 4 of the patent as granted) and "*indicia*" (claim 1 of the main request on file) were synonymous. In fact, it was apparent from independent claims 1, 4, 6 and 12 of the application as originally filed (which the examining division had correctly found "to provide four somewhat differently expressed versions of essentially the same broad features") as well as from numerous occurrences in the application description that the terms "*coded indicia*", "*machine coded data file*", "*bar coded label*" and "*machine coded label*" were interchangeably used throughout the application to designate the same physical entity, namely a machine readable code having a product information address. A corresponding overview over these alternative phrases had been given in a table bridging pages 8 and 9 of the letter of 21 December 2015. In the respondent's view, the mutual interchangeability of the terms in question was confirmed in particular by the passage on original page 6, lines 18 to 23 : "*Although the system will be described in terms of a portable terminal employing an integrated bar code laser scanner, it will be*

understood by those skilled in the art that the machine code reader can be a radio frequency identification tag reader, a CCD bar code reader having imaging capabilities for recording images or any other type of machine code reader which can decode encoded indicia on an article." The fact that any possible type of machine code reader could be conceived for use in the system confirmed the key point that a *"product information address"* had to be held in a machine readable code on each item, whereas it did not matter whether the code was named *"indicia"* or *"data file"*.

As regards amendment (iv), the respondent stated that the amendment was of less importance and that it had been proposed only because the respondent thought that the Board considered such an amendment to be necessary. Nevertheless, it was immediately apparent to a skilled reader of the wording of claim 4 of the patent as granted that the use of the definite article in the phrase: *"wherein said at least one page of graphical data includes at least one link to the data file associated with the selected item"* [emphasis added] did not make technical sense if it referred to the data file as addressed in the introductory phrase: *"wherein each of said set of items includes a machine coded data file"*. Moreover, the correction of this error, namely that *"the data file associated with the selected item"* actually meant *"a data file"* kept in the central database and transferred upon request to the portable terminal, as was claimed in present claim 1, was evident from the subsequent phrase in claim 4 of the patent as granted : *"and the selection of the link on the display generates a data request command transmission for the data file over the radio"*, since there was only one direction of file transmission, *i.e.* from the central data base to the portable terminal.

In case of any doubt, patent claims had to be properly interpreted in the light of the patent specification as a whole so as to give their wording the actually intended meaning.

In this context, the "Guidelines for Examination" (chapter F IV 4.2 "Interpretation") required that "Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, ... The claim should also be read with an attempt to make technical sense out of it." The publication "Case law of the boards of appeal", added in part II. chapter A.6.1 the general principles that "The skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity, *i.e.* building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent. The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding ...".

In the present case, the skilled person would have learned from the description that the *"machine coded data file having a product information address"* and the *"data file associated with the selected item"*, wherein *"the selection of the link on the display generates a data request command transmission for the data file over the radio"*, differ from each other. Thus, the skilled person would have interpreted claim 4 of the patent as granted in the sense of amendment (iv).

3.2.2 The appellant pointed to the fact that the term *"indicia"* was not present in claim 4 of the patent as

granted. The said claim referred instead to a "*machine coded data file*".

A "*data file*", however, was a file in a computer and definitely distinct from "*indicia*", which designated for instance a barcode or a label on a product.

3.2.3 The Board disagrees with the respondent. As will be shown in the following there are in fact two aspects of an extension of protection conferred in claim 1 of the main request with respect to claim 4 of the patent as granted.

Regarding amendments (i) and (ii), the Board concurs with the appellant that the term "*indicia*" used in present claim 1 does not have the same meaning as the term "*data file*" used in claim 4 of the patent as granted. As an aside it is noted that if that were not the case, the amendments in question would not be occasioned by a ground for opposition under Article 100 EPC and would thus be inadmissible in view of Rule 80 EPC, in the first place. However, in the common technical understanding of the term, a "*data file*" designates a specific piece of information which is stored in and retrievable from an electronic memory (such as for instance a memory that could be provided in an RFID tag). Its meaning does not encompass that of the term "*indicia*", which latter may indeed be represented by a bar code or any other kind of marking, *i.e.* by objects a technically skilled person would not consider to call a "*data file*".

In this context, the respondent has failed to provide convincing evidence for its assertion that the two terms in question constituted synonymous denotations for the same technical feature. The reference to the cited text of the originally-filed application

documents of the present patent does not suffice to provide such proof. It is not contested that the original application documents indeed use different terms, such as "*coded indicia*", "*machine coded data file*", "*bar coded label*" or "*machine coded label*", when referring to the reading of the product information address from a selected item. However, this circumstance does not reflect a sloppy and inconsistent use of language but, since for instance a "*label*" and a "*bar code*" are quite different technical entities, rather demonstrates the applicant's intention to describe and eventually claim a number of alternative embodiments. Apparently, only the alternative "*data file*" found its way into the definitions of the claims of the patent as granted.

Therefore, by using the term "*indicia*", according to aforementioned amendments (i) and (ii), instead of the term "*data file*", as in claim 4 of the patent as granted, claim 1 of the main request defines an *aliud*, contrary to the requirement of Article 123(3) EPC.

Regarding amendment (iv), it is as such clear from the plain text of claim 4 of the patent as granted that the term "*the data file*" in the phrase "*wherein said at least one page of graphical data includes at least one link to the data file associated with the selected item,*" refers to the initial definition of "*a machine coded data file having a product information address*". Contrary to the respondent's allegation, the use of the definite article does not constitute an obvious error, nor is it immediately evident that nothing else than the offered correction (*i.e.* the use of the indefinite article) would have been intended. In this context, the respondent ignores the fact that the definitions of claim 4 of the patent as granted imply the option that data read from the selected item is directly sent to a

central controller by the machine code reader (cf. column 11, lines 36-41 of the patent specification: "*In a preferred embodiment of the present invention, the bar code reader 240 acts as a dumb terminal with radio frequency communication means. In such case, all information is stored in a central location and the bar code reader 240 simply sends and receives data from the central location.*"). It follows from this observation that claim 4 of the patent as granted combines (in a confusing and perhaps unresolvable manner) two mutually exclusive embodiments concerning the transmission to a central controller of a request for product data relating to a selected item, either via direct data transmission by the machine code reader or via the selection of a link displayed on the display of the portable terminal.

Therefore, the mere fact that a skilled reader of claim 4 of the patent as granted might wonder about the purpose which is served by the claimed instruction that the link included in the graphical display should be made to the data file which is read from the selected item by the machine code reader does not justify ignoring the instruction and replacing it by an *aliud*. Moreover, it is to be noted that the claimed amendment "*a data file associated with the selected item*" refers to just any conceivable data file which would somehow be associated with the selected item. In fact, nothing in claim 1 of the main request on file requires the data file which is introduced according to amendment (iv) by the term "*a data file*" to correspond to the subsequently specified "*data file*" which is transmitted "*over the radio*" upon "*a data request command*", or to the "*set of product data*" included in the "*central data base*" or, perhaps, to the file defined by the phrase "*a file stored on the central controller in a predetermined location*".

In the factual circumstances as expounded above, any resort to Guidelines and case law allegedly calling for a technically sensible interpretation in the respondent's favour, is futile.

For the above reasons, the replacement of the definite by the indefinite article according to aforementioned amendment (iv) constitutes another *aliud* in claim 1 of the main request, contrary to the requirement of Article 123(3) EPC.

3.3 It follows from the above considerations that the main request is not allowable.

4. First auxiliary request - extension of protection conferred (Article 123(3) EPC)

Claim 1 of the first auxiliary request comprises amendment (iv) identified in point 3.1 above. For the same reasons as given in point 3.2.3 above, claim 1 of the first auxiliary request infringes the requirement of Article 123(3) EPC.

Therefore, the first auxiliary request is not allowable, either.

5. Admissibility of the respondent's second auxiliary request (Article 13(1) RPBA)

5.1 The second auxiliary request was filed at an advanced stage of the oral proceedings.

The appellant objected to the admission of this request into the proceedings as being late-filed and not clearly allowable.

The respondent defended the late filing of the second auxiliary request as being a reaction to objections under Article 123(3) EPC raised by the Board for the first time in the oral proceedings and an attempt to remove all wording objected to as entailing an extension of the protection conferred. Moreover, the amendments were not extensive, neither in number nor in substance.

5.2 The objection of extension of the protection conferred did not freshly arise during the oral proceedings but was known to the respondent at the time when the main request and the first auxiliary request were prepared and filed. At that time, the respondent must have been aware of the fact that all proposed amendments, including freshly made amendment (iv), would be examined in particular for compliance with the requirement of Article 123(3) EPC. Thus, the Board's objections against amendment (iv), as discussed in the oral proceedings and addressed in point 3.2.3 above, cannot be considered fresh objections for which the right to be heard and procedural fairness would justify an opportunity for still further amendment by a new request.

5.3 According to established case law, a decisive criterion for a board when exercising its discretion pursuant to Article 13(1) RPBA in favour of admitting a late-filed request into the proceedings is whether or not the new request would overcome all of the objections raised in the proceedings and would be clearly allowable. If, when judged on a *prima facie* basis, a late-filed request does not comply with a requirement of the EPC, it should not be admitted into the proceedings.

5.4 In the present case, one of the issues that had been raised by the appellant since the beginning of the opposition proceedings is the question of added subject-matter (Article 123(2) EPC). The appellant saw in particular no basis of disclosure for a combination of the features comprised in the independent claims of the patent as granted as well as in the amended claims maintained by the decision of the opposition division.

In the oral proceedings, the respondent pointed to original claims 2 and 4 and various passages in the application description as filed as the basis of disclosure for the subject-matter of claim 1 of the second auxiliary request. As regards in particular the aspect of a disclosure in combination of the various claim features, the respondent referred specifically to page 33 of the application as originally filed, where the last sentence of the first paragraph and the last paragraph respectively read: *"Accordingly, the herein described embodiments are merely exemplary in nature and are not intended to represent every possible embodiment of the present invention."* and *"It should be noted that the objects and advantages of the invention may be attained by means of any compatible combination(s) particularly pointed out in the items of the following summary of the invention and the appended claims."* Moreover, the respondent stressed the fact that according to the case law of the boards of appeal literal support of claim features was not required.

5.5 The Board notes that none of the originally-filed claims comprises the combination of features as it is included in claim 1 of the second auxiliary request so that none of them serves as a proper basis of disclosure for the claimed subject-matter.

As regards the remainder of the application documents, the claimed features may or may not be individually disclosed in one or the other of the various embodiments. What actually matters is the fact that - *prima facie* - there is no apparent basis of disclosure for the claimed combination of two mutually exclusive implementations :

- a system with a machine code reader which directly transfers a read "*data file*" to a central controller (original page 14, lines 23-26); or

- a system in which a "*link*" is provided on the terminal's display, the "*selection*" of which "*generates a data request command transmission for the data file over the radio*".

In the light of this observation, the two passages from original page 33 cited by the respondent do not constitute a clear and unambiguous disclosure for the claimed subject-matter.

For these reasons, the Board comes to the conclusion that claim 1 of the second auxiliary request does not comply with the requirement of Article 123(2) EPC.

Therefore, the Board did not admit the second auxiliary request into the proceedings.

6. In conclusion, it is found that there is no allowable request made by the respondent on file.

Order

For these reasons it is decided that:

The decision under appeal is set aside.
The patent is revoked.

The Registrar:

The Chairman:



R. Schumacher

G. Assi

Decision electronically authenticated