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**Datasheet for the decision
of 16 September 2015**

Case Number: T 2315/11 - 3.5.03

Application Number: 04745016.8

Publication Number: 1649333

IPC: G05B19/418, G05B23/02

Language of the proceedings: EN

Title of invention:

A system and method for monitoring and visualizing the output of a production process

Patent Proprietor:

Cognitens Ltd.

Opponent:

Born Sock Koo

Headword:

Visualizing the output of a production process/COGNITENS

Relevant legal provisions:

EPC Art. 56, 112(1)(a)
RPBA Art. 12(2), 12(4), 13(1)
EPC R. 103(1)(a)

Keyword:

Inventive step - no (main request and auxiliary request 1)
Admissibility - no (auxiliary requests 2 to 10)
Referral of questions to the EBA - no
Reimbursement of the appeal fee - no

Decisions cited:

T 0119/82, T 0520/01, T 0295/04, T 0809/06, T 0144/09

Catchword:



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Case Number: T 2315/11 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 16 September 2015

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(Patent Proprietor)

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 August 2011 concerning maintenance of the
European Patent No. 1649333 in amended form.**

Composition of the Board:

Chairman	F. van der Voort
Members:	T. Snell
	S. Fernández de Córdoba

Summary of Facts and Submissions

I. This appeal was lodged by the proprietor against the interlocutory decision of the opposition division that European patent No. 1 649 333 as amended in accordance with the seventh auxiliary request met the requirements of the EPC.

II. The following document cited in the impugned decision is relevant to the present decision:

E27: C. Hora et al., "An Effective Diagnosis Method to Support Yield Improvement", ITC International Test Conference 2002, Baltimore, USA, pages 260-269.

The substantive content of the other documents mentioned in the impugned decision is not relevant. Consequently, there is no need to identify these documents bibliographically.

III. Oppositions against the grant of the patent were filed by two parties, opponents OP1 and OP2. OP1 subsequently withdrew its opposition following commencement of the appeal proceedings and is therefore no longer party to these appeal proceedings.

IV. The only ground for opposition relevant to these appeal proceedings is that based on Article 100(a) EPC (novelty and inventive step). In this respect, the impugned decision essentially concludes that:

(i) E7 and E8 are to be regarded as prior art documents within the meaning of Article 54(2) EPC, since they are user manuals for a software product with "notorious wide availability", as demonstrated by E28, a document

introduced by the opposition division during the oral proceedings;

(ii) the subject-matter of claims 1 and 8 of the patent as granted (main request) and of auxiliary request 1 is not new with respect to E27;

(iii) the subject-matter of claims 1 and 8 of the patent as granted (main request) and of auxiliary request 1 does not involve an inventive step with respect to E7 or E8 combined with common general knowledge, or with respect to E14 combined with E27;

(iv) the subject-matter of the independent claims of auxiliary requests 2 to 6 and 8 does not involve an inventive step when starting out from E27 and taking into account common general knowledge or the teaching of E7, E8 or E14.

(v) the subject-matter of claims 1 and 7 of auxiliary request 7 involves an inventive step having regard to the disclosures of E7, E8, E14 and E27.

V. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that the patent be maintained either as granted or in accordance with one of the auxiliary requests 1 to 6 filed during the opposition procedure with the letter dated 16 May 2011 (i.e. auxiliary requests 1 to 6 referred to above).

It was also requested to reimburse the appeal fee due to the opposition division's allegedly having committed several substantial procedural violations, in particular regarding the introduction of document E28 during the oral proceedings.

VI. Opponent OP2 (respondent) did not reply to the statement of grounds.

VII. In a communication accompanying a summons to attend oral proceedings, the board gave a preliminary opinion, *inter alia*, that:

(i) with respect to the introduction of E28, the appellant's right to be heard had been violated. Further, the appellant's argument that E28 did not demonstrate that the software product manuals E7 and E8 were publically available before the filing date seemed plausible. Consequently, the board intended to disregard these documents;

(ii) the subject-matter of claim 1 of the main request did not appear to be new with respect to E27, or at least not to involve an inventive step;

(iii) auxiliary requests 1 to 6 did not appear to be admissible because there was no reasoned statement meeting the requirements of Article 12(2) RPBA;

(iv) despite the apparent violation of the right to be heard with respect to E28, the board did not consider that it would be equitable to reimburse the appeal fee, even assuming the appeal were to be allowed.

VIII. In a response to the board's communication, the appellant filed new auxiliary requests 1 to 4 and renumbered the previous auxiliary requests as 5 to 10.

The appellant also requested that E27 be excluded from the proceedings.

The appellant further reiterated the request to reimburse the appeal fee.

- IX. The respondent informed the board by letter that it would not attend the oral proceedings.
- X. Oral proceedings took place on 16 September 2015 in the presence of the appellant.

The appellant (patent proprietor) requested that the opposition be rejected or, in the alternative, that the patent be maintained in amended form on the basis of one of four auxiliary requests, all as filed with the letter of 31 July 2015, or on the basis of one of six auxiliary requests (renumbered as 5th to 10th auxiliary requests) all as filed with the statement of grounds of appeal.

Further, the appellant requested the referral of three questions to the Enlarged Board of Appeal and reimbursement of the appeal fee.

At the conclusion of the oral proceedings, after due deliberation, the chairman announced the board's decision.

- XI. Claim 1 of the **main request** (i.e. claim 1 of the patent) reads as follows:

"A method for visualizing the output of a production process comprising:
inspecting two or more materials or items produced by the production process;
directly measuring or extrapolating one or more values of one or more parameters of each inspected material or item;

comparing at least one of the measured or extrapolated values against a corresponding stored value to determine a difference value;
performing statistical analysis on corresponding values and or difference values associated with corresponding points on each of the inspected materials or items to derive a statistical analysis based data set;
using a computing device to generate an image of a material or item representing the inspected materials or items, wherein at least an area or section of the image corresponding to an area or section of each of the materials or items associated with the at least one of the measured or extrapolated values which was compared to the stored value is visually coded to indicate the corresponding said data of said statistical based data set."

XII. Claim 1 of **auxiliary request 1** reads as follows:

"A method for visualizing the output of a production process comprising:
inspecting two or more items produced by the production process;
directly measuring or extrapolating one or more values of one or more parameters of each inspected item by use of one or more inspecting units;
using a computing device to
. compare at least one of the measured or extrapolated values against a corresponding stored value to determine a difference value;
. perform statistical analysis on corresponding values and or difference values associated with corresponding points on each of the inspected items to derive a statistical analysis based data set; and
. generate an image of an item representing the inspected items, wherein at least an area or section of

the image corresponding to an area or section of each of the items associated with the at least one of the measured or extrapolated values which was compared to the stored value is visually coded to indicate the corresponding said data of said statistical based data set."

XIII. Claim 1 of **auxiliary request 2** reads as follows:

"A method for visualizing the output of a production process comprising:
automatically inspecting two or more items produced by the production process;
automatically directly measuring or extrapolating one or more values of one or more parameters of each inspected item by use of one or more inspecting units, said parameters being physical dimensions of each inspected item and being represented by a set of three dimensional coordinates (x, y, z);
using a computing device to
. compare at least one of the measured or extrapolated values against a corresponding stored value to determine a difference value;
. perform statistical analysis on corresponding values and or difference values associated with corresponding points on each of the inspected items to derive a statistical analysis based data set; and
. generate an image of an item representing the inspected items, wherein at least an area or section of the image corresponding to an area or section of each of the items associated with the at least one of the measured or extrapolated values which was compared to the stored value is visually coded to indicate the corresponding said data of said statistical based data set."

XIV. Claim 1 of **auxiliary request 8** reads as follows:

"A method for visualizing the output of a production process comprising
inspecting two or more items produced by the production process;
directly measuring or extrapolating one or more values of parameters of each inspected item,
said parameters being physical dimensions of the item, said physical dimensions of the item being represented by a set of three dimensional coordinates (x, y, z);
comparing at least one of the measured or extrapolated values against a corresponding stored value to determine a difference value,
said stored value representing a target value for said parameters;
performing statistical analysis on corresponding values and or difference values associated with corresponding points on each of the inspected items to derive a statistical analysis based data set,
wherein one or a series of statistical analysis operations is performed between all the data sets representing measured or extrapolated values from each of the inspected items for producing a single data set,
said one or a series of statistical analysis operations being a range determination operation and/or an averaging operation and/or a standard deviation operation;
using a computing device to generate an image of an item representing the inspected items, wherein at least an area or section of the image corresponding to an area or
section of each of the items associated with the at least one of the measured or extrapolated values which was compared to the stored value is visually coded to

indicate the corresponding said data of said statistical based data set."

- XV. For the sake of conciseness, the wording of claim 1 of **auxiliary requests 3 to 7, 9 and 10** is not reproduced, it being sufficient for the decision to note that claim 1 of auxiliary requests 3 and 4, like claim 1 of auxiliary request 2, include the following wording:

"said parameters being physical dimensions of each inspected item and being represented by a set of three dimensional coordinates (x, y, z)".

- XVI. The questions submitted for referral to the Enlarged Board of Appeal read as follows:

"1. Muss eine Entscheidung der Einspruchsabteilung bezüglich der Zurückweisung von Hilfsanträgen (hier: 1-6) im Rahmen des Beschwerdeverfahrens generell überprüft werden, wenn für die Zurückweisung herangezogene Dokumente (hier: E7/E8) von der Beschwerdekammer als nicht zu berücksichtigen angesehen bzw. ausgeschlossen werden, d.h. wenn die Entscheidungsgrundlage nicht mehr gegeben ist?

2. Muss die Überprüfung auch dann erfolgen, wenn in der Beschwerdebegründung die Zulässigkeit dieser Hilfsanträge nicht explizit begründet wurde?

3. Muss die Überprüfung insbesondere dann erfolgen, falls eine mögliche Entscheidung der Beschwerdekammer für den Hauptantrag (Patent wie erteilt) auf eine abweichende Entscheidungsgrundlage beruht (ohne E7/E8), die Hilfsanträge jedoch auch im Lichte der E7/E8 zurückgewiesen wurden und bleiben?"

Reasons for the Decision

1. Technical background

1.1 The patent in suit concerns a method for "visualising" the output of a production process. As stated in the patent (cf. paragraphs [0003] and [0004]), there existed various inspection systems which could scan or otherwise measure the surface of a manufactured item, and could produce a three-dimensional computer model of the scanned item. Various parameters, e.g. the physical dimensions, could be compared to stored values. The result of the comparison could be visualised with the aid of a computer. Further, as part of the visualization of an inspected item, deviations of measured parameter values from stored values could be indicated on a computer generated graphical representation of the [single] inspected item.

2. Request for excluding E27

2.1 The appellant requested that document E27 be excluded from the proceedings, essentially because it had been introduced "very late" by the opposition division and was prima facie not relevant in view of the fact that it was difficult to understand and came from a field unrelated to the present patent.

2.2 The board however observes that an opposition division is empowered to introduce a document into the procedure of its own motion at any time, in accordance with the principle of ex officio examination (Article 114(1) EPC), subject to the proprietor's right to be heard being respected (Article 113(1) EPC). The board notes that a violation of the right to be heard as regards E27 has never been alleged. As to prima facie

relevance, that is a factor to be assessed by the opposition division, who clearly considered E27 to be prima facie relevant, since E27 formed the basis of the decision (see point IV above). The board, in any case, agrees with the opposition division as to the prima facie relevance of E27, as will be discussed below. The board also finds the document to be sufficiently comprehensible. The board therefore finds that there is no basis for excluding E27 from these appeal proceedings. This request is therefore rejected.

3. *Main request - claim 1 - inventive step*

3.1 The closest prior art is considered by the board to be represented by E27. Document E27 is concerned with fault diagnosis in connection with the manufacturing process of semiconductor wafers. In the understanding of the board, in the semiconductor art, a wafer comprises a plurality of dies each with the same integrated circuit. Each die, which is considered to be an "item" within the meaning of the present patent, has a layout of electrical "nets", i.e. electrical circuits, the nets being interconnected with each other to form the integrated circuit. The aim of E27 is to identify repetitive failure mechanisms, i.e. systematically failing nets, in a plurality of dies on a wafer or in a lot and to present the results visually. To this end, each wafer is tested to obtain test data ("failing vectors"), which are compared with a stored library ("fault dictionary"), the data being subjected to a statistical diagnosis algorithm in order to obtain a list of suspected net failures (cf. page 263, section entitled "4. Experimental setup"). The suspected net failures of a batch of dies are represented graphically on a computer display ("fail histogram") (cf. Figs. 3 and 7a to 7d; page 265,

section "6.1. case study 1"). The fail histogram is constructed using layout coordinates of the die in the x-y plane with the number of net failures at each die location on the z-axis. Each point on the histogram represents the number of suspected net failures having the layout coordinates of that point in the tested batch.

3.2 The subject-matter of claim 1 requires essentially that:

(i) measured or extrapolated parameter values at corresponding points on several produced items are compared with stored values,

(ii) either the measured or extrapolated values and the stored values or the difference values are statistically analysed to form a data set, and

(iii) the data set is presented by visually coding an image representing the item.

3.3 E27 discloses essentially that:

(i) measured parameters (fail vectors) for several items (dies) are compared with stored values (dictionary) in order to determine a list of suspect nets (fault diagnosis). The fault diagnosis can be seen implicitly, or at least obviously, as resulting in a list of pass/fail values (e.g. a "1" for a pass and a "0" for a fail) for each net. This value can be seen as a parameter of corresponding points (nets) on several produced items (dies);

(ii) the pass/fail net values are analysed (here, by counting fails) to form a data set. The data set

consists, at each net location, of the number of fails over the entire lot, with those dies where the number of failures is above a threshold being ignored (cf. page 265, section 6.1), which in the board's view is a statistical analysis (the board will come back to this point subsequently when dealing with the appellant's arguments);

(iii) the data is represented visually as a histogram-coded depiction of a die (cf. Fig. 3).

3.4 The essential difference between the subject-matter of claim 1 and the disclosure of E27 is that in E27 the parameter values pertaining to each net (i.e. "pass" or "fail", or "0" or "1") are not compared with respective stored values. Instead, the comparison step occurs earlier and is performed on measurements taken from the die as a whole, in order to generate the parameters for each net, from which the pass/fail data is generated. This difference does not contribute to inventive step for the following reasons.

3.5 Firstly, the board notes that the basic aim of E27, as in the present patent, is to identify locations (nets) on each item (die) which systematically deviate from the norm, and to present the results for several items jointly by visually coding an image of the item.

3.6 Further, the skilled person would be aware on the basis of common knowledge that where a deviation at a specific location of an item can be ascertained by measuring parameters directly, it would be obvious to do so. E27 in fact suggests such measurements, particularly carried out at an earlier stage of production (cf. page 260, right-hand col., 2nd paragraph). Taking direct measurement of parameters is

also mentioned in paragraph [0003] of the description of the present patent, dealing with the background art.

- 3.7 The skilled person would further appreciate that each net, which is an individual electrical circuit, could (at least theoretically) be tested by directly measuring a parameter of the net, e.g. an output signal of the net, and comparing it to a stored value, in order to identify a failing net, it being well-known to test an electrical circuit by applying an input signal and measuring the output signal of the circuit. On the other hand, it may not be convenient to test nets in this way for reasons of impracticality or being too time consuming. In E27, the suspect nets are diagnosed by using the more complex procedure based a comparison of test data with a stored parameter vector dictionary and a statistical diagnosis algorithm, thereby reducing tester time overhead (cf. page 268, section "8. Conclusions"). However, in accordance with established case law, obviousness is not only at hand when the skilled person would have seen all the advantages of acting in a certain manner, but also when he could clearly see why he should not act in the suggested manner (here: taking direct measurements) in view of its predictable disadvantages or absence of improvement, provided he was indeed correct in his assessment of all the consequences (cf. T 119/82, point 16 of the reasons).

Hence, in the present case, when starting out from E27, the alternative of obtaining the suspect net data by taking the step of measuring parameters of each net directly cannot contribute to inventive step.

3.8 Consequently, the board concludes that the subject-matter of claim 1 does not involve an inventive step (Articles 52(1) and 56 EPC).

3.9 The board understood the appellant's main arguments to be as follows:

(i) The only statistical diagnosis in E27 is carried out on a single die to identify the suspect nets. There is no statistical analysis of two or more dies. A histogram depicting the number of net failures on a batch of dies is not a statistical analysis.

(ii) The image in E27 is not a physical representation of a die but a logic representation.

(iii) In E27, no parameters of corresponding points of the device are measured. Instead, logic outputs of an entire die are detected. Consequently, no difference calculation is performed either, as required by claim 1.

(iv) E27 concerns a different technical field to the present patent and is therefore not relevant to inventive step. A skilled person starting out from the prior art situation outlined in the description of the patent in paragraphs [0003] and [0004], which was related to motor vehicle production, would not seek a solution in a document concerned with chip manufacture.

3.10 Re (i): The board agrees with the appellant's view that in E27 a statistical analysis is performed in order to determine the list of suspect net failures on each die, the results of which are then represented as a histogram. However, in the board's view, the wording of claim 1 "performing statistical analysis on

corresponding values and or difference values associated with corresponding points on each of the inspected items to derive a statistical analysis based data set" arguably embraces such an embodiment. However, even if, for the sake of argument, the appellant's interpretation of claim 1 as requiring a statistical analysis of two or more items together is adopted, the board considers that the establishing of a data set representing the number of suspects nets at each corresponding location, and representing the data set as a histogram, is itself a statistical analysis. As stated above, each point on the histogram in Fig. 3 of E27 represents visually the statistical probability that a die will have a systematic net failure at that location. Further, the data set being reduced by excluding dies with a number of net failures above a threshold is also a statistical operation. The board's view that the list of suspect nets obtained from the statistical diagnosis undergoes a further statistical analysis is further corroborated by the abstract of E27, lines 6 to 9, which states: "The new approach is analyzing the failing vectors from an entire lot and produces a finite list of suspect locations, which are then subjected to further statistical and physical analysis" (board's underlining).

Re (ii): In the board's view, the fact that in E27 "layout co-ordinates" are referred to suggests a physical representation. This is corroborated by the fact that the x and y axes are shown in Fig. 3 as representing dimensions ("m"). In any case, claim 1 merely refers to an "image ... representing the inspected materials or items", which does not exclude a logical representation.

Re (iii): The board agrees that in E27 parameters of the nets are not measured directly, but are computed from global measurements. However, the board has explained above that this difference does not involve an inventive step, since it is an obvious idea to take direct measurements of nets even if this is not done in prior art due to being inconvenient or impracticable.

Re (iv): Claim 1 is not limited to a particular field. Furthermore, the board's analysis is based on starting out from E27, not from the state of the art described in paragraphs [0003] to [0005] of the description, which in any case does not mention any particular field of manufacture.

Consequently, the board finds the appellant's arguments unconvincing.

4. *Auxiliary request 1 - admissibility*

4.1 This request was filed in response to the board's communication. Consequently, the board has the discretion to admit the request in accordance with Article 13(1) RPBA.

4.2 Since the filing of the request could be seen as a reaction to comments made by the board in its communication concerning the technicality of the claim, and the board's consideration of the request did not present any undue procedural difficulty, the board admitted the request to the appeal proceedings.

5. *Auxiliary request 1 - claim 1 - inventive step*

5.1 Claim 1 of auxiliary request 1 (see point XII above) differs from claim 1 of the main request essentially in

that "items", instead of "materials or items", are inspected "by use of one or more inspecting units", and in that certain steps of the claimed method are carried out "using a computing device".

5.2 These aspects however do not distinguish the subject-matter of claim 1 further from E27; nor did the appellant argue otherwise. Consequently, these amendments make no difference to the assessment of inventive step.

5.3 The board concludes that the subject-matter of claim 1 of auxiliary request 1 does not involve an inventive step (Articles 52(1) and 56 EPC).

6. *Auxiliary requests 2 to 10 - admissibility*

6.1 Auxiliary requests 2 to 4 were filed in response to the board's communication, whereas auxiliary requests 5 to 10 were filed with the statement of grounds of appeal (as auxiliary requests 1 to 5, subsequently renumbered).

6.2 Article 12(2) RPBA states that "The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on".

Article 12(4) RPBA states that "... everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2)."

- 6.3 It follows that whether, and to what extent, the board shall take the auxiliary requests filed with the statement of grounds of appeal (here: auxiliary requests 5 to 10) into account is determined by the appellant's case set out in the statement of grounds in respect of these requests. Further, it is implicit that requests filed subsequently, whose admissibility is at the discretion of the board pursuant to Article 13(1) RPBA, should also be accompanied by a statement setting out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on (cf. T 144/09, point 1.17 of the reasons).
- 6.4 As to auxiliary requests 5 to 10, the appellant provided no statement meeting the requirements of Article 12(2) RPBA. A mere reference to submissions made during the opposition procedure cannot normally replace a reasoned statement (cf. e.g. T 295/04, point 1 of the reasons).
- 6.5 The appellant argued that the requests were filed already during opposition proceedings and thus were automatically included in the appeal proceedings. However, the board notes that appeal proceedings are separate proceedings governed by their own rules of procedure.
- 6.6 The appellant further argued that the decision of the opposition division to refuse these requests was tainted by a substantial procedural violation, because the reasoning was based on documents E7 and E8. In this respect, the board had indicated in its communication

that a substantial procedural violation had occurred and did not intend to take E7 and E8 into account.

6.7 In accordance with case law, the presence of a substantial procedural violation can be a reason for dispensing with the requirement to provide a proper statement setting out the grounds of appeal (cf. T 809/06, point 4 of the reasons). The board considers that this does not apply in the present case for the following reasons.

6.8 The board did indeed come to the preliminary conclusion that E7 and E8 should be disregarded in these appeal proceedings as not being prior art documents within meaning of Article 54(2) EPC, and that the opposition division had committed a substantial procedural violation by violating the right to be heard (see point VII above). However, when considering the reasons for refusing auxiliary requests 1 to 6 set out in the impugned decision (now auxiliary requests 5 to 10), the board notes that the opposition division in each case provided reasons which did not rely on either E7 or E8:

Re auxiliary request 1 (now auxiliary request 5): The decision states that "the subject-matter of independent claims 1 and 8 of the auxiliary request 1 is new with respect to the cited documents E1-E26, but not with respect to the cited document E27, and does not involve an inventive step starting from any of E7, E8 or E14" (board's underlining) (cf. point 8.4 of the reasons, last paragraph).

Re auxiliary requests 2 and 3 (now auxiliary requests 6 and 7): Claim 1 of these requests include one or more additional features identified in the decision as (iv'), (v) and (v'). It is stated that "For the same

reasons analysed in relation to feature (iv) of auxiliary request 1 ..., feature (iv') cannot contribute to inventive step", and "Features (v) and (v') ... constitute mere design options that are well known to the skilled person in all fields of technology ... Therefore, neither of these features can further distinguish the claimed subject-matter from the prior art E7 or E8, and in any case cannot contribute to inventive step" (board's underlining) (cf. point 9.4 of the reasons, 3rd paragraph).

Re auxiliary requests 4 to 6 (now auxiliary requests 8 to 10): Claim 1 of each of these requests includes additional features identified in the decision as (vii), (viii) and (ix). The decision states: "... the advantages of the method and system of E7, E18, E14 and E27 are independent of the particular production process to which they are applied. Hence the skilled person would readily apply them also to a process according to features (vii) or (viii) ... Hence these features do not contribute to an inventive step" and "Feature (ix) ... in fact defines some very common statistical techniques, which cannot contribute to inventive step" (board's underlining) (cf. point 10.4 of the reasons, 3rd and 4th paragraphs).

6.9 Consequently, there are reasons in the decision under appeal for refusing each auxiliary request which do not rely on either E7 or E8. It follows that whether or not a substantial procedural violation was committed in respect of E7 and E8 is not relevant in this respect, so that it was incumbent on the appellant to provide a statement in accordance with Article 12(2) RPBA in respect of these requests (i.e. present auxiliary requests 5 to 10).

- 6.10 As to auxiliary requests 2 to 4, the board notes that these requests are essentially based on auxiliary request 4 filed during the opposition procedure (now auxiliary request 8; cf. points XIII and XIV above). In particular, they all include the wording "said parameters being physical dimensions of each inspected item and being represented by a set of three dimensional coordinates (x, y, z)". It follows that the arguments set out in the impugned decision with respect to this feature apply, *mutatis mutandis*. Since the appellant did not address these arguments either in the statement of grounds of appeal or in the letter accompanying the filing of auxiliary requests 2 to 4, the board, exercising its discretion under Article 13(1) RPBA, sees no reason to admit these requests either, since when certain earlier requests are held inadmissible under Article 12(2) and (4) RPBA (here, auxiliary request 8), the same should apply to similar requests filed after the statement of grounds has been filed. Otherwise it would be easily possible for the appellant to artificially circumvent the provisions of Articles 12(2) and (4) RPBA.
- 6.11 The appellant did not specifically respond to the board's preliminary view expressed at the oral proceedings as to the inadmissibility of auxiliary requests 2 to 4 with arguments, but instead submitted questions for referral to the Enlarged Board of Appeal. However, the board considers that answers to these questions were not necessary in order to decide on admissibility and not relevant to the board's assessment (see below).
- 6.12 Consequently, the board held that auxiliary requests 2 to 10 were not admissible.

7. *Request for referral of questions to the Enlarged Board of Appeal*

7.1 At the oral proceedings, the appellant requested that questions be referred to the Enlarged Board of Appeal (see point XVI above).

7.2 The questions can be re-formulated in English as follows:

1. Must a decision of the opposition division with respect to the rejection of auxiliary requests (here: 1-6) generally be reviewed within the framework of the appeal proceedings when documents on which the rejection is based (here: E7/E8) are regarded by the board as not to be taken into consideration and/or to be excluded, i.e. when the basis for the decision no longer exists?

2. Must the review also be carried out when in the statement of grounds of appeal the admissibility of these auxiliary requests is not explicitly reasoned?

3. Must the review in particular be carried out if a possible decision of the Board of Appeal in respect of the main request (patent as granted) is based on a different reasoning (without E7/E8), the auxiliary requests however having been rejected in the light of E7/E8 and remain so?

7.3 In accordance with established case law, for a referral of a question by a Board of Appeal to the Enlarged Board of Appeal at the request of a party (cf. Article 112(1)(a) EPC) to be admissible, an answer to the question must be necessary in order for the referring

board to decide on the appeal (cf. e.g. T 520/01, point 4.1 of the reasons).

- 7.4 As regards question 1, there is no need for this question to be answered in order for the board to decide on the present appeal because documents E7 and E8 were not the only basis for the opposition division's rejection of these requests (see point 6.8 above).
- 7.5 Questions 2 and 3 are understood by the board as being subsidiary to question 1, i.e. as being the same as question 1 except for introducing additional conditions. Consequently, as there is no need for question 1 to be answered, the same applies to questions 2 and 3.
- 7.6 The request for referral of these questions to the Enlarged Board is therefore rejected.

8. *Alleged substantial procedural violations and reimbursement of the appeal fee*

- 8.1 The appellant submits that the opposition division committed a number of procedural violations and requests reimbursement of the appeal fee. The violations alleged are the following:

(a) The circumstances surrounding the introduction of E28 in the oral proceedings infringed the right to a fair conduct of the proceedings and the right to be heard.

(b) The basing of the decision on notorious knowledge infringed the proprietor's right to be heard (Article 113(1) EPC).

(c) Documents E9a-E9d, E11a-E11f and E12a-12d were not taken into account although they were relevant to the date of publication of E5-E8.

(d) Evidence was not taken from the witness Mr Soucy as requested by the proprietor in connection with evaluating E5-E8.

8.2 Rule 103(1) (a) EPC states that "The appeal fee shall be reimbursed where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation" (board's underlining).

8.3 In the present case, whether or not a substantial procedural violation was committed by the opposition division for the reasons submitted by the appellant is not relevant, because none of the appellant's requests are allowable, and therefore the appeal is not allowable. Since the appeal fee can only be reimbursed where the board deems an appeal to be allowable, it follows that the request for reimbursement of the appeal fee must be rejected.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The request for referral to the Enlarged Board of Appeal is rejected.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated