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**Datasheet for the decision
of 4 August 2017**

Case Number: T 2598/12 - 3.5.03

Application Number: 06026336.5

Publication Number: 1801677

IPC: G05B19/05

Language of the proceedings: EN

Title of invention:

Remote monitoring and control of an I/O module

Applicant:

Rockwell Automation Technologies, Inc.

Headword:

Remote monitoring/ROCKWELL

Relevant legal provisions:

RPBA Art. 12(2), 12(4), 13(1)

Keyword:

Admissibility of late-filed request (no)

Decisions cited:

G 0010/93, T 0144/09

Catchword:

There is no time bar to the requirement following from Article 12(2) and (4) RPBA that a request filed during appeal proceedings must be properly substantiated (cf. point 1.8 of the reasons). Consequently, this requirement applies, mutatis mutandis, to new requests filed in response to a communication of the board.



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Case Number: T 2598/12 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 4 August 2017

Appellant: Rockwell Automation Technologies, Inc.
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Mayfield Heights, OH 44124 (US)

Representative: Grünecker Patent- und Rechtsanwälte
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 2 August 2012
refusing European patent application No.
06026336.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman F. van der Voort
Members: T. Snell
O. Loizou

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division refusing European patent application No. 06026336.5, with publication number EP 1 801 677 A.

The refusal was based on the ground that the subject-matter of the independent claims of the main request and the auxiliary request respectively did not involve an inventive step with respect to the disclosure of document D3 (= US 6 201 996 B1). In an obiter dictum, it was also considered that the subject-matter of claim 1 of each request did not involve an inventive step with respect to the disclosure of D4 (= WO 01/69335 A2) either.

- II. The appellant filed an appeal against the above decision. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of a main request or an auxiliary request, both requests as filed with the statement of grounds of appeal. The appellant also conditionally requested oral proceedings (cf. Article 116 EPC).

- III. In a communication accompanying a summons to oral proceedings, the board gave a preliminary view that the subject-matter of claim 1 of both requests did not involve an inventive step having regard to the disclosure of D3.

- IV. With a letter of reply dated 10 July 2017, the appellant submitted claims of a second auxiliary request.

V. Oral proceedings were held on 4 August 2017. The appellant withdrew all requests and submitted a sole new request ("main request"). The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request as filed during the oral proceedings.

At the end of the oral proceedings, the chairman announced the board's decision.

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

An industrial automation system for monitoring and/or controlling an input/output, I/O, module, comprising the following computer-executable components:

a receiver component (102) that receives a request by a remote user for creating, editing or access of a web page (106) of a network adaptor (104);

an editor component (402) within the network adaptor that enables by means of an editing applet creating or editing of the web page by graphically arranging and interconnecting function blocks;

a save component (508) for saving the edited web page on a local drive or a network server (506); and

a converter component (302) for converting data of the web page from HTTP format to a format that conforms to the industrial protocol employed by the I/O module;

an execution component (112) that, upon a remote request from a user via the receiver component to access the web page, employs Java plug-ins (208) that are retrieved by an associated requestor component to

execute instantiated objects within said web page to effectuate at least one of monitoring and control of the I/O module (108) that is communicatively coupled to the network adaptor, thus allowing the user through remote access to the web page to effectuate remote monitoring and/or control of a process."

Reasons for the Decision

1. Main request - admissibility

1.1 Claim 1 of the main request, which was presented at the oral proceedings for the first time, is substantially amended as compared to claim 1 of either the main or first auxiliary request submitted with the statement of grounds of appeal. It is essentially based on claim 1 of the second auxiliary request as filed with the letter dated 10 July 2017 in response to the board's communication and includes features which had not been included in any claims submitted during in the examination procedure.

1.2 Amendments to a party's case after filing the statement of grounds of appeal are governed by Article 13 RPBA.

In accordance with Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. One of the criteria used by the boards when exercising their discretion is whether or not the new claims are prima facie allowable.

- 1.3 In addition to Article 13 RPBA, the board draws attention to the provisions of Articles 12(2) and (4) RPBA.

In accordance with Article 12(2) RPBA, the statement of grounds of appeal 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 evidence and arguments relied on.

In accordance with Article 12(4) RPBA, without prejudice to the power of the board to hold inadmissible requests which could have been presented in the first instance proceedings, everything presented by the parties under Article 12(1) RPBA shall be taken into account by the board if and to the extent it meets the requirements in Article 12(2) RPBA.

- 1.4 Article 12(4) RPBA, although referring to Article 12(1) and (2) RPBA concerning the notice of appeal and the statement of grounds of appeal, also applies to requests submitted later in the appeal proceedings, it being noted that a restriction in its application by the time limit for filing the statement of grounds of appeal would not seem to serve any useful purpose and might even result in a possibility of artificially circumventing Article 12(4) RPBA (cf. T 144/09, point 1.17 of the reasons).

- 1.5 With regard to Article 12(4) RPBA, the board cannot see why the present request could not have been submitted during the examination procedure, and notes in particular that at the oral proceedings before the

examining division, the applicant expressly did not wish to submit any more requests (cf. the minutes, point 7.1). The board further notes that the appellant did not even submit the present request with the statement of grounds of appeal, noting that Article 12(2) RPBA stipulates that the statement of grounds shall contain the appellant's "complete case".

- 1.6 The appellant argued that it did not file the request before the examining division as it was not in a position to know the outcome of the examination procedure. The appellant further argued that the quality of first instance decisions in the EPO had diminished, which meant that it was not fair to assume that the applicant was in a position to present everything in the first instance proceedings. It was essential to have a second instance which was more than a review instance and which "knows what it is doing" in order to compensate for the fall in quality of the first instance. The appellant stated that the German Federal Patent Court (Bundespatentgericht) allowed amendments and a full examination of the substantive issues. The appellant further stated that although the request could have been filed with the [statement of grounds of] appeal, time was short when reacting to the decision. There must also be some possibility to react to the board's preliminary opinion. The appellant further drew attention to the fact that the case had been pending for 11 years, 5 of which were with the board, but at least now there was possibility of discussing the case all day. It would be unfair to deprive the appellant of this possibility, especially given that the office had received renewal fees whilst the application had been pending for such a long time. Consequently, it was only a fair treatment to admit the new request.

1.7 The board finds these arguments either unconvincing or not relevant. In respect of the alleged drop in quality of the first instance decisions, the board notes that the appellant has not alleged that this applies in the present case, and indeed, in the present case, the board finds no reason to criticise the quality of the examination, noting that the board in its preliminary opinion essentially agreed with the conclusions of the examining division. As to the argument that the outcome of the examination procedure was not known, the board notes that the applicant was informed at the oral proceedings of the examining division's conclusions with respect to the requests on file, and expressly declined the opportunity to file another request (cf. the minutes, points 4.4, 6.4 and 7.1). As to the length of the proceedings and the corresponding payment of renewal fees, the board sees no logic dictating that the provisions of Articles 12(2) and 12(4) RPBA should not be applied.

1.8 As noted above, it is a further requirement in appeal proceedings that the appellant set out in writing the reasons as to why the decision under appeal should be "reversed, amended or upheld" and specify expressly all the facts, arguments and evidence relied on (cf. Article 12(2) RPBA). This is a prerequisite in order for the matter to be taken into account (cf. Article 12(4) RPBA).

Logically, this prerequisite applies in appeal proceedings without any time bar, i.e. also to requests filed in response to the board's communication, for the same reasons as given in connection with that aspect of Article 12(4) RPBA dealing with requests which could have been filed or were not admitted in the first

instance proceedings (cf. T 144/09, *ibidem*, and point 1.4 above).

- 1.9 In the present case, as pointed out above (cf. point 1.1), claim 1 is essentially based on claim 1 of the second auxiliary request filed with the letter dated 10 July 2017 in response to the board's communication. This second auxiliary request was however not accompanied with arguments explaining how the amendments overcome the objections leading to the decision to refuse the application, i.e. why the subject-matter of claim 1 involves an inventive step with regard to documents D3 and D4.
- 1.10 The appellant argued that the reasons given in the reply to the board's communication implicitly concerned the differences with respect to D3 and D4. The board however finds this unconvincing. The appellant's submission rather serves merely to explain in short the "invention" as described in the description, but in no way constructs an argument as to how the objection of lack of inventive step has been overcome, which at the least would require pointing out the differences over the prior art documents D3 and D4 and the significance thereof. Furthermore, an implicit argument does not meet the requirement that the appellant should specify expressly the arguments relied on (cf. Article 12(2) RPBA).
- 1.11 The board further notes that, since no new objections had been raised by the board in its communication, the filing of the second auxiliary request cannot be considered as an attempt to overcome objections raised by the board for the first time. Nor did the appellant argue otherwise.

- 1.12 The above deficiencies in respect of the second auxiliary request apply, *mutatis mutandis*, to the present request and count further against admitting this request.
- 1.13 It is further noted that if the request were admitted, the examination of claim 1 with respect to novelty and/or inventive step would in the board's estimation require a detailed analysis of D4, since, *prima facie*, D4 appears to be highly relevant and now probably represents the closest prior art. D4 is however a relatively complex document. The board would be forced either to examine claim 1 itself with respect to D4 in the oral proceedings, or to remit the case for further prosecution. The first option would run contrary to the purpose of appeal proceedings (cf. G 10/93, OJ EPO 1995, 172, point 4 of the reasons), which is essentially to examine the correctness of the first instance decision rather than to give a ruling on substantive matters which have not previously been examined (this indeed being essentially the reason why the boards are empowered under Article 12(4) RPBA to not admit requests which could have been presented before the first instance). The second option would run contrary to the requirement for procedural efficiency (cf. Article 13(1) RPBA).
- 1.14 Finally, for the sake of completeness, the board considers that claim 1 would likely not satisfy the requirement for an inventive step. The appellant's main argument put forward at the oral proceedings was that neither D3 nor D4 disclosed an execution component separate from the network adaptor, in contrast to the alleged invention, in accordance with which the network adaptor was relieved of this task. The board however notes that claim 1 does not require that the execution

component is separate from the network adaptor.

Hence, the request is prima facie not allowable (cf. point 1.2 above).

1.15 For the above reasons, the board decided not to admit the main and sole request.

2. Conclusion

As there is no admissible request, it follows that the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated