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**Datasheet for the decision  
of 18 September 2017**

**Case Number:** T 1632/14 - 3.5.03

**Application Number:** 08768435.3

**Publication Number:** 2162809

**IPC:** G05B23/02

**Language of the proceedings:** EN

**Title of invention:**

Improved functionality for handheld field maintenance tools

**Applicant:**

Fisher-Rosemount Systems, Inc.

**Headword:**

Field maintenance tool/FISHER-ROSEMOUNT

**Relevant legal provisions:**

EPC Art. 56, 84

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

**Keyword:**

Inventive step - main request (no)

Admissibility - auxiliary requests 1-1 to 1-3 (no)

Clarity - auxiliary requests 1 to 3 (no)

**Decisions cited:**

G 0010/93, T 0361/08, T 0144/09



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Case Number: T 1632/14 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 18 September 2017**

**Appellant:** Fisher-Rosemount Systems, Inc.  
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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 on 24 February 2014 refusing European patent application No. 08768435.3 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** F. van der Voort  
**Members:** A. Madenach  
O. Loizou

## Summary of Facts and Submissions

- I. The present appeal is against the decision of the examining division refusing European patent application No. 08768435.3, published as WO 2008/156665 A2, on the grounds that claim 1 of a main request was not clear (Article 84 EPC) and its subject-matter was not new (Articles 52(1) and 54(1) and (2) EPC); that claim 1 of a first auxiliary request was not clear (Article 84 EPC) and contained added subject-matter (Article 123(2) EPC); and that claim 1 of a second auxiliary request was not clear (Article 84 EPC) and its subject-matter was not new (Articles 52(1) and 54(1) and (2) EPC). A third auxiliary request was not admitted under Rule 137(3) EPC because it contained, *prima facie*, added subject-matter.
  
- II. In the decision, the examining division referred in particular to the following document:  
  
D1: US 2004/0230821 A1.
  
- III. In the statement of grounds of appeal, the appellant requested that the decision be set aside and that a patent be granted on the basis of claims of a main request, or, in the alternative, on the basis of claims of one of first to third auxiliary requests, all requests as filed with the statement of grounds of appeal. As an auxiliary measure, oral proceedings were requested.
  
- IV. In a communication pursuant to Article 15(1) RPBA accompanying a summons to oral proceedings, the board gave its preliminary opinion.

V. With a letter dated 18 August 2017, the appellant confirmed the previous requests and submitted additional auxiliary requests 1-1, 1-2 and 1-3.

VI. Oral proceedings were held on 18 September 2017.

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 with its statement of grounds of appeal, or, in the alternative, on the basis of the claims of one of auxiliary requests 1-1, 1-2 and 1-3 as filed with the letter dated 18 August 2017, or one of the first to third auxiliary requests as filed with the statement of grounds of appeal.

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

VII. Claim 1 of the main request reads as follows:

"A method of expanding functionality of a handheld field maintenance tool (22), the method comprising:  
coupling (152) the tool (22) for communication;  
uploading (156) tool information from the tool through the communication coupling, the tool information including licensing information (162) including information about a hardware module and configured to allow the tool (22) to selectively enable only a portion of functionality relative to the hardware module otherwise fully enabled;  
comparing the tool information to currently available functionality information stored in a database;  
displaying available additional functionality to a user based upon the comparison;

receiving a user selection relative to available additional functionality, wherein the user selection is used to provide a display to the user relative to a manufacturer part number and pricing of the selected additional functionality and wherein an order is placed to a manufacturer using the manufacturer part number and pricing;

wherein a server (104) is updated based upon the order, and a notification is sent to the user; and

wherein the additional functionality is downloaded to the tool after reception of the notification."

Claim 1 of auxiliary request 1-1 includes, compared with claim 1 of the main request, the following modified feature (underlining by the board):

"displaying available additional functionality and a price information to a user based upon the comparison".

Claim 1 of auxiliary request 1-2 includes, compared with claim 1 of the main request, the following modified feature (underlining by the board):

"coupling (152) the tool (22) to a computer (100) such that the tool (22) can upload information to the computer over a connection for communication".

Claim 1 of auxiliary request 1-3 includes, compared with claim 1 of the main request, the following modified feature (underlining by the board):

"A method of expanding functionality of a handheld field maintenance tool (22) having at least two media access units (32, 34) each being configured to communicate in accordance with a process industry standard protocol, the method comprising:".

Claim 1 of auxiliary request 1 includes, compared with claim 1 of the main request, the following additional feature:

"wherein various requirements for the licensing information are dynamically enforced".

Claim 1 of auxiliary request 2 reads as follows:

"A method of expanding functionality of a handheld field maintenance tool (22), the method comprising:  
coupling (152) the tool (22) for communication;  
uploading (156) tool information from the tool through the communication coupling, the tool information including licensing information (162) including information about a hardware module and configured to allow the tool (22) to selectively enable only a portion of functionality relative to the hardware module otherwise fully enabled;  
comparing the tool information to currently available functionality information stored in a database;  
displaying available additional functionality to a user based upon the comparison;  
receiving a user selection of one or more available licenses relative to the available additional functionality,  
once the user indicates that he/she is finished with the selection, enforcing various requirements for the selected licenses,  
displaying to the user manufacturer part number and pricing for the selected licenses;  
placing an order to a manufacturer using the manufacturer part number and pricing; and

updating a server (104) based upon the order, and sending a notification to the user informing the user that the selected licenses are available for the tool."

Claim 1 of auxiliary request 3 includes, compared with claim 1 of auxiliary request 2, the following additional feature:

"downloading the new license information from the server to a memory of the tool".

### **Reasons for the Decision**

1. *Claim 1 of the main request: inventive step (Articles 52(1) and 56 EPC)*

1.1 Document D1 is considered to represent the closest prior art. It relates to a method of authenticating an electronic, removable, non-volatile memory for a handheld field maintenance tool (independent claim 1), and to a method of adding functionality to a handheld field maintenance tool (independent claim 8) and, hence, to a method of expanding the functionality of a handheld field maintenance tool.

This latter method, which is further described in paragraphs [0016] and [0017], can be carried out through an external connection of the tool (paragraph [0017]) and, hence, through a coupling of the maintenance tool for communication. This method requires replacing or modifying an Identification Code file of a particular SD card of the tool. For this to be done, the Identification Code file, which can be considered to constitute tool information, must be uploaded from the tool through the communication coupling to a personal computer or a network (paragraph



[0017], lines 5-9). The tool information to be uploaded must also include licensing information, since the additional functionality is to be licensed (paragraph [0017], first line).

According to paragraph [0016], the handheld tool can be shipped containing all of the hardware and software necessary for various options, with only options purchased by the user being authorised and accordingly enabled. The user can subsequently select which additional functionality he or she would like to add (paragraph [0017]). This implies that information about the hardware module is also uploaded as part of the tool information, and that the tool information is compared to currently available functionality information, e.g. by displaying the two. According to D1, the latter information may be stored in a database (paragraph [0017], lines 11-13).

It is implicit that, for the user to be able to license additional functionality, the available additional functionality is displayed (paragraph [0017], lines 13-16). The user can then select which additional functionality he or she would like to add (paragraph [0017], lines 16-19). This selection is implicitly based on a comparison of the available additional functionality with the installed functionality and receipt of a user selection from available additional functionality.

In D1, a financial exchange is considered (paragraph [0017], lines 17-19). This suggests that the user selection is used to display to the user the pricing of the selected additional functionality. The display of pricing information is thus obvious if there is a financial exchange. Further, pricing information must

also be related to a product to be purchased, i.e. the additional functionality to be licensed. It is obvious to the skilled person that the pricing of the additional functionality to be licensed may be done by using the manufacturer part number as a well-known means of identifying a particular product to be ordered. Any potential order of a licence for the new functionality will then, obviously, be based on the pricing and the manufacturer part number.

The sending to the tool of an Identification Code file based on the SD card software identifier and the newly licensed functionality and created via a new Identification Code file (paragraph [0017], lines 19-25) implies that the personal computer or network, which forms or contains a server, is updated based on the order, that a notification is sent to the user, and that the additional functionality is downloaded to the tool after receipt of the notification.

For the above reasons, the subject-matter of claim 1 is obvious to the skilled person starting from D1 and taking into account common general knowledge (Article 56 EPC).

- 1.2 The appellant argued that D1 disclosed the expansion of functionality of a handheld field maintenance tool only via a new or modified memory card and, hence, did not disclose that a new Identification Code file, implying a new functionality, was downloaded.

The board notes that D1 discloses that an SD card, which is used as an example of an electronic memory device to be placed into a handheld field maintenance device (paragraph [0012]), has a unique, unalterable software identifier (CID) which inhibits in a given

handheld field maintenance device the use of another SD card, onto which the content, including an Identification Code file, of the original SD card has been copied, due to the fact that the Identification Code file is created based on the software identifier (paragraphs [0013] and [0014]). For a valid SD card, the Identification Code file can be read, in order to determine which options of all those the handheld field maintenance device was shipped with were purchased and are to be enabled accordingly (paragraph [0016]).

D1 further discloses that, for licensing additional functionality, the Identification Code file for a particular SD card is replaced or modified. This can be done through an external connection of the handheld field maintenance tool (paragraph [0017]), i.e. without having to use a new electronic memory card. For this to work, the software identifier is passed to an internet database and a new Identification Code file, based on the software identifier received and the newly licensed software functionality, is created and sent to the handheld field maintenance device (paragraph [0017]). The enforcement of a financial exchange, password or some other appropriate means of managing this feature (paragraph [0017]; i.e. the enabling of a new functionality) is understood to relate to the payment process for the extended licence and is not indicative of the new functionality.

The appellant argued in this respect that the skilled person would understand the external connection as mentioned in paragraph [0017] of D1 to be used only for ordering additional functionality. The actual download of the Identification Code file would still be done by replacing the SD card.

The board does not accept this argument. Even if such an interpretation of the relevant paragraph [0017] were possible, it would still at least be plausible for the skilled person to understand this paragraph such that the Identification Code file is downloaded over a network.

- 1.3 The appellant further argued that the skilled person would understand the additional functionality as mentioned in paragraph [0017] and in claim 8 of D1 to be nothing more than a possible upgrade, the installation of which the user can confirm as shown in detail in paragraph [0021] and Figure 2 of D1. Hence, it did not constitute an expansion of functionality with a true user selection as claimed.

The board does not accept this argument. The skilled reader would understand that D1 discloses two distinct methods, namely a method of authenticating an electronic, removable, non-volatile memory for a handheld field maintenance tool (independent claim 1), and a method of adding functionality to a handheld field maintenance tool (independent claim 8), the features of which do not necessarily overlap. In the process of authenticating an electronic, non-volatile memory for a field maintenance device, upgraded software and/or licence information is passed to the field maintenance device (see paragraph [0021]). By contrast, the licensing of additional functionality requires that the maintenance tool is shipped with all the necessary software and hardware (paragraph [0016]) and only the Identification Code file is replaced (paragraph [0017]). In the context of this latter method, the skilled person would not be led to give the term "additional functionality" the restricted meaning of the "software upgrade" performed in the former

method. Instead, he would give it the more general meaning usual in the art.

- 1.4 The appellant further argued that the features "comparing the tool information to currently available functionality information stored in a database" and "displaying available additional functionality to a user based upon the comparison" were distinctly different from the process described in paragraph [0017] of D1.

The board disagrees. According to D1, an "interactive application on a remote device, such as a server, will then display the license identity of the electronic media card. The user can then select which additional functionality he or she would like to add" (paragraph [0017]). This means that tool information in the form of the licence identity is displayed. In order for the user to be able to select additional functionality, a comparison of what is already available and licensed and what may be purchased via a financial exchange and transmitted to the tool must necessarily take place. Otherwise, the user would not know which options for the tool were available.

- 1.5 Similarly, the appellant further argued with reference to Figure 2 of D1 that, in block 116, the users were only able to confirm an upgrade, but not to select functionality.

The board does not accept this argument, noting again that D1 discloses two different methods. The appellant's argument is based on Figure 2, which illustrates the method of authenticating an electronic, removable, non-volatile memory in a handheld field maintenance tool (cf. paragraph [0019]). The above

inventive-step objection, by contrast, is based on the method of adding functionality, which is essentially described in paragraph [0017].

- 1.6 The board concludes that, since the subject-matter of claim 1 of the main request does not involve an inventive step (Articles 52(1) and 56 EPC), the main request is not allowable.
2. *Auxiliary requests 1-1 to 1-3: admissibility (Articles 12(4) and 13(1) RPBA)*
  - 2.1 Auxiliary requests 1-1 to 1-3 were submitted with the letter dated 18 August 2017 in response to preliminary objections of the board under Articles 84 and 123(2) EPC to claim 1 of auxiliary requests 1 to 3.
  - 2.2 Since, in the present case, the auxiliary requests were filed one month before the oral proceedings before the board, they constitute an amendment to the appellant's case within the meaning of Article 13(1) RPBA. In accordance with that article, 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.
  - 2.3 With respect to claim 1 of auxiliary requests 1-1 and 1-2, the board notes that the additional features compared with claim 1 of the main request, i.e. "displaying ... a price information" and "coupling the tool to a computer such that the tool can upload information to the computer over a connection" respectively, do not, *prima facie*, overcome the inventive-step objection in respect of claim 1 of the main request. According to D1, a financial exchange takes place (paragraph [0017], lines 17-19), implying

or at least suggesting the display of price information. Further, according to D1, the tool may be connected to a personal computer. The software identifier and the licence information are to be passed to the internet database (paragraph [0017], lines 6-13), which the skilled person would understand to be accessed via the personal computer or, alternatively, directly. Hence, information needs to be uploaded to the computer.

During the oral proceedings, the appellant did not submit further arguments in support of the admissibility of auxiliary requests 1-1 and 1-2.

- 2.4 Exercising its discretion according to Article 13(1) RPBA, the board therefore did not admit auxiliary requests 1-1 and 1-2 into the appeal proceedings.
- 2.5 With respect to claim 1 of auxiliary request 1-3, the board considers it appropriate, in exercising its discretion under Article 13(1) RPBA, to take into account Article 12(4) RPBA, following T 361/08 (Reasons for the Decision, point 13) and T 144/09 (Reasons for the Decision, point 1.17).
- 2.6 The board notes that the additional feature in claim 1 of auxiliary request 1-3 compared with claim 1 of the main request concerns two media access units configured to communicate in accordance with a process industry standard. This feature relates to the technical problem of enabling a field maintenance tool to flexibly communicate with various field buses. This problem was neither mentioned in the original application nor was any feature relating to this aspect included in the independent claims. Further, it is entirely different from the technical problem addressed by the subject-

matter claimed so far, which relates to updating and upgrading field maintenance tools (page 4, lines 3-8 of the application). Consequently, the amendments according to claim 1 of auxiliary request 1-3 result in an entirely fresh case being presented. It is established case law that *ex parte* proceedings before the boards of appeal are primarily concerned with examining the contested decision (G 10/93, OJ EPO 1995, 172, points 3 and 4 of the Reasons). The appeal proceedings are intended to review the correctness of the first-instance decision rather than to continue examination by other means.

The appellant pointed out with reference to Figures 6 and 9 and the accompanying description that it was an explicit part of the application that communication with two different field buses was described as a possible upgrade to a field maintenance tool. That is correct. However, the board notes that the feature in question relates to a property of the field maintenance tool, the functionality of which is to be expanded, whereas the example in Figures 6 and 9 relates to the method of expansion and is, thus, more restrictive.

2.7 It follows that auxiliary request 1-3 could, and indeed should, have been filed during the examination procedure if the appellant intended to pursue the claimed subject-matter for the application at issue in the present case. Exercising its discretion according to Article 12(4) RPBA to hold requests which could have been presented in the first-instance proceedings inadmissible, the board therefore did not admit this request into the appeal proceedings.

3. *Claim 1 of auxiliary requests 1 to 3: clarity (Article 84 EPC)*



3.1 Claim 1 of auxiliary requests 1 to 3 includes the feature "wherein various requirements for the licensing information are dynamically enforced" (claim 1 of auxiliary request 1) or "enforcing various requirements for the selected licenses" (claim 1 of auxiliary requests 2 and 3).

3.2 The terms "requirements" and "enforce" are unclear because they have no commonly understood meaning in the art.

More specifically, the nature of the "requirements" is unclear. Requirements might be, for example, technical, financial or social. Further, it is not clear on which entity or entities these "requirements" are imposed. In the present context, the requirements might apply, for example, to the user, to the field maintenance device, to the additional functionality, to the pricing, to the part number, or to any combination thereof.

Given the undefined nature of these two terms, claim 1 of auxiliary requests 1 to 3 does not clearly define the matter for which protection is sought (Article 84 EPC).

3.3 The appellant argued with reference to the example described on page 16, line 25, to page 17, line 3 of the application that "requirements" should be understood in such a way that licences might entail compulsory elements or mutually incompatible elements which would "enforce" the user to select such further compulsory elements or to deselect such incompatible elements in order for the licence to become valid. The board accepts that this is a valid example of how the terms "requirements" and "enforce" could be understood.

This specific example does not, however, exclude various other, more general interpretations of the claim.

3.4 Since, for the above reasons, claim 1 of auxiliary requests 1 to 3 is unclear (Article 84 EPC), none of these requests is allowable.

4. Since none of the requests is allowable, the appeal is to be dismissed.

### **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



L. Stridde

F. van der Voort

Decision electronically authenticated