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**Datasheet for the decision
of 12 October 2020**

Case Number: T 1360/16 - 3.4.03

Application Number: 10736923.3

Publication Number: 2454709

IPC: G06Q10/08, G06Q50/22, B65G1/00

Language of the proceedings: EN

Title of invention:
PORTABLE INVENTORY TRACKING SYSTEM

Applicant:
CareFusion 303, Inc.

Headword:

Relevant legal provisions:
EPC Art. 56
EPC R. 43(1)

Keyword:
Inventive step - (yes)

Decisions cited:

Catchword:



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Case Number: T 1360/16 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 12 October 2020

Appellant: CareFusion 303, Inc.
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San Diego, CA 92130 (US)

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 March 2016
refusing European patent application No.
10736923.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: A. Böhm-Pélissier
G. Decker

Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division to refuse European patent application No. 10 736 923. The refusal was based on the ground of lack of novelty (Article 54(1) EPC) and unallowed amendments (Article 123(2) EPC).
- II. Reference is made to the following documents:

D1 = US 2004/0 207 512 A
D5 = US 7 463 947 B
- III. In its decision, the Examination Division held that the subject-matter of the independent claims was not novel over D1 within the meaning of Articles 52(1) and 54(2) EPC.
- IV. The Appellant argued that D1 did not provide any useful teaching for solving the problem. D1 sought to reduce the number of pick/put to light (PTL) devices that are required in a warehouse and thus addressed a different problem from that addressed by the present invention. The solution of D1 was completely different from the present solution.
- V. In its preliminary opinion expressed in a communication under Rule 100(2) EPC the Board concluded that the amended Main Request as filed with the statement of grounds of appeal met the requirements of Article 56 EPC. D5 was considered as closest prior art. The Appellant was requested to amend the description.

VI. In reply to the preliminary opinion the Appellant filed an amended description with letter dated 19 August 2020.

VII. The Appellant requests that the decision under appeal be set aside and that a patent be granted in the following version:

Description: Pages 1 to 14 as filed with letter dated 19 August 2020;

Claims: Nos. 1 to 14 as filed with letter dated 9 May 2016;

Drawings: Sheets 1/9 to 9/9 as published.

VIII. **Claim 1** reads (Board's labelling):

(A) A system for tracking the quantity of an item comprising:

(B) a portable terminal (410) placed inside a first container (510) together with the quantity of the item,
(C) the portable terminal configured to provide an actuation indication in response to a change in the quantity of the item in the first container (510), and comprising:

(D) a unique identifier associated with the portable terminal (410);

(E) an input device (412) configured to be actuated to indicate the change in the quantity of the item in the first container (510); and

(F) a transceiver (440) configured to transmit the actuation indication to a client (430);

(G) the client (430), configured to receive the actuation indication from the portable terminal (410) with a transceiver (450) and to update the quantity of the item based on an association information stored in a memory of the client (430) when the item is packaged for delivery,

(H) the association information comprising the unique identifier to associate the portable terminal with the item; and

(I) a cabinet (500) comprising: the first container (510) configured to store the item;

(J) and a controller (506) configured to change a value indicating a quantity of the item based on the information transmitted from the client (430),

(K) wherein the controller is further configured to update a location record of the item associated with the portable terminal when the portable terminal (410) is moved from the first container (510) to a second container (520).

IX. **Claim 10** reads (Board's labelling analogous to the labelling of claim 1):

(A') A method for tracking the quantity of an item comprising:

(C') receiving an actuation indication from a portable terminal (410) (B') placed inside a first container (510) (I') in a cabinet (500);

(E') associating, (F') in a remote client (430), the actuation indication with a change in the quantity of the item in the first container (510) (G') based on an association information stored in a memory of the client (430) when the item is packaged for delivery prior to storage in the first container (510),

(H') the association information associating the portable terminal with the item using (D') a unique identifier associated with the portable terminal (410);

(J') (K') receiving a second actuation indication from the portable terminal (410) placed inside a second container (520) in the cabinet (500); and updating, in the remote client (430), the quantity of the item and a location record of the item associated with the portable terminal from the first container (510) to the

second container (520) in response to the second actuation indication.

Reasons for the Decision

1. Admissibility

The appeal is admissible.

2. Amendments

- 2.1 **Claim 1** has been amended to recite (underlining of additions, striking-through of deletions with respect to the claim as originally filed) "a portable terminal placed inside a first container together with the quantity of the item" and "to provide an actuation indication in response to a change in the quantity of the item". Furthermore, it was specified that the "transceiver (440) [is] configured to transmit the information indicating actuation indication to a client (430); the change in client (430), configured to receive the actuation indication from the portable terminal (410) with a transceiver (450) and to update the quantity of the item; based on an association information stored in a memory of the client, configured (430) when the item is packaged for delivery, the association information comprising the unique identifier to associate the portable terminal with the item based on the unique identifier, comprising a transceiver configured to receive the information indicating the change in the quantity of the item from the portable terminal, and transmit the information".

- 2.2 Furthermore, it was added that "the controller is further configured to update a location record of the item associated with the portable terminal when the portable terminal (410) is moved from the first container (510) to a second container (520)".
- 2.3 These amendments are based, for example, on page 7, lines 1 to 9, page 7 last paragraph, page 8 first paragraph, the paragraph bridging pages 8 and 9, and page 9, lines 15 to 22 of the originally filed application. The Board is of the opinion that the amendments fulfil the requirements of Article 123(2) EPC.
- 2.4 **Claim 10** is a method claim based on original claim 12 that mirrors the technical features of claim 1 and has been amended accordingly. **Dependent claims** 2 to 9 and 11 to 14 correspond to original claims 2 to 9 and 12 to 16, respectively, and have been amended for consistency with independent claims 1 and 10.
- 2.5 In the **description** D1 and D5 were acknowledged and discussed. Furthermore, the description was adapted to the amended claims.

3. The invention as claimed

- 3.1 In hospitals so-called medical cabinets provide a centralised distribution point of medicines and supplies to patients. The cabinets are frequently automated supply dispensing stations as described in D5.
- 3.2 These automated cabinets include a hard-wired user interface connected to the station in order to track

quantities of supplies within the station/cabinet. The cabinet may include return buttons and take buttons indicating to the cabinet's computer system the removal or addition of an item from an inventory. These buttons require multiple manual interactions by a user.

3.3 When a user wants to reorganise the items in the cabinet or add a different item it usually requires a great number of steps that include requiring the user to disassociate an item from a pair of buttons and then re-associate the item with another pair of buttons.

3.4 In order to overcome these drawbacks and to provide more flexibility and reliability while preventing abuse of drugs, the present invention provides mobile, e.g. wireless, terminals that can be moved quickly from one container in a cabinet to another container, and subsequently, be associated and/or disassociated with a supply of items in the container. The mobile terminals transmit information indicating changes in quantity of the supply of the items and assist the cabinet's controller in determining the location of the items.

4. Inventive step - Article 56 EPC

4.1 Closest prior art

The amended claims now clearly define that the portable device is placed inside the container. D1 discloses a portable device which is foreseen to be placed outside a container in or on a storage shelf of a warehouse (see Figure 4). D5 discloses as only piece of prior art a device recording the content of a container and being placed inside a cabinet and inside the frame of a container. Therefore, D5 is now considered as closest

prior art. D5 was considered to be the closest prior art in the international phase.

4.2 D5

- 4.2.1 D5 discloses a cabinet (878 in Fig. 4) with trays (922 in Fig. 6). The trays are containers which are placed inside the cabinet and comprise a terminal (948 in Fig. 5). The terminal is integrated into the frame of the tray. Since the tray can be considered portable by a human, the terminal can also be considered portable. The terminal is integrated into the frame of the tray/container; it is therefore "placed in the container material", but not "placed inside the container".
- 4.2.2 The portable terminal is configured to provide an actuation indication in response to a change in the quantity of the item in the first container (Fig. 19, column 18, lines 3ff).
- 4.2.3 The terminal is part of a LAN network. Hence, it implicitly needs to have a LAN network address and therefore has a unique identifier.
- 4.2.4 D5 further discloses a transceiver (LAN network) configured to transmit the actuation indication to a client (nursing computer 846, terminal computer 880, but also pharmacy computer 854, central server 860 etc.). The client (880, 846) is configured to receive the actuation indication from the portable terminal with a transceiver (LAN) and to update the quantity of the item based on an association information stored in a memory of the client when the item is packaged for delivery (Fig. 19, column 18, lines 21ff.)

4.3 Difference

4.3.1 D5 therefore discloses in Figs. 1, 4-5 (column 6, line 38 to column 10, line 34), Fig. 19 (column 18, lines 3 to 25) Features (A) and (C) to (J). D5 does not disclose that the portable terminal is placed inside the container.

4.3.2 D5 therefore does not disclose Features (B) and (K):

- (B) a portable terminal is placed inside a first container together with the quantity of the item, i.e. the terminal of D5 is separable from the tray.
- (K) the controller is further configured to update a location record of the item associated with the portable terminal when the portable terminal is moved from the first container to a second container.

4.4 Effect

The differing technical features provide the effect of a better and more efficient administration of the products by linking the terminal to the product and not to the container. This results in greater flexibility and - if the system is used correctly - higher reliability by providing better control of medication.

4.5 Problem

The problem to be solved therefore can be considered as improving flexibility, efficiency and reliability.

4.6 Obviousness

- 4.6.1 This problem is solved by features (B) and (K). In this way control over a product is maintained without need for multiple steps of reprogramming the keypad.
- 4.6.2 D5 itself does not provide any teaching of linking a portable device to a product and to separate the terminal from the tray. When the product in D5 is moved or relocated, any association between the product and the tray/container is lost. D5 is silent as to what should be done to maintain or update this association. The tray to which the product is relocated has to be reprogrammed manually.
- 4.6.3 The Board agrees with the Appellant that also D1 does not provide any useful teaching for solving the problem. D1 describes an inventory control system using a pick/put to light (PTL) device to direct an operator's attention to a particular location in a warehouse to indicate when a location needs to be serviced.
- 4.6.4 The Appellant argued that D1 sought to reduce the number of PTL devices that are required in a warehouse by use of an image display so that a single PTD device (Pick/Put To Display device) could cover multiple locations by having the image display indicate which of these locations needed servicing. This was a different problem from that addressed by the present invention and the solution of D1 was completely different from the present solution.

In D1 the location of the PTD device was not indicative of the location of the stored item. When in D1 the PTD was moved, or the item was relocated, any association

between the two was lost. Further, D1 was silent as to what, if anything, could be done to maintain or update said association.

- 4.6.5 The Board agrees with this reasoning. In addition, for transforming the terminal of D5 into a mobile device the skilled person would have to undertake major modifications of the system of D5.
- 4.6.6 However, the skilled person does not have any incentive to modify the system of D5 so as to arrive at the claimed invention, because the gist of D5 is that the mobile device is associated with a particular tray. Modifications aiming at associating the mobile device with the product would be contrary to the complete teaching of D5.
- 4.6.7 The Board is of the opinion that D1 and D5, in view of the different concepts disclosed therein, do not provide a useful hint towards "a portable terminal placed inside a first container together with the quantity of the item". Consequently, neither D1 nor D5 can provide any useful teaching as to Feature (B). Nothing in D1, D5 or any other cited document therefore suggests feature (K).
- 4.6.8 Consequently, none of these documents teaches that the portable terminal is separable from the tray and that the controller is further configured to update a location record of the item associated with the portable terminal when the portable terminal is moved from the first container to a second container.
- 4.6.9 The Examining Division also gave its opinion on proposed amendments specifying that a portable terminal would be placed inside a container. It was considered

that such an amendment might establish a difference over the disclosure of D1 but that this difference did not seem to be inventive. However, as discussed above, none of the cited closest prior art, and in particular neither D1 nor D5, discloses or suggests Feature (K).

4.6.10 **To summarise**, the Board is satisfied that the subject-matter of claim 1 involves an inventive step within the meaning of Article 56 EPC.

4.6.11 Claim 10 comprises similar features in terms of a method (see labelling in section VIII above). The Board is therefore of the opinion that the subject-matter of claim 10 also involves an inventive step within the meaning of Article 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to grant a patent in the following version:

Description: Pages 1 to 14 as filed with the letter dated 19 August 2020;

Claims: Nos. 1 to 14 as filed with the letter dated 9 May 2016;

Drawings: Sheets 1/9 to 9/9 as published.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated