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**Datasheet for the decision
of 12 July 2022**

Case Number: T 1183/19 - 3.4.02

Application Number: 05775614.0

Publication Number: 2079983

IPC: G01B13/14

Language of the proceedings: EN

Title of invention:

METHOD AND APPARATUS FOR PREPARING AN ITEM WITH AN RFID TAG

Applicant:

Omnicell, Inc.

Headword:

Relevant legal provisions:

EPC Art. 84

RPBA 2020 Art. 13(1), 13(2)

Keyword:

Claims - clarity - main request (no)

Amendment to appeal case - exercise of discretion - amendment
overcomes issues raised (no)

Decisions cited:

T 0989/15, T 0954/17

Catchword:



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Case Number: T 1183/19 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 12 July 2022

Appellant: Omnicell, Inc.
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Mountain View, CA 94043 (US)

Representative: Evens, Paul Jonathan
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 26 November
2018 refusing European patent application No.
05775614.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman T. Karamanli
Members: H. von Gronau
F. J. Narganes-Quijano

Summary of Facts and Submissions

I. The applicant's appeal is directed against the decision of the examining division to refuse European patent application No. 05775614.0. The examining division refused the application on the grounds that the subject-matter of claim 1 of the then main request was considered not to be new or not to involve an inventive step. Claim 1 of the then auxiliary request was considered not to be clear, and its subject-matter was considered not to involve an inventive step.

II. With the statement of grounds of appeal, claims according to a main request and an auxiliary request were filed. The appellant stated that the grounds of appeal were based on these claims and that they were the same as those considered by the examining division in the decision under appeal (see statement of grounds of appeal, page 1, second paragraph).

As an auxiliary measure, oral proceedings were requested.

III. In a communication under Article 15(1) RPBA 2020 annexed to the summons to oral proceedings issued on 8 October 2021, the board expressed its provisional opinion that, *inter alia*, the subject-matter of claim 1 of the main request was not new and that claim 1 of the auxiliary request was not clear and that its subject-matter did not involve an inventive step.

IV. By letter dated 10 June 2022, the appellant withdrew its main request so that its previous auxiliary request became its sole request, and it re-filed the claims of

the previous auxiliary request as the claims of the sole request.

- V. Oral proceedings before the board took place on 12 July 2022.

During the oral proceedings, the appellant filed amended claims according to a first and second auxiliary request.

The appellant's final requests were as follows.

The appellant requested that the decision under appeal be set aside and that a European patent be granted on the basis of the claims of the main request filed as the sole request by letter dated 10 June 2022 or, alternatively, on the basis of the claims of the first or second auxiliary request filed at the oral proceedings on 12 July 2022.

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

- VI. Claim 1 of the main request as filed by letter dated 10 June 2022 reads as follows:

"A method for tracking, monitoring, protecting and safeguarding an inventory of products in a medical environment, comprising:
adding an RFID tag (23) to each product (22) in the inventory of products by:
affixing the RFID tag (23) to the respective product (22), the RFID tag (23) having tag identification information, wherein when the RFID tag is affixed to the respective product, no association exists between the tag information and product information;

reading the tag identification information from the RFID tag (23) with an RFID scanner;
reading product information from the respective product (22) using a bar code reading system (27);
associating the tag identification information from the RFID tag (23) with the product information using a computer (29) with an associated database; and
storing an association between the product information and the tag identification information from the RFID tag (23) in the database;
providing an RFID cabinet having RFID reading capability; and
using each product with the RFID tag added in conjunction with the RFID cabinet."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the last feature of claim 1 of the main request reading "using each product with the RFID tag added in conjunction with the RFID cabinet" is replaced by the feature "using the RFID tag applied to each product in conjunction with the RFID cabinet to provide tracking, monitoring, protecting and safeguarding of the inventory of products".

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in the insertion of the feature "providing an alarming and alerting capability;" immediately after the penultimate feature of the claim reading "providing an RFID cabinet having RFID reading capability;".

Reasons for the Decision

1. The appeal is admissible.

2. Main request - claim 1 - clarity (Article 84 EPC)
- 2.1 The examining division was of the opinion that claim 1 was not clear (see contested decision, sections 28 and 29 on page 11).
- 2.2 The appellant was of the opinion that the subject-matter of claim 1 was clear because the skilled person would readily understand that an RFID cabinet was a secure storage unit with RFID reading capabilities for determining whether RFID-tagged items were stored in the cabinet, for example, as described in the applicant's co-pending application WO 2006/014813 (see grounds of appeal, page 3, section "Article 84 EPC - Clarity"). The method of claim 1 related to tracking, monitoring, protecting and safeguarding an inventory of products. According to the claim, a specific RFID tag was attached to and associated with a specific product in the inventory of products in a database, an RFID cabinet having RFID reading capability was provided, and each product with the RFID tag added was used in conjunction with the RFID cabinet. By analogy with similar terms such as "gun cabinet", the skilled person understood that an RFID cabinet used in tracking, monitoring, protecting and safeguarding an inventory of products was a secure unit which provided controlled access to cabinet contents, in this case, RFID-tagged products. Furthermore, in the context of tracking, monitoring, protecting and safeguarding the inventory of products, it would be implicit to the skilled person (e.g. from the fact that each product with the RFID tag added was used in conjunction with the RFID cabinet) that the RFID reading capability of the RFID cabinet was used to determine which RFID-tagged products were in the RFID cabinet (see letter dated 10 June 2022, section 6). During the oral proceedings before the

board, the appellant referred to the Guidelines for Examination, part F, chapter IV, section 4.13.3, in the version of March 2022, and argued that the feature "method for tracking, monitoring, protecting and safeguarding an inventory of products" in claim 1 had to be understood as a method of tracking, monitoring, protecting and safeguarding an inventory of products which implied, in the context of a method, additional steps not implied by or inherent in the other remaining steps defined in the claim and without which the claimed process would not achieve the stated purpose. Therefore, the claimed method comprised implicitly additional functional features defining how each product with the RFID tag was used in conjunction with the RFID cabinet. For a person skilled in the art, it was thus clear that the RFID tag of each product was read by the reader of the cabinet when entering or leaving the RFID cabinet so that tracking and monitoring of the products was implemented. It was clear from the description on page 1, paragraphs [0003] to [0005], that the claimed method provided a cost-effective way to safely dispense products from a storage location by reading RFID tags entering or leaving the cabinet. It was not necessary to specify further details of the method. Therefore, the claim was broad but clear.

- 2.3 The board does not share the appellant's opinion. The last feature of the claim that defines "using each product with the RFID tag added in conjunction with the RFID cabinet" does not define how products could be used in conjunction with an RFID cabinet and what happens with the products when they are used. It is also not defined whether the tag identification data is read from the RFID tag and, if this happens, when it is read and how the read information is used. It is not

clear how the purpose (for tracking, monitoring, protecting and safeguarding an inventory of products in a medical environment) can be achieved by using the products in conjunction with the RFID cabinet. In addition, even if the claim is construed as encompassing the functional feature of tracking, monitoring, protecting and safeguarding an inventory of products in a medical environment as submitted by the appellant, the claim wording is still not clear. In this case, the functional feature of tracking, monitoring, protecting and safeguarding an inventory of products in a medical environment would add the general step of tracking, monitoring, protecting and safeguarding to the claimed method, but it would not clarify how the products could be used in conjunction with the RFID cabinet, what would happen with the products when they are used, and when and where the tag identification data would be read from the RFID tag in relation to the RFID cabinet. The appellant's assumption that the RFID tags on the products are read when the product is placed in the cabinet and removed from it cannot be inferred from the wording of the claim. Therefore, the claim remains unclear even assuming that the method implicitly includes the tracking, monitoring, protecting and safeguarding steps.

- 2.4 The board therefore concludes that claim 1 of the main request does not meet the requirements of Article 84 EPC.
- 3. First auxiliary request - admittance (Article 13(2) RPBA 2020)
 - 3.1 In the case in hand, the summons to oral proceedings was notified after the date on which RPBA 2020 entered

into force, i.e. 1 January 2020 (Article 24(1) RPBA 2020). Thus, in accordance with Article 25(1) and (3) RPBA 2020, Article 13(2) RPBA 2020 applies to whether to admit the appellant's first auxiliary request, which was filed after notification of the summons to oral proceedings and is therefore an amendment within the meaning of Article 13(2) RPBA 2020.

Where an amendment is made to a party's appeal case at this advanced stage of the proceedings, Article 13(2) RPBA 2020 stipulates that it will, in principle, not be taken into account unless the party concerned has shown cogent reasons why the circumstances are exceptional. If such circumstances are shown to exist, the board may, in exercising its discretion, admit an amendment made to the appeal case at this advanced stage of the proceedings (see document CA/3/19, section VI, explanatory remarks on Article 13(2), third paragraph, last sentence).

The explanatory remarks on Article 13(2) RPBA 2020 also contain the following guidance: "At the third level of the convergent approach, the Board may also rely on criteria applicable at the second level of the convergent approach, i.e. as set out in proposed new paragraph 1 of Article 13" (document CA/3/19, section VI, explanatory remarks on Article 13(2), fourth paragraph). The board takes the view that, at the third level of the convergent approach, the boards of appeal are free to use or not use the criteria set out in Article 13(1) RPBA 2020 when deciding, in exercising their discretion in accordance with Article 13(2) RPBA 2020, whether to admit an amendment made at this stage of the proceedings (see also decisions T 989/15, point 16.2 of the Reasons and T 954/17, point 3.10 of the

Reasons).

- 3.2 The last feature of claim 1 of the first auxiliary request was amended to read: "using the RFID tag applied to each product in conjunction with the RFID cabinet to provide tracking, monitoring, protecting and safeguarding of the inventory of products".
- 3.3 The appellant argued that it was not clear to the appellant that in a method claim the definition "method for tracking, monitoring, protecting and safeguarding an inventory of products in a medical environment" could only be regarded as a method suitable for and not as a method of tracking, monitoring, protecting and safeguarding an inventory of products in a medical environment. The appellant had learned only during the oral proceedings in the discussion on claim 1 of the main request that the board construed the claimed method as a method suitable for tracking, monitoring, protecting and safeguarding an inventory of products. This view of the board, which was surprising for the appellant, constituted an exceptional circumstance within the meaning of Article 13(2) RPBA 2020, justifying the filing of the first auxiliary request. In the grounds of appeal, the appellant had pointed out that claim 1 was directed to a method "of tracking, monitoring, protecting and safeguarding an inventory of products in a medical environment". Therefore, the appellant's view was not a new issue raised for the first time during the oral proceedings before the board. Furthermore, basis for the amended wording could be found in paragraph [0007] of the published application, and the amended wording overcame the clarity objection raised by the board. The amended language clarified that the method of tracking, monitoring, protecting and safeguarding an inventory of

products used RFID tags in conjunction with the cabinet and the RFID reader. Thus, tags were read as the product moved in and out of the cabinet to update the inventory of products. The monitoring step was clearly done by using the RFID tag in conjunction with the cabinet. Therefore, the claim was broad but clear.

3.4 The board notes that it was not until the oral proceedings that the feature "method for tracking, monitoring, protecting and safeguarding an inventory of products" in claim 1 of the main request was discussed and that the board informed the appellant that it considered this feature to be a method only suitable for tracking, monitoring, protecting and safeguarding an inventory of products. According to the appellant, this constituted an exceptional circumstance within the meaning of Article 13(2) RPBA 2020 which justified taking the first auxiliary request into account. The board accepts the appellant's argument that the board's arguments when discussing the clarity of claim 1 of the main auxiliary request at the oral proceedings present an exceptional circumstance within the meaning of Article 13(2) RPBA 2020. Under these circumstances, the board considers it justified to exercise its discretion under Article 13(2) RPBA 2020, taking into account the criteria set out in Article 13(1) RPBA 2020.

3.5 Under Article 13(1) RPBA 2020, when admitting amendments to a party's appeal case, the board exercises its discretion in view of, *inter alia*, the current state of the proceedings, the suitability of the amendment to resolve the issues which were raised by the board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, *prima facie*,

overcomes the issues raised by the board and does not give rise to new objections. However, in the current case, the board cannot see that the clarity objection has been *prima facie* overcome by the amended wording of claim 1 of the first auxiliary request. Although the question of how the products can be used in conjunction with the RFID tag is now no longer an issue, it is still unclear how the RFID tag applied to each product is used in conjunction with the RFID cabinet to provide tracking, monitoring, protecting and safeguarding of the inventory of products. The claim still does not define where and when the tag identification data is read from the RFID tag and how the read information is used to provide tracking, monitoring, protecting and safeguarding of the inventory of products. The appellant's assumption that the RFID tags on the products are read when the products are moved in and out of the cabinet can still not be inferred from the wording of the claim.

3.6 Exercising its discretion under Article 13(2) RPBA 2020 and taking into account the criteria set out in Article 13(1) RPBA 2020, the board therefore decided not to admit the first auxiliary request into the appeal proceedings.

4. Second auxiliary request - admittance (Article 13(2) RPBA 2020)

4.1 The appellant's second auxiliary request was filed after notification of the summons to oral proceedings and is therefore an amendment within the meaning of Article 13(2) RPBA 2020.

Claim 1 of the second auxiliary request comprises in comparison to claim 1 of the first auxiliary request

the additional step of providing an alarming and alerting capability.

- 4.2 The appellant put forward that this step was added to clarify the protecting step by adding the alarming and alerting capability.
- 4.3 The board notes that the considerations set forth in points 3.4 and 3.5 above on the first auxiliary request apply likewise to the second auxiliary request. The additional step in claim 1 of providing an alarming and alerting capability might help to clarify the step of protecting the inventory of products, but the board does not see how this additional feature could *prima facie* clarify the remaining issues still present in claim 1 of the first auxiliary request.
- 4.4 Exercising its discretion under Article 13(2) RPBA 2020 and taking into account the criteria set out in Article 13(1) RPBA 2020, the board therefore decided not to admit the second auxiliary request into the appeal proceedings either.
5. Since the claims of the main request do not meet the requirements of Article 84 EPC and the first and second auxiliary requests are not admitted into the appeal proceedings, none of the appellant's requests is allowable, and the appeal therefore has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



L. Gabor

T. Karamanli

Decision electronically authenticated