

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 25 January 2024**

Case Number: T 1757/20 - 3.5.01

Application Number: 16758004.2

Publication Number: 3345135

IPC: G06Q10/00, G06Q10/08

Language of the proceedings: EN

Title of invention:

METHOD AND SYSTEM FOR TRACKING CONTAINERS

Applicant:

Owens-Brockway Glass Container Inc.

Headword:

Tracking containers/OWENS-BROCKWAY GLASS CONTAINER

Relevant legal provisions:

EPC Art. 56
EPC R. 137(3)

Keyword:

Inventive step - gather the necessary data relating to the filling of a container with the purpose of being able to modify a design of the containers (no - no technical effect)
Substantial procedural violation - discretionary decision of the examining division on amendments (yes - not fully reasoned)

Decisions cited:

T 1234/17, T 1741/08, T 0641/00, T 1389/08, T 1045/18,
T 0309/09



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1757/20 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 25 January 2024

Appellant: Owens-Brockway Glass Container Inc.
(Applicant) One Michael Owens Way
Perrysburg, OH 43551 (US)

Representative: Blumbach · Zinngrebe Patentanwälte PartG mbB
Alexandrastraße 5
65187 Wiesbaden (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 March 2020
refusing European patent application No.
16758004.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: N. Glaser
D. Rogers

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European patent application No. 16758004.2 pursuant to Article 97(2) EPC on the ground of lack of inventive step (Article 56 EPC) with regard to prior art publication D1 (WO 2010/009448), because the features distinguishing claim 1 of the main request from D1 were non-technical constraints with no technical effect other than their automated execution on the claimed system.

Claim 1 of the first auxiliary request was seen as a reformulation of the subject-matter of claim 1 of the main request, but in substance identical, and the same reasons applied.

The second and third auxiliary requests, both filed on 13 December 2019 as tenth and eleventh auxiliary requests and then renumbered, were not admitted by the examining division in the proceedings under Rule 137(3) EPC.

II. In the statement setting out the 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 main request, or first to fifth auxiliary request, filed therewith. Oral proceedings were requested as an auxiliary measure.

III. In the communication accompanying the summons to oral proceedings the Board expressed its preliminary view that it tended to agree with the decision under appeal that the subject-matter of claim 1 according to the

main and first auxiliary request lacked an inventive step over D1 for essentially the same reasons. In regard to the auxiliary requests the Board noted that it tended not to admit the requests under Article 12(6) or respectively Article 12(2) and (4) RPBA.

- IV. The appellant did not respond to the communication and did not file further requests.
- V. Oral proceedings were held as a videoconference on 25 January 2024. The final requests of the appellant were to set aside the decision under appeal and to grant a patent upon the basis of the main request, or upon the basis of the first auxiliary request. Alternatively, the appellant requested that the case be remitted to the examining division and that the appeal fee be reimbursed. Further the appellant requested that the decision under appeal be set aside and that a patent be granted upon the basis of one of the second to fifth auxiliary requests.
- VI. Independent claim 1 of the main request reads as follows (labelling of the steps according to the grounds of appeal):

*"(F1) a method for container manufacturing and design, comprising the steps of:
(F2) designing and manufacturing containers (24) including forming the containers (24) and serializing each of the containers (24) with a unique machine-readable code (26) that is integral to and irremovable from the container (24);
(F3) using the machine-readable codes (26) to store data associated with the containers (24), including at least one of a date of container manufacture, a time of*

container manufacture, production facility data, or container quality data;
(F4) *supplying the containers (24)*
(F5) *to a customer who fills containers;*
(F6) *receiving from the customer, data obtained from readings of the machine-readable codes (26) and*
(F7) *including data relating to the filling of the containers (24); and*
(F8) *using the data received from the customer relating to the filling of the containers as feedback for modifying a design of the containers (24)."*

Claim 1 of the first auxiliary request is based on claim 1 of the main request by replacing feature (F8) with the feature "*modifying a design of the containers (24) using the data received from the customer relating to the filling of the containers as feedback*".

Claim 1 of the second auxiliary request is based on claim 1 of the main request by replacing feature (F8) with the feature "*designing and manufacturing strengthened or lightened containers (24) using the data received from the customer relating to the filling of the containers*".

Claim 1 of the third auxiliary request is based on claim 1 of the main request by replacing feature (F7) with the feature "*including a number of times the container has been filled or refilled by the customer*" and feature (F8) by the feature "*designing and manufacturing strengthened or lightened containers (24) using the number of times the container has been filled or refilled by the customer*".

Claim 1 of the fourth auxiliary request amends claim 1 of the third auxiliary request by specifying that containers are made of "reusable *glass*".

Claim 1 of the fifth auxiliary request amends claim 1 of the fourth auxiliary request by defining the additional feature (F7b) in between features (F7) and (F8) "*comparing the data including the number of times the reusable glass container has been filled or refilled by the customer with data relating to another type of container, data relating to containers of another product brand, or data for containers traveling in a different distribution channel*".

Reasons for the Decision

1. The invention
 - 1.1 The invention relates to tracking and collecting data about reusable containers, see [0001], which are said to be designed and intended to travel repeatedly through an extensive distribution chain, see [0002].
 - 1.2 Data regarding how a particular container travels through the distribution chain is either unavailable or limited, and as such, of little use to the container manufacturer, the initial customer of the container, or to other parties, see [0002].
 - 1.3 The primary purpose of the invention is to track and collect data about containers as they travel through various points in a distribution chain using permanent and unique identifiers for each container, see [0003].
 - 1.4 Paragraph [0060] mentions different usages of the collected data. One usage may be for the manufacturer

as feedback to "learn how a particular container design performs" or as feedback "for modifying the design of a container", which is said to mean to strengthen, lighten or otherwise enhance or optimise container manufacture and/or design with the purpose of a longer lifetime or similar lifetime with reduced weight or increase speed or accuracy in filling. Another usage may be to charge customers for the containers supplied, in particular for implementing different pricing models based on the usage of the containers.

2. Main and first auxiliary request

2.1 D1 operates with recyclable products ("containers"), see [0003], on each of which a scannable identifier is added with the purpose of identifying and tracking a container, see [0027][0028], during its whole product life cycle, from the time of manufacturing, filling, and until they are recycled and reprocessed. A scannable unique identifier ("machine readable code") is added to a product which has two purposes: it visually identifies a product as a recyclable product and it allows the tracking of a product during its life cycle, including manufacturing and filling stages, distribution, retail, recycling and reprocessing, see [0023][0024]. The machine-readable code of a product is read and information about product status and other additional information is entered either manually or automatically, see [0024]. The collected product information is stored in a central database which can be accessed by the different users of a product, see Figure 1 and [0025].

2.2 The invention can operate with "reusable" containers travelling more than once through a more extensive distribution chain, see [0002] of the application.

However, claim 1 does not define such a feature and does not exclude that it works with "recycled" containers. Finally, the Board cannot identify any particular difference between D1 and claim 1 in the handling of containers, depending on whether they are for single or for multiple use.

- 2.3 The appellant alleged that claim 1 differed from D1 by features (F5), (F6) and (F7) which reflect that the claimed containers are "reusable" and that there is a separate manufacturing and filling step, and further by feature (F8). D1 teaches that a container is manufactured and filled by the same entity, as shown in Figure 1.

Feature (F7) should be construed as data which actually refers to the process of filling a container, such as the date/time of filling, the contents, and the number of times a container was filled.

Feature (F8) did not imply that feedback was computed, but that it was received from a customer, as stipulated by feature (F6). Furthermore feature (F8) should not be construed as referring to the mere possibility of using this data, but to its actual usage for modifying a design, which referred to the functional form or shape of it, which related to its performance and determined its lifetime, as described in [0060] of the application.

- 2.4 The Board is not convinced by these arguments. First, there is no particular technical effect, regardless of whether there is a combined step of manufacturing and filling containers, or two separate steps. D1, [0024], speaks in general about the life cycle of a product ("container") with different stages which does not

exclude that these stages happen at the same or at different locations. Second, D1 discloses, see [0025], the collection of various kinds of information about a recyclable product ("container") during its life cycle, such as "bottle information", "shelf life" and the type of material of the product. Third, claim 1 does not define a transmission of data between a location where containers are designed and manufactured and another location where they are used or filled. Data may also be centrally stored in a database which can then be accessed from different locations, as shown in D1, Figure 1. Fourth, Figure 4 gives an example for data which is collected for a product in the form of a bottle filled with water. This example does, however, not limit the term "product" in D1 to "bottled water", in other words to the assumption that a "product" in D1 refers to a container and its content. The unique identifier, see Figure 5, added to a bottle is independent from its content, and, when D1 speaks about recycling a product, it certainly does not refer to a full bottle, but to an empty one. However, Figure 4 may be seen as an example for "data relating to the filling of a container".

The Board concludes that features (F5) to (F7) are known from D1 at the level of generality at which they are claimed.

2.5 As regards feature (F8), this feature defines the general purpose ("modifying a design"), but not how this is achieved and no active technical effect of how the design of a container can be improved is given. A mere data transmission about the filling of a container is not sufficient for acknowledging a technical effect. The present case is comparable to T 1234/17 where the present Board, in a different composition, found that

the provision of a customised design for manufacturing does not alter the abstract nature of the customised design, see reasons, point 3.2. The Board in that case held that manufacturing an item based on a customised design was certainly a technical problem, but the provision of a specification was not sufficient to acknowledge technical character if the specification does not define how the manufacturing process is controlled in order to produce the item, or what components are to be used in the process.

The Board agrees with the examining division that feature (F8) defines a non-technical administrative constraint.

2.6 Irrespective of whether feature (F8) is interpreted as the possibility of using this data or as actual usage of this data, the usage can be interpreted in light of the description of the application in that the manufacturer learns from it and then mentally decides that a design should be changed. This situation is then similar to T 1741/08, reasons, point 2.1.6, which essentially concluded that a chain of effects, from providing information, to its use in a technical process, is broken by the intervention of a user. In other words, a possible final technical effect brought about by the action of a user cannot be used to establish an overall technical effect because it is conditional on the mental activities of the user, which might be a person skilled in the art of container design and manufacture.

2.7 The objective technical problem can be formulated as how to gather the necessary data relating to the filling of a container with the purpose of being able to modify a design of the containers, following the

COMVIK approach (see T 641/00 - *Two identities/COMVIK*, OJ EPO 2003, 352). In this approach, the non-technical features can form part of the problem formulation.

2.8 The Board concludes that claim 1 lacks an inventive step (Article 56 EPC) over D1 in combination with common general knowledge, because the person skilled in the art would adapt D1 to implement the administrative scheme of using data relating to the filling of containers as a feedback for modifying a design of the containers.

2.9 The same reasoning applies to claim 1 of the first auxiliary request which only reformulates feature (F8), but does not add any further technical matter. The amendment may clarify that a container is modified based on feedback, as argued by the appellant, but it still does not define how this is achieved on a technical level. The term "design of containers" is comparable to a sort of "configuration model", which belongs to information modelling, which is, as such, not an invention for the purposes of Article 52(1) EPC, see T 1389/08, reasons, point 2.

3. Second and further auxiliary requests

3.1 The second and third auxiliary requests, both filed on 13 December 2019 as tenth and eleventh auxiliary requests, and then renumbered, were not admitted by the examining division in the proceedings under Rule 137(3) EPC, because they defined the subject-matter in terms of the result to be achieved, see item 21.1 of the impugned decision. The examining division referred to its communication dated 21 November 2019, section 1.1.3, but did not cite any legal provisions which were not met, such as Article 84 EPC.

3.2 The appellant argued that the requests were not admitted for reasons upon which he had no adequate opportunity to express its arguments contrary to Article 113 EPC and requests the reimbursement of the appeal fee.

3.3 The Board agrees with the appellant that a substantial procedural violation occurred, see below.

Late-filing

3.4 The requests were filed on 13 December 2019 within the time limit set out on the cover page of the summons to oral proceedings issued on 2 December 2019 and were therefore filed on time. These oral proceedings were a postponement of previous oral proceedings which had set another time limit. The examining division apparently wanted to maintain the original deadline by writing in the summons the phrase *"As the change of date is not substantial, the applicant and/or their representative should realise that the date set for submissions prior to the oral proceedings remains the same"*. However, the message communicated to the appellant was contradictory and unclear.

3.5 In a telephone conversation, see protocol of 15 January 2020, item 2, the examining division expressed the view that these requests were late-filed, not converging and prima facie did not overcome the objections raised in regard of defining the subject-matter in terms of the result to be achieved, with reference to a previous communication dated 21 November 2018, section 1.1.3.

3.6 During oral proceedings, according to the minutes, the examining division maintained its previous position in regard to the late filing of these requests without a

proper explanation why it considered the arguments of the then applicant not convincing.

- 3.7 In the decision, section 21.1, the examining division seems to have completely changed its mind. There is no reference to *prima facie* non-compliance, because of a alleged late-filing. It would seem that the examining division became aware that it was mistaken to consider these requests as late-filed. Such a mistake could have been easily avoided if the arguments of the then applicant would have been properly assessed and discussed during oral proceedings. As a consequence the examining division applied the wrong legal principle.

Reasons for non-allowability

- 3.8 The reasons given in the decision refer back to the protocol of a telephone conversation dated 21 November 2019 in which the examining division explained its position and mentioned in section 1.1.3 that the computation of feedback data to improve the manufacturing and the design of containers is defined in terms of the result to be achieved. No legal provision is cited. Article 56 EPC is not mentioned.
- 3.9 During oral proceedings, according to the protocol, the examining division considered these requests still not converging and *prima facie* not allowable under Article 56 EPC. The examining division seems to have abandoned its previous position that they were late filed.
- 3.10 In the decision, section 21.1, the examining division seems to have again changed its mind. The reasons for not allowing the two requests was not Article 56 EPC, as discussed during oral proceedings, but that the

subject-matter of these requests is defined in terms of a result to be achieved.

3.11 It is not apparent from the contested decision that the examining division took all relevant factors of the examination procedure into account when exercising its discretion under Rule 137(3) EPC not to admit the requests into the proceedings. The appellant was rather confronted with alternating objections, without proper reasoning. The discretionary decision of the examining division is not fully reasoned and justified.

3.12 An examining division has to take all relevant factors into account when exercising its discretion under Rule 137(3) EPC, see T 1045/18, reasons, point 4. Prima facie allowability is at most one criterion for the admissibility of late-filed amendments which does not apply in the present case. Moreover, discretionary decisions should not be taken arbitrarily and - like all decisions open to appeal - need to be substantiated, see T 309/09, reasons, points 6.1 and 6.3.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The request for the reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated