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Case Number: T 0869/21 - 3.5.01

Application Number: 13842029.4

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Title of invention:
DRUG INSPECTION ASSISTANCE DEVICE AND METHOD

Applicant:
FUJIFILM Toyama Chemical Co., Ltd.

Headword:
Drug inspection assistance device and method/FUJIFILM

Relevant legal provisions:
RPBA 2020 Art. 13(2), 15(1)
EPC Art. 84, 56, 123(2)

Keyword:
Amendment after communication under Art. 15(1) RPBA - cogent reasons (no), exceptional circumstances (no)

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Case Number: T 0869/21 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 12 March 2024

Appellant: (Applicant)	FUJIFILM Toyama Chemical Co., Ltd. 14-1, Kyobashi 2-chome Chuo-ku Tokyo 104-0031 (JP)
Representative:	Klunker IP Patentanwälte PartG mbB Destouchesstraße 68 80796 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 4 February 2021 refusing European patent application No. 13842029.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	L. Falò
Members:	N. Glaser
	L. Basterreix

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division to refuse the European patent application No. 13842029.4 on the grounds of lack of clarity (Article 84 EPC), added subject-matter (Article 123(2) EPC) and lack of inventive step (Article 56 EPC).

II. In the statement setting out the grounds of appeal, the appellant requested that the decision be set aside and that a patent be granted on the basis of a main request or an auxiliary request 1, both filed therewith. Oral proceedings were requested as an auxiliary measure.

III. In a communication accompanying the summons to oral proceedings, the Board set out its preliminary opinion that the subject-matter of claim 1 of the main request was unclear (Article 84 EPC) and did not involve an inventive step (Article 56 EPC). As regards auxiliary request 1, an amended version of the previous third auxiliary request, the amendments to claim 1 were neither explained nor justified by the appellant as required by Article 12(4) RPBA. Furthermore, the subject-matter of claim 1 did not overcome the inventive step objection (Article 56 EPC) and introduced new problems in regard of Article 84 EPC and Article 123(2) EPC.

IV. In a reply, the appellant filed a new main request, maintaining the auxiliary request 1 unchanged, and provided further arguments in favour of inventive step.

V. At the oral proceedings, the appellant filed a new auxiliary request 1 replacing the previous one.

Admissibility of the main and of the auxiliary request was discussed. After due consideration of the appellant's arguments, the Chairman announced the decision.

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

"1. A drug inspection support apparatus (10) for inspecting drugs that are prepared based on prescription information and are packaged in a prescription bag, comprising:

first drug determination means (13) for comparing drug master images from a drug database (15), which stores drug master images of drugs that can be prepared, with a captured image obtained by capturing an image of prepared drugs and determining to which kind of drug each drug present in the captured image corresponds; and

list creation means (18) for creating a list displaying the drug master images of the drugs prepared according to a prescription and drug area images, which are determined to be respective drugs in the captured image, so that positions of the drug master images and the drug area images are aligned with one another,

inspection result determination means (17) for determining whether or not the prepared drugs and the number the prepared drugs match the prescription information based on the prescription information,

wherein the list creation means (18) displays drug area images of which orientations are rotated so that orientations of the drug area images and the drug master images are same, in the list, wherein the list

includes a field for displaying a determination result of the inspection result determination means (17),

wherein either one of a row and a column of the list corresponds to the drug prepared according to the prescription, and the other one of the row and the column corresponds to the prescription bag,

the drug master images of the prepared drugs are arranged side by side in the either one of the row and the column, and

for each prescription bag, a drug area image of each drug included in the captured image is arranged in the row or the column corresponding to the determined drug,

wherein drugs to be taken at each specified dosage time are packaged in the prescription bag,

wherein the drug inspection support apparatus (10) further comprises a comparison target selection means (16) for acquiring drug master images of drugs, which should be prepared and drugs similar to the drugs, which should be prepared from the drug database (15),

wherein the first drug determination means (13) compares the captured image with the drug master images acquired from the drug database (15),

wherein as drug master images of drugs similar to drugs, which should be prepared, the comparison target selection means (16) acquires drug master images of drugs which have features located at a distance within a predetermined threshold value from a position of features of the drug master image of the drugs, which should be prepared in a feature space,

wherein the list creation means (18) is capable of arranging the drug area images, which are rotated, so that the orientation, corresponding to the angle of each drug master image, and the orientation of each drug area image arranged in the list are the same, in the list, and

wherein the list creation means (18) is capable of aligning the drug master images in order according to a difference between a position in the feature space of each of the drug master images and a position in the feature space of the drug area images,

wherein as the features of the drugs, a pattern feature indicating a brightness distribution on the drug surface, an outer shape feature, a size feature indicating the area or the lengths of the long and short axes, and a color feature are used."

VII. Claim 1 of auxiliary request 1 is based on claim 1 of the current main request, thereby deleting several features which were added during the appeal procedure in the appellant's submission of 22 January 2024, notably the three following features : "*inspection result determination means (17) for determining whether or not the prepared drugs and the number of the prepared drugs match the prescription information based on the prescription information", "wherein the list includes a field ... inspection result determination means (17)", "wherein as the features of the drugs ... are used";* as well as the feature "*wherein the list creation means (18) ... in the feature space of the drug area images*" which was added in the version of claim 1 of the main request as submitted with the grounds of appeal.

Reasons for the Decision

1. Admissibility

1.1 The appellant filed a new main request on 22 January 2024 in response to the Board's communication under Article 15(1) RPBA in combination with a summons to oral proceedings and a new auxiliary request 1 during oral proceedings. Previous requests were not maintained.

1.2 The admittance of these requests falls under Article 13(2) RPBA, which sets strict conditions. Article 13(2) RPBA stipulates that "Any amendment to a party's appeal case made [...] after notification of a communication under Article 15(1) RPBA shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned".

1.3 The Board may also rely on the criteria as set out in paragraph 1 of Article 13 and Article 12, paragraphs 4 to 6 RPBA. These criteria include the complexity of the amendment, whether an amendment to a patent application overcomes the objections raised and whether the amendment, *prima facie*, does not give rise to new objections (see Case Law of the Boards of Appeal, 10th edition, V.A.4. New submissions on appeal – case law on the RPBA 2020, in particular 4.5.9 and 4.5.10b)).

2. The main request

2.1 Claim 1 of the main request, which was filed in response to the Board's communication under Article

15(1) RPBA, adds two additional features to claim 1 of the previous main request, namely, a determination of an inspection result and a display as to whether the prepared drugs and their number match the prescription information as part of the list of drug master images and drug area images, and a definition of the features of drugs. The first amendment adds the subject-matter of claim 7 and the second amendment is based on the description, [0048], as filed. Claim 1 also includes the feature concerning an alignment, by the list creation means, of the drug master images based on a difference between a position in the feature space of the drug master images and a position of the drug area images, which was introduced in appeal proceedings with the previous main request.

2.2 The appellant explained that these two amendments were made to render the subject-matter of claim 1 clear in view of the Board's communication, in particular in view of points 5.3 and 5.5. They also pointed out that the feature "*list creation means*" was initially added to claim 1 in appeal proceedings to address the clarity objection under point 12.3 of the impugned decision. The filing of the new main request at this stage of the procedure was justified because it addressed clarity issues which were expressed in the Board's communication for the first time.

2.3 The Board observes that the reasons explaining the lack of clarity of claim 1 in respect of the term "*feature space*" were known to the appellant, as this issue was discussed during oral proceedings before the examining division (see points 14 to 19 of the minutes) and was one of the grounds for refusing the application (see points 12.2, 12.3 of the impugned decision).

Any amendment addressing this objection could and should have been introduced during the proceedings before the examination division. It is noted that the appellant took the opportunity to file three auxiliary requests during oral proceedings before the examining division which were not maintained in appeal proceedings.

2.4 Moreover, the introduction of the feature concerning an alignment of drug master images as regard to a position in the feature space does not address, let alone overcome, the clarity objection raised by the examining division concerning the term "feature space". Also the reasons given by the appellant, namely that this amendment would define how drug master images are arranged based on similarity, do not explain how this amendment could render the term "feature space" clear.

This amendment does therefore not *prima facie* overcome the lack of clarity objection and the Board does not see any exceptional circumstances or cogent reasons which may justify its introduction in the appeal proceedings.

2.5 As regards the features concerning the determination and display of an inspection result, now added to claim 1, this amendment does not *prima facie* overcome the lack of clarity objections raised by the Board, see point 5.3 of the Board's communication under Article 15(1) RPBA. The Board objected, among others, that it was unclear whether one or more drug master images were displayed or whether there was a selection, as supported by and shown in Figure 4 of the application. This is because said feature merely defines a further item to be displayed.

This amendment rather introduces a new clarity problem, because this feature determines whether or not the prepared drugs and the number of the prepared drugs match the prescription information, but does not define how the "*number of the prepared drugs*" should be determined.

2.6 In view of the above, the Board decided not to admit the main request in the appeal proceedings under Article 13(2) RPBA.

3. Auxiliary request 1

3.1 Claim 1 of auxiliary request 1 corresponds to claim 1 of the refused main request with linguistic reformulations. It is a generalisation of claim 1 of the present main request, but also of the main request submitted with the grounds of appeal, because it omits the features which were added during appeal proceedings (see point VII above).

3.2 The appellant explained that the filing of this request was a reaction to better address points 12.2 and 12.3 of the impugned decision. They had moreover interpreted point 4.5 of the Board's communication under Article 15(1) RPBA, regarding the feature "*list creation means (18)*" of claim 1, in a different way, and only with the detailed explanations given during oral proceedings the Board's objections became clear. It was therefore thought that deleting this feature would clarify the claimed subject-matter.

3.3 The Board observes that the appellant filed auxiliary request 1 at the latest possible time, namely during oral proceedings and after the (even more specific) main request had been discussed, while they had ample

opportunity to file this auxiliary request after having received the Board's communication under Article 15(1) RPBA, issued more than four months before the date of oral proceedings.

3.4 Moreover, when filing the statement of the grounds of appeal the appellant decided to abandon its previous requests and, instead, directed its appeal to more specific requests. In the Board's view, neither the Board's subsequent clarity objections, nor the alleged misunderstanding of these objections by the appellant can be considered as exceptional circumstances under Article 13(2) RPBA which may justify the filing of a more general request and, thereby, the reintroduction of abandoned subject matter.

3.5 Finally, the Board is of the opinion that the communication under Article 15(1) RPBA, point 4.5, was sufficiently clear in that it expressed the Board's preliminary opinion that the amendments introduced on appeal were not sufficiently motivated. Furthermore, the Board found that additional clarity problems arose in claim 1, and explained why this was the case. In other words, the Board expected an explanation why the addition of a further function, that is, an image alignment function, to the list creation means could render the operation of the comparison target selection means clear.

3.6 Accordingly, the Board cannot identify any exceptional circumstance or cogent reason which could justify the introduction of the first auxiliary request and decided not to admit it into the appeal proceedings (Article 13(2) RPBA).

4. Conclusion

4.1 There being no admitted claim requests on file, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek L. Falò

Decision electronically authenticated