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**Datasheet for the decision
of 20 May 2025**

Case Number: T 1446/22 - 3.4.01

Application Number: 12825659.1

Publication Number: 2748769

IPC: G06K5/02, G06K19/08, G06K17/00,
G06K7/10

Language of the proceedings: EN

Title of invention:

SYSTEM FOR ASSOCIATING RFID TAG WITH UPC CODE, AND VALIDATING
ASSOCIATIVE ENCODING OF SAME

Patent Proprietor:

eAGILE, INC.

Opponent:

Mühlbauer GmbH & Co. KG

Headword:

Method of identifying and encoding a plurality of RFID
inlays / eAgile inc.

Relevant legal provisions:

EPC Art. 114(1), 123(2)

RPBA 2020 Art. 11, 12(2), 12(4), 12(6), 13(2)

Keyword:

Examination of own motion - error in use of discretion at first instance (no)

Amendment after summons - exceptional circumstances (yes)

Amendments - extension beyond the content of the application as filed (no)

Remittal - (yes)

Decisions cited:

G 0010/91, G 0001/05



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1446/22 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 20 May 2025

Appellant: eAGILE, INC.
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Respondent: Mühlbauer GmbH & Co. KG
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
20 December 2021 concerning maintenance of the
European Patent No. 2748769 in amended form.

Composition of the Board:

Chair P. Scriven
Members: A. Medeiros Gaspar
R. Winkelhofer

Summary of Facts and Submissions

- I. An opposition was filed, invoking grounds under Article 100(a) EPC; and a single ground under Article 100(c) EPC against claim 1 of the patent.
- II. Among the evidence submitted in support of the grounds under Article 100(a) EPC were:

E1: Specification of RFID Air Interface, 2005
E2: US 2007/0046432 A1
- III. The opposition was withdrawn, after the Opposition Division had issued a summons to oral proceedings.
- IV. In the preliminary opinion that accompanied that summons, the Opposition Division had not only agreed with the opponent's objection under Article 100(c) EPC, but had also raised, of its own motion, further issues under Article 100(c) EPC with claim 1 of the patent, which also applied to claim 1 of the auxiliary requests then on file. Additionally, they had expressed the opinion that claim 1 each of those requests lacked inventive step in view of either E1 or E2.
- V. The Opposition Division decided to continue opposition proceedings.

- VI. During oral proceedings before them, the proprietor filed two further auxiliary requests, 5 and 6.
- VII. The Opposition Division found auxiliary request 6 to meet all the requirements of the EPC. The higher ranking requests were either found not allowable or were not admitted into proceedings, due to issues of added matter.
- VIII. The proprietor appealed this decision, requesting that it be set aside and the patent maintained in amended form, on the basis of a main request, or one of six auxiliary requests, submitted with the statement of grounds of appeal. The main request and the auxiliary requests 3 and 5 were identical to the auxiliary requests 1, 2, and 3 of the contested decision, respectively. Auxiliary requests 1, 2, 4, and 6 were new on appeal. Oral proceedings were also conditionally requested.
- IX. Additionally, the Board was "asked to review the exercise of discretion by the Opposition Division", when raising, of its own motion, new issues of added matter with claim 1 of the patent.
- X. In the communication that accompanied the Board's summons to oral proceedings, the proprietor was informed of the Board's preliminary opinion:
- (a) that the Opposition Division had properly exercised its discretion, when raising, of its own motion,

new grounds of opposition against claim 1 of the patent, and

- (b) that, on substance, while the Board generally agreed with the appellant, in that certain passages of the original disclosure contained a teaching that could be isolated and provide basis for a claim, claim 1 of each of the requests on file nonetheless contravened Article 123(2) EPC.

XI. In reaction, the proprietor submitted, ahead of oral proceedings, an auxiliary request 7.

XII. At oral proceedings, the appellant submitted a new main request, based on auxiliary request 7, and withdrew all the other substantive requests. The appellant also indicated their understanding that the case might be remitted to the Opposition Division for further prosecution, on the basis of the new main request, and that they would agree to that.

XIII. The sole claim of the main request reads:

A method of identifying and encoding a plurality of RFID inlays positioned within a transmission field of a transmitter (352), the plurality of RFID inlays being removably arranged in a matrix configuration on a carrier substrate (350) and positioned in an identification and encoding station (354), the method including the steps:

a) transmitting a request (356) to a plurality of RFID inlays for each RFID inlay's unique identifier by means of the transmitter (352) which is included in the identification and encoding station (354) for communicating with each RFID inlay, wherein each unique identifier is a Unique Tag Identifier (UTID) stored in an on-chip memory bank containing a factory programmed, unique serial number that is permanently write-protected;

b) creating a list (358) of unique identifiers associated with available RFID inlays based upon responses to the request (356) by means of the identification and encoding station (354);

c) sequentially encoding (360) an electronic product code (EPC) value to each available RFID inlay in the list by means of the transmitter (352), wherein a write command is transmitted to the RFID inlay preselected for encoding, the write command incorporating the unique identifier for the RFID inlay preselected for encoding;

d) receiving a transmission (362) from each RFID inlay by means of the identification and encoding station (354) if the encoding is successful;

e) updating the list by means of the identification and encoding station (354) to indicate that the unique identifier

associated with each RFID inlay becomes unavailable after the EPC has been encoded;

f) polling (364) the list by means of the identification and encoding station (354) to ascertain whether any RFID inlay is not encoded; and

g) repeating the encoding, receiving, updating and polling steps until the list contains no more unique identifiers associated with available RFID inlays.

Reasons for the Decision

On the exercise of discretion by the Opposition Division

1. In their preliminary opinion, mentioned under item IV above, the Opposition Division not only agreed with the ground under Article 100(c) EPC invoked by the opponent, but also raised, of its own motion, new added matter issues with respect to claim 1 of the patent and each of the auxiliary requests then on file.
2. On appeal, the appellant argued, with reference to the principles set out in G 10/91 *Examination of opposition/appeals*, OJ 1993, 420, that, in doing so, the Opposition Division had exceeded the scope of its discretion under Article 114(1) EPC.
3. However, as is apparent from the contested decision, the Opposition Division saw the further added-matter

issues as *prima facie* prejudicing the maintenance of the patent.

4. They then followed the guidance provided by G 10/91, when exercising their discretion under Article 114(1) and Rule 81(1) EPC, in particular by drawing upon the (*prima facie*) relevance of these issues for the maintenance of the patent.
5. Whether or not the Opposition Division erred in their substantive assessment of those issues plays no role in the assessment of whether or not they properly exercised their discretion.
6. Therefore, no error can be identified in the Opposition Division's exercise of discretion under Article 114(1) EPC.

Main Request - consideration

7. The main request was filed during the oral proceedings before the Board. It is based on auxiliary request 7, itself submitted after notification a communication under Article 15(1) RPBA, sent with the Board's preliminary opinion.
8. Admission of either of these requests was subject to the provisions of Article 13(2) RPBA, which requires, for their consideration, that exceptional circumstances be present and that these have been justified by cogent reasons. This applies for the main request, for the following reasons.
9. Claim 1 of this request differs from that of previous auxiliary request 7 in that it solves a minor,

immediately-apparent inconsistency in its wording. Concretely, claim 1 of auxiliary request 7 erroneously indicated that a certain method step was carried out by the *transmitter (354)*, instead of by the *encoding station (354)*.

10. Auxiliary request 7 was, itself, filed in reaction to the Board's preliminary opinion, which, in essence, had subscribed to the appellant's view as to why the Opposition Division had erred in their assessment of added-matter, but which had identified new added-matter issues.
11. Claim 1 of the main request *prima facie* solves all those issues without raising new ones.
12. Additionally, consideration of this request does not affect any other party's rights, given that the opponent has withdrawn their opposition.
13. On submission of this request the proprietor, furthermore, withdrew all the other substantive requests.
14. The purpose of the Rules of Procedure of the Boards of Appeal is the defence of parties' right to a fair hearing within a reasonable time.
15. All these aspects having been considered, the circumstances in the present case are regarded as exceptional and weigh in favour of the admission of the main request (Article 13(2) RPBA 2020).

Main request - added-matter

16. The Board agrees with the appellant in that, for establishing whether or not a claim infringes Article 123(2) EPC, what is relevant is whether or not there is basis in the application as filed for the subject-matter defined. As explained in G 1/05 *Divisional / ASTROPOWER, OJ EPO 2008, 271*, reasons 5.3, Article 123(2) EPC, second sentence, refers to the (full) application as filed rather than (only) to the claims as filed.
17. The Board also agrees with the appellant in that the method of identifying and encoding a plurality of RFID inlays, set out in paragraphs [0089] to [0095] of the application, by reference to figures 13 to 15, is a self-contained teaching, that can be isolated, from the verification process subsequently set out in paragraphs [0096] to [0098], which need not take place. Indeed, as indicated in paragraph [0094], after finalization of the identification and encoding methods described, the RFID inlays may be prepared for shipment or additional encoding and verification steps may follow.
18. The essence of the method defined in the sole claim of the main request finds a basis in figure 13 and paragraph [0094] of the original application.
19. The claim also contains limitations beyond those described in paragraph [0094], but which are described as essential in the remaining paragraphs of that part of the disclosure.
20. Concretely, paragraph [0089] and figure 14 provide a basis for the further definition concerning *the plurality of RFID inlays being removably arranged in a*

matrix configuration on carrier substrate (350) and positions in an identification an encoding station (354).

21. Paragraphs [0090] and [0091] provide a basis for the limitation *wherein each unique identifier is a UTID stored in an on-chip UTID memory bank containing a factory-programmed, unique serial number that is permanently write-protected*. Indeed, paragraph [0090] discloses the identification encoding system as being "fundamentally based" upon each RFID having a single permanent unique identity.
22. Paragraphs [0092] and [0093] provide a basis for the limitation *wherein a write command is transmitted to the RFID inlay preselected for encoding, the write command incorporating the unique identifier for the RFID inlay preselected for encoding*. Indeed, these paragraphs also teach that it is this special write command, incorporating the UTID of the RFID inlay selected for encoding, that avoids the encoding of inlays other than the intended one.
23. It is to these UTIDs that figure 13 and paragraph [0094], as well as paragraph [0095], refer, concluding that the process enables a plurality of RFID inlays to be identified and encoded regardless of the order in which they are.
24. Therefore, in view of the amendments introduced into it, claim 1 of the main request finds a basis in paragraphs [0089] to [0095] and figures 13 to 15 of the original application and, consequently, does not to contravene Article 123(2) EPC.

Remittal for further prosecution

25. In the notice of opposition, the then opponent argued that claim 1 of the patent lacked inventive step in view of E1, as well as in view of E2.
26. During opposition proceedings, the Opposition Division expressed the preliminary view that the subject-matter of claim 1 of the patent, as well as that of claim 1 of several of the auxiliary requests before them, lacked inventive step, in view of either E1 or E2.
27. The current main request defines, as did claim 1 of the patent and claim 1 of those auxiliary requests, *a method of identifying and encoding a plurality of RFID inlays*.
28. In view of the conclusion of the Opposition Division, that those requests were not allowable, due to issues of added-matter, the question of the patentability of the subject-matter they defined in view of E1, and in view of E2, was not addressed in the decision.
29. In view of the above, and of the primary object of the appeal proceedings being to review the decision under appeal, remittal o the Opposition Division for further prosecution is justified (Article 11 and 12(2) RPBA).
30. The appellant did not object, but instead agreed to such a remittal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chair:



C. Moser

P. Scriven

Decision electronically authenticated