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**Datasheet for the decision
of 12 March 2025**

Case Number: T 0660/23 - 3.5.05

Application Number: 19155854.3

Publication Number: 3525211

IPC: G16H10/40, G16H15/00

Language of the proceedings: EN

Title of invention:
Test order processing apparatus, computer program therefor and test system

Applicant:
HORIBA, Ltd.

Headword:
Non-compliant test apparatus/HORIBA

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 12(6), second sentence

Keyword:
Inventive step - main request and auxiliary requests I to IV
(no): technical effect not made credible within the whole
scope claimed
Admittance of claim requests filed on appeal - auxiliary
request IA (no): should have been filed earlier
Reimbursement of the appeal fee - (no): appeal not allowable

Decisions cited:
T 0258/03

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Case Number: **T 0660/23 - 3.5.05**

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 12 March 2025

Appellant: (Applicant)	HORIBA, Ltd. 2, Miyanohigashi-cho, Kisshoin, Minami-ku, Kyoto-shi Kyoto 601-8510 (JP)
Representative:	Isarpatent Patent- und Rechtsanwälte Barth Charles Hassa Peckmann & Partner mbB Friedrichstrasse 31 80801 München (DE)
Decision under appeal:	Decision of the Examining Division of the European Patent Office posted on 25 November 2022 refusing European patent application No. 19155854.3 pursuant to Article 97(2) EPC.

Composition of the Board:

Chair	K. Bengi-Akyürek
Members:	E. Konak
	C. Heath

Summary of Facts and Submissions

I.   The appeal is against the examining division's decision to refuse the present European application.

The examining division decided that the main request and auxiliary requests I and II did not comply with Articles 52(2)(c), 52(3) and 56 EPC and that auxiliary requests III and IV did not comply with Article 56 EPC.

II.   In the present decision, reference is made to the following prior-art documents:

D1:   WO 2017/073567 A1,

D3:   Skeggs, "An Automatic Method for Colorimetric Analyses", American Journal of Clinical Pathology, 28, p. 311, 1957,

D4:   Zagatto et al.: "Chapter 2 - Historical View" in "Flow Analysis with Spectrophotometric and Luminometric Detection", 2012.

For language reasons, in the following, the references made to **D1** are to its late-published European family member EP 3 364 366 A1.

III.   Oral proceedings were held before the board on 12 March 2025.

The appellant's final requests were that the decision under appeal be set aside and that a patent be granted on the basis of a **main request** or one of **auxiliary Requests I to IV**, all underlying the contested decision, or **auxiliary requests IA** (to be inserted between the main request and auxiliary request I), filed with the statement of grounds of appeal.

Furthermore, the appellant requested reimbursement of the appeal fee and, in the auxiliary, remittal to the examining division for further examination and discussion of documents D3 and D4.

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

IV.   Claim 6 of the **main request** reads as follows:

"A computer program causing a computer (10) to execute a test order processing to link each test result, sent from a test apparatus (44) to the computer, to a corresponding test order, wherein the test order comprises a test order ID and wherein the computer (10) is configured to be used in an on-line system for data communication and is connected to one or more test apparatuses (41, 42, 43, 44), the computer program making the computer (10) functions as:
    a first display image output part (140) that displays mutually linked one or more test orders and one or more test apparatuses (41, 42, 43, 44) on a display device (20) in a displaying form showing which test order is linked to which test apparatus (41, 42, 43, 44),
    a test apparatus determination part (150) that determines the test apparatus (41, 42, 43, 44) that should perform the test and one or more test orders linked thereto from the test orders and the test apparatuses linked thereto, which are displayed on the display device, by a user's input or by an automatic selection;
    a test result receiving part (170) that receives each test result sent from the one or more test apparatuses connected to the test order processing apparatus (10); and

a test result/test order linking part (180) that
links one or more test results to the one or more test
orders linked to the test apparatuses, according to the
input sequence or the automatic selection sequence
determined by the test apparatus determination
part (150), the test results being received by the test
result receiving part from the test apparatus that
should perform the test, and the test apparatuses being
determined by the test apparatus determination
part (150), wherein the test apparatus being determined
is a test order ID send/receive non-compliant test
apparatus (44)."

Claim 6 of **auxiliary request IA** differs from claim 6 of
the main request as follows (with the additions
underlined and the deletions ~~struck through~~):

"[...]
a test apparatus determination part (150) that
determines the test apparatus (41, 42, 43, 44) that
should perform the test and one or more test orders
linked thereto from the test orders and the test
apparatuses linked thereto, which are displayed on the
display device, by a user's input selection or by an
automatic selection;
[...]
a test result/test order linking part (180) that
links one or more test results to the one or more test
orders linked to the test apparatuses, according to the
user's input selection sequence or the automatic
selection sequence determined by the test apparatus
determination part (150) [...]"

Claim 6 of **auxiliary request I** differs from claim 6 of
the main request as follows (with the additions
underlined):

"[...];
    wherein after the test apparatus that is a test
order ID send/receive non-compliant test apparatus (44)
is determined by the test apparatus
determination (150), the test results received by the
test result receiving part (170) from the determined
test apparatus (44) as the first test result received
after the determination are linked to the test order
linked to the determined apparatus (44)."

Claim 6 of **auxiliary request II** differs from claim 6 of
auxiliary request I as follows (with the additions
underlined):

    "[...]
    a selection sequence storage part that stores a
sequence of the user's input or a sequence of the
automatic selection;
    a test result receiving part (170) that receives
each test result sent from the one or more test
apparatuses connected to the test order processing
apparatus (10); and
    a test result/test order linking part (180) that
links one or more test results to the one or more test
orders linked to the test apparatuses, according to the
input sequence or the automatic selection sequence
determined by the test apparatus determination
part (150), the test results being received by the test
result receiving part from the test apparatus that
should perform the test, and the test apparatuses being
determined by the test apparatus determination
part (150), wherein the test apparatus being determined
is a test order ID send/receive non-compliant test
apparatus (44);
    wherein when plural test results are sequentially
sent from the determined test apparatus (44), the test

result/test order linking part (180) is configured to
refer to the sequence of selection stored in the
selection sequence storage part, the test result and
the test order are linked to each other according to a
sequence of reception and the sequence of selection
corresponding."

Claim 4 of **auxiliary request III** differs from claim 6
of auxiliary request II as follows (with the additions
underlined):

"A computer program causing a computer (10) to
execute a test order processing to link each test
result, sent from a test apparatus (44) to the
computer, to a corresponding test order, wherein the
test order comprises a test order ID and wherein the
computer (10) is configured to be used in an on-line
system for data communication and is connected to one
or more test apparatuses (41, 42, 43, 44), the computer
program making the computer (10) functions as:
        a test order receiving part (110) that receives
the test order further containing one or more test
items from a sender of the test order (30);
        a linking information-holding part (120) that
holds information linking said one or more test items
contained in the test order to a test apparatus (41,
42, 43, 44) corresponding thereto; and
        a test order/test apparatus linking part (130)
that refers to the linking information and test items
in the test order and links the test order to one or
more corresponding test apparatuses (41, 42, 43, 44);
[...]
        as a test report sending part (190) that sends the
test result, linked to the test order by the test
result/test order linking part (130), to a given
recipient as a test report or a part of a test report;

wherein when plural test results are sequentially
sent from the determined test apparatus (44), the test
result/test order linking part (180) is configured to
refer to the sequence of selection stored in the
selection sequence storage part, the test result and
the test order are linked to each other according to a
sequence of reception and the sequence of selection
corresponding."

Auxiliary request IV includes the same claims 1 to 3 as
auxiliary request III. Claim 1 of auxiliary request IV
reads as follows:

  "A test order processing apparatus (10) for linking
a test result sent from a test apparatus (44) to a test
order corresponding to the test result, wherein the
test order processing apparatus (10) is configured to
be used in an on-line system for data communication of
a medical institution and is connected to one or more
test apparatuses (41, 42, 43, 44) and comprises:
     a test order receiving part (110) configured to
receive the test order from a sender of the test
order (30), wherein the test order contains a test
order ID and one or more test items necessary for a
medical diagnostic;
     a linking information-holding part (120)
configured to hold information linking said one or more
test items contained in the test order to a test
apparatus (41, 42, 43, 44) corresponding thereto; and
     a test order/test apparatus linking part (130)
configured to refer to the linking information and test
items in the test order and link the test order to one
or more corresponding test apparatuses (41, 42, 43,
44);
     a first display image output part (140) configured
to display mutually linked one or more test orders and

one or more test apparatuses (41, 42, 43, 44) on a
display device (20) in a displaying form showing which
test order is linked to which test apparatus (41, 42,
43, 44),

a test apparatus determination part (150)
configured to determine the test apparatus (41, 42, 43,
44) that should perform the test and one or more test
orders linked thereto from the test orders and the test
apparatuses linked thereto, which are displayed on the
display device, by a user's input or by an automatic
selection;

a selection sequence storage part configured for
storing a sequence of the user's input or a sequence of
the automatic selection;

a test result receiving part (170) configured to
receive each test result sent from the one or more test
apparatuses connected to the test order processing
apparatus (10); and

a test result/test order linking part (180)
configured to link one or more test results to the one
or more test orders linked to the test apparatuses,
according to the input sequence or the automatic
selection sequence determined by the test apparatus
determination part (150), the test results being
received by the test result receiving part (170) from
the test apparatus that should perform the test, and
the test apparatuses being determined by the test
apparatus determination part (150), wherein the test
apparatus being determined is a test order ID
send/receive non-compliant test apparatus (44);

a test report sending part (190) configured to
send the test result, linked to the test order by the
test result/test order linking part (130), to a given
recipient as a test report or a part of a test report;

wherein when plural test results are sequentially
sent from the determined test apparatus (44), the test

result/test order linking part (180) is configured to
refer to the sequence of selection stored in the
selection sequence storage part, the test result and
the test order are linked to each other according to a
sequence of reception and the sequence of selection
corresponding."

Reasons for the Decision

1.   Main request

1.1   Claim 6 of the **main request** contains the following
       features (the examining division's labelling):

       a.   A computer program causing a computer to execute
             a test order processing to link each test result,
             sent from a test apparatus to the computer, to a
             corresponding test order,
          1. wherein the test order comprises a test order
              ID and
          2. wherein the computer is configured to be used
              in an on-line system for data communication
              and is connected to one or more test
              apparatuses,
       b.   the computer program making the computer
             functions [sic] as:
          1. a first display image output part that
              displays mutually linked one or more test
              orders and one or more test apparatuses on a
              display device in a displaying form showing
              which test order is linked to which test
              apparatus,
          2. a test apparatus determination part that
              determines the test apparatus that should
              perform the test and one or more test orders

linked thereto from the test orders and the
test apparatuses linked thereto, which are
displayed on the display device, by a user's
input or by an automatic selection;

3. a test result receiving part that receives
    each test result sent from the one or more
    test apparatuses connected to the test order
    processing apparatus;

4. a test result/test order linking part that
    links one or more test results to the one or
    more test orders linked to the test
    apparatuses, according to the input sequence
    or the automatic selection sequence
    determined by the test apparatus
    determination part,

    a. the test results being received by the
        test result receiving part from the test
        apparatus that should perform the test,
    b. the test apparatuses being determined by
        the test apparatus determination part,
    c. wherein the test apparatus being
        determined is a test order ID send/receive
        non-compliant test apparatus.

1.2   The examining division raised an objection under
      Article 52(2)(c) and (3) EPC against claim 6.

1.3   The board cannot endorse this objection, since claim 6
      includes technical features such as a "computer" in
      communication with "test apparatuses" and therefore
      clearly overcomes the first hurdle (i.e. the "any
      hardware test"; see e.g. **T 258/03**, headnote I)
      according to the established case law of the Boards of
      Appeal. Rather, the issue to be discussed should have
      been whether the subject-matter of claim 6 involves an
      inventive step within the meaning of Article 56 EPC.

1.4   The appellant submitted that the subject-matter of
          claim 6 differed from D1 in **features b2, b4 and b4.c**
          and solved the technical problem of *how to use a "[test
          order ID send/receive] non-compliant test apparatus" in
          an environment in which test orders include an ID*.

1.5   The examining division and the appellant disagreed on
          whether or not **feature b4.c** is a technical feature.

          In the board's view, this discussion misses the point
          that feature b4.c is not a feature of the "computer
          program" of claim 6. Instead, it is a feature of the
          "test apparatuses" from which the "computer" on which
          the "computer program" of claim 6 runs receives test
          results, which causes a problem in linking received
          test results to corresponding test orders. Thus,
          feature b4.c is the problem *itself* (as the appellant
          indeed incorporated in its own formulation of the
          technical problem: "*how to use a **non-compliant test
          apparatus**"), and not a feature of the "computer
          program" of claim 6 which contributes to the solution
          of a technical problem.

1.6   Regarding **feature b2**, the appellant argued that, in the
          system of **D1**, there was no "user's input" selection.

          However, this is one of the two options ("by a user's
          input **or** by an automatic selection") provided in
          feature b2, the other being an "automatic selection" of
          the "test apparatuses" that should perform the tests.
          Document D1 does however disclose the *second* option of
          an "automatic selection". Therefore, feature b2 cannot
          establish novelty.

1.7   Thus, the only distinguishing feature that allegedly
          solves the objective problem of *how to use a "[test*

*order ID send/receive] non-compliant test apparatus" in
an environment in which test orders include an ID is*
feature b4, namely linking the test results to the test
orders "according to [...] the automatic selection
sequence determined by the test apparatus determination
part".

1.8   The board agrees with the appellant that documents **D3**
and **D4** are not relevant for this matter. The real
question is indeed whether feature b4 solves the
underlying technical problem at all. In the board's
view, the answer to this question is in the negative.

It would be appropriate to discuss this on the basis of
the only example in the application as filed which
illustrates a case in which "test results" are linked
to a plurality of "test orders", i.e. Figure 4. In
Figure 4, test apparatuses 41 and 44 were selected as
the test apparatuses to perform test items for the test
order with "ID A1001". If test apparatuses 41, 42 and
43 were then selected to perform test items of "test
order A1002" and test apparatuses 42 and 44 were
selected thereafter to perform test items of "test
order A1003", a linking according to feature b4 would
in fact link the results of test apparatuses 41 and 44
for "test order A1001" with the results of test
apparatuses 42 and 43 for "test order A1002" together,
as they are in the same **first** "selection sequence". It
would then link the results of test apparatus 41 for
"test order A1002" with the results of test
apparatuses 42 and 44 for "test order A1003" together,
as they are in the same **second** "selection sequence". In
other words, no technical effect can be derived from
the mere linking of some "test results" to "test
orders" which are in turn linked to the respective
"test apparatuses" according to any determined

sequence. Therefore, feature b4 does not credibly solve the above-mentioned technical problem.

1.9   The appellant argued that the board's understanding of a "selection sequence" did not correspond to what was intended by that term in the application. Referring in particular to paragraphs [0038] and [0042] of the description, it argued that the term "selection sequence" was not intended to include a "horizontal" selection of a plurality of test apparatuses selected for a particular test order but rather as the sequence of test items assigned to a particular non-compliant test apparatus.

However, the claim wording, even if interpreted according to the passages of the description, is not restricted to a particular "sequence" of selecting test apparatuses.

1.10   For this reason, no technical effect is derivable from the claim wording. As a consequence, the subject-matter of claim 6 (and of the corresponding apparatus claim, i.e. claim 1) of the main request does not involve an inventive step (Article 56 EPC).

2.   Admittance of auxiliary request IA

2.1   The contested decision is not based on **auxiliary request IA** filed with the statement setting out the grounds of appeal, contrary to Article 12(2) RPBA. Thus, this request is an "amendment" within the meaning of Article 12(4) RPBA, which can only be admitted at the board's discretion.

2.2   The appellant argued that it only became clear to them having studied the contested decision that the

examining division did not sufficiently appreciate that the phrase "input sequence" in claim 1 of the main request should be understood as a "user's selection".

2.3   However, if claims are apparently prone to any misunderstanding, appropriate amendments should be made already in the examination proceedings. The appellant cannot then use appeal proceedings as a continuation of the examination proceedings in order to make good what should have been addressed before, but has not been. Consequently, such a request should indeed have been submitted already during the examination proceedings (cf. Article 12(6), second sentence, RPBA).

2.4   Therefore, the board did not admit auxiliary request IA into the appeal proceedings (Article 12(6) RPBA).

3.   Auxiliary requests I to IV

3.1   Claim 6 of **auxiliary request I** differs from claim 6 of the main request in that it includes the following additional features:

    (i)   wherein after the test apparatus that is a <u>test order ID send/receive non-compliant test apparatus</u> is determined by the test apparatus determination,

    (ii)   the test results received by the test result receiving part from the determined test apparatus as the first test result received after the determination are <u>linked</u> to the test order linked to the determined apparatus.

3.2   Claim 6 of **auxiliary request II** differs from claim 6 of the main request in that it includes the following

additional features:

(iii)   a <u>selection sequence storage part</u> that
        stores a sequence of the user's input or a
        sequence of the automatic selection;

(iv)   wherein when plural test results are
        sequentially sent from the determined test
        apparatus, the test result/test order
        linking part is configured to <u>refer</u> to the
        sequence of selection stored in the
        selection sequence storage part, the test
        result and the test order are linked to
        each other according to a sequence of
        reception and the sequence of selection
        corresponding.

3.3   These features indeed reflect the scenario elaborated
        above when assessing the main request and do not remedy
        the fact that a linking based on the selection sequence
        does not solve the technical problem at hand.

3.4   Regarding **auxiliary request II,** the appellant argued at
        the oral proceedings before the board that this request
        could clarify the intended meaning of a "selection
        sequence" according to the invention, which assigned
        "test results" to the correct "test order".

        However, the additional features of claim 6 of
        auxiliary request II merely state that the selection
        sequence is stored and used thereafter while linking
        the received results to test orders. They do not
        restrict how the term "selection sequence" is to be
        interpreted.

3.5   Claim 4 of **auxiliary request III** differs from claim 6
        of auxiliary request II in that it has the following

additional features:

    (v)   a test order receiving part that receives the test order further containing one or more <u>test items</u> from a sender of the test order;

    (vi)   a <u>linking information-holding part</u> that holds information linking said one or more test items contained in the test order to a test apparatus corresponding thereto;

    (vii)   a <u>test order/test apparatus linking part</u> that <u>refers</u> to the linking information and test items in the test order and <u>links</u> the test order to one or more corresponding test apparatuses;

    (viii) a <u>test report sending part</u> that sends the test result, linked to the test order by the test result/test order linking part, to a given recipient as a test report or a part of a test report.

The board agrees with the contested decision that these features are already disclosed in D1. The appellant argued that D1 does not disclose a "test order/test apparatus linking part". The board cannot accept that conclusion since the "test order sending part 130" in document D1 exactly performs this function referring to the "linking information-retaining part 120".

3.6   **Auxiliary request IV** includes the same claims 1 to 3 as auxiliary request III. The appellant only deleted claims 4 and 5 of auxiliary request III to a "computer program" to address the examining division's objections under Article 52(2)(c) and (3) EPC, which was however not necessary to address them after all (see point 1.2 above).

3.7   Therefore, the subject-matter of the independent claims
        of auxiliary requests I to IV does not involve an
        inventive step either (Article 56 EPC).

4.   Request for reimbursement of the appeal fee

        The appellant did not substantiate its request for
        reimbursement of the appeal fee and the board could not
        see any legal basis for it. Therefore, the board
        rejected this request.

5.   Request for remittal to the examining division

5.1   The appellant argued that it did not have a chance to
        comment on documents **D3** and **D4** in the examination
        proceedings and requested that the case be remitted to
        the examining division for "further examination and
        discussion of documents D3 and D4".

5.2   However, the board did not consider documents D3 and D4
        to be relevant to assess the allowability of the
        present claim requests. Therefore, the board sees no
        merit in this request for remittal.

Order

For these reasons it is decided that:

1.   The appeal is dismissed.

2.   The request for reimbursement of the appeal fee is
        refused.

The Registrar: The Chair:

B. Brückner   K. Bengi-Akyürek

Decision electronically authenticated