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D E C I S I O N
of 31 May 1994

Case Number: T 0769/92 - 3.5.1

Application Number: 86110223.4

Publication Number: 0209907

IPC: G06F 15/21

Language of the proceedings: EN

Title of invention:

General-purpose management system, method for operating said system and transfer slip

Applicant:

Sohei, Yamamoto, et al

Opponent:

-

Headword:

General-purpose management system/SOHEI

Relevant legal norms:

EPC Art. 52(1),(2),(3), 111(1)

Keyword:

"Non-exclusion from patentability - technical considerations to be regarded as resulting in a technical contribution to the art - no doing business as such - no computer programs as such - no presentation of information as such"
"Remittal for further prosecution"

Decisions cited:

T 0026/86, T 0038/86

Headnote:

I. An invention comprising functional features implemented by software (computer programs) is not excluded from patentability under Article 52(2)(c), (3) EPC, if technical considerations concerning particulars of the solution of the problem the invention solves are required in order to carry out that same invention.

Such technical considerations lend a technical nature to the invention in that they imply a technical problem to be solved by (implicit) technical features.

An invention of this kind does not pertain to a computer program as such under Article 52(3).

II. Non-exclusion from patentability cannot be destroyed by an additional feature which as such would itself be excluded, as in the present case features referring to management systems and methods which may fall under the "methods for doing business" excluded from patentability under Article 52(2)(c), (3) EPC (following established case law according to which a mix of features, some of which are excluded under Article 52(2) and (3) EPC and some of which are not so excluded, may be patentable [in contrast to recent case law concerning inventions excluded by Article 52(4) EPC, cf. T 820/92, to be published, according to which one feature excluded under Article 52(4) EPC suffices for the whole claim to be excluded from patentability]).

Case Number: T 0769/92 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 31 May 1994

Appellants: Sohei, Yamamoto
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Decision under appeal: Decision of the Examining Division of the European Patent Office dated 26 March 1992 refusing European patent application No. 86 110 223.4 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg

Members: W. B. Oettinger

F. Benussi

Summary of Facts and Submissions

- I. The appeal contests the Examining Division's decision to refuse the European patent application No. 86 110 223.4 filed on 24 July 1986 (publication No. 0 209 907).

The reason given for the refusal was that, in accordance with Article 52(2) and (3) EPC, the subject-matter of the independent method Claim 1 and system Claim 2 filed on 20 February 1991 could not be regarded as an invention within the meaning of Article 52(1) EPC.

More particularly, the Examining Division held that the subject-matter claimed would differ from prior art document

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by features involving a computer program, excluded from patentability by Article 52(2)(c), and presentation of information, excluded by Article 52(2)(d), and that no technical contribution to the art was discernible.

- II. That decision was posted on 26 March 1992 and the appeal against it was lodged on 18 May 1992.

The appeal fee was paid on 27 May 1992.

On 4 August 1992, the Appellant filed a Statement of Grounds.

- III. In the Statement of Grounds of Appeal, the Appellant requested that the decision under appeal be set aside and the patent application allowed on the basis of amended claims (main or auxiliary request).
- IV. In response to a communication pursuant to Article 11(2) Rules of Procedure, the Appellant filed new (main request) claims.
- V. In the oral proceedings, which were held, in compliance with Rules 1(2) and 2(1) and (2) EPC, on 15 March 1994, he requested that a patent be granted on the basis of:
- Claims 1 and 2 filed on 15 February 1994 but amended by deleting the words "of said transfer slip" in the last two lines of these claims (main request) or
- Claim 2 (renumbered 1) filed on 15 February 1994 but amended in the same way (first auxiliary request) or
- Claims 1 to 6 ("auxiliary request") filed on 4 August 1992 (second auxiliary request),
- with the description being amended by replacement pages 3 and 3a filed on 4 August 1992 and 7 filed on 15 February 1994, and by page 27 being deleted, and
- the drawings (sheets 1 to 16) as published.
- In addition, the Appellant submitted, in the oral proceedings, a paper, marked 3' by the Board, stating the "technical problem of the invention".
- The claims of the main request read as follows:

"1. A computer system for plural types of independent management including at least financial and inventory management

comprising a display unit (4), an input unit (3), a memory unit (2), an output unit (4, 5) and a digital processing unit (1) wherein:

said display unit (4) displays, in the form of an image on the screen of the display unit (4), a single transfer slip (Figure 2) having a format commonly used for at least financial and inventory management in order that items relating to at least a debit item, a credit item and a commodity item may be input successively,

said memory unit (2) includes:

a journalized daybook file having a plurality of storage areas for storing data entered with use of said transfer slip format for each transfer slip,

an item master file for storing data necessary for management processing with respect to a plurality of items in correspondence to each item code,

a commodity master file for storing data necessary for management processing with respect to a plurality of commodities in correspondence to each commodity code,

a journalized daybook accumulation file for storing data relating to the financial management among the data in said journalized daybook file for each transfer slip, and

an inventory file for storing data relating to the inventory management among the data in said journalized daybook file for each transfer slip, and

said digital processing unit (1) comprises:

first processing means for causing said display unit (4) to display said transfer slip and for

automatically displaying data entered through said input unit (3) and storing said data in accordance with said transfer slip into said journalized daybook file in the memory unit (2),

second processing means for automatically updating data corresponding to each item code in said item master file and data corresponding to each commodity code in said commodity master file with use of data entered through said input unit (3),

third processing means for transferring data necessary for financial management processing stored in said journalized daybook file to said journalized daybook accumulation file to store therein and for relating data stored in said journalized daybook accumulation file with item codes in said item master file,

fourth processing means for transferring data necessary for inventory management processing stored in said journalized daybook file to said inventory file to store therein and for relating data stored in said inventory file with commodity codes in said commodity master file, and

fifth processing means for reading, in response to an output command entered through said input unit (3), data necessary for a specific type of management from at least one of said journalized daybook file, item master file, commodity master file, journalized daybook accumulation file and inventory file to output them through said output unit (4, 5) in accordance with a predetermined format for said specific type of management.

2. A method for operating a general-purpose computer management system including a display unit (4), an

input unit (3), a memory unit (2), an output unit (4, 5) and a processing unit (1), for plural types of independent management including at least financial and inventory management comprising the steps of:

providing said memory unit (2) for storing a general-purpose management program and data necessary for management including a journalized daybook file, an item master file, a commodity master file, a journalized daybook accumulation file, and an inventory file,

providing a single transfer slip (Figure 2) by displaying it in the form of an image on the screen of said display unit, said transfer slip having ... [further wording of this step identical with wording of function of display unit (4) as defined in Claim 1 (cf. above)],

automatically entering data successively input through said input unit (3) into the transfer slip, storing said data in accordance with the format of said transfer slip ... [further wording corresponding to function of first processing means],

updating said data ... [further wording identical with that of function of second processing means],

transferring said data ... [further wording identical with that of function of third processing means],

transferring said data ... [further wording identical with that of function of fourth processing means], and

reading, ... [further wording identical with that of function of fifth processing means]".

VI. In the oral proceedings of 15 March 1994, the Appellant argued, in support of these requests, essentially as follows:

Technicality (meant is the technical nature of the invention which implies non-exclusion from patentability under Article 52(2) and (3) EPC) of an invention should, in principle, be examined independently of the question of novelty and inventive step, although realistically this examination cannot be carried out without some reference to the prior art. However, the fact that technical considerations were applied in order to arrive at the invention should suffice to find that it has technical character. Whenever a computerised solution of a problem involves an implementation which is different from how a human being would solve the problem manually or mentally, technicality in the above sense should be assumed. As to computer programs, Article 52(2)(c) was only intended to exclude program listings.

In the present case, the file handling needs a knowledge of the capacities of the computer on which the respective program is to be run. It is not the financial and inventory management which are regarded as technical, and neither the meaning of the data nor the details of their transactions. The claims could just as well have been expressed in an abstract way, referring to "files A, B, ...", but that would have made comprehension more difficult; the explicit management application could be seen as a voluntary limitation of the scope of protection.

The technical features of Claim 1 are in particular the unitary format of the "single transfer slip" and the "file management" features made possible by the unitary format. There are two consequences of the unitary slip format: firstly, the operator input is facilitated in that always the same screen is displayed; secondly, when the transfer slips have been stored in the daybook file, the processor knows always where exactly to find data which are to be copied to other files. This latter feature makes it possible to update various files directly from the stored transfer slips without involving the operator; multiple inputs of redundant data are thus avoided.

In D1, which is concerned with inventory management only, the unitary format is limited to the records in the "job file"; the format of records in other files are different. Incidentally, it is not even certain that input screens ("Formulare") were known *per se* in 1985. In any case, since D1 does not deal with input formats, it is not really close to the claimed invention and, apart from not taking its technical nature, does not render it obvious.

VII. At the end of the oral proceedings, the Board announced its decision to continue the proceedings in writing.

Reasons for the Decision

1. The appeal (cf. point II) is admissible.
2. *Main request amendments*

2.1 By accepting Claims 1 (method) and 2 (system) of 20 February 1991 for consideration, the Examining Division implicitly acknowledged that the amendments made to these claims were allowable under Article 123(2) EPC.

The Board, agreeing with this view, considers that the same is true for Claims 1 (system) and 2 (method) as last amended on 15 March 1994 in the oral proceedings (cf. point V).

2.2 In essence, Claim 1 is based on the original Claim 3 as follows:

The introductory phrase is based on the introductory statement in the original Claim 1 with the reference to a "computer" being taken from the original description and the types of management "at least" to be performed being taken from the original Claim 2 and the original description; the non-inclusion of the other two types of management mentioned in the description (page 1, first paragraph and page 2, lines 5 to 11) is considered allowable, for instance, on the basis of the "example" expressly referred to on page 2 (lines 14 to 25).

The hardware features are taken from the original Claim 1. The five (first and second) files stem from that part of Claim 3 which relates to the two kinds of management at least to be performed.

The five functional features attributed to the (first to fifth) processing means, insofar as they are more specific than the general functions mentioned already

in the context of the memory files, are derivable from the original description; for instance, the particular feature of "updating" data is disclosed on page 11, lines 6 to 9 and line 22 to page 12, line 4.

- 2.3 Claim 2 is based, in essence, on the original Claim 7, having regard to its reference back, *inter alia*, to Claim 3.

In effect, that method claim is understood as the function performed by the computer system of Claim 1 when being operated, i.e. in use, by causing respective programs to run; no other feature has been added or omitted.

- 2.4 Pages 3 and 3a of the description comply with Rule 27(1)(b) EPC.

Page 3', if intended to be included in the description, complies with Rule 27(1)(c) EPC.

Page 7 removes an inconsistency with the claims.

Page 27 was deleted to comply with various provisions of the Convention (Articles 69(1), 84; Rules 27, 29, 34(1)(c)).

3. *Main request non-exclusion from patentability*

- 3.1 The decision under appeal dealt with the question of exclusion from patentability under Article 52(2), (3) EPC of the subject-matter of the method and system claims then on file jointly without distinguishing any differences based on their different categories. The

Board agrees with this approach and considers that the same would apply to the system and method claims now on file.

As already stated above (paragraph 2.3), system Claim 1 and method Claim 2 differ only by their categories (apparatus and process) and, consequently, by the categories (means or steps respectively) of their individual features. Even though their possible scopes of protection will be different, Claim 2 is not more specific when defining the individual "steps" of the claimed method than Claim 1 where it defines the respective functions of the claimed system, and Claim 1 is not more specific when defining the individual (program-controlled processor) "means" than Claim 2 where it defines the respective steps of the claimed method to be carried out by these means.

It would thus appear that, at least in the present case, the question of exclusion or not from patentability cannot be answered differently for system Claim 1 and method Claim 2, that question being primarily a matter of whether or not a patent may be granted and not a question of extent of protection.

For this reason, it appears convenient also for the Board to deal with the question of exclusion or not from patentability of the subject-matter of system Claim 1 and method Claim 2 jointly.

- 3.2 Both claims state that the system, claimed as such and when being operated respectively, is intended for performing a plurality of independent "managements" of different types. The types of management "at least" to

be performed by the claimed system are of the "financial and inventory" kinds. Such types of management would seem to fall, generally, under the activity of "doing business", excluded, as such, from patentability by Article 52(2)(c) in conjunction with (3) EPC.

However, in accordance with the description (page 1, first paragraph), the plural types of management to be performed may include, for instance, "personnel" and "construction" managements. While personnel management, as an administration kind of management, would seem to be of similarly abstract character as the aforementioned inventory management, construction management dealing with works to be done, and having been done, by workers on construction sites could more realistically seem to be comparable with management of manufacturing processes. It would appear debatable whether management of such technical processes would still fall under "doing business" in the sense of Article 52(2)(c) EPC.

But, however this may be, according to the Appellant, Claims 1 and 2 have been restricted to financial and inventory management and, consequently, to the input items being debit, credit and commodity items, for the only reason of rendering the invention more easily understandable. The important point would not be the particular kinds of management mentioned but only that the managements are of different, "specific" types to be performed "independently" of each other; thus, for the claimed invention, it would not be important by what meaning the input items differ from each other, but only that their significance is governed by **different** types of management to be performed.

Moreover, for the specific features defining the particular way in which the different files are handled it would not make an essential difference whether the "managements" to be performed are managements in a narrow sense or activities in a wider sense, the only important point being that they are **different**.

The Board at this point sees no reason to question this view. It would normally appear debatable whether it is admissible to decide on the question of patentability of a claim without duly taking into account a feature restricting that claim; but in the present case, the outcome will not depend on an answer to this question, as will be apparent from subsequent considerations.

- 3.3 Proceeding now, from the said statement in the introductory phrase of Claims 1 and 2 regarding the application, or use, of the claimed system, to the more specific features claimed, these apparently define a mix of computer hardware, i.e. technical, and of "processing", i.e. functional, features. Clearly, these latter will be implemented by software (programs), excluded as such from patentability, like other (mostly non-technical) subject-matter or activities mentioned in Article 52(2), by that Article in conjunction with Article 52(3) EPC.

In accordance with the Boards' case law (cf. T 26/86 OJ 1988, page 19), such a mix may or may not be patentable. If, for instance, a non-patentable (e.g. mathematical, mental or business) method is implemented by running a program on a general-purpose computer, the fact alone that the computer consists of hardware does not render the method patentable if said hardware is

purely conventional and no technical contribution to that (computer) art is made by the implementation. However, if a contribution to that art can be found either in a technical problem (to be) solved, or in a technical effect achieved by the solution, said mix may be not excluded from patentability under Articles 52(2), (3) EPC, following T 38/86, OJ 1990, page 384.

In the Board's view the non-exclusion from patentability also applies to inventions, where technical considerations are to be made concerning the particulars of its implementation.

The very need for such technical considerations implies the occurrence of an (at least implicit) technical problem to be solved (Rule 27 EPC) and (at least implicit) technical features (Rule 29 EPC) solving that technical problem.

- 3.4 Dealing first with the pure hardware features mentioned in both claims, it is noted that a display unit, an input unit, a memory unit, a digital processing unit and an output unit are all parts of any conventional computer, and this is still the case if the memory unit includes a plurality of files of different information contents and the processing unit executes a plurality of processing steps so that it may be regarded as comprising a plurality of processing means.

What is not, in Claims 1 and 2, part of any conventional general-purpose computer is, apparently, the particular significance of all the different files in the memory and the manner in which, by the different

processing means or in the different processing steps, the input data and the data stored are handled.

It would thus appear that no hardware unit which as such would be novel from a technical point of view is contained in the system claimed as such (Claim 1) or in operation (Claim 2).

3.5 Turning, therefore, to the more specific functions defined (by way of means) in Claim 1 and (as steps) in Claim 2, the Board considers it appropriate to follow, for the time being, the Appellant's argument that, although the claims are restricted to at least financial and inventory management, the question of whether their subject-matter is of a technical nature should be answered on the basis that the types of management to be performed could, in principle, be of other kinds or even be activities in a wider sense than normally attributed to the term "management" (cf. point 3.2 above); i.e. what matters for the invention as claimed would be only that said managements, or activities, are independent of each other and of different types. More particularly, it is provisionally considered not to be relevant for this question that the first kind of input items, necessary for the first type of activity (management processing), are financial (debit and credit) items and that the second kind of input items, necessary for the second type of activity (management processing), is an inventory (commodity) item, but that the only thing that is relevant is that the first and second kinds of input item are different (in accordance with their necessity for the first and second type, respectively, of further processing).

Similarly, with respect to the question concerning the technical nature of the invention as claimed, the journalised daybook, item master, commodity master, journalised daybook accumulation and inventory files will provisionally be regarded somewhat "generalized" in the sense that

- the first of these files is intended for storing all data entered;
- the second and fourth of these files are intended for storing data necessary for, and obtained in, the first type of activity ("management"); and
- the third and fifth of said files are intended for storing data necessary for, and obtained in, the second type of activity ("management").

Likewise, the different processing means defined in Claim 1 and the steps defined in Claim 2 will, for the same reasons, provisionally be regarded somewhat "generalized" in the sense that

- the first processing means controls the display unit and the storing of all entered data in the first file;
- the second processing means updates the data stored in the second and third files using the data entered;
- the third processing means transfers the data updated in the second file to, and stores them in, the fourth file and relates them with data stored

therein for the purposes of the first type of management, or activity;

- the fourth processing means transfers the data updated in the third file to, and stores them in, the fifth file and relates them with data stored therein for the purposes of the second type of management, or activity; and
- the fifth processing means reads, and outputs, data necessary for a specific one of the two different types of activity ("management") to be performed with the respective format for that specific type of activity, or management.

3.6 Against claims so generalised in the Board's view, no objection that they relate only to "doing business" as such could be raised. In other words: in their generalised version as outlined above, the subject-matter of these claims would not be judged as being abstract or non-technical in the sense this is normally attributed to the subject-matter and activities excluded from patentability by Article 52(2) as such in accordance with Article 52(3) EPC. More particularly, the teaching to provide, in the memory, the aforementioned five files intended for different purposes (as outlined in point 3.5) and to cause the processing unit to perform the afore-mentioned five functions would clearly require technical considerations (in the sense mentioned under 3.3).

Still, the question remains what the effect of the *de facto* restriction of said first and second types of

management to financial and inventory ones on this finding is.

In the Board's view, by that restriction the subject-matter claimed only gains, in addition to the aspect, or component, i.e. the combination of features, which is not excluded as just outlined, a new aspect, or component, i.e. further feature(s), which as such would have to be regarded as being excluded from patentability. However, by this addition of a new component, or feature(s), non-technical as it may be, the afore-identified component found, as a technical component, not to be excluded from patentability, will not be reduced to zero but retained, at least implicitly, in the features of the subject-matter claimed.

The fact that the types of processing to be performed on the data files are specified, in the actual claims, more precisely than in the provisionally "generalized" claims should not change, in the Board's opinion, the claimed subject-matter from one which is not excluded to one which would be excluded from patentability. It follows from the afore-mentioned case law that subject-matter is not excluded from patentability if it involves, or implies, at least one aspect, or component, which is not excluded.

- 3.7 This view, that the claimed invention contains, at least implicitly, a technical component, is furthermore confirmed by the following considerations of the effects achieved by it:

The claimed system allows, by its operation, data necessary for one type of processing (in the form of files), particularly financial management, and data necessary for another type of processing (in the form of other files) particularly inventory management, to be performed independently, whereby each type of data may be relevant also for the respective other type of processing, to be input using a single, common form, called "transfer slip", displayed to the user.

The Appellant has argued that this transfer slip is a "user interface" requiring technical considerations of the person implementing the claimed invention. The Board agrees with this view, considering that said interface within the context of the whole of each of Claims 1 and 2 constitutes neither only presentation of information nor only computer programs (or programming) as such.

Presentation of information as such would be excluded from patentability by Article 52(2)(d) and (3) EPC but the presentation, in the claimed invention, of said "interface" in the form of said "transfer slip" is not governed only by the particular meaning of each of the information items displayed. Rather, it also implies that by it, in effect, two kinds of systems (here: management systems) having different purposes and implying independent activities (here: managements) are combined by a common input device (embracing the input unit, the display unit and the journalised daybook file), allowing each of the entered items necessary for use in one of said systems (to which the item master and journal daybook accumulation files belong) to be used, if required, also in the other (to which the

commodity master and inventory files belong), and vice versa.

Insofar as the implementation of a method by computer programs would imply that these programs must be provided by programming, it is noted that programming may be implied also in the subject-matter as presently claimed. Mere programming as such would, in the Board's view, also be excluded from patentability by virtue of the fact that it is an activity, which essentially involves mental acts excluded and, in addition, only results in computer programs which are also excluded from patentability by the same Article 52(2)(c) EPC. However, the implementation, in the claimed system and by the claimed method, of the said "interface" in the form of said "transfer slip" is not merely an act of programming but rather concerns a stage of activities involving technical considerations to be carried out before programming can start.

In this context, it may be noted that the programming aspect may have an impact on the question of sufficiency of disclosure (Article 83 EPC) but that in the present case it may be expected from a programmer to be able to implement the method to be performed, by a program given the way the steps of this method have been identified in the claims.

- 3.8 In the above considerations concerning the question whether the claimed invention makes a technical contribution to the art, or involves technical considerations for its implementation which may be regarded as resulting in a technical contribution to the art, any specific prior art (other than general

computer art, cf. point 3.4), for instance D1, has not been taken into account.

If this is done, however, nothing in the above considerations will effectively be changed.

D1 discloses a computer system for generating work orders for producing manufactured components. In this context (see, in particular, column 2, line 53 to column 3, line 3) it proposes to store, in the memory (20) of the computer (Figure 1), a number of files (cf. Figure 5), such as an inventory file, a job file, a bill of material file and the like. It is only with respect to the job file that it proposes to use a "single representation format" for all end item requirements. More specifically, according to this document, information defining actual customer orders, planned customer orders, and internal work orders are all stored in the job file in a "common format" by customer identification number and part number, followed by quantities and due data for the same part number. This computer system cannot therefore be said to perform **plural** types of **independent** management using a single **user interface in the form of a displayed transfer slip**. Where it refers to a single, common format for different items, this format is a storing format and not an input format and, moreover, the items stored in a single, common format are not items for different types of independent management but items of generally the same kind, viz. customer and internal work orders required for one and the same type of management, to be stored in one and the same file, viz. the job file. In contrast, in the claimed system, the common format used in the transfer slip of the input

unit will not, or not necessarily, be maintained throughout the further processing, in particular not in the journalised daybook accumulation and inventory files. When being outputted, the output format will be "predetermined" by the "specific type of management" to be performed.

It follows therefrom, that the considerations regarded above to be of a technical kind (cf. 3.6, 3.7) cannot be said to be anticipated by D1. Consequentially, those considerations are still to be regarded as indeed resulting in contributions made, by the claimed invention, "to the (computer) art".

3.9 The decision under appeal has come to a different conclusion by a different approach which may schematically be summarised as

- starting with a specific prior art (D1) and equating most of the features of the claimed subject-matter with what is known from that prior art,
- identifying only two features differing from D1,
- stating one of these differences as merely being implemented by a computer program, and
- stating the other as being presentation of information.

When dealing with the Applicant's counter-arguments, the Examining Division, *inter alia*, considered the

claimed use of a single transfer slip as merely being a matter of user-friendliness.

However, on the basis of what has been explained above (paragraphs 3.6 to 3.8), the Board cannot but dismiss the conclusions drawn in the decision under appeal.

- 3.10 In summary, the Board considers the implementation the system of Claim 1 and method of Claim 2 to involve technical considerations to be regarded as resulting in a technical contribution to the art within the meaning of the case law with the consequence that this system and method are held not to be excluded from patentability.

The Board therefore concludes that the invention as claimed in Claims 1 and 2 of the main request is to be considered as an invention within the meaning of Article 52(1) EPC.

4. *Final remarks*

- 4.1 It would follow already from the above considerations (point 3.8), that the claimed system and method are new against D1.

However, no further conclusion regarding novelty and inventive step has either been drawn by the Examining Division for the subject-matter then claimed or could directly be drawn from the considerations made, in the context of the issue of exclusion from patentability, in the appeal proceedings.

- 4.2 Page 3' (cf. point V) stating "the technical problem of the invention" is intended, according to the Appellant, to more accurately define the problem underlying the claimed invention than did the paragraph stating "an object of the present invention" in the section "Summary of the Invention" on page 3 of the description.

It is therefore understood by the Board as having been filed, in the oral proceedings, not only for the purposes of the oral discussion of the present case but also as a replacement paper for that paragraph. The Board interprets, consequently, the Appellant's main request as including the deletion of the last paragraph on page 3 filed on 4 August 1992 and its replacement by page 3'.

- 4.3 On 4 August 1992, the Appellant filed a new page 3a apparently intended to replace the last paragraph of the original page 3 stating what "according to the present invention, the foregoing object is attained by".

However, it is clear from the outset that by this replacement the statement referred to was not amended in accordance with Rule 27(1)(c) EPC.

Moreover, no amendment to the first and second paragraphs of page 4 was made. It is noted that the latter paragraph refers to claims which no longer exist.

- 4.4 Since, for the reasons explained before (points 3.1 to 3.10), the question to be decided in this case, i.e.

whether the subject-matter of the main request claims constitutes an invention within the meaning of Article 52(1) EPC, has been answered by the Board to the affirmative (point 3.10), any consideration of the auxiliary requests would be without object at this stage of the proceedings.

- 4.5 In these circumstances and in order to preserve the Appellant an opportunity to have the still outstanding issues judged upon in two instances, the Board thinks it appropriate to use its discretion under Article 111(1) and to remit the case to the first instance.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the application documents according to the Appellant's main request (cf. point V), having regard to the above final remarks (points 4.1 to 4.4).

The Registrar:

The Chairman:

M. Beer

P. K. J. van den Berg

