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D E C I S I O N
of 25 July 1997

Case Number: T 0410/96 - 3.5.1

Application Number: 89480094.5

Publication Number: 0349462

IPC: G06F 15/20

Language of the proceedings: EN

Title of invention:

Method of document definition utilizing a list directed
expression architecture

Applicant:

International Business Machines Corporation

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 84, 54
EPC R. 29

Keyword:

"Clarity of 'means for' in claim"
"Reference in a claim to another claim of a different category"

Decisions cited:

G 0006/88, T 0784/89, T 0026/86, T 0208/84

Catchword:



Europäisches
Patentamt

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Patent Office

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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0410/96 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 25 July 1997

Appellant: International Business Machines
Corporation
Old Orchard Road
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N. Y. 10504 (US)

Representative: Schuffenecker, Thierry
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 30 November 1995
refusing European patent application
No. 89 480 094.5 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
G. Davies

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division dated 30 November 1995 to refuse European patent application No. 89 480 094.5 on the ground that claim 6 did not define all the essential features of the invention (Articles 84 and Rules 29(1) and (3) EPC). Claims 1 to 5 were held to be allowable.

- II. On 16 January 1996 the appellant (applicant) lodged an appeal against the decision and paid the prescribed fee. On 5 April 1996 a statement of grounds of appeal was filed, with an alternative set of claims of an auxiliary request. A request for oral proceedings was also filed.

- III. Following a communication from the Board, which expressed the provisional view that the claims of the auxiliary request appeared to overcome the objections on which the decision under appeal was based, the appellant withdrew this request and maintained a request with a claim 6 which was substantially equivalent to that refused.

- IV. Oral proceedings were held on 25 July 1997. At the oral proceedings the appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution on the basis of claims 1 to 5, received with letter dated 17 July 1995 and claim 6, received on 18 April 1997. As an auxiliary request the applicant requested that a patent be granted on the basis of the same documents.

V. Claim 1 reads as follows (omitting reference signs):

"A method of defining the structure of a multi-element entity within a data stream, said method comprising data processing system implemented steps of:
creating a plurality of tabular specifications, each of said tabular specifications including a plurality of elements;
specifying once for each of said plurality of tabular specifications the logical relationship between all of said plurality of elements contained therein and at least one other element contained therein;
storing said specified logical relationship in association with each of said plurality of tabular specifications;
accessing said plurality of tabular specifications and said associated specified logical relationships utilizing a reference; and
defining the structure of a multi-element entity within a data stream by reference to said accessed plurality of tabular specifications and associated specified logical relationships."

Method claims 2 to 5 are dependent on claim 1.

Claim 6 reads as follows:

"Data processing system comprising means for carrying out the steps of the method according to anyone of the claims 1 to 5."

Claim 6 of the auxiliary request, now withdrawn, reads as follows:

"A data processing system for defining the structure of a multi-element entity within a data stream, comprising:

means for creating a plurality of tabular specifications, each of said tabular specifications including a plurality of elements;
means for specifying once for each of said plurality of tabular specifications the logical relationship between all of said plurality of elements contained therein and at least one other element contained therein;
means for storing said specified logical relationship in association with each of said plurality of tabular specifications;
means for accessing said plurality of tabular specifications and said associated specified logical relationships utilizing a reference; and
means for defining the structure of a multi-element entity within a data stream by reference to said accessed plurality of tabular specifications and associated specified logical relationships."

VI. The appellant argued as follows:

In the field of data processing many patents were granted with method claims. Patentees were however interested in enforcing rights against the sale of apparatus which could carry out a patented method. Given the variations in the law relating to contributory infringement in different countries, the best way of enforcing these rights was through apparatus claims. These claims usually repeated each of the steps of a method claim preceded by the expression "means for" as in the case of claim 6 of the auxiliary request, as withdrawn. This formulation was not concise, prone to error and expensive for the applicant. The appeal therefore concerned the allowability of claim 6 in a form which simply referred to the steps of the method claims. This was adequate to meet the requirements of Article 84 and Rule 29 EPC.

Moreover, the use of the expression "means for" did not extend the scope of the claim to cover any system suitable for carrying out the method, which might include many known systems, but only one capable of carrying out the steps specified in the preceding method claim or claims.

Reasons for the Decision

1. The appeal is admissible.
2. The Board is invited to approve a claim which is directed to a data processing system comprising **means for carrying out the steps** of any one of preceding method claims. The examining division refused the application on the ground that such a claim was an independent claim and must therefore define all the "essential features" of the invention, Article 84 and Rule 29(1) and (3) EPC, but failed to do so.
3. The method claims have themselves been approved by the examining division and the Board sees no reason to exercise its discretion under Article 114(1) EPC to reopen the matter.
4. Dealing first with the presence of method features in a claim directed to apparatus, the Enlarged Board has stated in G 6/88 ("BAYER/second non-medical indication", OJ EPO 1990, 114), point 2.2, that "there are no rigid lines of demarcation between the various possible forms of claim". One well-known example of apparatus in which method features are common is a general purpose computer, which prima facie must always

be lacking in novelty. It has in the past been argued that what is claimable is a new use for, or method of operating, the computer. The established jurisprudence of the boards of appeal, see e.g. T 208/84 ("Vicom", OJ EPO 1987, 14), and T 26/86 ("Koch and Sterzel", OJ EPO 1988, 19) is however that claims to a computer of known type, set up to operate according to a new program, must be assessed as a whole. Such a claim, even if directed to a computer or a data processing system, is in fact a hybrid claim to apparatus for carrying out certain specified method steps.

5. It is moreover established case law that if a method of processing data, comprising specified steps, is allowable, then a claim directed to a data processing system and including as integers explicit "means for" carrying out each of the specified steps is in principle allowable too. Claim 6 of the withdrawn auxiliary request (see point V above) illustrates this form of claiming. Claims of this type were allowed in T 784/89 (OJ EPO 1992, 438). The Board notes that according to the decision under appeal at page 6, paragraph 9.5 the examining division was apparently prepared to allow an independent claim of this form, "provided such claims would satisfy the requirements of the EPC". Such a claim is hereinafter referred to as the "long formulation".
6. It follows that claim integers of the "means plus function" type must be interpreted as requiring means **adapted** to carry out the given function as opposed to means **suitable for** carrying it out. The examining division was apparently of this opinion concerning the "means plus function" steps in the long formulation (see point V above).

7. Present claim 6, however, does not include as integers the explicit means for carrying out each processing step, but specifies only "means for carrying out the steps of the method according to anyone of claims 1 to 5". This is hereinafter referred to as the "short formulation".

8. The first question arising from the short formulation is whether it is permissible for a claim to a system to refer back to a claim to a method. Rule 29(4) EPC states that "any claim which includes all the features of any other claim (dependent claim) shall contain, if possible at the beginning, a reference to the other claim and then state the additional features which it is desired to protect". Although Rule 29(4) EPC mentions a reference only in the context of a claim including all the features of the claim it refers to, the Board takes the view that this does not imply a contrario that a reference which does not fulfil this condition is necessarily impermissible. In the present case the Board considers that claim 6 is in effect an independent claim which partially draws its features from preceding claims of a different category. It will be apparent from point 4 above that there is no a priori objection to such a hybrid claim under Article 84 EPC.

9. In the decision under appeal the examining division, having stated that claim 6 was an independent claim, argued that "According to Article 84 EPC, independent system claim 6 should contain all essential features of the invention in terms of apparatus features. Such was not the case, since the sole indication that the claimed system was 'for carrying out the method of claims 1 to 5' had to be construed as merely 'suitable for carrying out the method ...' (see Guidelines, C-III, 4.8) and could not dispense the applicant from specifying expressly the features of the system."

10. Rule 29(3) provides that an independent claim, i.e. "any claim stating the essential features of an invention" may be followed by one or more claims concerning particular embodiments of that invention. The Board however infers from the fact that the examining division considered method claims 1 to 5 allowable that they had already accepted that the "essential features" of the method of the invention were present in claim 1. Since these features are included by reference in claim 6, it follows that the claim also complies with Rule 29(3) EPC. It will be clear from the discussion at points 5 and 6 above that the Board considers that the means for carrying out the method steps incorporated in claim 6 must be adapted to do so, and not merely suitable.
11. Finally, since the system claim is directed to means for carrying out **the** steps of a method claim rather than merely steps in general it follows that all the steps of the method claim are included. It might be argued that such a claim leaves ambiguous the question of whether a single means carries out all the steps or whether respective means are provided; in the present case of a data processing system, in which all steps are carried out by the same instrumentality, the question is however academic.
12. The question of the extent of protection conferred by such a claim, i.e. of infringement, is a matter for national courts; the Board can take no position on the question of interest to the appellant, namely whether a claim to a data processing system including means for carrying out specified (method) steps covers the system in use, or the system with the specified steps in long-term storage (eg in a hard drive), or the system when sold with shrink-wrapped software for carrying out the steps.

13. The Board therefore concludes that, in the present case, neither the reference to the steps of the method claim, nor the use of the expression "means for ..." prevents the allowability of the form of present claim 6. Thus a claim in the form of the present claim 6 may, at least in principle, be allowable under Article 84 in combination with Rules 29(1) and (3) EPC.

14. The Board notes that the questions of whether claim 6 meets the requirements of Article 84 EPC as to clarity and support in the description and Article 123(2) as to added subject-matter (cf T 784/89, supra) have not yet been fully considered. In particular, it will be necessary to decide whether claim 6 as appended to claim 2 or 4, neither of which appears to include method steps, is clear. In order to preserve two instances the Board therefore considers it appropriate to remit the case to the examining division for examination to be completed.

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 claims 1 to 5, received with letter dated 17 July 1995 and claim 6, received on 18 April 1997.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg