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**Datasheet for the decision  
of 22 June 2012**

**Case Number:** T 1924/07 - 3.5.01

**Application Number:** 99309745.0

**Publication Number:** 1006468

**IPC:** G06F 17/40, G06F 17/60

**Language of the proceedings:** EN

**Title of invention:**

A method of and device for collecting and combining FA information

**Applicant:**

Bridgestone Corporation

**Headword:**

FA Information/BRIDGESTONE CORP.

**Relevant legal provisions:**

EPC Art. 123(2)  
EPC R. 103(1)(a)

**Keyword:**

Additional search - necessary (yes - technical features not notorious) - necessary for technical features acknowledged to be known in application (yes - search is basis for substantive examination)

Substantial procedural violation - no additional search, but substantive examination (yes - search manifestly necessary)

Added subject-matter - "two-step" process for setting data collecting conditions (no - inaccurate paraphrasing of claim)

**Decisions cited:**

T 0172/03, T 1242/04, T 0690/06, T 1515/07, T 1411/08,  
T 0698/11

**Catchword:**

An applicant's acknowledgement in the original application that certain prior art is known is in general not a sufficient reason for not carrying out an additional search (see point 9 of the reasons). The only condition under which an additional search can be dispensed with is where all the technical features of a claim correspond to notorious prior art (see point 10 of the reasons).



Case Number: T1924/07 - 3.5.01

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.01**  
**of 22 June 2012**

**Appellant:** Bridgestone Corporation  
(Applicant) 10-1, Kyobashi 1-chome,  
Chuo-ku  
Tokyo (JP)

**Representative:** Oxley, Robin John George  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted 11 July 2007  
refusing European patent application No.  
99309745.0 pursuant to Article 97(1) EPC 1973.**

**Composition of the Board:**

**Chairman:** S. Wibergh  
**Members:** W. Chandler  
P. Schmitz

## **Summary of Facts and Submissions**

- I. This appeal is against the decision of the examining division posted on 11 July 2007 to refuse the European patent application No. 99309745.0. It concerns collecting factory automation (FA) information generated at each step of a manufacturing process, in particular, information about abnormal conditions.
- II. The search division issued a declaration under Rule 45 EPC 1973 on the grounds that the claims related to subject-matter excluded from patentability and commonplace implementation features. The search division pointed out that a search might be carried out during examination should the problems be overcome.
- III. In a reply, the applicant argued that at least the apparatus claims should have been searched in the light of the recent change in practice at the EPO as reflected in the Guidelines.
- IV. In their three communications and decision, the examining division did not refer to excluded subject-matter, but raised substantive objections, mainly of lack of inventive step over the prior art cited in the description. The division refused the application on the ground that there was no basis in the original application for the "two-step" setting of the data collection conditions in amended claim 1 (Article 123(2) EPC). The objection of lack of inventive step was in a section entitled "Obiter Dicta".
- V. In the notice of appeal, dated 10 September 2007, the appellant requested amendment or cancellation of the decision under appeal. In the statement of grounds of appeal, dated 1 November 2007, the appellant re-

submitted the refused claims as the main request and filed a first to third auxiliary request corresponding, respectively, to the originally filed claims and successively limited claims filed during examination. The appellant requested that oral proceedings be appointed if the Board intended not to decide in the appellant's favour.

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

"An FA information collecting method for collecting work front information sent to a data transmission line (11,13,26), using a network, for use in an FA system (10) that manages plural steps for manufacturing a product, the method comprising

setting a data collecting condition on said network, to collect desired information from among the said work front information, and

managing data collection by collecting and storing, as measured data, desired information based on the data collecting condition from an information collecting end (18,19,20,21,22), characterized in that the method further comprises:

specifying another data collecting condition to detect abnormal information;

collating the measured data, with another data collecting condition thus specified;

collecting, when abnormal data deviated from said another data collecting condition is detected, data over a predetermined period going back from the point where said abnormal data was detected; and

transmitting the data over a predetermined period to the FA system."

## Reasons for the Decision

### *The application*

1. The opening part of the description as published states that manual collection of FA information (such as production amount, working information of machine tools, quality and failure [8]) has been automated [3]-[5]. Terminals (later referred to as "Agent" 21 - Figure 1 and [62]) collect information and send it over a network 11 to a shared server 19. This is said to work for routine tasks [6], but not for new situations [6] and/or when many users are accessing the data [10]. An improvement is to let users define the data they are interested in. This is done by setting conditions (later, "Mission" [61]) in a data collecting condition setting device (later, "View" [60]) and transmitting them to the data collection devices [11]. The amount of data collected and managed may become excessive and it is difficult to determine the time when the data was generated [12]. There is a related problem of monitoring abnormal information, such as plant malfunction and abnormal products [14], which can be overlooked in the midst of so much data [15].
2. Looking at Figure 4 (repeated in Figures 5 and 6), the contribution of the invention is essentially that when abnormal data, corresponding to a specified condition (e.g. data above or below specified values - Figure 5a [90]), is detected, the Agent collects data over a period from a given time before the detection of the abnormality onwards. This data is then transmitted to View [87]. Although the embodiment of Figure 6 talks about an abnormality in the trend of the data, the condition still appears to be a value exceeding a limit [93].

*Examination procedure*

3. In the present case, no search report was established on the grounds that the claims related to subject-matter excluded from patentability and commonplace implementation features. The examining division, however, never referred to excluded subject-matter, but raised substantive objections, for the most part that the claims (limited in each successive amendment) lacked inventive step over the prior art cited in the opening part of the description. The last amendments were found to have no basis in the original application and that was the ground for the refusal.
  
4. Thus the division essentially examined the application despite the fact that no search had been carried out. This is however only possible in exceptional cases. As set out in T 1242/04 - Provision of product-specific data/MAN (OJ EPO 2007, 421), the search is an essential element of the grant procedure, designed to identify prior art relevant to the application (point 8.2). The decision goes on to state (point 8.3) that a search can only be dispensed with under Rule 45 EPC 1973 (now Rule 63 EPC) if it is not possible to carry out a "meaningful" search. "Meaningful" relates to the practicability of the search and not to the potential relevance of the results in substantive examination. T 1242/04 also points out that features that the search division deems "trivial" do not prevent a meaningful search into the state of the art, which in fact ought to be particularly simple in such a case.
  
5. T 1242/04 also explains that an additional search may need to be carried out if an objection of lack of technical character raised at the search stage is not

maintained during subsequent proceedings. According to the jurisprudence of the boards, this may be dispensed with if the technical features of the claims are considered to be "notorious", i.e. generic and so well known that they cannot reasonably be refuted (see T 1411/08 - Pairing providers with consumers/IN-DEVELOPMENT, not published in OJ EPO, point 4). As set out above, the features in question are collecting factory automation information over a network from terminals at each step of a manufacturing process, setting data collection conditions over the network, including one for "abnormal" data, collecting and storing the measured data based on the conditions, and transmitting the data. In the Board's view these cannot be considered as "notorious". Thus an additional search would have been necessary before addressing inventive step.

6. When assessing inventive step, the examining division started from the prior art acknowledged by the applicant in the description. In several communications, including the summons to oral proceedings at point 3.5, but not in the decision, the examining division stated that they did not "contest" this state of the art and that therefore no further proof was required, referring to decision T 172/03 - Order management/RICOH (not published in OJ EPO) at point 18. However, the present Board notes that the features in question in case T 172/03, namely general purpose computers at different locations and connected by a communication network, although referred to as "common general knowledge as can, for instance, be seen from the prior art referred to by the appellant", were in fact notorious as defined above. Moreover, a search was actually performed in this case. The present case is thus not comparable to that in T 172/03.



7. Nevertheless, it is true that T 1242/04 (*supra*) also suggests at point 9.2 the idea that an additional search is not required if the features of the claim form part of the "common general knowledge", or are accepted by the applicant as known (criteria followed to various degrees in T 690/06 - Financial records/AUKOL, point 2 and T 1515/07 - Cost estimate/SAP, point 6, both not published in OJ EPO).
  
8. Concerning "common general knowledge", the present Board notes that its first use in point 9.2 of T 1242/04 is qualified with the term "undisputable" ("unstreitig" in the original German). The resultant meaning thus corresponds very closely to "notorious" as described above and, in practice, there will be little reason to distinguish between the two concepts. This is how the present Board understands the expression "common general knowledge" used in the decisions cited above.
  
9. Concerning the applicant's acknowledgement of prior art, the Board judges that, given the primacy of the search, which as T 1242/04 (*supra*) puts it at point 8.3, "is the basis for substantive examination...and not vice versa", an applicant's acknowledgement in the original application that certain prior art is known is in general not a sufficient reason for not carrying out an additional search since such statements may be - and indeed frequently are - withdrawn or qualified. Moreover, this could only apply in cases where *all* the technical features in the claim would be acknowledged as known. In the present case, the appellant did not acknowledge the features of specifying the second data collection condition for abnormal data and collecting and storing

- the measured data based on it, so that a search would need to be carried out for these features anyway.
10. In summary, therefore, in the present Board's view, the only condition under which an additional search can be dispensed with is where all the technical features of a claim correspond to notorious prior art.
  11. As to whether the examining division's course of action is a substantial procedural violation, the Board is guided by the existing jurisprudence on the matter. Essentially, this turns on whether the examining division acted despite realising that the features were technical and not notorious, thereby indicating a situation where a search was "manifestly necessary" (cf. T 1515/07 and T 1411/08, *supra*), or whether the features were erroneously overlooked or misjudged, i.e. an "error of judgement" (cf. T 690/06, *supra* and T 698/11 - Packaging specification/SAP, not published in OJ EPO).
  12. In the present case, it is clear from the above that the division had indeed recognised that at least some of the claim features were technical and not notorious and had not overlooked or misjudged them. In particular, the division had discussed the inventive step involved in adding a certain new "filter" to the acknowledged prior art by a database specialist (see the "Obiter Dicta" in the decision under appeal). As a result, the examining division must be held to have committed a substantial procedural violation in the sense of Rule 67 EPC 1973 by not performing an additional search that was manifestly necessary. It is therefore equitable to reimburse the appeal fee.

13. The Board thus remits the case to the examining division for further prosecution, starting with an additional search, which is the proper basis for the appellant to decide which amendments are necessary. Normally, the Board would make no assessment of any substantive issues. However, since in this case, the appellant has filed amendments in reply to the examining division's lack of inventive step objections and the final decision is based on them, the Board considers it expedient to review this decision.

*Added subject-matter - main request*

14. It is apparent from the impugned decision at point 2.4 that it is common ground that according to the application the Mission (information collecting condition), set by the user and sent from View to Agent, may also specify an abnormal condition to detect abnormal information. The Agent collects information according to the Mission, stores it and transmits it to View where it is analysed, e.g. by using spreadsheet software.
15. The examining division considered at point 2.1 of the decision that claim 1 defined this in two phases: setting a first condition for collecting the data and *subsequently* setting a second condition for the abnormality. The division considered that there was no basis in the application to support such a "two-step" method. The objection under Article 123(2) EPC raised in the summons was said to be still valid because of this. Firstly, however, the Board cannot see the link between the two objections. The previous objection was that there was no support for setting more than one data collecting condition at the same time. The claim was then limited to "another" condition i.e. the

abnormal data condition. Now the objection is that there is no support for setting this second condition in the "two-step" process. It thus appears to the Board that the previous objection does not actually apply anymore, but has been replaced with a different one. Such arguments are difficult to follow and review and, in the Board's view, are complicated by paraphrasing the claim, in this case to the "two-step" process.

16. Moreover, in the Board's view, the examining division's characterisation of the method as "two-step" is not what is actually claimed and is thus not what is to be looked for in the way of support. The Board therefore prefers to stick to the wording of the claim as the appellant did at page 3 of the grounds of appeal. What the relevant parts of the claim actually say is:

"setting a data collecting condition". This is the "Mission" discussed previously in the originally filed application and disclosed for example at page 19, lines 5 to 8 [84].

"specifying another data collecting condition to detect abnormal information". It is not disputed that such a condition is specified and is disclosed in particular at page 19, lines 10 to 12 [84]: "Moreover, the condition (...) to detect abnormal information is also specified by the Mission." In the Board's view, the use of the word "also" implies that this is an additional condition to the previous one. There is no mention in the claim of this being done "subsequently" and so in the Board's view this does not give rise to any "two-step" process with any timing implication, but simply that there are two different conditions.

"collating the measured data [with this condition]". This is disclosed almost verbatim at page 20, lines 3 to 4 [87].

"collecting, when [the second condition is met], data over a predetermined period going back from the point where the said abnormal data was detected". Although this feature is slightly strange in that the detection of the abnormal condition cannot actually be used to trigger collection of data prior to this point, the Board understands it to mean that the already stored data is "collected" as explained on page 20, lines 8 to 11 [87]. In any event, the claimed wording is disclosed on page 20, lines 4 to 7.

17. The Board therefore agrees with the appellant that all the features of claim 1 find support in the originally filed application so that the claim does not violate Article 123(2) EPC.
18. Since the Board has decided in the appellant's favour according to the appellant's request, oral proceedings are not necessary.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



T. Buschek

S. Wibergh

Decision electronically authenticated