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**Datasheet for the decision
of 7 November 2012**

Case Number: T 0982/08 - 3.5.06
Application Number: 00116824.4
Publication Number: 1089179
IPC: G06F 11/273, G07C 5/08
Language of the proceedings: EN

Title of invention:
Vehicle component diagnostic and update system

Patentee:
Eaton Corporation

Opponent:
Volvo Technology Corporation

Headword:
Logistic service system/EATON

Relevant legal provisions:
EPC Art. 123(2)
EPC R. 4(1), 134(1)
RPBA Art. 12(2), 13(1)

Relevant legal provisions (EPC 1973):
EPC Art. 100(a), 100(c)
EPC Art. 56

Keyword:
"Request for simultaneous translation - granted"
"Added subject-matter - no"
"Inventive step - no"



Case Number: T 0982/08 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 7 November 2012

Appellant I: Eaton Corporation
(Patent Proprietor) Eaton Center
1111 Superior Avenue
Cleveland, Ohio 44114-2584 (US)

Representative: Rüger, Barthelt & Abel
Webergasse 3
D-73728 Esslingen (DE)

Appellant II: Volvo Technology Corporation
(Opponent) S-405 08 Göteborg (SE)

Representative: Montevecchi, Emma
Cantaluppi & Partners S.r.l.
Piazzetta Cappellato Pedrocchi, 18
I-35122 Padova (IT)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
18 March 2008 concerning maintenance of
European patent No. 1089179 in amended form.

Composition of the Board:

Chairman: D. H. Rees
Members: G. Zucka
C. Heath

Summary of Facts and Submissions

- I. The appeals of appellant I (patent proprietor) and appellant II (opponent) are against the decision by the opposition division, with written reasons dispatched on 18 March 2008, to maintain the European patent with application number 00116824.4 in amended form. (For clarity the appellants will simply be referred to in the decision as the "proprietor" and "opponent" respectively.)
- II. A notice of appeal from the proprietor was received on 26 May 2008, the appeal fee being paid on the same day. A statement of the grounds of the appeal was received on 18 July 2008.
- III. The proprietor requested that the decision of the first instance be set aside and the patent be maintained in amended form on the basis of the claims filed with the grounds of the appeal. The proprietor made a conditional request for oral proceedings.
- IV. A notice of appeal from the opponent was received on 27 May 2008, the appeal fee being paid on the same day. A statement of the grounds of the appeal was received on 28 July 2008.
- V. The opponent requested that the decision of the first instance be set aside and the patent be revoked in its entirety. The opponent made a conditional request for oral proceedings.
- VI. The board issued a summons to oral proceedings, to take place on 07 November 2012. In an annex to the summons,

the board gave its provisional interpretation of some of the expressions in claim 1 and summarised the parties' arguments with respect to novelty and inventive step.

VII. In response to the summons, on 08 October 2012 (a Monday) the proprietor filed a new main request and auxiliary requests 1 and 2, replacing all previously filed requests. The proprietor announced that he would speak in German at the oral proceedings and requested simultaneous translation from English into German.

VIII. On 15 October 2012 the opponent requested simultaneous translation from German into English. With a further submission on 26 October 2012 the opponent filed two additional prior art documents, *i.e.* documents D8 and D9 mentioned below.

IX. Cited documents

The following documents were cited during the opposition procedure:

D1 = US 4 602 127 A
D2 = US 5 931 877 A
D3 = US 5 715 314 A
D4 = US 5 884 073 A
D5 = EP 0 671 631 A
D6 = Volvo publication TSI number 030-600 "VCADS Pro User's Manual" PV776-030-600 SM Publ. date 2.99
D7 = Volvo publication "Servicehandbok Lastvagnar" Grupp 03, Version 01 VCADS Pro Användarmanual TSP 29629, 1998

The following documents were cited by the opponent during the appeal procedure:

D8 = US 5 541 840 A

D9 = US 4 757 463 A

X. The proprietor requests that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the claims of the main request (claims 1 to 33), the auxiliary request 1 (claims 1 to 21) or the auxiliary request 2 (claims 1 to 21) as submitted with the telefax received on 8 October 2012. The proprietor further requests that documents D8 and D9 not be admitted into the proceedings.

XI. The opponent requests that the proprietor's new main and auxiliary requests not be admitted, the decision under appeal be set aside and the patent be revoked. The opponent further requests that no simultaneous translation at the expense of the European Patent Office be provided during the oral proceedings.

XII. Claim 1 of the proprietor's main request reads as follows:

"A logistic service system comprising:

 a re-programmable vehicle module (12);

 a local service computer (14) having servicing means (22, 64) providing diagnostic means (26) and update data component means (28);

 a central server (16);

 a first two-way data link (18) connecting said module (12) to said service computer (14) supporting diagnostics and updates;

a second data link (20) connecting said service computer (14) to said central server (16) and establishing a client-server interface (21) for allowing real-time transfer of information between said service computer (14) and server (16);

said diagnostic means (26) comprising:

means for retrieving one of a fault code (88) from said component module and isolated symptoms (112);

a diagnostics database (48) on said central server (16); and

a debugging scenario (90), said debugging scenario determined by a comparison (82) of at least one of said fault code (88) or said symptoms (112) with a corresponding fault code or said symptoms in said diagnostics database."

XIII. Claim 1 of the proprietor's auxiliary request 1 differs from claim 1 of the main request in that the logistic service system further comprises

"component information (50) associated with said module (12); said service computer (14) retrieving at least a portion of said component information by means of said first data link (18), and at least a sub-set of said component information being transmitted to said server (16) by means of said second data link (20)" and

"a component database (44) stored on said server (16); said component database being updated with said sub-set of said component information".

XIV. Claim 1 of the proprietor's auxiliary request 2 differs from claim 1 of the auxiliary request 1 in that the specification of the "debugging scenario" is amended to read as follows (addition in **bold**):

"...a debugging scenario (90), said debugging scenario determined by a comparison (82) of at least one of said fault code (88) or said symptoms (112) with a corresponding fault code or said symptoms in said diagnostics database **and also based on the component information stored in the component database.**"

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

Reasons for the decision

1. *Admissibility of the appeals*

In view of the facts set out at points I to V above, both appeals are admissible, since they comply with the EPC formal admissibility requirements.

2. *Simultaneous translation at the oral proceedings;
Rule 4 EPC*

The opponent argued that the proprietor's request for simultaneous translation was filed too late, on 8 October 2012, the oral proceedings having been scheduled for 7 November 2012. Although 7 October 2012 was a Sunday, the "extension of period" foreseen under Rule 134(1) EPC did not apply in the present case because there is no *time limit* that can be extended but

a *condition* that needs to be respected. The opponent's representative is a native Italian speaker who is not completely fluent in the language of the procedure (English). If the proprietor's representative were to have the possibility to speak and listen in German, with which he is more familiar than with English, both parties would not be playing on an even playing field. In addition, the opponent argued that simultaneous translation carries a risk of distorting the meaning of some of the translated arguments and that it would be better for her if she could hear those arguments without any such distortion.

The opponent further argued that, under Rule 4(1) EPC, the proprietor itself should have provided for interpretation given that it did not give notice within the indicated time frame that the representative would use a language different from the language of the proceedings. If the board enforced this condition, the proprietor would have a stronger incentive not to use a language different from the language of the proceedings, with the above indicated disadvantages for the opponent.

The board finds that it is not necessary to resolve the question whether the condition indicated in Rule 4(1) EPC was indeed respected by the proprietor in the present case. Even if it were to be assumed that the notice given by the proprietor was one day late, the last sentence of Rule 4(1) EPC gives discretion to the European Patent Office to permit a derogation from the provisions of the Rule, which it did in effect by default by making the arrangements for the simultaneous translation to take place, as requested by both parties,

without raising any question of costs. Although the disadvantages mentioned by the opponent may be real, they are inherent to a system that has three official languages and representatives having any of a great variety of native languages spoken in the EPC member states. Neither of these disadvantages should be taken into consideration when deciding whether a derogation as mentioned in Rule 4(1) should be permitted (assuming that such a derogation were indeed required).

Furthermore, the board takes the view that the board would not respect the principles of legal certainty and good faith if it first were to lead the party requesting a simultaneous translation to believe that the translation will take place and to prepare for the oral proceedings under that assumption, only for the board to decide at the start of the oral proceedings that there is to be no translation.

For these reasons, the board considers it not appropriate to grant the opponent's request not to provide simultaneous translation at the expense of the Office.

3. *Main request of the proprietor*

3.1 *Admissibility*

The opponent argued that changing the expression "diagnostic means **or** update data component means" in claim 1 of the main request to "diagnostic means **and** update data component means", for which a basis only exists in the original description, completely changed

the focus of the proceedings and should therefore not be admitted at this late stage of the procedure.

However, whatever the opponent's motivation, it has always argued, during both the opposition and the appeal proceedings, as if the claimed local service computer comprised both the "diagnostic means" and the "update data component means". The amendment can therefore not be considered so profound as to change the focus of the proceedings to such an extent that it would necessitate additional preparations by the opponent and thus cause a delay in the proceedings. The board also considers that the change from "or" to "and" is an appropriate response to the board's summons, where it is observed (in section 4) that the word "or" implies that there are two alternatives and that certain claimed features would not be limiting in one of these alternatives.

The opponent gave an additional reason for not admitting the proprietor's main request, viz. that the change from "or" to "and" constitutes an unallowable intermediate generalisation and therefore infringes Article 123(2) EPC. However, as set out under 3.2 below, the board considers that Article 123(2) has not been infringed, let alone that it would have been infringed *prima facie*, which would be a necessary requirement for not admitting the request.

The proprietor's main request is therefore admissible.

3.2 *Added subject-matter; Article 123(2) EPC*

The opponent argued that the passage cited by the proprietor in support of the change from "or" to "and" in claim 1 (paragraph [0012] of the application as published) "says that the services are not only diagnostics and component update, but also update service PC server data subset, parts procurement, etc etc" and that "There is no provision in claim 1 of these other characteristics which are listed in this paragraph deemed to be the basis for the amendment". Hence, the amendment constitutes an intermediate generalisation without a basis and infringes Article 123(2) EPC.

The board however judges that, although the cited passage indeed lists more services than diagnostics and component update, it is clear from the original application as a whole that these other services are not essential to the invention. For example, the paragraph on page 18, lines 1 to 7 in the original description only mentions diagnostics and update services. Also, in the passage entitled "summary of the invention" (page 2, line 7 - page 3, line 13), the word "improved" only appears in connection with the terms "diagnostic servicing", "component module updating" and "debugging or updating scenarios".

Thus claim 1 of the main request does not infringe Article 123(2) EPC.

3.3 *Inventive step; Article 56 EPC*

The board considers that D1 discloses a logistic service system ("vehicular diagnostic system") comprising:

a re-programmable vehicle module (the on-board computer 17; see D1, Fig. 1 and col. 7, lines 45 to 51);

a local service computer having servicing means (the portable communication station 12; col. 2, lines 31 to 34 and col. 6, line 7) providing diagnostic means (col. 7, lines 1 to 6: the provision which enables the data processing station operator to energise, de-energise or otherwise operate any electronically controlled device in the vehicle is obviously intended as diagnostic means; at the very least it is *usable* as diagnostic means, which is sufficient for it to fall within the definition of that term) and update data component means (it is evidently the means via which the reprogramming information of col. 7, lines 45 to 51 is input to the on-board computer from the remote processing station 14 - see Fig.1);

a central server (remote processing station 14; col. 3, line 42);

a first two-way data link (cable 22) connecting said module to said service computer supporting diagnostics and updates (col. 4, lines 14 to 19);

a second data link (telephone line 42, 54) connecting said service computer to said central server

and establishing a client-server interface (col. 4, lines 24 to 28 and 42 to 63) for allowing real-time (col. 2, lines 35 to 39) transfer of information between said service computer and server;

said diagnostic means comprising means for retrieving one of a fault code from said component module and isolated symptoms (col. 8, lines 25 to 28).

As is admitted by the opponent, table 1 itself is not a diagnostics database. The board also holds the view that the table does not *necessarily* imply the presence of such a database, at least not according to the usual definition of "database", since the table could, for example, be generated on the basis of a series of conditional branching statements in a program. However, given that the number of fault codes in D1 is likely to be rather high, the most straightforward possibility for the skilled person to implement the table of D1 would be by means of a database.

The "T codes" in the table of D1 correspond to the "fault codes" of claim 1 and it is also implicit from this table that these "T codes" are compared with corresponding fault codes in the diagnostics database, assuming that the table is implemented by means of a database, as indicated above. Further, as implied by the table and by the passage in column 7, lines 1 *sqg.* in D1, a skilled person would for example press the button F5 to operate the air switch solenoid as part of a debugging scenario. The energising of the solenoid could also be automatic, as part of a data analysis procedure (col. 7, lines 30 to 34).

According to the proprietor, an essential element of the invention is that the local service computer includes servicing means, which is not disclosed in D1, the rotary switch 68 mentioned in column 6, lines 30 to 34 being merely a switch, unable to carry out any diagnostics or updating by itself. However, the board notes that, although the wording "diagnostic mode" is used in that passage, it is not relevant for the inventive step assessment made above, where the switch 68 does not enter into the equation. Furthermore, claim 1 itself allows for at least one element used in the diagnostic process, viz. the diagnostic database, not to be part of the local service computer, so that the specification of "diagnostic means" and "update component means" as part of the "local service computer" cannot be interpreted as meaning that the local service computer necessarily supplies these services independently of the central server. It is clear that in D1 at least some diagnosis is carried out at the local device (see D1, figure 2, display 80 and slide switch 78, and col. 8, lines 55 and 56: "to select the parameter desired to be displayed").

For this reason, the board considers that the subject-matter of claim 1 of the proprietor's main request is obvious in view of a straightforward combination of the disclosure of D1 with common general knowledge. The request is therefore not allowable because of a lack of inventive step, Article 56 EPC.

4. *Auxiliary request 1 of the proprietor*

4.1 *Admissibility*

The proprietor explained that his auxiliary request 1 was identical to auxiliary request 1 that was the subject of the appealed decision, except for the same amendment to claim 1 that was also made in claim 1 of his main request. Since the request was already present at the opposition stage and the opponent had already had and used the opportunity to provide arguments against the request at that stage, the proprietor was of the opinion that the request could hardly be considered late filed.

The board notes that an appellant's case should be set out completely in his or her grounds of appeal (*cf.* Article 12(2) RPBA). Amendments to the appellant's case should normally only be made in the light of relevant new circumstances, such as new evidence or new arguments brought by an other party or by the board. The proprietor's new auxiliary request 1 was clearly not filed in view of such new circumstances but could already have been filed together with the grounds of the appeal. In addition, the request can not be considered a promising starting point for arriving at an allowable request in view of the reasons given in the appealed decision for not allowing the request on which the present auxiliary request 1 is based.

For these reasons, the board decides not to admit the auxiliary request 1 under Article 13(1) RPBA.

5. *Auxiliary request 2 of the proprietor*

5.1 *Admissibility*

The opponent argued that the introduction by the proprietor of the new auxiliary request 2 represents a significant change in the proprietor's case and should not be admitted at this late stage of the procedure.

The board points out that it has discretion under Article 13(1) RPBA to admit amendments to a party's case. Given that (1) the opponent has already had and used the opportunity both during the opposition proceedings and in the grounds of the appeal to give arguments against the request on which the proprietor's present auxiliary request 2 is based and (2) the board has already found the proprietor's main request and auxiliary request 1 to be respectively not allowable and not admissible, it would be unfair and disproportionate to deny the proprietor a chance to try and maintain the patent at least on the basis of a request that essentially corresponds to the request that had been maintained during the first instance proceedings, even if during the appeal procedure it was filed only about one month before the oral proceedings.

The request is therefore admissible.

5.2 *Added subject-matter; Article 123(2) EPC*

The opponent argued that claim 1 of the auxiliary request 2 contravenes Article 123(2) EPC, firstly for the same reason as claim 1 of the main request (replacement of "or" by "and") and secondly because the

added feature "and also based on the component information stored in the component database" constitutes an intermediate generalisation that is not supported by the original application documents. According to the opponent, the originally filed claims cited by the proprietor in support of this amendment (*i.e.* claims 21 and 22), as well as the corresponding passage in the original description (page 13, lines 4 to 7) consistently mention the component information stored in the component database as including historical information (or "present and past component information"). The "historical information" is therefore an essential feature of the invention. The absence of this feature in the amended claim 1 implies an unallowable intermediate generalisation.

In the board's view, claim 1 of auxiliary request 2 does not *prima facie* infringe Article 123(2) EPC. Whilst it would seem possible to attempt to argue such an infringement if one focuses solely on the passages mentioned by the opponent, the issue does not appear straightforward in view of the disclosure of the originally filed patent application as a whole and, given that this claim had effectively already been discussed during the first instance oral proceedings and the opponent had at that moment apparently agreed that Article 123(2) had not been infringed, according to item 21 in the minutes of those oral proceedings, the board considers the opponent's arguments, raised for the first time in its letter received on 26 October 2012, late filed in view of the complexity of the issue and does not admit the consequent change to the opponent's case under Article 13(1) RPBA.

5.3 *Inventive step; Article 56 EPC*

Compared to the subject-matter of claim 1 of the main request, claim 1 of the auxiliary request 2 contains the following additional features:

"component information (50) associated with said module (12); said service computer (14) retrieving at least a portion of said component information by means of said first data link (18), and at least a sub-set of said component information being transmitted to said server (16) by means of said second data link (20);

"a component database (44) stored on said server (16); said component database being updated with said sub-set of said component information;

...

...said debugging scenario determined...also based on the component information stored in the component database".

The board considers that a skilled person faced with the disclosure of D1 would naturally want to find the most suitable way of selecting diagnostic means that may lead to an effective debugging scenario. The proprietor argues that the skilled person would not combine the teaching of D1 and D2 for that purpose, given that the system in D2 is only described in detail in connection with military aircraft. In addition, the vehicle components in D2 are not re-programmable. In the board's view however, the fact that the components in D2 are not re-programmable as in D1, does not mean that the teaching of that document would not be useful for the skilled person or that the skilled person would

simply discard the document. Further, although the preferred embodiment in D2 is a maintenance system for aircraft and military weapons, the possibility of applying its teaching to, for example, automotive repair activities is explicitly mentioned in column 3, lines 56 to 60 and in column 10, lines 8 to 18. (It is also noted in passing that D1 is listed among the "References Cited" in D2.)

D2 discloses a logistic service system (equipment maintenance system 10) comprising a local service computer (Portable Maintenance Aid 12), which has a first two-way data link with a system (14) to be diagnosed/repaired and a second data link with a central server (central data warehouse 16, etc.).

A component database in D2 (maintenance database 20) contains recent as well as historical component information (see D2, col. 6, lines 38 *sqq.*), which is updated automatically (col. 6, lines 65 and 66). It is implicit from D2 that at least a portion of the component information is retrieved by means of the first data link and at least a sub-set of the component information is transmitted to the central server by means of the second data link.

Given the above-mentioned aim of the skilled person, *viz.* to find the most suitable way for selecting diagnostic means that may lead to an effective debugging scenario, he or she would, after combining the teaching of D1 and D2, also base the debugging scenario on the component information stored in the component database. Adding this to the above finding that the subject-matter of claim 1 of the main request

is not inventive in view of the disclosure of D1 and common general knowledge, the conclusion is that the skilled person would arrive at the subject-matter of claim 1 of the proprietor's auxiliary request 2 without the need for an inventive step.

The proprietor pointed out that, in D2, col. 6, lines 65 and 66, the data which is updated in the maintenance database is different from the historical performance data mentioned on col. 6, lines 38 *sqq.* The latter, which is not specific for the component that is being serviced but based on the fault symptoms that typically occur in components of the given type, is not automatically entered into the database by the maintenance system, whereas the former is data that comes from service activity reports, *i.e.* data such as serial number and type of component, which would be of no use in a debugging scenario which, as in claim 1, is based on a comparison of fault codes. However, the board judges that the wording of claim 1 leaves open the possibility that the component information used for the debugging scenario is different from the sub-set of component information which is transmitted to the server earlier in the claim. Moreover the information retrieved by means of the first data link (*i.e.* from the vehicle) does not even have to be among the data transferred to the server, as the claim is worded. The proprietor's argument is therefore not a valid one. The board also points out that according to the description of the published patent (paragraph 28), the information that is updated in the component database is not only related to the performance of the components but also includes "tracking and identification information", *i.e.* the kind of information that would typically be

included in a maintenance report rather than in a failure analysis.

The board therefore considers that the subject-matter of claim 1 of the proprietor's auxiliary request 2 is not inventive.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees