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Datasheet for the decision
of 4 July 2017

Case Number:	T 1817/14 - 3.5.06
Application Number:	11751562.7
Publication Number:	2441033
IPC:	G06N5/04, G06F17/30
Language of the proceedings:	EN

Title of invention:
THE FSTP EXPERT SYSTEM

Applicant:
Sigram Schindler Beteiligungsgesellschaft mbH

Headword:
Expert system/SCHINDLER

Relevant legal provisions:
EPC Art. 56, 69, 84
EPC R. 111(2), 137(3)
RPBA Art. 11

Keyword:

Fundamental procedural deficiency - yes (non-admitted request not mentioned in the decision)
Special reasons for not remitting the case - yes (missing reasons contained in the minutes)
Relationship between Articles 69 and 84 EPC
Referral of questions to the Enlarged Board - no
Inventive step - no (all requests)

Decisions cited:

T 0860/93, T 0049/99, T 0641/00, T 0556/02, T 0061/03, T 0820/14

Catchword:

Case Number: T 1817/14 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 4 July 2017

Appellant: (Applicant)	Sigram Schindler Beteiligungsgesellschaft mbH Ernst-Reuter-Platz 8 10587 Berlin (DE)
Representative:	adares Patent- und Rechtsanwälte Reininger & Partner GmbB Tauentzienstraße 7 b/c 10789 Berlin (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 17 April 2014 refusing European patent application No. 11751562.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	W. Sekretaruk
Members:	M. Müller
	S. Krischer

Summary of Facts and Submissions

I.   The appeal lies against the decision of the examining
       division, with reasons dispatched on 17 April 2014, to
       refuse European patent application No. 11 751 562.7 for
       lack of clarity of the main and first auxiliary
       requests, Article 84 EPC. In a section entitled "Obiter
       dicta" it is added that claim 1 of the main request
       lacks inventive step, Article 56 EPC, over a
       conventional database. A second auxiliary request filed
       during the oral proceedings before the examining
       division and annexed to the minutes of the oral pro-
       ceedings was not admitted pursuant to Rule 137(3) EPC.

II.   Notice of appeal was filed on 4 June 2014, the appeal
       fee being paid on the same day. A statement of grounds
       of appeal was received on 27 August 2014. The appellant
       requested that the decision under appeal be set aside
       and that a patent be granted on the basis of the main
       or the auxiliary request "of the appealed decision",
       and as re-filed with the grounds of appeal, or on the
       basis of the second auxiliary request as attached to
       the grounds of appeal, or that the case be remitted to
       the examining division for further prosecution. The
       application documents are as follows:

       claims
        1-10 as filed on 7 August 2013 and re-filed on
              27 August 2014 (main request)
        1-8   as filed on 3 March 2004 and re-filed on
              27 August 2014 (first auxiliary request)
        1-6   as filed on 27 August 2014 (2nd auxiliary
              request)
       description pages 1-69 as originally filed
       drawings sheets 1-17 as originally filed

The appellant argued that it had been a substantial procedural violation for the examining division not to mention the second auxiliary request in the decision. However, it did not request immediate remittal of the case to the examining division, but only if the board was not minded to grant any of the pending requests (see grounds of appeal, section II). The appellant also challenged the clarity objections of the examining division because they had been raised without due consideration of Article 69 EPC.

III.   In an annex to a summons to oral proceedings, the board informed the appellant of its preliminary opinion that the claims were unclear, Article 84 EPC, and their subject-matter lacked inventive step over common knowledge in the art, Article 56 EPC.

IV.   In response to the summons, with letter dated 6 June 2017, the appellant provided further arguments on the relation between, on the one hand, Article 84 EPC and, on the other hand, either Article 69 EPC or a "general principle of law" relating to claim interpretation. It also suggested that the board was departing from established jurisprudence of the boards of appeal and invited it to refer questions to the Enlarged Board of Appeal, without however proposing specific questions for referral.

V.   Oral proceedings took place as scheduled on 4 July 2017, at the end of which the chairman announced the board's decision.

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

        "A method for analyzing of a patent's or any other endeavor's claim (and the technical teaching TT.p

underlying it) over at least one document.i (and the
technical teaching TT.i underlying it), PTR denoting
the set of information that includes a) the technical
teaching (TT.p) to be analyzed and b) the technical
teachings (TT.i) of the at least one document.i,
whereby a technical teaching (TT) identifies
-    A, B, C, D, ... as the elements of the technical
     teaching (TT.p) to be analyzed,
-    A.i, B.i, C.i, D.i, ... as the peer elements in the
     TT.i's (of document.i, i=1,2,3,...) to these TT.p
     elements, and
-    X).n, X.i).n as the fundamental facts of these
     elements X/X.i=A/A.i, B/B.i, C/C.i,...,
     n=1,2,3,...,
whereby the user of this method interacts with this
method's application by a computer system,
whereby this application
     - repeatedly reads information from, writes it
       into, copies it to, or transforms it from/to/
       within this computer system's various memory
       sections via their various interfaces during
       executing the steps (a)-(e),
whereby this information comprises items of a
-    first kind, given by the user, comprising
     information identifying or describing at least one
     item of the PTR or one law of nature or one
     National Patent System, which are input to the
     computer system by the user, and a
-    second kind, the below (a)-(d), which are generated
     by the execution of this method's steps (a)-(c),
     and
whereby applying this method comprises at least once
executing any one of the steps (a)-(d) of compiling
(a) as (a)-item at least one first kind item into at
     least one technical fundamental fact of the TT.p or
     a TT.i,

(b) as (b)-item at least one TT.i technical fundamental
    fact disclosing its peer TT.p fundamental fact,

(c) as (c)-item at least one combination of technical
    fundamental facts of TT.i's that may disclose or
    suggest TT.p, and

(d) inputting all such second kind items into this
    information and defining all interrelations - as
    directed by the user - between all items in the
    information, wherein such defining of
    interrelations includes that the (a)-(c)-items are
    processed to form an ANC (ANC = anticipates/not-
    anticipates-and-not-contradicts/contradicts)
    Matrix, wherein the ANC defines the relation
    between X.i).n's and X).n's, such that

a query for any item in regard to the information of
the technical teaching is replied to / answered by this
method automatically and instantly by displaying to the
user this item's information and all its such
interrelations to other items (i.e. presentation of
these data)."

Claim 1 of the first auxiliary request reads as
follows:

"A method for analyzing the technical teaching TT.p
claimed in a patent's or patent application's claim
over at least one document. (and the technical teaching
TT.i it discloses), PTR denoting the set of information
that includes a) the technical teaching (TT.p) to be
analyzed and b) the technical teachings (TT.i) of the
at least one document.i,
whereby a formal description of a PTR identifies
–   A, B, C, D, ... as the elements of the technical
    teaching (TT.p) of the claim to be analyzed,

- A.i, B.i, C.i, D.i,... as the corresponding
  elements in the TT.i's (of document.i, i=1,2,3,...)
  to these TT.p elements, and
- X).n, X.i).n as properties/attributes of these
  elements X/X.i=A/A.i, B/B.i, C/C.i,...,
  n=1,2,3,...,

whereby the user of this method interacts with a
computer system in that the user

- repeatedly reads information from, writes it into,
  copies it to, or transforms it from/to/within this
  computer system's various memory sections via their
  various interfaces during executing the steps
  (a)-(d),

whereby this information comprises items of a

- first informal kind, given by the user, comprising
  natural language information identifying or
  describing at least one item of the PTR which are
  input to the computer system by the user, and a
- second formal kind, the below (a)-(c),

whereby applying this method comprises at least once
executing any one of the steps (a)-(d)

(a) of compiling as (a)-item at least one first kind
    item into at least one formal description of the
    first kind item in the form of a property/attribute
    of an element of the TT.p or a TT.i,

(b) of compiling as (b)-item at least one property/
    attribute of an element of a TT.i that corresponds
    to the property/attribute of an element of the
    TT.p,

(c) of compiling as (c)-item at least one combination
    of properties/attributes of elements of TT.i's that
    may disclose properties/attriburtes of TT.p
    elements, and

(d) of inputting all such second kind items into this
    information and defining all relations - as
    directed by the user - between all items in the

information, wherein such defining of relations
includes that the (a)-(c)-items are processed to
form an ANC (ANC = anticipates/not-anticipates-and-
not-contradicts/contradicts) Matrix, wherein the
ANC Matrix defines the relation between X.i).n's
and X).n's in that it identifies in a Matrix for
each property/attribute X).n of all elements X of
TT.p if the TT.i's disclose elements X.i that
contain properties/attributes X.i).n that
anticipate, not anticipate or contradict said
properties/attributes X).n, such that a query for
any item in regard to the information of the
technical teaching is replied to / answered by this
method automatically and instantly by displaying to
the user this item's information and all its such
interrelations to other items."

Claim 1 of the second auxiliary request reads as
follows:

"A method for analyzing the technical teaching TT.p
claimed in a patent's or patent application's claim
over at least one document.i (and the technical
teaching TT.i it discloses), PTR denoting the set of
information that includes a) the technical teaching
(TT.p) to be analyzed and b) the technical teachings
(TT.i) of the at least one document.i,
whereby a formal description of a PTR identifies
-   A, B, C, D, ... as the elements of the technical
    teaching (TT.p) of the claim to be analyzed,
-   A.i, B.i, C.i, D.i,... as the corresponding
    elements in the TT.i's (of document.i, i=1,2,3,...)
    to these TT.p elements, and
-   X).n, X.i).n as properties/attributes of these
    elements X/X.i=AIA.i, B/B.i, C/C.i,...,
    n=1,2,3,...,

whereby the user of this method interacts with a
computer system in that the user
- repeatedly reads information from, writes it into,
  copies it to, or transforms it from/to/within this
  computer system's various memory sections via their
  various interfaces during executing the steps (a)-
  (d),
whereby this information comprises items of a
- first informal kind, given by the user, comprising
  natural language information identifying or
  describing at least one item of the PTR which are
  input to the computer system by the user, and a
- second formal kind, the below (a)-(c),
whereby applying this method comprises at least once
          executing every one of the steps (a)-(d) of
(a) as (a)-item, compiling by the user at least one
    first kind item into at least one formal
    description of the first kind item in the form of a
    property/attribute of an element of the TT.p or a
    TT.i,
(b) as (b)-item, compiling by the user at least one
    property/attribute of an element of a TT.i that
    corresponds to the property/attribute of an element
    of the TT.p ,
(c) as (c)-item, compiling by the user at least one
    combination of properties/attributes of elements of
    TT.i's that may disclose properties/attributes of
    TT.p elements, and
(d) of inputting by the user all such second kind items
    into this information and defining all relations -
    as directed by the user - between all items in the
    information, wherein such defining of relations
    includes that the (a)-(c)-items are processed to
    form an ANC (ANC = anticipates/not-anticipates-and-
    not-contradicts/contradicts) Matrix, wherein the
    ANC Matrix defines, in any entry item, the relation

between X.i).n's and X).n's provided by the user by
identifying whether a X.i).n anticipates, not
anticipates or contradicts the corresponding X).n,
such that

a query for any (a)-item, (b)-item, (c)-item or matrix
entry item is replied to / answered by this method
automatically and instantly by displaying to the user
this item's information and all its such relations to
other items."

All three requests also comprise an independent
apparatus claim corresponding closely to method
claim 1.

Reasons for the Decision

The alleged procedural violation, Article 11 RPBA

1.   During the oral proceedings before the examining
        division, a set of claims according to a second
        auxiliary request was filed but not admitted (see the
        minutes, points 74, 80 and 90). However, the decision
        under appeal does not mention the existence of a second
        auxiliary request, let alone give reasons why it was
        not admitted.

1.1   The decision of the examining division to refuse
        consent to (i.e. not to admit) a set of amended
        claims under Rule 137(3) EPC is a decision which,
        according to Rule 111(2) EPC, must be reasoned.
        Therefore, the fact that the second auxiliary request
        is not mentioned in the decision under appeal makes
        the decision insufficiently reasoned and thus

constitutes a fundamental deficiency in the sense of
Article 11 RPBA.

1.2   However, as is clear from the minutes (and not disputed
        by the appellant), the appellant was heard on the
        admission of the second auxiliary request, and the
        claims themselves are annexed to the minutes. Also, the
        reasons missing from the decision are available in the
        minutes.

1.3   Therefore, the appellant was in a position to
        understand the examining division's reasons for not
        admitting the second auxiliary request, and to respond
        to them in its grounds of appeal.

1.4   The board considered these circumstances, along with
        the appellant's express agreement to the board
        considering the substantive merit of the requests to
        hand (see grounds of appeal, section II, last
        sentence), to constitute special reasons for not
        immediately remitting the case to the examining
        division under Article 11 RPBA.

Admission of auxiliary requests

2.   The examining division had discretion under Rule 137(3)
        EPC to refuse consent to the second auxiliary request,
        and the board has no reason to doubt that it exercised
        its discretion correctly. This and Article 12(4) RPBA
        notwithstanding, however, the board exercises its own
        discretion and admits the second auxiliary request into
        the appeal proceedings (see T 820/14, reasons 10). It
        is also relevant in this respect that the board finds
        all requests to lack inventive step for the same
        reasons (see below).

The invention

3.   The application relates to an expert system for aiding
        patent administration and jurisprudence by providing
        (semi-)automated support for assessing a patent or
        patent application (or other "endeavour") for novelty
        and inventive step in view of "a national patent system
        or its Highest court precedents" (see page 1,
        lines 1-5; see also page 3, penultimate paragraph;
        sections I.K and I.L on pages 26-28; page 29,
        paragraph 2; section II.A.1.2, page 37, towards the
        bottom *et seq.;* and page 47, footnote "To F:").

3.1   In a nutshell, the invention proposes to obtain from a
        patent (or patent application) p and any prior art
        document i elements of their respective technical
        teachings TT.p and TT.i. These may be specified
        informally, e.g. in natural language (see the
        "technical fundamental informal facts", page 2, in the
        middle), or formally ("technical fundamental formal
        facts"). The TT.i's of the prior-art document i are
        collectively referred to as "RS" (reference set) and,
        in combination with the TT.p's, as "PTR" (pair of TT.p
        and RS; see page 2, in the middle).

3.2   The elements and their "relations", expressing
        anticipation and contradiction between elements or sets
        of elements, are arranged in what is called an ANC
        matrix ("anticipates/non-ants/contradicts"; see e.g.
        page 3, line 9, and figure 2b).

3.3   The information in this matrix can be queried by and is
        then displayed to the user (see e.g. original claim 1,
        last two lines).

The prior art

4.   The remarks on inventive step given in the decision
        refer to a prior-art document but do not rely on many
        individual features of its disclosure. As is explained
        below, the board takes the view that the merits of the
        present invention can be assessed without reference to
        an individual piece of prior art.

The decision under appeal

5.   The decision finds the claims of the main and first
        auxiliary requests to be unclear, due to several terms
        with unclear meaning such as the "technical teaching"
        and its "elements", the notions of "fundamental facts"
        and "kinds", and the "ANC matrix" (reasons 10.1), and
        several further problems including the facts that the
        method of claim 1 is specified as one of "analysing"
        although an analysis step is missing from the claim
        (see reasons 10.6 and 16.4), that the possible queries
        are not properly defined (see reasons 10.13), and that
        it is unclear what the computer actually does and how
        the ANC matrix is used in this context (see esp.
        reasons 10.11, 10.12 and 16.5).

Articles 69 and 84 EPC

6.   The appellant contested all clarity objections.

6.1   It reasoned *inter alia* that the examining division had
        failed to interpret the claims in the light of the
        patent specification as a whole, as required by
        Article 69 EPC. Applying Article 69 EPC in examination
        was necessary to ensure that the same claim
        interpretation was considered when an examining
        division assessed patentability and when a court

determined the extent of protection of a claim (see the grounds of appeal, section III.1, page 2, last paragraph, to page 3, paragraph 2).

6.2   Alternatively, the appellant argued that it was a general principle of law that claims had to be interpreted in the light of the specification (see the appellant's letter of 6 June 2017, page 2, paragraph 2).

7.   The board takes the following view.

7.1   Article 84 EPC concerns the European *patent application*. It stipulates *inter alia* that the claims shall be clear and concise and be supported by the description.

7.2   Article 69 EPC relates to the extent of protection conferred by a European patent or a European patent application, and stipulates in its paragraph 1 that this is determined by the claims, which in turn are to be interpreted in view of the description and drawings. Its paragraph 2 further explains that the extent of protection of a European patent application is determined retroactively by the extent of protection of the European patent, on the implicit condition that a patent is granted at all. As regards procedures before the EPO, the EPC refers to the extent of protection only once, namely in Article 123(3) EPC which provides that the European *patent* may not be amended in such a way as to extend the protection it confers. Therefore, Article 69 EPC does not apply *per se* to the examination procedure.

7.3   The board does agree, however, that, as a matter of
        principle, a patent claim cannot be interpreted in
        isolation but rather that reference may have to be made
        to the patent specification (see the same letter,
        page 2, paragraph 2, the paragraph bridging pages 2
        and 3, and page 3, paragraph 3). In this regard, the
        board agrees with the decisions of the boards of appeal
        cited by the appellant, and specifically with the
        statements in T 860/93 (reasons 5.7) and T 556/02
        (reasons 5.3) according to which "the positive
        requirement of Article 69(1) EPC" applies also in
        examination, and with that in T 61/03 (reasons 4.2)
        according to which a patent application "may be its own
        dictionary".

7.4   By virtue of Article 84 EPC, an examining division can
        and shall examine the clarity of the claims before it.
        A clarity objection obliges the applicant to consider
        amending the claims in the light of the patent
        specification. That is, even if it is possible to
        interpret a claim in the light of the patent
        specification, Article 84 EPC may oblige the applicant
        to make that interpretation explicit in the claim
        language.

7.5   When a claim has been clarified, it becomes easier and
        more predictable to determine its scope in examination
        (e.g. when assessing inventive step) or its extent of
        protection in post-grant procedures (according to
        Article 69 EPC). In the board's view, this is a main
        purpose of Article 84 EPC.

8.   In view of the foregoing the board concludes that it is
        normally not sufficient for overcoming a clarity

objection to indicate that the claim can be interpreted in the light of the description.

9.   The board also rejects the appellant's proposal to refer questions to the Enlarged Board of Appeal under Article 112(1)(a) EPC. Firstly, the board considers its position to be in line with the cited jurisprudence, so no decision from the Enlarged Board of Appeal is required in order to ensure uniform application of the law (see the appellant's letter of 6 June 2017, page 3, last paragraph). Secondly, for the purposes of this decision, the board has adopted a claim interpretation that was not challenged by the appellant, and has decided the present case on the basis of inventive step rather than clarity (see below). Thus, questions relating to Article 84 EPC (and, for instance, its relationship to Article 69 EPC) need not be addressed in the present decision.

10.   The clarity of the claims to hand and in particular the clarity issues the board raised in its summons to oral proceedings are therefore left open.

Claim construction

11.   In the annex to the summons to oral proceedings, the board summarised its understanding of the claimed subject-matter and, thus, how it intended to interpret the claims in order to assess its inventive merit. This analysis was not challenged by the appellant either in writing or in the oral proceedings.

12.   The claimed method (according to claim 1 of all requests) has two phases. The first phase leads to the creation of the ANC matrix which, in the second phase,

is used to "automatically and instantly" produce
responses to user queries.

12.1   The major part of the first phase is done by the user.
Especially the generation of the ANC is under user
control. Only the processing of user queries is meant
to be automated. This is consistent with the
appellant's summary of the situation given in the
grounds of appeal (see page 7, paragraph 1).

12.2   More specifically, the user

-    inputs the "technical teaching" TT.p underlying a
patent (or such like) and that of the prior-art
documents TT.i in terms of their "elements" and the
"fundamental facts of these elements",
-    identifies which elements in TT.p and TT.i
correspond to each other and thus are "peer
elements",
-    selects and defines "information identifying or
describing at least one item of the PTR or one law
of nature or one National Patent System", and
-    defines "all interrelations", especially which
elements are anticipated or rendered obvious by
other elements or groups of elements.

12.3   Moreover, the method claim refers to "compiling", based
on user-input "first-kind items", a number of so-called
(a)- to (c)-items and "inputting" these "second-kind
items" into the computer and "process[ing]" them "to
form an ANC" (see steps (a) to (d) in claim 1 of all
requests).

12.4   Although the term "compiling" has a specific meaning in
the field of computer programming, it also has the
conventional non-technical meaning of "collecting" and

"assembling". In the board's understanding, the latter meaning applies to the claims in suit. In oral proceedings, the appellant did not challenge this interpretation. Accordingly, the claim is construed as specifying that the items mentioned are "compiled" and input by the user and "processed to form an ANC" under user control.

Technical effects and inventive step

13.   In view of the foregoing, the board concludes that the major part of claim 1 (of all requests) is a modelling procedure during which the user considers the items in the domain of interest (comprising, specifically, the patent/patent application and the documents being compared, the laws of nature and the items of a national patent system), extracts their relevant properties (elements, facts, relations), and "compiles" them "into" a formal language.

13.1   Following T 49/99, the board considers this procedure of information modelling to be an intellectual activity (effectively a method for performing mental acts, Article 52(2)(c) EPC) which does not, *per se*, contribute to the technical character of an invention). For this conclusion it is immaterial that the present application does not even relate to the modelling (let alone simulation) of a physical system but to the modelling of what a given set of documents discloses and how they relate to each other.

13.2   Accordingly, a technical contribution of the present invention could only lie in the way in which the generation and use of the model are implemented.

13.3   In the oral proceedings, the appellant essentially
        argued that particular features of the ANC data
        structure had to be considered to be technical. It
        stressed in particular that the ANC had to reflect the
        analysis of documents in terms of two different levels
        of granularity ("elements" and "fundamental facts of
        these elements") and that it contained novel fields
        (e.g. "anticipates/not-anticipates-and-not-contradicts/
        contradicts" as claimed).

13.4   However, the appellant did not argue that (or explain
        in what way) the particular ANC data structure had a
        specific technical advantage for the subsequent query
        processing. It was thus unable to convince the board
        that the modelling steps caused any technical effect.
        When, however, the modelling steps are assumed to be
        taken as an aim to be achieved in a non-technical field
        - according to established jurisprudence of the boards
        of appeal (see T 641/00, headnote 2) - the form of the
        ANC is determined by the model and thus obvious.

14.   The computer support specified in claim 1 of all
        requests (see claim 1, lines 9-11 and 13) does not, in
        the board's judgement, go beyond the general statement
        that a computer is used to support the users in their
        task. Likewise, the feature that users may query the
        "items" in the ANC and the method replies
        "automatically and instantly by displaying to the user
        this item's information and all its such relations to
        other items" does not, in the board's judgement, go
        beyond the statement that the information in the ANC
        may be accessed by user queries, as is known from
        prior-art database systems.

14.1   The board considers that the above assessment applies
        to all three requests alike, and the appellant

confirmed during oral proceedings that, in this regard, the auxiliary requests did not raise new issues.

14.2   The board thus concludes that claim 1 of all requests lacks inventive step in view of common knowledge, as an obvious way of providing computer support to an essentially non-technical method, Article 56 EPC.

Rule 103(1)(a) EPC

15.   The appeal fee cannot be reimbursed because the appeal is dismissed. It can therefore be left open whether the above-mentioned deficiency of the decision under appeal is a substantial procedural violation that would have made a reimbursement equitable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

B. Atienza Vivancos   W. Sekretaruk

Decision electronically authenticated