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**Datasheet for the decision
of 8 July 2021**

Case Number: T 0824/18 - 3.4.03

Application Number: 10737463.9

Publication Number: 2553664

IPC: G07F9/00

Language of the proceedings: EN

Title of invention:

METHOD AND APPARATUS FOR CONTROLLING AND MONITORING A VENDING
MACHINE

Applicant:

Felique, Pascal

Headword:

Relevant legal provisions:

EPC Art. 123(2)
RPBA 2020 Art. 13

Keyword:

Amendments - extension beyond the content of the application
as filed (yes) - not admitted - do not overcome outstanding
objections

Decisions cited:

Catchword:



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Case Number: T 0824/18 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 8 July 2021

Appellant: Felique, Pascal
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 17 November 2017 refusing European patent application No. 10737463.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman T. Häusser
Members: M. Papastefanou
T. Bokor

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division refusing the European patent application No. 10 737 463 (published as WO 2011/120104 A1).

In the decision under appeal, the examining division, exercising its discretion under Rule 137(3) EPC, did not admit the applicant's Main Request and Auxiliary Request 1 into the proceedings. The application was refused under Article 113(2) EPC because the application did not contain any claims submitted or agreed to by the applicant and admitted by the examining division.

II. At the end of the oral proceedings before the board, which were held as a video conference at the request of the appellant, the appellant (applicant) requested that the impugned decision be set aside and that a patent be granted on the basis of a sole request consisting of the following application documents:

- claims 1 to 60 submitted by telefax dated 7 June 2021;
- description, pages 1 to 38 as originally filed and published, with amendments to the description as filed with the telefax dated 7 June 2021;
- drawings, Figures 1 to 7 as published.

III. Claim 1 has the following wording:

*An apparatus to control and/or monitor a vending machine, said vending machine comprising:
a vending machine controller board;
a microcontroller (A);
a vending software program running on said*

*microcontroller (A);
an interface between said microcontroller (A) and said
vending machine controller board;
an interface between said vending machine controller
board and said vending machine,*

*said apparatus comprising:
a microprocessor (B) or a host computer;
a debug circuit;
an interface between said microprocessor (B) or said
host computer and said debug circuit;
an interface between said debug circuit and said
microcontroller (A),*

*said vending software program controls/and or [sic]
monitors said vending machine during normal operation
and/or during service mode operation,*

*said vending software program controls and/or monitors
status information, and/or configuration data, and/or
one or more events, and/or one or more activities, in
said vending machine, during normal operation and/or
during service mode operation,*

*said apparatus controls and/or monitors said vending
machine from said microprocessor (B) or said host
computer, through said debug circuit, during normal
operation and/or during service mode operation,*

*said debug circuit controls and/or monitors said status
information, and/or said configuration data, and/or
said one or more events, and/or said one or more
activities, in said vending machine, during normal
operation and/or during service mode operation,*

said apparatus controls and/or monitors said vending

software program from said microprocessor (B) or said host computer, through said debug circuit, during normal operation and/or during service mode operation, by controlling and/or monitoring the same said status information, and/or the same said configuration data, and/or the same said one or more events, and/or the same said one or more activities, in said vending machine, as said vending software program, during normal operation and/or during service mode operation,

said apparatus implements and/or uses a software application programming interface (API) library for said vending machine,

said software application programming interface (API) library is implemented on said microprocessor (B) or said host computer, and/or said debug circuit, and/or said microcontroller (A),

said software application programming interface (API) library provides one or more software API functions to control and/or monitor said status information, and/or said configuration data, and/or said one or more events, and/or said one or more activities, in said vending machine, during normal operation and/or during service mode operation.

- IV. The appellant argued essentially that all the embodiments described in the application comprised a debug circuit. The specific implementation of the debug circuit of the claimed apparatus was not important and the skilled person would know how to implement such a debug circuit based on common general knowledge. The embodiments in the application were to be understood as examples of possible implementations.

The appellant's arguments are dealt with in detail in the following reasons for the decision.

Reasons for the Decision

1. The appeal is admissible.
2. The invention

The invention relates to an apparatus for controlling and monitoring a vending machine.

A vending machine normally comprises a central processor which is installed on a vending machine controller (VMC) board. This processor (controller) controls and monitors the functions and activities of the vending machine such as monitoring the user interface and recognising user actions, monitoring inventory, communicating with distant payment systems to carry out payments etc. (see page 1, lines 19 to 28 of the application as published).

As technology advances, it is often desired to upgrade/modernise existing vending machines by modifying their functionalities or adding new ones. Conventionally, for such an upgrade it is necessary to replace the central controller and the whole VMC board, something that is costly and cumbersome (*ibid.*, page 3, lines 20 to 38).

- 2.1 The application proposes an apparatus that can be added to the existing VMC board of a vending machine (a "retro-fit kit"; *ibid.*, page 15, lines 11 to 14) and which only replaces the existing central processor/microcontroller with another one. In this way the new microcontroller can use the existing memories, connections and software of the VMC board without the

need for extensive replacement of parts and software in the vending machine (*ibid.*, page 9, lines 24 to 37 and page 11, lines 23 to 36).

2.2 The application describes five different embodiments of the proposed apparatus, all of which are based on in-circuit emulation techniques (*ibid.*, page 12, line 13 to page 13, line 16 for an overview of the different embodiments).

3. The procedure before the examining division

3.1 In his letter of 7 June 2021 the appellant alleged for the first time that the examining division had committed errors in the way it exercised its discretion when deciding not to admit the amended claims (see page 3). The appellant repeated these allegations during the oral proceedings before the board.

The board notes that the claims, which had not been admitted by the examining division, were replaced by the appellant in advance of the oral proceedings before the board and, hence, the question of whether the examining division exercised its discretion correctly does not appear decisive for the present decision. For the sake of completeness, however, the board addresses these objections of the appellant.

3.2 The issue of added subject-matter had been raised from the beginning of the examination of the application in the regional phase before the EPO (see point 4 of the examining division's communication of 8 June 2016). The issue was raised again in the annex to the summons to the oral proceedings before the examining division (see point 4).

After the receipt of the summons to the oral proceedings, the appellant (then applicant) filed an amended set of claims with the letter of 31 August 2017. In a telephone conversation with the applicant, the first examiner explained on behalf of the examining division that *prima facie* the amendments did not overcome existing objections but rather introduced new ones. The examiner warned the applicant that the division might use its discretion under Rule 137(3) EPC and not admit the amendments into the procedure. The examiner further explained briefly the division's objections (see minutes of telephone consultation dated 29 September 2017).

During the oral proceedings, the objections concerning added subject-matter and lack of clarity were discussed and the examining division, exercising its discretion under Rule 137(3) EPC, decided not to admit the then Main Request into the proceedings. An auxiliary request filed during the oral proceedings (former Auxiliary Request 1) was also found not to address the outstanding objections and was not admitted by the examining division, either (see points 1 and 2 of the Reasons of the impugned decision).

- 3.3 It is established case law and practice that, on appeal against a decision taken by a department of first instance (e.g. an examining division) in exercise of its discretion, it is not for the board to review all the facts and circumstances of the case as if it were in that department's place and decide whether or not it would have exercised the discretion in the same way. If the EPC permits that a department of first instance exercises discretion in certain circumstances, that department should have a certain degree of freedom to do so without interference from the boards. The boards

should overrule the way in which it exercised its discretion in reaching a decision in a particular case only if they conclude that it did so in accordance with the wrong principles, without taking the right principles into account or in an arbitrary or unreasonable way (see *Case Law of the Boards of Appeal of the EPO*, 9th Edition, July 2019, section V.A.3.5.1 b)).

- 3.4 The first allegation of the appellant was that the examining division had come "unprepared" to the oral proceedings and that "[i]t was obvious that the examining division had not taken the time and effort to review the detailed arguments in the Response on August 31st, 2017" (first paragraph on page 3 of appellant's letter of 7 June 2021).

The board notes that, in general, the deciding organ (e.g. examining division or board) is obliged to consider the arguments of the parties which are relevant to the decision for the right to be heard to be respected (Article 113(1) EPC).

In the present case, the decision was based on the question of the admission of the amended claims filed on 31 August 2017 (former Main Request) and during oral proceedings before the examining division (former Auxiliary Request 1). A crucial issue for both requests was added subject-matter. Taking the minutes of the oral proceedings and the written decision into consideration, the board concludes that the examining division considered all the applicant's arguments related to added subject-matter. Moreover, since the examining division concluded that the amendments still contained added subject-matter and decided not to admit them into the proceedings, it did not need to consider

any other of the remaining arguments of the applicant, which related to other aspects, such as inventive step.

As to whether the examining division came unprepared to the oral proceedings, the board notes that the division presented the appellant a proposal for a claim, which it considered to fulfill the requirements of the EPC (see minutes of the oral proceedings before the examining division, point 5). The board regards this as a clear indication that the examining division had studied the application, the prior art and the applicant's arguments in depth, not only in relation to the question of added subject-matter but also in relation to the other EPC requirements, in particular inventive step and the related question of the advantages of the invention over the prior art.

3.5 In the board's view, the other points raised on page 3 of the appellant's letter of 7 June 2021 relate to aspects of the examining division's interpretation and assessment of the claims to which the appellant does not agree. The board considers these points to relate to substantive questions rather than to the way the examining examining division exercised its discretion and does not see them as indications of any error committed by the examining division.

3.6 The board notes further, that the examining division explained to the appellant (then applicant) in advance of the oral proceedings the criteria for the exercise of its discretion when deciding on the admission of the amended requests (see point 3.1 of the minutes of telephone consultation dated 29 September 2017). These criteria were provided:

- "Do the amendments overcome previously existing objections?"

- "Do the amendments prima fasciae [sic] not lead to new objections?"
- "Are the amendments not in conflict with the EPO's interest in bringing the examination to a close?"

These criteria were then consequently followed when reaching the decision not to admit the requests (see point 1.1 of the grounds of the impugned decision).

- 3.6.1 The board notes that these criteria are in line with the Guidelines for Examination valid at that time (see Guidelines for Examination at the EPO, November 2016, H II-2.3 and 2.7). The examining division, thus, followed established practice in exercising its discretion.
- 3.7 The board's conclusion is that the examining division exercised its discretion in reaching the decision not to admit the amended requests taking the right principles into account and does not see any errors committed.
- 4. Main Request - admission
 - 4.1 The newly filed request of the appellant constitutes an amendment to the appellant's case, which is to be admitted at the discretion of the board. Moreover, since it was filed after the summons to oral proceedings were issued, the appellant has to establish the existence of exceptional circumstances that justify such a late filing of the request (Articles 13(1) and 13(2) Rules of Procedure of the Boards of Appeal - "RPBA 2020").
 - 4.2 Regarding the exceptional circumstances, the appellant explained that it was waiting for the outcome of a

parallel procedure before the USPTO because it wanted to submit the same claims which had led to the grant of a corresponding US Patent. It was legitimate to aim at having the same claims granted in Europe and the USA.

The board notes that the present proceedings are separate and independent from the proceedings before the USPTO, which are governed by other laws and may well be based on other prior art documents. The filing of a new set of claims at a very late stage of the proceedings cannot be justified by the recent outcome of the US proceedings. Hence, exceptional circumstances within the meaning of Article 13(2) RPBA 2020 cannot be recognised in the present case.

4.3 Furthermore, according to established case law and practice, when exercising its discretion under Article 13(2) RPBA 2020 in order to decide on the admission of an amendments of a party's case, the board may also consider the criteria of Article 13(1) RPBA 2020. One of these criteria is whether the amendments address successfully the outstanding issues. The board considers that in the present case, it is appropriate to take this criterion into account for the exercise of its discretion as the primary criterion. The question is thus whether or not the submitted amendments overcome the objections of added subject-matter.

4.4 In the decision under appeal, the examining division was of the opinion that claim 1 of the Main Request then on file defined a generalisation of the claimed apparatus which had no basis in the application as originally filed (see points 1.1.3.1 and 1.1.3.2 of the Reasons).

4.4.1 In essence, claim 1 of the Main Request then on file contained a generalised definition of the claimed apparatus in an apparent effort to combine all the embodiments described in the application. This was also confirmed by the appellant (see, for example, page 23 of the statement of the grounds of the appeal). The originally filed claims comprised only separate independent claims for each embodiment (claims 1 to 5 as originally filed).

4.4.2 Compared to claim 1 of the Main Request before the examining division, claim 1 of the current request comprises the same generalised definitions and, in addition, a series of features relating to functions of the vending control program, the debug circuit and the apparatus in general (see point III above).

4.5 One of the points of discussion during appeal was the definition in claim 1 that the claimed apparatus comprised "a debug circuit".

4.5.1 The originally filed application does not provide any general definition or description of a "debug circuit". The drawing of the appellant representing a "generalised embodiment" (see statement of grounds of appeal, page 24 and appellant's letter of 7 June 2021, page 29) is not included in the application.

The application describes five different specific ways (in corresponding embodiments) to implement an apparatus including a circuit that could be understood as a "debug circuit" (see for example page 13, line 18 to page 15, line 9 of the published application). This is also reflected in Figures 3 to 7, which represent the five different embodiments of the apparatus. There is no generalised embodiment of the apparatus described

or suggested in the application. There is no generally defined "debug circuit" in the application, but five specific embodiments that implement a debug circuit/logic. Furthermore, the application describes repeatedly the five different embodiments of the claimed apparatus but does not indicate or suggest at all that (any of) these embodiments may be combined in any way.

The generic term "debug circuit" in claim 1, however, leaves open how this debug circuit is to be implemented. In the board's view, therefore, the term "debug circuit" encompasses further/other possible implementations of such a circuit (and the corresponding apparatus), which were not envisaged in the originally filed application. This amounts to an intermediate generalisation, which is not supported by the content of the application as originally filed.

- 4.5.2 The appellant explained that the main concept behind the claimed invention was the use of a debug circuit during normal operation of the vending machine. Debugging took place normally during production or service operation and not during normal operation of a controller/processor. The debug circuit of the claimed apparatus intercepted the communication of the microcontroller of the vending machine and the various parts of the vending machine, allowing thus to enhance the operation of the vending machine by introducing functionalities which were not previously implemented in the machine.

The described embodiments had all in common that the apparatus comprised a debug circuit to control and/or monitor the vending machine. The specific implementation of the debug circuit was not important;

what was important was its use during normal operation of the vending machine. The skilled person was free to implement the debug circuit as they saw fit, based on their common general knowledge. The specific embodiments described in the application were to be understood only as examples. The skilled person could even use existing debug circuits (e.g. from the market), as long as they implemented them for use during the normal operation of the vending machine.

Moreover, the new claim 1 provided the necessary limitations to the generic term "debug circuit" as it defined specific functions of the vending software program, the claimed apparatus, and the debug circuit. It was thus not true that a generic debug circuit was claimed.

4.5.3 The board is not persuaded by these arguments of the appellant.

As a first point, it is noted that the defined functions of the debug circuit (and the vending software program and the apparatus) are not limited to the normal operation of the vending machine. Claim 1 repeatedly defines that the listed functions are active "during normal operation and/or during service mode operation". Hence, even if the main concept behind the invention was the use of a debug circuit during normal operation of the vending machine as the appellant argued, the invention defined in claim 1 is not limited to that. A debug circuit operating only during service mode is also covered by the claim.

As a second point, it is generally reminded that according to established case law and practice, the criterion for determining whether an amendment complies

with the requirements of Article 123(2) EPC is whether a skilled person would derive such an amendment *directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed* (the so-called "gold standard"; see also *Case Law of the Boards of Appeal of the EPO*, 9th Edition, July 2019, section II.E.1.3.1). According to Article 123(2) EPC, the content of the application at the moment of filing sets the limits of what can be claimed during the subsequent grant procedure, including any opposition and appeal procedures. This aims to establish legal certainty for the public. Even if any finally granted claims are not known at the moment of filing, by studying the content of the application as originally filed any third party can have an idea of the limits of the scope of protection which the granted patent will finally confer. The applicant, therefore, although they can amend the application during prosecution, they cannot add information (subject-matter) which was not included or at least suggested (according to the "gold standard") at the moment of filing.

In the present case, although the board agrees with the appellant that all described embodiments comprise a debug circuit, the application does not describe or suggest any generalised embodiment comprising a generic "debug circuit". The skilled person reading the application as originally filed would only get information of five different possible implementations (embodiments) of such a debug circuit within the claimed apparatus but no indication about a generalised "debug circuit" as such. The generic term "debug circuit" in the claim covers other possible implementations beyond those described in the

originally filed application. The skilled person may have been aware of other implementations of a debug circuit based on common general knowledge, but the application does not provide any indication that any implementation of the debug circuit other than those described is to be used in the context of the described apparatus and to be considered as part of the invention.

The board, thus, concludes that the term "debug circuit" in claim 1 constitutes added subject-matter in the sense of Article 123(2) EPC.

- 4.6 The same applies also to the multiple occurrences of the term "interface" in claim 1. The claim defines an interface between microcontroller (A) and the VMC board, an interface between the VMC board and the vending machine, as well as interfaces between the microprocessor (B) or host computer and the debug circuit and between the debug circuit and the microcontroller (A).

However, there is no interface in the originally filed application that is defined generally or generically. Rather, in each embodiment of the invention the application describes in detail how the various parts are connected to each other and how they communicate with each other (see for example pages 19 to 35 of the description of the published application).

In the board's opinion, therefore, the term "interface" constitutes a further generalisation, which has no basis in the originally filed application.

- 4.7 The board notes also that the description states repeatedly and explicitly that in all the embodiments

of the invention the integration takes place at the processor level of the VMC board and in that the original VMC board is not replaced, but only the original microcontroller of the VMC is replaced (see for example, page 10, lines 5 to 7; page 11, lines 34 to 36 or page 15, lines 11 to 14 of the published application).

Such a definition is, however, absent from claim 1 introducing a further unsupported generalisation.

- 4.7.1 The same applies to the use of in-circuit emulation techniques. According to the description all embodiments use in-circuit emulation techniques (*ibid.*, page 4, lines 1 to 3 or page 12, line 13 to page 13, line 16, for example).

Claim 1, however, does not contain any reference to emulation, something that constitutes yet another generalisation, which does not find support in the originally filed application.

The appellant's argument that emulation was not necessary because the described embodiments presented only examples of possible implementations did not convince the board for the same reasons as for the "debug circuit" (see point 4.5.3 above).

- 4.8 The appellant also made reference to the passage on page 38, lines 7 to 25 of the application as basis for the amendments. According the appellant, this passage supported an abstraction (generalisation) of the hardware and software implementation, providing the necessary support to the generalisations in claim 1.

4.8.1 The board is not convinced by this argument. The board rather shares the opinion of the examining division that this passage cannot support the generalisation of the claimed apparatus. The cited passage does not disclose any concrete technical teaching in relation to the described apparatus but only general statements that other, undefined implementations may be used.

In the board's view, the skilled person could not derive, directly and unambiguously, from the general statements of this passage the generalised embodiment of claim 1 (see also *Case Law of the Boards of Appeal of the EPO*, 9th Edition, July 2019, section II.E.1.8.1).

The same applies to the hardware and software equivalents the appellant referred to in the statement of the grounds of appeal (see pages 26 to 34) and his letter of 7 June 2021 (see pages 31 to 34). There is no such reference to or suggestion of any equivalents in the application as originally filed. In the board's opinion such equivalents are not supported by the originally filed application, in accordance with the "gold standard".

4.8.2 Finally, the board notes also that the passages on pages 6 and 7 of the application referred to by the appellant (see pages 28 and 30 of the statement of the grounds of appeal) seem to relate to the description of background technology and not to the description of the claimed apparatus. Hence, they are not suitable for providing a basis of the amended claims.

4.9 The board concludes, thus, that the amendments in claim 1 of the request on file do not overcome the outstanding objections regarding to added subject-

matter (Article 123(2) EPC).

Exercising its discretion under Article 13(2) RPBA 2020 the board decides, thus, not to admit the request filed with the appellant's letter of 7 June 2021 into the proceedings.

5. Since there is no allowable request on file, the appeal has to be dismissed.

6. Right to be heard

6.1 At the end of the oral proceedings before the board the appellant complained that the board had not considered all his arguments, especially those submitted with his letter of 7 June 2021. The appellant complained that the board, following the same approach as the examining division, was rejecting his request using "one-line reasons", without any real examination of the arguments presented. The board did not respect the time and effort put by the appellant into preparing his response to the impugned decision and the board's preliminary opinion. The appellant insisted on a written response to each and every argument presented (see paragraph bridging pages 3 and 4 of the minutes of the oral proceedings).

6.2 Although the board is of the view that this complaint of the appellant does not constitute a formal objection under Rule 106 EPC, an allegation of ignoring (some of) the appellant's arguments is understood as an allegation of violation of the appellant's right to be heard. The board considers thus appropriate to address these complaints.

- 6.3 According to Article 113(1) EPC, *the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments*. It is established case law that the right to be heard requires that parties not only have a right to present their comments (on the facts and considerations pertinent to the decision) but also to have those comments considered and reviewed with respect to their relevance for the decision (see *Case Law of the Boards of Appeal of the EPO*, 9th Edition, July 2019, section III.B.2.4.1 and 2.4.2). In other words, in order to respect the appellant's right to be heard, all its arguments, which are considered pertinent to the decision, have to be considered and responded to. The decision must "demonstrably show that arguments were heard and considered".
- 6.4 It is also established case law that the deciding organ (e.g. examining division or board) does not need to consider each and every argument of the parties in detail. In particular, arguments that are considered irrelevant for the decision may be disregarded (see *Case Law of the Boards of Appeal of the EPO*, 9th Edition, July 2019, section III.B.2.4.1 and 2.4.3 as well as V.B.4.3.10).
- 6.5 As a final general comment, it is evident that as soon as a request (claim set) violates only one of the provisions of the EPC it has to be held not allowable. In such a case it is not necessary to discuss whether the request fulfills the remaining requirements of the EPC because, even if the request fulfilled all the remaining requirements of the EPC, it would still not be allowable, irrespective of the amount of work put

into it.

6.6 In the present case, it is assessed whether the request submitted by the appellant on 7 June 2021 is admitted into the proceedings under Article 13(2) RPBA 2020, considering in particular whether the amendments successfully address the outstanding issues concerning the requirements of Article 123(2) EPC. As presented under point 4 above in detail, the board considered the relevant arguments of the appellant and responded to them appropriately. Taking into account the appellant's submissions in the statement of the grounds of the appeal, his letter of 7 June 2021, and during the oral proceedings, the board is convinced that, in reaching its conclusion that the request should not be admitted into the proceedings as claim 1 of this request does not overcome the objections under Article 123(2) EPC, it has taken into consideration all the relevant arguments of the appellant.

6.7 The appellant provided several other arguments, both in the statement of the grounds of appeal and in his letter of 7 June 2021, as well as during the oral proceedings before the board. In the board's view, these arguments went beyond the discussion about added subject-matter as they related to other aspects of the application and the claimed invention, such as possible applications of the claimed apparatus, its advantages over the prior art, etc.

6.8 Since, however, the decision is taken on the basis of the question whether or not the present sole request is admitted into the proceedings under Article 13(2) RPBA 2020, considering in particular whether claim 1 comprises added subject-matter, the board does not consider those arguments of the appellant to be

pertinent for the present decision.

Based on these considerations, the board does not see itself obliged to respond to those arguments of the appellant.

6.9 Summarising, the board is satisfied that it has taken the appellant's arguments that are pertinent to the decision into consideration and that the appellant's right to be heard has been respected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

T. Häusser

Decision electronically authenticated