BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Publication in the Official Journal ~~Yes~~ / No

File Number: T 80/90 - 3.5.1

Application No.: 81 302 478.3

Publication No.: 0 041 406

Title of invention: Component identification in computer system

Classification:

D E C I S I O N
of 28 January 1991

Applicant:

Proprietor of the patent: Honeywell Inc.

Opponent: Siemens AG

Headword:

EPC Articles 56, 114(2)

Keyword: "Inventive step (yes)"
"Late-filed documents"

Headnote

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number : T 80/90 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal
of 28 January 1991

Appellant : (Opponent)
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Representative :

Respondent : (Proprietor of the patent)
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Representative :
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Decision under appeal :
Interlocutory decision of the Opposition Division of the European Patent Office dated 20 November 1989 concerning maintenance of European Patent No. 0 041 406 in amended form.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : A. Clelland
C. Holtz

Summary of Facts and Submissions

I. European patent No. 0 041 406 was granted on patent application No. 81 302 478.3, filed on 4 June 1981 and claiming the priority of an application in the United States dated 4 June 1980.

Notice of grant was published on 13 May 1987.

II. On 15 February 1988 the Opponent (Appellant) filed an admissible Notice of Opposition, requesting revocation of the patent on the ground that its subject-matter was not patentable having regard to the provisions of Articles 52 and 56 EPC. The Opponent based his submissions on DE-A-2 328 058, hereinafter referred to as D1.

III. In a submission received on 8 December 1988 the Patentee (Respondent) filed amendments to the patent and in particular to Claim 1. He requested maintenance of the patent in amended form.

IV. By a decision dated 20 November 1989 the Opposition Division rejected the opposition and maintained the patent in the amended form requested by the Patentee.

V. On 17 January 1990 the Appellant filed a Notice of Appeal and paid the appeal fee. A written statement setting out the grounds of appeal was filed on 30 March 1990. The Appellant requested that the contested decision be set aside and the patent revoked in its entirety.

VI. In a letter received on 27 July 1990 the Respondent requested that the patent be maintained in the amended form and that the appeal be dismissed.

VII. In a submission received on 20 December 1990, in response to a communication from the Board, the Appellant introduced into the proceedings a further document, US-A-3 735 106, hereinafter referred to as D2. It was argued that the subject-matter of Claim 1 lacked an inventive step in view of the disclosure of this document.

VIII. Oral proceedings were held before the Board on 28 January 1991.

In the course of these proceedings the Respondent modified his request and asked that the patent be maintained on the basis of a modified Claim 1 filed in the course of the oral proceedings. He argued that the revised claim met the requirements of the EPC. He furthermore requested that the Board refuse to admit document D2 to the proceedings since it was not submitted in due time by the Appellant and constituted a fresh ground of opposition.

IX. The patent now consists of the following documents:

Description: column 1, lines 1 to 43 (up to and including the word "is") as granted;
column 2, line 17 (after the word "inserted") to line 65 as granted;
column 5, lines 1 to 12 as granted;
page 2 and columns 3, 4 as filed at the oral proceedings.

Claims: Claims 1 to 6 (part) as filed at the oral proceedings,
Claims 6 (part), 7 as granted.

Drawings: Sheets 1, 2 as granted.

X. Claim 1 as filed at the oral proceedings reads as follows:

"A computer system having a computer and a plurality of components making up said system, annotation means for annotating technical changes in any of said components, characterised in that the annotation means comprise:

a coding section (30, 40, 50) included in each component for establishing a code word, identifying the revision status of the component, which is manually changeable in accordance with instructions for manually revising the physical layout or state of the component and of the coding section, thereby concurrently manually changing the code word to correspond to revisions to said component, said code word being changeable with a difficulty of the same order of magnitude as the corresponding revision to said component; and addressing means (54; 60, 62) addressable by the computer to enable the computer to interrogate the component for its revision status."

XI. The Appellant argued that D2 should be admitted to the proceedings because the document formed part of the prior art cited in the European Search Report and was, therefore, in effect present in the pre-grant proceedings. It should also be taken into account by the Board. It was, in any case, in the interests of the Respondent to take it into account rather than risk the invalidity of the patent in proceedings before national courts. Its introduction would not constitute a new ground on which the appeal was based but merely supplemented an existing ground. The document was, moreover, clearly relevant and if taken into account would result in a finding of lack of inventive step against at least Claim 1.

Furthermore, whatever view the Board might take on D2, the subject-matter of Claim 1 lacked an inventive step in view of the disclosure of D1. This document related to a computer system with a plurality of components, each with an address register over which it is addressed by the system bus. This corresponded to the annotation means of Claim 1 and provided a coding section included in each component for establishing a code word identifying the revision status of the component; addressing means addressable by the computer to enable the computer to interrogate the component for its revision status must also be present. The only difference between the disclosure of D1 and the subject-matter of Claim 1 lay in the fact that the patent changed the revision status of the component and the code word manually. Whether revision of the code word took place automatically in response to component failure or manually in response to manual revision of the component was of no inventive significance. Moreover, the feature failed to define the invention clearly since it depended on human intervention.

XII. In response, the Respondent argued that document D2 should not be admitted to the proceedings since it was first submitted barely one month before the date of the oral proceedings and immediately prior to the Christmas period. Although it had been found by the search examiner, it was dismissed by the Examining Division as not relevant and had never appeared in the opposition proceedings. The document represented a good starting point for the invention since it merely showed addressing means addressable by a computer but no means of identifying the revision status of the component; it did not address itself to the technical problem of ensuring that the revision of the component and that of the annotation means

correspond, and even a cursory glance at this document would convince the skilled man of its irrelevancy.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. The amendments submitted at the oral proceedings are admissible. The only substantive amendments are those to Claim 1 and the corresponding statement of invention. The first of these amendments amends the claim to read "manually revising **the physical layout or state of** the component and **of the coding section, thereby** concurrently manually changing the code word to correspond to revisions to said component", the words in bold type having been added. These words make clear that revision of the component involves a physical change in the component, thereby excluding the case that the component is altered by a software command effecting an alteration in permanent memory in the component, and also make clear that the coding section is also physically changed. Both amendments are accordingly clarifying amendments and limit the scope of the claim. The second amendment to the claim is the substitution of the words "commensurate with" by "of the same order of magnitude as", bringing it into line with the language of the originally filed description at page 7, lines 1 to 4.

The amended claim, furthermore, includes all features of the originally filed claim; Article 123(2) and (3) EPC are accordingly met.

3. Document D2 is not, however, admissible. This document, although cited in the European Search Report, was not

mentioned either in the pre-grant proceedings by the Examining Division or in the opposition proceedings by either the Opponent (Appellant) or the Opposition Division. Nor was it mentioned by the Appellant in the present appeal until shortly before the oral proceedings. Article 114(2) EPC permits the Board to disregard facts or evidence which are not submitted in due time. Nevertheless, it is the established jurisprudence that the Board will exercise its discretion to admit a particularly relevant document even at a late stage since it would not be in the public interest to ignore such a document. This is not such a case. Neither the Examining Division nor the Opposition Division considered the document to be of sufficient relevance to justify its introduction into either of these proceedings. The Board share this view; the document is not pertinent to the patentability of the subject-matter of Claim 1 as now presented and does not address the Appellant's problem as discussed above. It is accordingly not admitted.

4. The claims now on file are considered to meet Article 84 EPC as to clarity, although Claim 1 should apparently include an "and" before "annotation means" at line 2. The claim, moreover, appears to be correctly delimited with respect to the prior art discussed at column 1, lines 8 to 37, Rule 29(1) EPC.

5. Turning now to the issue of inventive step, document D1 discloses an arrangement for testing of component boards by means of diagnostic software in conjunction with a diagnostic interface which is introduced for the purpose of testing and then removed. Each component being tested has a "module address identity recognition mechanism" i.e. addressing means addressable by the computer to enable the computer to interrogate the component. This is merely the standard addressing provided for components connected to

the system bus. D1 does not provide for any physical alteration of the component and does not disclose a coding section which is manually altered at the same time as, and with a degree of difficulty of the same order of magnitude as, the corresponding revision of the component. Neither the problem of disparity between the physical changes undertaken in a component and the record kept of such changes, nor the use of a manually revisable coding section, are discussed in D1. Nor would the skilled man, given the teaching of D1 and faced with the Patentee's problem, be led to construct an arrangement falling within the scope of Claim 1.

6. For these reasons, in the Board's view, the subject-matter of Claim 1 involves an inventive step.

7. Claim 1 being allowable, the same applies **mutatis mutandis** to dependent Claims 2 to 7, which relate to specific embodiments of the computer system of Claim 1.

Order

For these reasons, it is decided that:

1. The appeal is dismissed.

2. The case is remitted to the first instance with the order to maintain the patent on the basis of the documents specified at paragraph IX above, with the amendment to Claim 1 referred to at paragraph 4 above.

The Registrar: The Chairman:

M. Kiehl P.K.J. van den Berg