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**D E C I S I O N**  
of 15 July 1996

**Case Number:** T 0953/94 - 3.5.1

**Application Number:** 85305087.0

**Publication Number:** 0169703

**IPC:** G06F 15/21

**Language of the proceedings:** EN

**Title of invention:**  
A method of functional analysis

**Patentee:**  
Georges, Bradford John

**Opponent:**  
Robert Pettit

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 52(1), (2), (3), 100(a)

**Keyword:**  
"Invention not excluded from patentability (no - main and four auxiliary requests, yes - fifth auxiliary request)"  
"Use of mathematical method in physical process"  
"Remittal for decision on other grounds for opposition invoked"

**Decisions cited:**  
T 0208/84, T 0115/85, T 0453/91

**Catchword:**  
-



Case Number: T 0953/94 - 3.5.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.1  
of 15 July 1996

**Appellant:**  
(Proprietor of the patent) Georges, Bradford John  
Newbridge House  
School Road  
Upwell  
Norfolk (GB)

**Representative:**  
Paget, Hugh Charles Edward  
MEWBURN ELLIS  
York House  
23 Kingsway  
London WC2B 6HP (GB)

**Respondent:**  
(Opponent) Robert Pettit  
The Bays, Symonds Lane  
Linton  
Cambridgeshire CB1 6HY (GB)

**Representative:**  
Beresford, Keith Denis Lewis  
BERESFORD & CO.  
2-5 Warwick Court  
High Holborn  
London WC1R 5DJ (GB)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 30 September 1994  
revoking European patent No. 0 169 703 pursuant to  
Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. K. J. van den Berg  
**Members:** W. B. Öttinger  
G. Davies

### Summary of Facts and Submissions

- I. The appeal contests the opposition division's decision to revoke, following an admissible opposition, the European patent No. 0 169 703 granted on patent application No. 85 305 087.0.
- II. The reason given for the revocation was that the subject-matter of granted Claims 1 and 5 (main request) and that of Claims 1 and 5 filed in five versions on 22 April 1994 (first to fifth auxiliary requests) were, in accordance with Article 52(2) and (3) EPC, not to be regarded as inventions within the meaning of Article 52(1) EPC (Article 100(a) EPC).
- III. The relevant claims are worded as follows (with some repeated reference numerals omitted):

#### **Main request claim 1**

"1. A method of generating with a digital computer a data analysis of the cyclical behaviour of a curve represented by a plurality of plots relating two parameters to one another, said method including the steps of:

loading into said computer (106) initial data comprising a set of values for each of said parameters, said sets defining said curve (10) if represented graphically;

calculating with said computer a moving average (14) of said curve over a specified range of one of said parameters;

calculating with said computer the difference between the actual value of the curve and the moving average to produce an oscillator (30);

calculating with said computer the average of the oscillator over the same range of said one parameter; and

adding with said computer this oscillator average to the moving average to produce a first dynamic moving average (20);

said method additionally including the following steps:

(a) repeating the calculation with said computer of the average of the oscillator over a plurality of shorter ranges, each range being shorter than the last by a given ratio to produce a series of dynamic moving averages (22, 24, 26, 28, 29);

(b) determining with said computer the maximum deviation of the curve from the moving average and also all the associated dynamic moving averages previously calculated;

(c) using this maximum value of deviation to generate with said computer an envelope whose upper band (32) for each point in the range is the sum of this value and the lowest value represented by the moving average or any of its associated dynamic moving averages at that point, and whose lower band (34) for each point in the range, is calculated by subtracting this deviation value from the highest value represented either by the moving average or any one of its associated dynamic moving averages at that point;

(d) generating with said computer a plurality of inner and/or outer envelopes (35, 37; 36, 38) by repeating the above process of envelope generation of step (c) using values of said maximum deviation related thereto by said given ratio and multiples of said given ratio;

(e) repeating all the above process steps in sequence using a plurality of ranges of moving average each said range being related to the said first range by said given ratio or a multiple of said given ratio;

(f) storing data in said computer comprising each set of lines which includes the moving average, its associated moving averages and envelopes;

(g) systematically repeating method step (f) according to said given ratio and multiples of said given ratio and storing in said computer the data generated thereby; and

(h) extending the range of said one parameter for displaying on a visual display unit (116) of said computer the prolongation of said curve."

**Main request claim 5**

"5. A system for carrying out the method according to claim 4 [viz. 'a method according to any one of the preceding claims, characterized in that said method is applied to an industrial process having a time dependent parameter, wherein said parameter is sensed at spaced apart intervals of time to generate a plurality of plots of a first curve (10) indicating the historical performance of said parameter as a function of time'] in the case where it is necessary to prevent some parameter exceeding or falling below a predetermined value, characterized in that the system includes:

(a) means (108) for monitoring the analog value of said parameter;

(b) means (110) for converting said analog value into a digital value;

(c) means for inputting said value into the computer;

(d) means (112, 114) for programming said computer to carry out said method in accordance with specific requirements;

(e) means (104) for effecting an adjustment of the analog value in the event that the computer outputs a signal indicating that the value of said parameter, will probably exceed or fall below said predetermined value; and

(f) means (112, 114) for generating control signals to effect an adjustment of said parameter having studied the various sets of lines displayed on the screen of the video display unit (116), or allow the computer (106) to perform such adjustment automatically."

**Auxiliary requests claim 1**

The first auxiliary request differs from the main request in that the following feature is inserted, with the former feature (h) being re-designated (i):

"(h) displaying said curve on a screen over said specified range and, superimposed thereon, said series of dynamic moving averages and said inner and/or outer envelopes for indication of the probable prolongation of said curve and the extension of said one parameter beyond said specified range;"

The second auxiliary request differs from the first in that the last two features are worded as follows:

"(h) displaying said curve over said specified range on a visual display unit (116) of said computer and, superimposed thereon, said series of dynamic moving averages and said inner and/or outer envelopes;

(i) extending the range of said one parameter for displaying on the visual display unit the prolongation of said curve and of said series of dynamic moving averages and said inner and/or outer envelopes associated with said prolongation of the curve."

The third auxiliary request differs from the main request in that, in its first paragraph the words "method of generating" are specified as "method of controlling an industrial process comprising generating".

The fourth auxiliary request differs from the third in that the features (h) and (i) are worded as in the second auxiliary request.

The fifth auxiliary request differs from the third in that its first paragraph is replaced by the following two paragraphs:

"A method of controlling a physical process based on analysing a functional relationship between two parameters of the physical process comprising the steps of:

measuring the values of the two parameters, and generating with a digital computer a data analysis of the cyclical behaviour of a curve represented by a

plurality of plots relating the two parameters to one another,"

and that the last feature is worded as follows:

"(h) extending the range of said one parameter in accordance with the data generated for displaying on a visual display unit (106 [sic, apparently meaning 116]) the prolongation of said curve for use in the control of said physical process."

**Auxiliary requests claim 5**

Claim 5 is, in all auxiliary requests, substantially (apart from a purely formal amendment) identical in wording with that of the main request.

IV. More particularly, in the decision under appeal:

- Claim 1 as granted was considered to refer to a mathematical method as such (Article 52(2)(a), (3) EPC);
- Claim 5 as granted was considered to be in reality directed to no more than the method of claim 1, the system being conventional and no technical contribution to the known art being made;
- Claims 1 of the first and second auxiliary requests were unallowable for the same reason as that of the main request;
- the mere mentioning, in Claim 1 of the third and fourth auxiliary requests, of the possibility of using the non-technical method in a technical process did not make technical the method as such;



- the reference, in Claim 1 of the fifth auxiliary request, to a physical process did not really limit the claimed method in a technical sense;
- Claims 5 of the auxiliary requests were unallowable for the same reason as that of the main request.

V. No opinion was expressed, in the decision under appeal, on the other grounds for opposition invoked, viz. that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC) and that the invention was not susceptible of industrial application within the meaning of Article 57 (Article 100(a) EPC).

VI. The appeal was lodged, by the proprietor of the patent, on 6 December 1994 with a request that the decision be cancelled in its entirety. The respective fee was paid on the same day.

On 9 February 1995, the appellant filed a statement of grounds.

VII. In that statement, the appellant contested the reasoning in the decision under appeal and upheld its six requests which were rejected in that decision.

VIII. In response, the respondent (opponent) requested that the appeal be dismissed (main request) or that the case be remitted to the first instance for further prosecution on the basis of the grounds for opposition not dealt with in the decision under appeal (auxiliary request).

As a further auxiliary request, oral proceedings were requested.

- IX. In respect of the claims of all of the appellant's requests, the respondent referred, for support, also to Rule 27 and, in respect of the appellant's fourth and fifth auxiliary requests, to Article 84 EPC. With regard to the respondent's own auxiliary request, reference was made to the notice of opposition.

### Reasons for the Decision

1. The appeal (cf. VI) is admissible.
2. The issue to be decided in this appeal is whether, in the order of the appellant's six requests, the subject-matter claimed is, or is not, to be considered as an invention within the meaning of Article 52(1) EPC, i.e. not excluded from patentability by Article 52(2) in conjunction with 52(3) EPC.
3. *Main request*
  - 3.1 According to the Boards', in particular the present Board's, consistent case law, subject-matter is excluded (Article 52(2) EPC), as such (Article 52(3) EPC), from patentability (Article 52(1) EPC), if it makes no contribution to the art in a field which is not excluded from patentability by that Article of the Convention. The said contribution may lie in the problem to be solved, in the solution of the problem, or in the effects achieved.

Since the list of excluded matters as enumerated in Article 52(2) EPC is apparently ("in particular") not exhaustive, and since all those excluded matters enumerated can, *cum grano salis*, be subsumed under the

term "abstract", the requirement for a contribution in the aforementioned sense is normally equated with a requirement for a "technical" contribution to the art.

Referring, in particular, to T 208/84 (OJ EPO 1987, 14), cited in the first instance proceedings, in that case, the "data" to be processed represented "images in the form of a two-dimensional data array having elements arranged in rows and columns", and those images were considered as a "physical entity".

In another case, T 115/85 (OJ EPO 1990, 30), the "message" to be displayed indicated a "specific event which may occur in the ... device in a ... processing system", and the Board considered that "giving visual indications automatically about conditions prevailing in an apparatus or system was considered to be basically a technical problem", implying that the said "event" or "conditions" were understood as being technical events in, or technical conditions of, the apparatus or system itself and not, for instance, data to be processed.

3.2 Turning, after these references to the case law, now to Claim 1 as granted, the following is noted in respect of its introductory passage:

A "curve represented by a plurality of plots relating two parameters to one another" is nothing but a representation of a mathematical function, just as is an equation  $y = f(x)$  with  $x = f(a,b)$ , e.g.  $y = \sin(a/b)$ . The term "parameter" is not specified in any way and embraces thus any mathematical or other variable.

Therefore, an "analysis of the cyclical behaviour" of such a curve is clearly a mathematical method excluded (Article 52(2)(a) EPC) as such from patentability.

3.3 The reference, in the introductory passage of Claim 1, to a digital computer has only the effect of indicating that the claimed method is carried out with the aid of a computer, meaning that (at least some of) the method steps claimed are, in effect, functional features of a computer in operation, i.e. when being used.

With no further specification, it may rightly be assumed that that computer will be a programmable general-purpose computer, and its function will be under control of a program, such program being excluded (Article 52(2)(c) EPC) as such from patentability.

3.4 Turning now to the individual method "steps" claimed, it is noted that all of them relate only either to the mathematical method mentioned in the introductory passage or to the use of a computer for carrying it out:

The "loading" step is but the absolutely conventional and indispensable step of feeding the computer with the data to be processed.

The three "calculating" steps and the "adding" step are steps of the mathematical method.

The same applies to the additional (a) "repeating", (b) "determining", (c) "using ... to generate", (d) "generating ... by repeating", and (e) "repeating" steps.

The (f) "storing" step is again a conventional and, in computer functioning, indispensable step of holding data as long as they are required.

The (g) "repeating ... and storing" step is also a step of the mathematical method and of conventional and indispensable computer functioning.

Finally, the (h) "extending ... for displaying" step is only again a step of the mathematical method and, in addition, a step of displaying its result. In respect of the latter, it may be mentioned that presentations of information are also excluded (Article 52(2)(d) EPC) as such from patentability.

Summarising this analysis of the claimed method steps, it is noted that none of these steps contains either an indication of a novel structural feature of the computer or anything else that would go beyond the implementation of the mathematical method by a programmed general-purpose computer, including a conventional monitor for displaying the result of the computation.

- 3.5 The appellant's submission (point 4 of the statement of grounds) that the relationship of the parameters would "represent properties of a physical entity of some form, as examples in the description illustrate" has no basis in the patent documents on file.

As follows from the above (3.2-3.4), Claim 1 is not restricted to any particular application (or use) of the claimed method but is directed only to that mathematical method itself and, as indicated before (3.2), the "parameters" mentioned in it are not restricted to any "technical" or "physical" entities.

Incidentally, in one of the examples referred to, viz. in the embodiment relating to a "financial" application (column 5 line 11), the said parameters are such financial values as, for instance, the U.S. dollar and the Deutsche Mark, which (except perhaps when "physically" represented by banknotes or coins) clearly cannot be regarded as being physical entities. Said "financial" application must therefore be considered to relate to "schemes, rules and methods for doing

business", which are, like other non-technical matters, excluded (Article 52(2)(c) EPC) as such from patentability, and it cannot therefore be used as evidence for supporting the appellant's submission recited above.

3.6 The appellant's further assertion (point 3 of the statement of grounds) that the claimed method would be a "technical process" is, in this situation, also unconvincing.

3.7 Unconvincing is, in these circumstances, also the appellant's submission (point 5 of the statement of grounds in response to section 3.1 of the decision), that a number of specific examples in different fields would contradict the assertion that no technical problem could be identified in the claimed invention.

The problem solved by the claimed method lies in the mathematical field, as specified by the expressions "analysis of ... a curve ..." and "(h) extending the range ... for displaying ... the prolongation of the curve". As indicated before (3.5), a selection of some of the examples for possible applications of the claimed method to which Claim 1 is not restricted (cf. also 3.2) is not relevant for this question.

Thus, the fact that the description discloses examples both in non-technical and in technical fields does not contradict, but rather confirms, the view that the problem solved by the claimed mathematical method is independent of any field of application and can thus lie, in the present case, only in the mathematical and not in a technical field.

3.8 The appellant's further submission (point 6 in response to section 3.1 of the decision) is correct in so far as a mere "reference" to a mathematical method as such does not necessarily exclude the claim from patentability.

But, apparently, what the opposition division meant was that, since Claim 1 relates **only** to a mathematical method as such, its subject-matter is excluded from patentability.

3.9 The Board is also unable to identify a "technical" effect that would be achieved by the claimed method.

Rather, the direct effect, or result, of the computation carried out in the mathematical method claimed, is only the prolongation of a curve representing a mathematical function of whatever parameters, allowing the probable continuation, or extrapolation, of that function in the direction of the abscissa to be assessed.

3.10 Therefore, in the claimed method nothing can be identified that could be regarded as making a contribution to the art in a field which is not excluded from patentability in the sense of the relevant Article of the Convention and of the respective case law.

3.11 For the avoidance of any misunderstanding, it should be added that, as the Convention shows (Article 52(1) EPC), the requirement (defined in Article 52(2) and (3) EPC) of claimed subject-matter being an "invention" (not excluded), is distinct from the requirement (defined in Article 57 EPC) of the claimed invention being "susceptible of industrial application".

Even though the former requirement may, *cum grano salis*, be equated with a requirement for a "technical" contribution, as pointed out before, this is not the same as a requirement for an "industrial" applicability; at least in this context, the terms "technical" and "industrial" are not synonyms. In Article 57 EPC, the meaning of "industrial" is evidently intended to cover commercial applications; this is made clear, for instance, by the German version ("gewerblich"). In the context of Article 52(2) EPC, this is clearly not the case for the meaning of "technical".

Incidentally, a tentative inclusion of "commercial" activities in "technical" matters would not make sense also because of the fact that commercial activities, like financial activities (cf. 3.5), may fall under "schemes, rules and methods for doing business" which are excluded (Article 52(2)(c) EPC) as such from patentability.

Therefore, since the decision under appeal dealt only with the requirement for non-exclusion from patentability (Article 52(2) and (3) EPC), the Board's decision is also only on this point and must not be misinterpreted as a decision on the requirement for industrial applicability (Article 57 EPC).

- 3.12 For the aforementioned reasons (3.2-3.10), Claim 1 as granted is unallowable at least on the ground of exclusion from patentability (Article 52(2) and (3) EPC).
- 3.13 A request for maintenance of the patent, or for declaring one of the requirements under the EPC to be met, on the basis of a plurality of claims, can only be allowed if all of these claims meet the respective requirements or requirement.



Since, in the present case, Claim 1 is unallowable, the appellant's main request must be rejected, irrespective of whether or not any of the other claims on file, e.g. Claim 5, would meet the respective requirement.

3.14 This means, on the other hand, that the respondent's main request would in so far be allowable as it relates to the respective (main request) claims.

4. *First and second auxiliary requests*

4.1 It goes without saying that all the above considerations (3.2-3.10) are not affected in any way by the amendments made in Claim 1 to features (h) and, where applicable, (i).

4.2 Claim 1 of the first two auxiliary requests is, therefore, unallowable for the same reasons as that of the main request (3.12).

4.3 The conclusions drawn for the parties' requests are therefore the same (3.13, 3.14).

5. *Third and fourth auxiliary requests*

5.1 **Prima facie**, the situation might appear changed by the restriction of Claim 1 to the method "controlling an industrial process".

This is because, in the context of "controlling a ... process", the adjective "industrial" should, other than in the context of Article 57 (cf. 3.11 above), be understood to relate only to technical processes usually occurring in "industry" (this latter term in its present context being understood in the narrower sense of what

in German would be called "Industrie") and thus not as including "commercial", or even "financial", applications.

5.2 However, if Claim 1 is analysed in respect of its individual features (steps), it is noted that there is none which is directed, or would contribute, to an actual step of controlling the industrial process. The claimed steps are still the same as in granted Claim 1 or, respectively, in the second auxiliary request Claim 1 which were found to be directed only to a mathematical method, and Claim 1 in any of the auxiliary requests now considered could therefore be understood, or misunderstood, as still being directed to that method as such, albeit with an informal indication that it is suitable for use in an industrial process.

In an earlier case (T 453/91 of 31 May 1994), the Board has considered that a claim directed to a "method of manufacturing a semiconductor chip", making use of a non-patentable design method, should, for being directed to a patentable invention, include (in addition to the designing steps) the necessary technical feature directed to the actual "producing" of the designed chip.

In effect, in the present case as in the earlier one cited, such a technical feature is a necessity for the achievement of the intended result mentioned in the introductory passage of the claim, and therefore "essential" in the sense of Rule 29(1) and (3) EPC for the claimed invention.

5.3 In the Board's view, therefore, the amendments made to Claim 1 of the considered auxiliary requests are not sufficient to make it absolutely "clear" that the "matter for which protection is sought" (Article 84 EPC)

is the claimed method of analysing the behaviour of a curve as defined in the claim **only** when actually being used to control an industrial process.

As long as the "financial" embodiment remains undeleted, an assumption of the claim being "supported by the description" (Article 84 EPC) would moreover nourish the impression that the reference to an industrial process should only be taken as an informal indication of an application for which the claimed method is suitable.

5.4 Claim 1 in either of the considered auxiliary requests must therefore be considered as not unambiguously (Article 84 EPC) defining a method excluded as such from patentability (Article 52(2) and (3) EPC).

5.5 The conclusions to be drawn with respect to the parties' requests remain therefore the same as before (cf. 4.3).

6. *Fifth auxiliary request*

6.1 The amendment consisting in the replacement of the term "industrial", as used in the previous auxiliary requests, by the term "physical" may, **prima facie**, appear unclear and/or unsupported.

However, it can be interpreted, as apparently the respondent does, as meaning that the method, in which the mathematical method of analysing a curve is said to be used, is required to be a process in which the parameters are of a physical nature, or physical "entities". Whether or not this is the same as an "industrial" process, it is clear that the expression "physical process" does not include any processes in which the parameters are not of a physical nature, such as "financial" parameters.

But this is not the decisive point. If otherwise the claim were the same as in the previous auxiliary requests, the conclusions would probably be the same (5.2-5.4).

- 6.2 The situation explained above is effectively changed by the additional amendment made to feature (h) consisting in the insertion of the expression "for use in the control ...".

It is now clear that the amended Claim 1 has to be understood as being restricted to the application (or use) of the mathematical method, identified in granted Claim 1, in a method within the framework of which the result of the said mathematical method on parameters which are of a "physical" kind is actually used to control (by the intervention of a human operator, after he has interpreted the "prolongation of said curve", or automatically) a physical process.

- 6.3 It is for this latter reason that the Board disagrees with the conclusion, drawn in the decision under appeal, that the wording of the fifth auxiliary request Claim 1 would "not really limit the fourth auxiliary request in a technical sense". In its view, Claim 1 refers no longer only to a mere "possibility" of using the mathematical method in a technical or physical process.

It is agreed that, if the expression "for use" were understood as merely indicating that the claimed extension of the range of a parameter for displaying the prolongation of the curve would be "suitable" for use in the process control, such an interpretation might cast doubt on the effectiveness of the limitation of the claim. However, in conjunction with the expressly intended restriction of the claimed method to a "method

of controlling a physical process" the word "for" can, in the Board's view, no longer be interpreted as merely meaning "suitable for".

- 6.4 It should however be added, that the Board's interpretation presupposes that the description will be amended in accordance with the restriction of Claim 1 to a physical process.

The fact that the description (still) contains such non-technical or non-physical applications as a "financial" application cannot in the case of the fifth auxiliary request be used, under Article 69 EPC (and the Protocol on its Interpretation), to interpret Claim 1 as covering, contrary to its wording, the opposite of what it purports to cover. In the Board's view, Article 69 EPC would only be applicable in cases where, as in the third and fourth auxiliary requests, Article 84 EPC leaves some room for different interpretations.

Rather, therefore, the said fact is simply to be regarded as an inconsistency of the description with the claims which will have to be removed in accordance with Rule 27(1) EPC by deletion of those embodiments from the description. In view of the patentee's declared preparedness (cf. the letter accompanying the auxiliary request claims of 22 April 1994) "of course" to formally amend the description so as to "bring it into conformity with the amended claims", it is expected that the respondent's understandable concerns based on Rule 27 and Article 84 EPC will all be removed by these amendments still to be made in the further prosecution of the case (cf. 7.5 below).

- 6.5 For these reasons, the Board concludes that the subject-matter of the fifth auxiliary request Claim 1 in its only proper interpretation (i.e. disregarding any

examples which have become inconsistent by the amendments made to the claim and which have to be, and will, therefore be deleted) is not excluded from patentability by Article 52(2) and (3) EPC and is therefore to be regarded as an invention within the meaning of Article 52(1) EPC.

6.6 Claim 4, to which Claim 5 refers, restricts the "method of controlling a physical process" of Claim 1 still further to an industrial process in which the parameters referred to in that claim are time dependent.

Claim 5 is, by virtue of its independent (system) category, an "independent" claim; but it must nevertheless be understood as being restricted, by virtue of its reference to Claim 4, to an apparatus, defined by functional features of "means" it includes, for carrying out, in operation i.e. when being used, the method of "controlling a physical process" as defined in Claim 1, when applied to a case where it is an "industrial process" the parameters of which are time dependent as defined in Claim 4, with the characterising features of Claim 5 defining the functions of additional means of the computer or of other parts of the system in the particular case where it is necessary to prevent some of said parameters from exceeding or falling below a threshold value as defined in the preamble of Claim 5.

In these circumstances, as a mere matter of logic, the method of Claim 4 and system of Claim 5 cannot be less "technical" or less "physical", in the sense this term was used above (6.2, 6.3), than the method claimed in Claim 1.

6.7 The subject-matter of Claim 5 at issue is therefore not excluded from patentability but to be regarded as an invention within the meaning of the Convention for, in effect, the same reasons as that of Claim 1 (6.5).

7. *Conclusions*

7.1 The parties' concurring requests that the decision under appeal be set aside (VI, VIII) has to be allowed.

7.2 The appellant's further request aiming at a decision that the claims be declared not to be unallowable for the reason for which they were rejected in the decision under appeal must be rejected in as far as the main and first to fourth auxiliary request claims are concerned.

To that extent, the respondent's main request has to be allowed.

7.3 In so far as the fifth auxiliary request claims are concerned, the appellant's further request has to be allowed.

In so far as the respondent's main request aims at a confirmation of the revocation also for the fifth request claims, this request must be rejected.

7.4 The respondent's auxiliary request for remittal of the case to the first instance department for further prosecution has to be allowed (Article 111(1) EPC) in respect of the fifth request claims.

7.5 In said further prosecution (7.4), the opposition division will in particular have to decide on the two further grounds for opposition invoked (V).

The outcome in respect of Article 57 EPC may appear obvious, if account is taken of the above interpretation, in this context, of the term "industrial" (3.11).

However, the same may not be so certain in respect of Article 100(b) EPC. In any case, a formal decision on this point by the first instance is still outstanding and the Board refrains, therefore, from commenting on the respondent's submissions under "Insufficiency".

7.6 In the event that the outcome in respect of said further grounds will be in favour of the claims, the existing deficiencies of the description (6.4) will have to be dealt with in order to preclude any attempt, in possible later proceedings, to interpret the claims, under Article 69 EPC, in an improper way which would be contrary to the Board's findings above (in particular 6.2, 6.3, 6.6).

7.7 Since the respondent's first auxiliary request is allowed (7.4), its further auxiliary request (cf. VIII) needs not to be considered.



**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance department for further prosecution on the basis of the fifth auxiliary request claims, having regard in particular to points 7.5 and 7.6 of the Reasons (Article 111(2) EPC).

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg

