

**Internal distribution code:**

- (A)  Publication in OJ  
(B)  To Chairmen and Members  
(C)  To Chairmen

**D E C I S I O N**  
**of 6 July 1994**

**Case Number:** T 1002/92 - 3.4.1

**Application Number:** 82902213.6

**Publication Number:** 0086199

**IPC:** G07C 11/00

**Language of the proceedings:** EN

**Title of invention:**

System for determining the queue sequence for **servicing**  
**customers** at a plurality of service points

**Patentee:**

PETTERSSON, Per Martin, ET AL

**Opponent:**

Nemo Q AB

**Headword:**

Queueing system/PETTERSSON

**Relevant legal norms:**

EPC Art. 100, 114, 52(2)(c) and (3), 56  
EPC R. 55(c)

**Keyword:**

"Scheme or method of doing business (No)"  
"Patentable subject-matter (Yes)"  
"Late-filed facts, evidence and argument relating to  
unsubstantiated prior use (Not admitted)"  
"Inventive step (Yes)"

**Decisions cited:**

G 0009/91 and G 0010/91 (OJ EPO 1993, 408 and 420);  
T 0038/86 (OJ EPO 1990, 384); T 0022/85 (OJ EPO 1990, 12);  
T 0854/90 (OJ EPO 1993, 669); T 0222/85 (OJ EPO 1988, 128);

T 0550/88 (OJ EPO 1992, 117); T 0002/89 (OJ EPO 1991, 51);  
T 0156/84 (OJ EPO 1988, 372); T 0951/91 (to be published);  
T 534/89 (to be published); T 0017/91 (to be published);  
T 0328/87 (OJ EPO 1992, 701); T 0093/89 (OJ EPO 1992, 718)

- 2 -

T 1002/92

**Headnote:**

I. In proceedings before the Opposition Divisions, late-filed facts, evidence and related arguments, which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of the grounds of opposition on which the opposition is based, should only exceptionally be admitted into the proceedings, if prima facie, there are clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent.

II. In proceedings before the Boards of Appeal, new facts, evidence and related arguments, which go beyond the "indication of facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of the grounds of opposition on which the opposition is based, should only very exceptionally be admitted into the proceedings in the appropriate exercise of the Board's discretion, if such new material is prima facie highly relevant in the sense that it can reasonably be expected to change the eventual result and is thus highly likely to prejudice maintenance of the European patent; and having regard also to other relevant factors in the case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection, and the degree of procedural complication that its admission is likely to cause.

**Case Number:** T 1002/92 - 3.4.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.4.1**  
**of 6 July 1994**

**Appellant:**  
(Opponent)

Nemo Q AB  
Box 210  
S-191 23 Sollentuna (SE)

**Representative:**

Sedvall, Bengt Gustaf  
Brolin & Sedvall Patentbyrå AB  
Box 7182  
S-103 88 Stockholm (SE)

**Respondent:**  
(Proprietor of the patent)

PETTERSSON, Per Martin  
Ljungliden 20  
S-439 00 Onsala (SE)

**Representative:**

Chivarov, Gueorgui, Dr  
Patentanwältsbüro  
Tiedtke-Bühling-Kinne & Partner  
Bavariaring 4  
D-80336 München (DE)

**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office dated  
24 August 1992 rejecting the opposition  
filed against European patent  
No. 0 086 199 pursuant to Article 102(2)  
EPC.**

**Composition of the Board:**

**Chairman:** G. D. Paterson  
**Members:** H. J. Reich  
R. K. Shukla



## Summary of Facts and Submissions

I.

---

[REDACTED]

---

---

or for which the selected desired service point is the particular free service point."

Granted claims 2 to 9 are dependent on Claim 1.

- II. (a) This patent was opposed by the Appellant on the grounds mentioned in Article 100(a) EPC, relying in particular on Articles 52(2)(c) EPC in that the subject-matter of Claim 1 is a scheme, rule or method for doing business, and on Article 52(4) and 56 EPC in that considerable parts of Claim 1 lack novelty with regard to the state of the art as established by the following evidence:

D5 Affidavit of Hans Alm dated 10 September 1984 and descriptive article concerning a prior public use of an automatic queue system constructed by Elcentralen AB, in the Regional Social Insurance Office in Malmö, SE, in 1979; hereinafter referred to as "the Malmö system"; and

D6 Affidavit of Lars Jander dated 22 December 1982 and descriptive article concerning a prior public use of an automatic queue system constructed by Bela Elektronik in a bank in Sollentuna in 1981; hereinafter referred to as "the Sollentuna system".

- (b) On 18 October 1990, i.e. about one and a half years after the expiry of the opposition period, the Appellant supplemented the facts concerning the state of the art by the following evidence:

D7.1 Affidavit of Bernt Anderson dated 6 July 1990 concerning automatic telephone call distribution system A 435/Triton provided by Ericsson and put into operation on 22 May 1979 - according to the Appellant's statement - at the Tele office in Gothenburg, SE; hereinafter referred to as "the Triton system".

III. The Opposition Division rejected the opposition.

- (a) It regarded the subject-matter of claim 1 as an item of business **equipment** and not as a contribution to the art in the field of business or computer programming as such and thus an invention within the meaning of Article 52(1) EPC, in particular for the following reasons: The problem addressed by the present application is to provide technical **means** in the form of an apparatus to assist in organising customer queuing. The claimed solution involves interacting physical structures (apparatus features) which are neither simply the functional realisation of an actual or notional rule for doing business nor the hardware realisations of the steps of a computer program.
- (b) As to novelty and inventive step, the Malmö and Sollentuna systems (D5, D6) offer to a customer a plurality of turn-allocating units, which organise separate parallel queues each for a separate service point, and thus would give no hint how to handle both customers preselecting a particular service point, and customers with no preference for a particular service point in a common queue.

In the well-known so-called "barbershop practice" there is no provision for a customer to select a desired service point by his entry into the shop. i.e. at the instance when his turn in the common queue is allocated.

- (c) The Opposition Division found that the technical facts concerning the Triton system were not sufficiently relevant to affect the result of the envisaged decision. For this reason, the Opposition Division did not admit the related evidence (D7.1) which was not submitted in due time, pursuant to Article 114(2) EPC.

IV. The Appellant lodged an appeal against this decision.

---

---

---

---

decision to be taken, and might therefore be regarded as inadmissible under Article 114(2) EPC. In response the Appellant filed on 6 June 1994 further evidence concerning the Triton system as follows:

- D7.2 Declaration by Mr Bernt Anderson, received by Norens Patentbyrå AB on 12 July 1990;
- D7.3 Affidavit of Mr Leif Nilsson, dated 6 June 1994, declaring that "the type A 435/Triton telephone central system with automatic call distribution was taken into operation in 1979 at the tele office in Gothenburg" and that the "telephone central system A 435/Triton is the same as the Ericsson system ASDP 162";
- D13.1 Declaration of Mr Janos Werner, dated 11 February 1994, concerning the education in Teletraffic theory;
- D13.2 Lecture Program of the Kungl Tekniska Högskolan, Stockholm, on "Teletrafik systems" in spring 1977;
- D13.3 Karsten F. Larsen: "Köteori och Informations - system", Stockholm, 1971, pages 1 to 33;
- D14.1 Ericsson Review No. 1, 1979, front page and pages 7 to 13, presenting the ASDP 162 system;
- D14.2 LM Ericsson System Manual ASDP 162 Specification, front page, and sheets 6 and 7;
- D14.3 LM Ericsson System Manual ASDP 162, "Introduction" page, "contents" page, and sheet 1;

and on 1 July 1994 documents:

- D15.1 Order of Televerkets material division, Stockholm, dated 28 August 1978 for electric supply equipment for ASDP 162/0, and
- D15.2 Time Schedule for the installation of pilot plant T-435, dated 12 October 1978 and 21 November 1978.

VI. Oral proceedings were duly held on 6 July 1994. The Appellant (Opponent) requested that the decision under appeal be set aside and that the European patent No. 0 086 199 be revoked. The Respondent (Patentee) requested that the appeal be dismissed and that the patent be maintained as granted.

VII. In support of his request, the Appellant made essentially the following submissions:

- (a) Though Claim 1 is formulated as an apparatus claim, its subject-matter represents a scheme, rule or method for doing business as such within the meaning of Article 52(2)(c) EPC. The claimed system is not defined in terms of its physical structure but only in extremely general functional terms which correspond to the steps of such an unpatentable method. Therefore, the claimed system does not contribute anything more to the art than the method itself. In such a case, according to Decision T 38/86 OJ EPO 1990, 384, if the method is excluded from patentability, so is the apparatus.
- (b) The selection unit and the computing means claimed in Claim 1 are also present in the "Malmö system". In this system, a customer does not exercise any

preference for a service point when he takes one ticket from each of the five turn-number allocating units, the units, when placed close together, in a row constituting a turn-allocating unit in the sense of Claim 1. A **single** turn-number allocation unit is not claimed in Claim 1 and moreover would not be inventive but merely trivial. Hence, the "Malmö system" (D5) discloses all the features of Claim 1 except the features that the particular turn-number to be served is the next in turn in the memorised sequence of allocated turn-numbers "for which no desired service point is selected or for which the selected desired service point is the particular free service point (see lines 43 to 46 of Claim 1)". Hence, the features distinguishing the subject-matter of Claim 1 over the nearest prior art fall within the unpatentable method of doing business, and the invention does not involve any contribution to the art in a field not excluded from patentability. According to Decision T 38/86, Headnote II, it appears to be the intention of the EPC not to permit patenting in those cases.

- (c) Most of the features in the characterising part of Claim 1 are disclosed by the "Malmö system" (D5), so that Claim 1 does not satisfy Rule 29(1) EPC.
  
- (d) The features which distinguish the subject-matter of Claim 1 from the "Malmö system" (D5), are indicated in paragraph VII-(b) above and represent a queue algorithm which was used in the Triton system as established by evidence D7.1 in

particular paragraph 3. Therefore, evidence D7.1 would be sufficiently relevant to influence the decision to be taken and should have been admitted into the proceedings by the Opposition Division. Evidence D7.2, D7.3, D14.1, D14.2 and D14.3 was filed in order to further demonstrate the technical relevance of the "Triton system" and should form evidence allowing the Board to revise the decision of the Opposition Division.

- (e) The close and obvious connection between the claimed invention and telecommunications is supported by evidence D8 to D11. Additionally evidence D13.1, D13.2 and D13.3 show that a person skilled in determining a queue sequence would consult the field of telecommunication when solving a problem concerning serving customers from a queue.

VIII. The above submissions were contested by the Respondent who argued essentially as follows;

- (a) The subject-matter of Claim 1 represents a hardware-like selfconsistent physical structure, which has a concrete technical construction with a turn-number allocating and service point selection unit, a computing unit, a terminal at each service point and an information unit. Such a technical realisation of the claimed system forming subject-matter of the claim is by no means a mental rule or method which is only "as such" excluded from patentability by Articles 52(2) and (3) EPC. The terms used in Claim 1 would give the expert an unambiguous constructional instruction. A general

formulation of constructional elements of a three-dimensional system - in particular in terms of their function within the system - is an accepted practice in European and national patent practices and does not transform such constructional elements into non-technical objects.

- (b) The "Malmö system" (D5) has five independently working turn-number allocating units, one for each service point so that five parallel queues are organised according to the "first in - first out" principle. Thus, in the "Malmö system" a customer selects a particular service point, joins the corresponding queue and stays there until he is served. Therefore, neither the selection unit nor the computing means claimed in Claim 1 are known from the "Malmö system". Therefore, the subject-matter of Claim 1 would provide a technical contribution to the art of **devices** which are useful in business.
  
- (c) It is contested that the features of the "Malmö system" have been made available to the public before the priority date of the present invention. However, even in such a case it would not have been obvious to a skilled person - in particular not in view of the barbershop-principle - to provide computing means which decide which particular turn-number is to be served at a particular free service point, and transmit this information in the form of signals to an information unit. In none of the cited prior art documents, there is a unit which allows a customer

to select a particular service point before he enters a common queue integrating all service points. The technical implementation of these unobvious functions forms the subject-matter of Claim 1, which therefore involves an inventive step.

- (d) It is also contested, that the technical features of the "Triton system" which are derivable from the Appellant's late filed evidence D7.1, D7.2, D7.3, D14.1, D14.2 and D14.3 have been made available to the public before the priority date of the present invention. However, the essential reason for the technical irrelevance of the "Triton system" is a queue organisation which is completely different from the present invention. The "Triton system" allows no selection of a desired operator. The choice of an individual operator who serves a particular in-coming call, is done by a supervisor by way of altering a priority pattern to suit the traffic. The evidence concerning the "Triton system" is therefore not sufficiently relevant to justify its late introduction into the proceedings.

- (e) Moreover, a telephone network system represents a non-analogous art where a skilled person who is competent for systems organising the serving of customers at service points, would not look for help.

IX. At the conclusion of the oral proceedings the decision was announced that the appeal is dismissed.

## Reasons for the Decision

1. *Relationship between Article 52 EPC and Article 56 EPC*

As set out in paragraph VII (a) and (b) above, the Appellant submitted in the grounds of appeal that the subject-matter of Claim 1 is a scheme, rule or method of doing business within the meaning of Article 52(2)(c) EPC, because the apparatus features of the claim are in very general terms corresponding to the steps of a method, which would be unpatentable, and such apparatus does not contribute anything more to the art than the method. In this connection the Appellant relied upon Decision T 38/86, especially as summarised in headnotes II, IV and V.

This submission was further developed during the oral hearing, when it was emphasised that the only feature in Claim 1 which was not disclosed in the Malmö prior use was that set out in the last lines of the claim (column 7, lines 41 to 46), and that the feature was not a technical feature, so that the claimed subject-matter did not involve "some contribution to the art in a field not excluded from patentability".

In the Board's view, these submissions result from a misinterpretation of the relationship between Articles 52 and 56 EPC. In a case such as the present, a first question to be considered is whether the Appellant is correct in his contention that the subject-matter of Claim 1 does not constitute an "invention" within the meaning of Article 52(1) EPC.

If, contrary to the Appellant's contention, such subject-matter is not excluded from being patentable under Article 52 EPC, a further and separate question, also raised by the Appellant, is whether the claimed subject-matter involves an inventive step.

2. *Articles 52(2)(c) and (3) EPC*

Article 52(2) EPC excludes patentability under the EPC for certain categories of "subject-matter or activities as such", which are set out in sub-paragraphs (a) to (d) of Article 52(2) EPC. A common characteristic of such excluded categories is that their subject-matter is abstract in nature.

In the present case the Appellant has submitted that the apparatus system claimed in Claim 1 constitutes in effect a scheme, rule of method for doing business, which is one of the excluded categories. The Board does not accept this submission. The claimed apparatus is **clearly technical in nature** (cf. Decisions T 22/85 OJ EPO 1990, 12, T 854/90, OJ EPO 1993, 669), and has practical application to the service of "customers". The fact that one such practical application of such apparatus concerns the service of customers of "a business equipment" does not mean that the claimed subject-matter must be equated with **a method of doing business, as such.**

Thus **in the Board's judgment the claimed subject-matter is not excluded from patentability under Article 52(2) and (3) EPC.**

This conclusion is also supported by the following detailed considerations.

2.2 The wording of Claim 1 leaves no doubt that protection is sought for a "system which is capable to determine the queue sequence of customers", and thus for a three-dimensional object with the afore-mentioned capacities. Claim 1 explicitly indicates that this system comprises: "a turn-number allocation unit, a selection unit, terminals, an information unit and computing means". Hence, the wording employed in the claim defines a technical item with at least five constructional components, which item clearly belongs to the category of an apparatus. Each of the five components is characterised in terms of its functions. In the present case, such a broad claiming is justified on the basis of the disclosed embodiments and examples. As generally recognised, a characterisation of an apparatus component by its function does not **per se transform** the corresponding claim feature **into a measure**, which a user shall exercise onto this apparatus component.

2.3 Among the functions indicated in Claim 1, there is a first group which can be exclusively interpreted as apparatus properties inherent to the corresponding system component. This first group consists of the following functions: "Allocating a turn-number to every customer desiring to be served" is a property of the turn-number allocating unit. "Receiving signals identifying the particular turn-number to be served and the free service point for indicating them to the customers" is an attribute of the "information unit". "Enabling customers to select a desired service point

among said plurality of service points" is a function of the "selection unit". "Memorising the sequence of allocated turn-numbers with the selected desired service point" is a hardware property of the "computing means". "Receiving from the plurality of terminals signals identifying a particular service point which is free for serving a customer" specifies the circuit interconnection between terminal outputs and the input of the computing means. "Feeding out signals identifying the particular turn-number and the particular free service point to the information unit" characterises the circuit interconnection between the output of the computing means and the input of the information unit. The above-mentioned functions do not correspond technically to the steps of a method, and therefore the true nature of the subject-matter of Claim 1 when considered as a whole cannot be interpreted as a method for doing business as such.

- 2.4 There remains only one more function in Claim 1. It describes the basic working principle of the claimed computing means: "deciding which particular turn-number is to be served at the particular free service point" according to the rule: "the particular turn-number to be served being the next in turn in the memorised sequence of allocated turn-numbers for which no desired service point is selected or (next in turn) for which the selected desired service point is the particular free service point". In the Board's view only this functional term in Claim 1 is of an amphibious nature in that it is as well a step of a method for doing business which may be performed by a mental act as a hardware capacity of the computing means, which allows to achieve the intended technical result by the claimed

[Redacted text block]

[Redacted text block]

nature of a particular feature and is therefore not justified.

2.6 As results from the above analysis, Claim 1 is directed to an apparatus which comprises, inter alia, computer hardware operating according to a particular computer program. The program-determined output signal of the hardware is used for an automatic control of the operation of another system component (information unit) and thus solves a problem which is completely of a technical nature. In such a case - according to the case law established by the Boards of Appeal - a mix of technical and non-technical elements shall not be excluded from patentability under Article 52(2) and (3) EPC. For this reason Claim 1 is held to be an invention within the meaning of Article 52(2) EPC.

2.7 During the proceedings before the Opposition Division, the opponent relied upon the fact that, in response to an opposition against the Swedish priority application in Sweden on the ground that the subject-matter was not patentable, the Swedish Patent Office rejected the application. In appeal proceedings, the Swedish Court of Patent Appeals also rejected the application. In a further appeal, the Swedish Supreme Administrative Court also rejected the application. The claims of the Swedish application were essentially in respect of the same subject-matter as the claims of the patent in suit. The ground of rejection of the Swedish application essentially corresponded to the ground of objection under Article 52(2) and (3) EPC against the patent in suit.

Although this history of the corresponding Swedish application was not specifically relied upon by the opponent during the proceedings before the Board of Appeal, nevertheless in deference to the views expressed in support of the rejection of the Swedish application by the Swedish Patent Office, the Court of Patent Appeals and the Supreme Administrative Court, and in view of the object of harmonising patent protection within the Contracting States which underlies the EPC, the Board makes the following observations.

The Board notes that both the Swedish Patent Office and the Court of Patent Appeal regarded the subject-matter of the Swedish application as constituting a solution to a problem which was not of a technical nature, and therefore unpatentable. Although the Supreme Administrative Court confirmed the rejection of the application, its judgment included a dissenting opinion.

Since the issue of these decisions in Sweden between 1983 and 1987, the case law of the Boards of Appeal concerning the interpretation of Article 52 EPC has been developed, and has been matched by corresponding development of the law in Sweden, as shown in the judgment of the Supreme Administrative Court issued on 13 June 1990 in a case concerning an application by N. V. Philips Gloeilampenfabrieken. This judgment indicates that earlier Swedish case law, at the time of the above-identified decisions on the corresponding Swedish application, had deviated from the EPO case law.

Having regard to what is now established case law within the Boards of Appeal, and for the reasons set out in detail above, the Board does not agree with the reasoning which led to the rejection of the corresponding Swedish application.

3. *Admissibility of late-filed evidence*

As set out in paragraphs II(b) and III(c) above, during the proceedings before the Opposition Division, the opponent attempted unsuccessfully to introduce evidence concerning prior use of the Triton telephone system, more than two years after the grant of the opposed European patent. During the appeal proceedings, as set out in paragraphs IV and V above, the opponent continued to press for the admissibility of both the earlier evidence and further evidence concerning the alleged prior public use of the Triton system and its alleged relevance to the claimed invention.

From the procedural point of view, therefore, in such circumstances two separate questions have to be decided by the Board concerning the admissibility of the evidence concerning the Triton system:

- (i) should the decision of the Opposition Division that the evidence filed on 18 October 1990 was inadmissible be overruled by the Board?
- (ii) should the evidence filed on 18 October 1990 together with the further evidence filed on 6 July 1994 be admitted into the appeal proceedings?

3.1 *Applicable principles*

When deciding upon the answers to both these questions, in the Board's view the reasoning which is common to Decision G 9/91 and Opinion G 10/91 (OJ EPO 1993, 408 and 420) should be taken into consideration, because when interpreting the relevant provisions of the EPC such reasoning makes reference to procedural principles which are applicable to the question of admissibility of late-filed facts, evidence and arguments during opposition proceedings.

Article 99(1) EPC requires that an opposition shall be initiated within nine months of grant of a European patent by filing a notice of opposition "in a written reasoned statement". According to Rule 55(c) EPC this reasoned statement must include three components:

- (i) the extent to which the European patent is opposed;
- (ii) the grounds on which the opposition is based;
- (iii) an indication of the facts, evidence and arguments in support of these grounds.

Decision G 9/91 is concerned with component (i), the first of these three components of the opposition statement. No question arises in relation to this component in the present case, since the patent in suit was opposed to its full extent. Opinion G 10/91 is specifically concerned with component (ii) of the opposition statement, since the question which was referred to the Enlarged Board by the President of the EPO in that case was whether or not the examination of an opposition should be restricted to the grounds of opposition referred to in the opposition statement. Components (ii) and (iii) are closely related, however.

The "indication of the facts, evidence and arguments" constitutes the legal and factual reasons why the alleged grounds of opposition should succeed. It is well established in the case law of the Boards of Appeal that such legal and factual reasons (i.e. component (iii) above) in support of the statement of the grounds of opposition (component (ii) above) must be set out in the notice of opposition sufficiently completely so that the entire case of the opponent against the maintenance of the patent as granted can be properly understood on an objective basis, both by the patent proprietor and by the EPO, if the opposition is to be admissible (see for example Decisions T 222/85 (OJ EPO 1988,128), T 550/88 (OJ EPO 1992, 117), T 2/89 (OJ EPO 1991, 51)).

Such "indication of the facts, evidence and arguments" in support of the stated grounds of opposition is often referred to as the "substantiation" of the grounds of opposition.

In its reasoning which is common to Decision G 9/91 and Opinion G 10/91, the Enlarged Board recognised in relation to the referred questions concerning both of components (i) and (ii) that "the core of the matter in the present cases" is whether or not, or to what extent, the examination of an opposition or an appeal is governed by the opponent's statement in the notice of opposition pursuant to Article 99(1) and Rule 55(c) EPC (see paragraph 5 of the reasoning). The Enlarged Board held in this respect that "Rule 55 (c) EPC only makes sense interpreted as having the double function of governing (together with the other provisions) the admissibility of the opposition and of establishing at

the same time **the legal and factual framework, within which the substantive examination of the opposition in principle shall be conducted**" (original emphasis).

The Enlarged Board went on to consider whether "the above principal framework for the substantive examination of the opposition" is subject to any exceptions. In relation to component (ii) of the opposition statement, in Opinion G 10/91 the Enlarged Board first considered the discretionary power of the Opposition Divisions (in paragraph 16), and held that, having regard to Article 114 EPC, in the proper exercise of its power, an Opposition Division may consider and examine a ground of opposition not covered by the statement under Rule 55(c), either of its own motion or if such a ground is raised by an opponent. The Enlarged Board emphasised, however, that such consideration of a fresh ground, as an exception to the principle set out above, should only take place in cases where prima facie "there are clear reasons to believe that (such a ground would) prejudice the maintenance of the European patent".

The Enlarged Board then went on to consider the corresponding discretionary power of a Board of Appeal (in paragraph 18), and in this connection emphasised that "the purpose of the appeal procedure is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits", and furthermore that the appeal procedure is a judicial procedure, in contrast to the first instance procedure which is an administrative procedure, and is therefore "less investigative" than the first instance procedure. Thus for a Board of Appeal to consider and examine a

fresh ground of opposition pursuant to Article 114 EPC, the Enlarged Board held that such ground has to be "prima facie **highly** relevant" (emphasis added), and the patentee has to agree to the introduction of the fresh ground into the appeal proceedings.

- 3.2 Of course, when so considering the admissibility of a further ground of opposition not covered by the notice of opposition after expiry of the opposition period, both before an Opposition Division and before a Board of Appeal, the Enlarged Board was necessarily implicitly considering the admissibility of such a fresh ground in combination with at least an indication of the fresh "facts, evidence and argument" which are intended to support it. The mere stating of a fresh ground without any indication of the fresh facts, evidence and argument supporting it would obviously be inadmissible, either within or after expiry of the opposition period.

It would be illogical to have one criterion for the admissibility of late-filed new facts, evidence and argument in combination with a fresh ground, and a different criterion for judging the admissibility of late-filed new facts, evidence and arguments in support of a ground of opposition already covered by the opposition statement.

Hence, in the Board's view it follows that the principles set out by the Enlarged Board as underlying the admissibility of fresh grounds of opposition (cf. component (ii) of the opposition statement under Rule 55(c) EPC), are also generally applicable to the admissibility of late-filed new "facts, evidence and

arguments" intended to support grounds of opposition already covered by the opposition statement, both before the Opposition Divisions and the Boards of Appeal.

- 3.3 Thus following the principles set out in Opinion G 10/91, as regards proceedings before the Opposition Divisions, late-filed facts, evidence and related arguments, which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of the grounds of opposition on which the opposition is based, should only exceptionally be admitted into the proceedings by the Opposition Division, if prima facie, there are clear reasons to suspect that such late-filed material **would prejudice** the maintenance of the European patent in suit.

Such consideration of relevance as the principal factor governing the exceptional admissibility of late-filed new facts, evidence and related arguments in proceedings before the Opposition Divisions follows from the administrative character of such proceedings.

- 3.4 As regards proceedings before the Boards of Appeal, following the same principles new facts, evidence and related arguments which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition in support of the grounds of opposition on which the opposition is based, should only very exceptionally be admitted into the proceedings, if such new material is prima facie highly relevant in the sense that it is highly likely to prejudice maintenance of the European patent in suit.

Such a more restrictive and stringent requirement for the admissibility of late-filed facts, evidence and related arguments during appeal proceedings is fully consistent with the three previously mentioned findings contained in Opinion G 10/91, namely:

- (1) that the statement under Rule 55(c) EPC set out in the notice of opposition should establish the legal **and factual** framework within which the substantive examination of the opposition shall be conducted (emphasis added);
- (2) that the primary purpose of appeal proceedings is to give the losing party the chance to challenge the decision of the Opposition Division on its merits (such a "primary purpose" of appeal proceedings presupposes that the legal and factual framework of the proceedings does not change following issue of the first instance decision);
- (3) that the appeal procedure is a judicial procedure, and therefore less investigative than the first instance procedure.

Beyond such consideration of high relevance as a factor which very exceptionally justifies the admissibility of new facts, evidence and related arguments during appeal proceedings, as explained by the Enlarged Board the exercise of discretion by the Boards of Appeal under Article 114 EPC is also subject to broader considerations, in line with the fact that the appeal procedure is a judicial procedure. In particular, a further important consideration to be taken into account is the avoidance of procedural complications

and uncertainty for patentees during the appeal stage of opposition proceedings, having regard also to the fact that a European patent may subsequently be the subject of revocation proceedings before national courts.

On the above basis, the Enlarged Board held that a fresh ground of opposition can only be admitted during appeal proceedings if the patentee agrees.

In the Board's view, when exercising its discretion under Article 114 EPC whether to admit new facts, evidence and related arguments which are intended to support a previously raised ground of opposition into the appeal proceedings a Board of Appeal should take into account and weigh all factors in the case which are relevant to the exercise of such discretion, including in particular those set out above. Thus, in proceedings before the Boards of Appeal, new facts, evidence and related arguments, which go beyond the "indication of facts, evidence and argument" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of the grounds of opposition on which the opposition is based, should only very exceptionally be admitted into the proceedings in the appropriate exercise of the Board's discretion, if such material is prima facie highly relevant in the sense that it can reasonably be expected to change the eventual result and is thus highly likely to prejudice maintenance of the European patent; and having regard also to other relevant factors in the case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection, and

the degree of procedural complication that its admission is likely to cause.

In general the later that such new material is filed, the greater the degree of procedural complication that it is likely to cause.

The Board is aware that in some recent Board of Appeal decisions, late-filed facts evidence and related arguments have been held inadmissible regardless of their relevance. Thus in Decision T 951/91 (to be published in OJ EPO), the Board of Appeal held that if a party fails to submit facts, evidence and arguments until after appeal proceedings have been commenced, without adequate excuse, such late-filed material may be held to be inadmissible regardless of its relevance. Similarly, in cases of abuse of procedure, late-filed material has been held inadmissible regardless of its relevance (Decisions T 534/89 and T 17/91 (both to be published in OJ EPO)). In the Board's view these Decisions are in line with the principles set out above.

- 3.5 Following Decision T 156/84 (OJ EPO 1988, 372), the practice in relation to late-filed facts and evidence has been that the EPO (both first and second instances) has generally felt compelled to fully examine the relevance of such material, having regard to the interpretation of Article 114 EPC set out in that Decision, by which the principle of examination by the EPO of its own motion was said to take precedence over the possibility of disregarding facts or evidence not submitted in due time. Following such an examination of the late-filed material, the admissibility of the

material was determined having regard primarily to whether or not (in the opinion of each instance) it was likely to affect the outcome of the decision to be taken.

As regards the admissibility of late-filed facts, evidence and related arguments before the Opposition Divisions, the principle set out in paragraph 3.3 above following Opinion G 10/91 is generally similar to the principle set out in Decision T 156/84. As regards the admissibility of new facts, evidence and arguments in appeal proceedings, however, the principles set out in paragraph 3.4 above following Opinion G 10/91 are clearly more restrictive than that set out in Decision T 156/84.

4. *Admissibility of the late-filed facts, evidence and argument relating to the Triton system*

4.1 Previous decisions of the Boards of Appeal have established that if an opponent wishes to rely upon prior use as being part of the state of the art for the purpose of Article 54(2) EPC and as part of the legal and factual framework within which the substantive examination of the opposition is to be conducted, the notice of opposition must indicate within the opposition period, all the facts which make it possible to determine the date of prior use, what has been used, and the circumstances relating to the prior use. Prior public use is only adequately substantiated if specific details are given of what was made available to the public, where, when, how and by whom (see Decisions T 328/87 (OJ EPO 1992, 701) and T 93/89 (OJ EPO 1992, 718)). The notice of opposition must also indicate the

evidence and arguments supporting the ground of opposition.

4.2 In the present case, the notice of opposition filed with the opposition period contains an indication of the facts and evidence relied upon in connection with the Malmö system and the Sollentuna system, and also contains an indication of the related arguments in support of the alleged grounds of lack of novelty and inventive step. However, it contains no indication of facts, evidence or argument and therefore no substantiation relating to the Triton system. Such facts, evidence and argument were filed for the first time about one and a half years after expiry of the opposition period, and were held to be inadmissible by the Opposition Division on the basis of insufficient relevance (see paragraphs II(b) and III(c) above). On behalf of the opponent it was explained that the primary reason for the late-filing of this material was the difficulty in obtaining such facts and evidence. In the present case, therefore, there is no question of any abuse of procedure by the opponent.

4.3 With reference to question (i) set out in paragraph 3 above, the Board has considered the opponent's evidence filed on 18 October 1990 and the Opposition Division's decision that such evidence was inadmissible. The Board is satisfied that such decision of inadmissibility was made by the Opposition Division in the exercise of its discretion having regard to the right principles as set out in paragraph 3.3 above, and should be upheld.

4.4 With reference to question (ii) in paragraph 3 above, the Board is satisfied that the totality of the facts,

evidence and arguments concerning the Triton system which has been filed by the opponent is prima facie not sufficiently highly relevant to justify its admissibility into these proceedings at such a late stage in the overall opposition procedure.

When so deciding, the Board has in mind not only the degree of relevance of the late-filed material, but also the objection to its admissibility raised by the patentee, and the nature of the material, in that it relates to an alleged prior use of a system. If such material was to be admitted at a late stage in the appeal procedure, it would probably be necessary to delay the proceedings in order to give the patent proprietor a proper opportunity to make his own enquiries concerning the alleged prior use of the Triton system. It might then also be necessary to remit the case to the first instance for a full consideration of all the evidence from both parties concerning the Triton system.

- 4.5 Furthermore, the Board has in fact satisfied itself that the Respondent's submissions in paragraph VIII (d) concerning the Triton system are technically consistent with the disclosure in paragraph 1.1 of evidence D14.2. When weighing all facts and arguments presented by the parties, it appears more probable to the Board, that the "Triton system" does not allow a customer to select an individual operator within an operator group by the call signals entering into the queuing system structure via the trunk routes and therefore does not affect the decision to be taken.

For the above reasons, the Board has decided not to admit any of the late-filed facts, evidence and related arguments concerning the alleged prior use of the Triton system.

5. Article 56 EPC

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

number allocating unit enabling customers to select a desired service point among said plurality of service points."

The selection unit defined by the wording of Claim 1 is realised in the Malmö system via an aggregation of independent turn-number allocating units which organise individually the queue for each service point according to the "first in - first out" principle and also allow selection of a particular service point. Contrary to the Appellant's opinion in paragraph VII-(b) above, the computing means defined by the remaining wording of the characterising part of claim 1 is not disclosed in document D5 due to the fact that the "Malmö system" needs no signal identifying a selected desired service point.

Claim 1 does not satisfy Rule 29(1) EPC. However, this deficiency is no ground for opposition; see paragraph VII-(c) above.

- 5.3 Starting from the closest prior art of the Malmö system, the objective technical problem underlying the patent in suit is to provide apparatus means which allow to combine the individually service points of the conventional system into a common pool, wherein each free service point serves a customer in the same numerical sequence of one global turn-number allocation unit (i.e. one common queue for all service points) and the possibility of selecting one desired service point is maintained. This integration of the independently working terminals of the conventional system into one cooperating pool system necessitates a complete reorganisation of the conventional signal flow, and

thus a change from the circuit interconnections of the prior art.

- 5.4 This problem is solved by "computing means for memorising the sequence of allocated turn-numbers with the selected desired service points, for receiving from the plurality of terminals signals identifying a particular service point which is free for serving a customer, for deciding which particular turn-number is to be served at the particular free service point and for feeding-out signals identifying this particular turn-number and the particular free service point to the information unit, the particular turn-number to be served being the next in turn in the memorised sequence of allocated turn-numbers for which no desired service point is selected or for which the selected desired service point is the particular free service point".

In the appeal proceedings the Appellant argued lack of inventive step mainly on the basis of late-filed evidence which in the Board's view has no influence on the decision to be taken. In the "barbershop practice" a common first in-first out queue is formed which does **not** take into account a customers' preference for a particular barber when he **joins** the queue. Moreover, the customer can allow his turn to lapse until the barber of his choice is free. This basic idea of voluntarily offering one's own turn to the next customer in the queue does not give a hint to provide apparatus means which enables a customer to enter into the apparatus means a desired service point when he **joins** the queue and which automatically respects this selection in an appropriate way when the customer's turn-number is the next in the sequence. The further

evidence taken into account in the opposition proceedings is less relevant.

5.5 For the reasons stated above, in the Board's judgement the subject-matter of granted Claim 1 involves an inventive step within the meaning of Article 56 EPC.

6. Hence, it follows that granted Claim 1 can be maintained. Granted Claims 2 to 9 concern particular embodiments of the system according to Claim 1 and can likewise to be maintained.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

M. Beer

G. D. Paterson