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**Datasheet for the decision
of 5 May 2009**

Case Number: T 0571/07 - 3.2.02

Application Number: 00903298.8

Publication Number: 1150618

IPC: A61C 7/08

Language of the proceedings: EN

Title of invention:

System and method for producing tooth movement

Applicant:

Align Technology, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC R. 68(2), 67

RPBA Art. 11

Keyword:

"Reasoned decision (no)"

"Substantial procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

Decisions cited:

T 0278/00, T 0897/03, T 0276/04

Catchword:

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Case Number: T 0571/07 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 5 May 2009

Appellant: Align Technology, Inc.
881 Martin Avenue
Santa Clara, CA 95050 (US)

Representative: Clark, Jane Anne
Mathys & Squire LLP
120 Holborn
London EC1N 2SQ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 October 2006
refusing European application No. 00903298.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Noël
Members: P. L. P. Weber
A. Pignatelli

Summary of Facts and Submissions

- I. The appeal is directed against the decision of the examining division dated 17 October 2006 to refuse the European patent application.
The decision of the examining division was issued according to the state of the file.
- II. In its communication dated 29 September 2005 the examining division considered that claims 7 to 10 in the version filed on 6 August 2001 related to a method for treatment of the living human or animal body by therapy which had to be excluded from patentability pursuant to Article 52(4) EPC 1973. The examining division further considered claims 1-6 and 11,12 did not fulfil the requirements of Article 84 EPC 1973 and Rule 29 EPC 1973 as the repositioning system according to these claims was not defined in terms of technical features. Given the broadness of the terms of the claims, the requirements of Article 83 EPC 1973 were also considered not to be fulfilled. Finally the examining division considered that the claimed subject-matter was not novel.
- III. With its response of 27 March 2006 to the above communication the appellant filed a new set of claims 1 to 11 and explained over five pages why in its opinion the requirements of Articles 123(2), 52(4), 84, 83, 54 and 56 EPC 1973 were fulfilled.
- IV. In the annex to the summons to attend the oral proceedings dated 10 May 2006 the examining division considered that in claims 1-5, 10,11 the system could not be defined with reference to another entity

(horizontal/vertical misfit). Several terms were considered to be unclear because they defined "results to be achieved". This resulted in that claims 1 to 11 still were considered not to fulfil the requirements of Article 84 EPC 1973.

Anyway the subject-matter of claims 1-5, 10, 11 was not considered novel over the disclosure of any of documents D1, D2 or D3.

The subject-matter of claims 6 to 9 was considered to lack novelty over D3.

A lack of unity objection was also raised between the subject-matter of claim 6 and the one of claim 9.

Finally claims 1 and 10 were not considered to fulfil the requirements of Rule 29(2) EPC 1973.

V. With its response of 8 September 2006 in preparation for the oral proceedings the appellant, again, filed a new set of amended claims 1 to 8 (forming the main request in the present appeal) along with a large number of comments and arguments extending over ten pages, explaining why the present set of claims fulfilled the requirements of the EPC. In particular it explained why the reference to a horizontal or vertical misfit was cancelled, why the claims were further provided with technical features, why the method of treatment of the human body by therapy was disclaimed, why the claimed subject-matter was novel and inventive over D1, D2 and D3, and why the claims fulfilled the requirements of unity of invention and of Rule 29(2) EPC 1973.

VI. A telephone conversation took place between the examining division and the appellant on 26 September

2006. The report (posted on 4 October 2006) of this telephone conversation reads as follows:

"The set of claims, filed with the letter of 08.09.06, was discussed. The Representative was informed, that the objections raised in the previous communications and in the summons were uphold.

Consequently, oral proceedings as summoned will take place on 10.10.06.

Alternatively, a request for a decision "on the file as it stands" can be filed as already proposed in the summons."

VII. With letter of 28 September 2006 received by fax on the same day, the appellant withdrew its request for oral proceedings before the examining division and requested a decision based on the current state of the file.

VIII. On 17 October 2006 the decision to refuse the European patent application was sent to the appellant.

The grounds for the decision of refusal of the examining division read as follows:

"In the communication(s) dated 29.09.2005, 08.05.2006, 26.09.2006 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 02.10.2006

The application must therefore be refused."

- IX. A notice of appeal was filed on 15 December 2006 and the appeal fee paid on the same day. The statement setting out the grounds of appeal was filed on the 19 February 2007.
- X. In its statement setting out the grounds of appeal the appellant submitted that there has been a substantial procedural violation in that the decision under appeal did not provide adequate reasons for the decision. While the appellant filed substantial amendments and presented detailed arguments in response to the communication annexed to the summons to attend oral proceedings, the decision under appeal did not give any reason as to why the latest submissions were not considered convincing. He further submitted that the telephone note did not give any explanation in respect of the reasons for the decision either.
- XI. The appellant requests the decision to be set aside and a patent to be granted on the basis of the claims on file or on the basis of the set of claims according to an auxiliary request filed with the statement setting out the grounds of appeal.

The appellant further requests reimbursement of the appeal fee for reason of a substantial procedural violation and oral proceedings to be held in case the board intends to take a decision other than to allow the present appeal.

Reasons for the Decision

1. The appeal is admissible.

2. Pursuant to Article 106(1) EPC 1973 an appeal shall lie from the decisions of the examining divisions. According to Rule 68(2) EPC 1973 the decisions of the European Patent Office open to appeal shall be reasoned.

It is established jurisprudence of the boards of appeal that for this requirement to be fulfilled the decision must include, in logical sequence, the arguments justifying the order. The grounds upon which a decision is based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision (see inter alia T 278/00, OJ 2003, 546).

In a number of decisions the boards of appeal of the European Patent Office have pointed out that where a decision only refers to several communications, leaving it to the board of appeal and the appellant to speculate as to which of the reasons given by the examining division in the various communications might be essential to the decision of refusal does not meet the requirement imposed by Rule 68(2) EPC 1973 (see T 897/03, T 276/04) that decisions which are open to appeal shall be reasoned.

These requirements obviously aim at allowing the losing party to understand the reasons for the negative decision taken against it so that it can envisage the filing of an appeal. The same is true for the board of appeal which may have to deal with the appeal and has to understand why the first instance took the impugned decision.

It should be noted that a request for a decision based on the current state of the file does not mean that the party gives up its right to a reasoned decision. It simply means that the party does not wish to further comment on the case. The instances of the European Patent Office cannot omit to give reasons for their decisions when the EPC so requires.

3. In the present case the impugned decision solely refers to a first communication, an annex to the summons to attend oral proceedings (posted on 10 May 2006 and not 8 May 2006 as indicated in the impugned decision) and to a report of a telephone conversation with the examining division.

As can be seen from the above points II. and IV. the communication and the annex to the summons were issued in relation to completely different versions of the set of claims and the examining division raised a number of different objections against these claims.

From the report of the telephone conversation it is impossible to guess what exactly was discussed. Thus it is impossible to determine which one or ones of the numerous objections previously raised by the examining division were maintained against the last set of claims filed on 8 September 2006.

Moreover the contested decision does not contain any comments or counterarguments against the arguments presented by the appellant in support of the new set of claims.

It results from the above that it is left to the appellant and to the present Board to speculate on the very reasons for the refusal.

By failing to give the reasons for the decision and explain why the applicant's arguments were not considered convincing, the examining division did not issue a reasoned decision within the meaning of Rule 68(2) EPC 1973 and the appellant was deprived of its right to obtain such a fully reasoned decision which results in a substantial procedural violation.

4. For the reasons mentioned above the appellant had to appeal in order to obtain a fully reasoned decision. It appears therefore to be equitable to order reimbursement of the appeal fee pursuant to Rule 67 EPC 1973.
5. Since a fundamental deficiency is apparent in the first instance proceedings and no special reasons present themselves for doing otherwise the case is remitted to the first instance for further prosecution pursuant to Article 111 EPC and Article 11 of the Rules of Procedure of the Boards of Appeal in the version which entered into force on 13 December 2007 (OJ EPO 2007, 536).
6. The request for oral proceedings to be held in case the board intends to take a decision other than to allow the present appeal is immaterial as the appeal is allowed.

Order

For these reasons it is decided that:

1. The decision is set aside
2. The case is remitted to the first instance for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:

D. Sauter

M. Noël