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**Datasheet for the decision
of 10 May 2010**

Case Number: T 1140/07 - 3.2.02

Application Number: 98949238.4

Publication Number: 1036539

IPC: A61B 1/00

Language of the proceedings: EN

Title of invention:

Endoscope with single-use cartridge for the invagination of endoscopic tubes

Applicant:

Matasov, Sergej

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 84

Relevant legal provisions (EPC 1973):

EPC R. 46, 29(1)(3)

Keyword:

"Extended subject-matter - (yes)"

Decisions cited:

T 0686/99, T 0260/85, T 0331/87

Catchword:

-



Case Number: T 1140/07 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 10 May 2010

Appellant: Matasov, Sergej
Ranka Dambis 7/1-55
1048 Riga (LV)

Representative: -

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 1 February 2007
refusing European patent application
No. 98949238.4 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: M. Noël
Members: D. Valle
M. J. Vogel

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal on 9 March 2007 against the decision of the Examining Division posted on 1 February 2007 to refuse the application under Article 123(2) EPC in view of unacceptable extension of the claimed subject-matter beyond the content of the application as filed. The fee for the appeal was paid on 8 March 2007 and the statement setting out the grounds for appeal was received on 27 May 2007.

II. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of a new set of claims 1 to 9 and an amended page 1 of the description, all filed with the statement of grounds on 27 May 2007. It further requested that the case be remitted to the first instance for further prosecution on the substantive issues.

III. Independent claim 1 reads as follows:

"A colonoscope comprising an invaginator in the form of a tube eversible under fluid pressure, which is arranged by pleats on the distal part of an endoscopic tube (3), **characterized** in that the invaginator (23) is formed in a compact hollow cylinder which has a gap (25) with the endoscopic tube (3)."

IV. In the statement of grounds of appeal and in its subsequent reply of 7 March 2010 to the preliminary opinion of the Board sent on 9 November 2009, the appellant submitted essentially the following arguments:

There was a contradiction between the lack of unity of the various features objected to by the search department under Article 82 together with Rule 46 EPC (1973) and the objection under Article 123(2) EPC raised by the Examining Division, which considered the invention as being the combination of all features constituting the endoscope.

The main problem and the essential feature of the invention resided in the invagination of an endoscopic tube, as already apparent from the title of the present patent application. The other features of the endoscope, which were omitted from claim 1 as filed, were not essential to solve the first problem referred to in paragraph [8] of the patent application (European publication).

The Examining Division ignored the most important embodiment of the endoscope presented in paragraph [21] of the patent application, which included only part of the features originally claimed. The claimed invention, therefore, could be broadened without infringing Article 123(2) EPC.

The mere reference, by the Board, to the Case Law of the Boards of Appeal (in particular Chapter III.A.2) was not sufficient to object to the combination of features presented in claim 1. In this respect, the decision T 686/99 mentioned in the Case Law had no relationship with the present case.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) EPC*
- 2.1 Claim 1 of the application as originally filed has the following wording:

"An endoscope with a disposable cartridges for invagination of an endoscopic tube comprising: - a source of light; - a source of pressure; - biopsy forceps; - an endoscopic tube with a control block and a communication branch containing inwardly light and image transmission elements, a liquid or gas feeding channel, a biopsy channel, two pairs of closely wound springs with traction lines which pairwise connect a mechanism for bending the distal end to manual extractors of traction lines located in a control block, but externally a compressed spring mounted on the tube, an invaginator, a tip, a seal, an anal dilatator, **differs** in that the endoscope is supplied with:

- a disposable cartridge consisting of: - a shell with a projection at its proximal end containing: a condom of the distal part of the endoscopic tube connected to a spring stop; a compressed spring; a spring distancer in which is positioned a distal seal of the endoscopic tube fastened at the unverted end of the invaginator, a fixator of the compressed spring; the invaginator in the shape of a hollow compact flexible cylinder which has a gap with condom, recurrent narrowings of the external

- and widenings of the internal diameter, at that the everted end of the invaginator is fastened to the distal end of the shell; - a proximal seal of the endoscopic tube mounted on the shell; - an anal dilatator with a channel in its wall; - an endoscopic tube's tip joined to the condom with a protective glass, a channel for glass washing and blowing-up of the intestines, elements for hermetic connection to the endoscopic tube;
- a system of extractors-intractors of traction lines with a pneumo-hydro-manual drive including the pressure and vacuum sources which are connected to the elastic tubes cavities, comprising liquid and springs with traction lines, at that the tubes are fixed to the springs with a thread, but the springs are made with steps and terminate at some distance from the mechanism for bending the distal end of the endoscopic tube, at that the traction lines at the distal end are connected to the springs, but in the control block - with the manual extractors-intractors of traction lines, connected with elements for synchronous vacuum feeding into the cavity of the manually extracted traction line and an excess pressure into the cavity of the introduced traction line;
 - an endoscopic tube supplied with: transverse pleats of its external cover turned inwards; two additional air-ducts with cocks, the larger of which communicates with the cavity of the proximal seal of the endoscopic tube through the lateral opening but the smaller one - with the cavity of condoms; areas for air-tight fastening of condom's ends; a proximal condom;

- a system for intraction and extraction of biopsy forceps which includes pressure and vacuum sources connected through a cock to a cavity of the biopsy channel, the entry to which hermetized by the seal of biopsy forceps, the distal end of which has a piston of the biopsy channel;
- a biopsy forceps with traction line intensifier which include a flexible hermetic tube, the cavity of which is connected to pressure and vacuum sources, but the distal end of the traction line and the tube terminates with a piston and a cylinder respectively or the tube ends with an elastic element for instance, a sylphone, but the traction line is connected to its distal end."

2.2 Contrary to the assertion of the appellant, the essential features of an invention have to be determined on the basis of the content of the application as a whole, taking due account of the problem set and the solution presented in the application as filed. In the present case the problem is contained in paragraph [8] of the application and is constituted of a series of four partial problems presented as counter parts of the four drawbacks of the state of the art referred to in paragraphs [4] to [7]. Contrary to the assertion of the appellant the Board does not see any hierarchy between these partial problems, the solution of which is given as a whole in subsequent paragraph [9] and in more details in the following paragraphs [10] to [14].

More specifically paragraph [8] states four objectives of the invention and paragraph [9] stipulates that these objectives are achieved by an endoscope

comprising, besides conventional features presented in the first part of paragraph [9], also five additional features listed as follows:

- a disposable cartridge for the invagination of an endoscopic tube;
- a system of extractors-intractors of traction lines;
- an essentially changed endoscopic tube;
- a system of introduction and extraction of biopsy forceps;
- a traction line intensifier of biopsy forceps.

Each of these items is then developed in paragraphs [10] to [14], respectively. In each paragraph, reference is made to claim 1 (between brackets) in order to identify the corresponding feature, thus strengthening that said feature has to be regarded as essential.

In the Board's view, it is therefore clear that all these features are presented as essential throughout the application as filed and that they should be reflected in the main claim. As a matter of fact, each of the above-listed features is an essential part of the endoscope and contributes to solving the objectives and advantageous effects presented in paragraph [8]. For these reasons, the Board is satisfied that these features are essential and should have been at least outlined in claim 1.

2.3 In comparison, the subject-matter of claim 1 under appeal is directed to a colonoscope comprising an invaginator in the form of a tube and provided with pleats on a distal part of the endoscope tube, whereby

the invaginator forms a gap with the endoscopic tube. Apart from the endoscopic tube, none of the other essential features referred to above is present in this claim, which is now restricted to structural details of a colonoscope.

However, it is not allowed to delete features presented throughout the application as being essential to the solution of the stated problem. Such a deletion amounts to extending the claimed subject-matter beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC (see Case Law of the Boards of Appeal, Chapter III.A.2, in particular T 260/85 and T 331/87).

For similar reasons, there is no basis in the description for a protection restricted to a colonoscope having the features of claim 1 at issue, without the essential features identified above. Therefore, claim 1 also suffers from lack of support by the description, contrary to the requirements of Article 84, second sentence EPC. As further specified in Rule 29(1) and (3) EPC (1973), the main claim should contain the essential features of the invention. In the present case, this requirement is not met, as demonstrated above.

It is true that an alternative and preferred embodiment of the invention is presented in paragraph [21] of the application, i.e. a colonoscope having an endoscopic tube without biopsy channel, i.e. without the features related to a system for intraction and extraction of biopsy forceps. However, the remainder of the above-listed essential features are still missing from

claim 1, so that paragraph [21] does not revert the findings of the Board.

2.4 Furthermore, it is not sufficient to state that the claimed features are supported, in isolation, by the application, as listed in the Table provided by the appellant with the statement of grounds of appeal (enclosure No. 2). The new combination of features of claim 1 must also be supported as such, i.e. based on the application as filed in the sense of being the solution of the problem presented in the application. In this respect T 686/99 is also applicable to the present case in the sense that it stresses that the content of an application should not be considered as a reservoir from which individual features pertaining to separate sections could be combined in order to artificially create a particular combination.

2.5 The contradiction referred to by the appellant between Articles 82 EPC (lack of unity) and 123(2) EPC (extension of subject-matter) is not accepted by the Board since these two Articles serve different purposes and are not incompatible. While the purpose of Article 82 EPC together with Rule 46 EPC (1973) is to limit the search report to those parts of the application which relate to the invention first mentioned in the claims, the purpose of Article 123(2) EPC is to examine the amendments made to the claims with respect to the content of the application as filed in order to set out possible unacceptable extension of subject-matter, independently on the number of inventions revealed and searched by the search department.

Moreover, in the present case, lack of unity was objected to by the search department against a set of claims 1 to 8 filed by the applicant with letter of 19 September 2002, whereas Article 123(2) EPC is now addressed to an amended set of claims 1 to 9 filed with the statement of grounds of appeal. It is immediately apparent that the subject-matter of the respective claims 1 are not the same, so that the previous objection of lack of unity, besides not being further pursued in the examination proceedings, cannot be set against the present objection of extension of subject-matter, on which the present appeal is based. Therefore, the appellant's argument is irrelevant.

2.6 Accordingly, the present claim 1 does not comply with Article 123(2) EPC.

3. *Remittal*

The appellant's request that the case be remitted to the first instance department for further prosecution on the substantive issues cannot succeed since, as mentioned in the communication of the Board dated 9 November 2009, the deficiencies raised under Article 123(2) EPC have not been removed by the appellant's reply of 7 March 2010. The appeal, therefore, has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Sauter

M. Noël