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**Datasheet for the decision  
of 21 August 2012**

**Case Number:** T 1798/08 - 3.2.02

**Application Number:** 99912385.4

**Publication Number:** 1061874

**IPC:** A61F 9/08

**Language of the proceedings:** EN

**Title of invention:**

Visual prosthesis

**Patentee:**

JOHNS HOPKINS UNIVERSITY

**Opponent:**

IMI Intelligent Medical Implants AG

**Headword:**

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**Relevant legal provisions:**

EPC Art. 21(3)(a)(b), 53(c), 54, 56, 64(1), 69(1), 112(1)(a),  
114(2), 123(2)

EPC R. 102(g), 124(1)

RPBA Art. 9

**Keyword:**

"Added subject-matter (main request: yes; auxiliary request 1:  
no)"  
"Exception from patentability (no)"  
"Admissibility of late-filed evidence (yes/no)"  
"Novelty (yes)"  
"Inventive step (yes)"  
"Referral of questions to the Enlarged Board of Appeal (no)"  
"Request for legal hint (rejected)"  
"Enlargement of the Board (no)"  
"Interruption of oral proceedings (no)"  
"Postponement of oral proceedings (no)"  
"Request for recording a statement in the minutes of oral  
proceedings (rejected)"

**Decisions cited:**

G 0005/83, G 0002/88, G 0001/04, G 0001/07, T 0015/91,  
T 0082/93, T 0712/93, T 0775/97, T 0071/06, T 1695/07

**Catchword:**

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## **Summary of Facts and Submissions**

- I. On 26 August 2008 the Opposition Division posted its interlocutory decision concerning maintenance of European patent 1 061 874 in amended form on the basis of the patent proprietor's first auxiliary request, against objections under Articles 54 and 56 EPC. The main request was found not to fall under the exception clause of Article 53(c) EPC, but was rejected since it was in breach of Article 123(2) EPC.
- II. Appeals were lodged against this decision by both the patent proprietor and the opponent, by notices received on 3 November 2008 and 2 September 2008 respectively, with the appeal fees being paid on the same days. The statements setting out the grounds of appeal were received on 5 January 2009 and 22 December 2008 respectively.
- III. By communication of 18 April 2012, the Board forwarded its provisional opinion to the parties and summoned them to oral proceedings to be held on 21 August 2012.
- IV. With letter dated 3 July 2012 the appellant patent proprietor requested postponement of the oral proceedings.
- V. By communication of 4 July 2012, the Board informed the parties that the request for postponement could not be allowed and that the oral proceedings would take place as scheduled.
- VI. Oral proceedings were held on 21 August 2012.

The final requests of the parties were as follows:

The appellant patent proprietor requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, filed with letter dated 22 May 2009 or, in the alternative, on the basis of one of the auxiliary requests 1 to 5 filed on the same date or on the basis of one of the auxiliary requests 6 and 7, filed with letter dated 14 August 2012.

The appellant opponent requested that the decision under appeal be set aside and that the patent be revoked.

It further requested:

- that three questions as detailed below at the end of point X be referred to the Enlarged Board of Appeal;
- that the Board provide the appellant opponent with a legal hint as to novelty of claim 1 of auxiliary request 1 in view of D1, D4 and D9;
- if the Board declined to do so, that the Board be expanded by two further members;
- should the two preceding requests be rejected, that the oral proceedings be interrupted and rescheduled for another date;
- to record in the minutes: "in view of the rejection of the previous Requests, denial of the legal right to be heard by the Boards of Appeal is submitted by the Opponent".

At the end of the oral proceedings, the Board gave its decision as indicated in the minutes. An obvious

mistake in the decision given by the Board and recorded in the minutes was corrected by the Board's decision of 27 August 2012.

VII. The following documents are of importance for the present decision:

**D1:** M. Schwarz et al. "Hardware Architecture of a Neural Net Based Retina Implant for Patients Suffering from Retinitis Pigmentosa", Proceedings of the 1996 IEEE International Conference on Neural Networks, Washington, DC, 3-6 June 1996, Vol. 2, pages 653 to 658;

**D2:** US-A-4 603 697;

**D4:** T. Stieglitz et al. "Development of Flexible Stimulation Devices for a Retina Implant System", Proceedings of the 19th International Conference, IEEE/EMBS, Chicago, IL., 30 October - 2 November 1997, pages 2307 to 2310;

**D6:** R. Lerch "Elektrische Messtechnik", Springer-Verlag, Berlin, Heidelberg, New York, 1996, pages 320 to 321;

**D7:** W. Böge (Ed.) "Vieweg Handbuch Elektrotechnik", Friedr. Vieweg & Sohn Verlagsgesellschaft mbH, 1998, pages 1034 to 1035;

**D8:** K. Najafi "Micromachined Systems for Neurophysiological Applications" in "Handbook of Microlithography, Micromachining and Microfabrication", Vol. II: Micromachining and Microfabrication, SPIE, 1997;

**D9:** M. Schwarz et al. "Concept of a Retina Implant for Ganglion Cell Stimulation Applicable for Patients Suffering from Retinitis Pigmentosa", Proceedings of the 5th Vienna International Workshop on Functional

Electrostimulation, Vienna, 17-19 August 1995, pages 413 to 416;

**D10:** Declaration by G. Richard dated 5 January 2009;

**D24:** Declaration by E. de Juan dated 20 May 2009;

**D26:** US-A-5 016 633.

VIII. Claim 1 of the main request reads:

"A visual prosthesis, comprising:

a) means for perceiving a visual image, said means producing a visual signal output in response thereto;

b) retinal tissue stimulation means comprising an electrode array (22) capable of stimulating retinal cells to produce phosphenes in a pattern to stimulate vision, said electrode array (22) adapted to be operatively attached to a retina of a user; and

c) visual signal communication means for transmitting said visual signal output to said retinal tissue stimulation means, comprising a primary coil (16) for wirelessly transmitting a radio frequency encoded image signal and a secondary coil (18) for receiving the radio frequency encoded image signal transmitted via the primary coil (16), wherein

I. the electrode array (22) and the secondary coil are in communication via a decoding and demultiplexing circuit block (20) to which the radio frequency encoded image signal is passed from the secondary coil (18) and which communicates said signal to the electrode array (22) and wherein

II.

a) the secondary coil (18) and the decoding and demultiplexing circuit block (20) are suitable to be located extra-ocular on the body of the user outside a wall of the sclera, or

b) the decoding and demultiplexing circuit block (20) is suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera and the secondary coil (18) is suitable to be located implanted in the eye behind the iris."

Claims 2 to 30 are dependent claims.

Claim 1 of auxiliary request 1 corresponds to claim 1 of the main request except for feature c) II. a) which reads:

"a) the secondary coil (18) and the decoding and demultiplexing circuit block (20) are suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera, or".

Claims 2 to 29 are dependent claims.

It is not necessary for the present decision to consider auxiliary requests 2 to 7.

IX. The arguments of the appellant patent proprietor are summarised as follows:

There was explicit textual basis in the application as filed at page 4, lines 30 to 35, that in an embodiment of the invention the secondary coil (radio frequency receiving element) and circuit block (decoding and demultiplexing element) were suitable to be located extra-ocularly as defined in claim 1 of the main request. This statement did not include a requirement that the radio frequency receiving, decoding, and demultiplexing element must also be suitable to be



attached to the sclera. Further support in this respect could be found at page 4, lines 3 to 12, where reference was made to extra-ocular components, again without requiring attachment to the sclera. These generic disclosures in the "Brief Summary of the Invention" were to be understood as relating to the specific embodiments, and it was therefore permissible under Article 123(2) EPC to introduce the term "extra-ocular" in alternative a) of part II of feature c) of claim 1 of the main request.

The claims of all requests were exclusively directed to a visual prosthesis, i.e. a device, which could not fall under the exception clause of Article 53(c) EPC. No surgical step was needed to make any of the components of the claimed device.

None of documents D6 to D9 was prima facie highly relevant to the proceedings, in the sense that it could reasonably be expected to change the outcome, and should therefore not be admitted into the proceedings. Late-filed document D26 was also irrelevant.

Claim 1 of auxiliary request 1 was novel over D1, which did not comprise an explicit or implicit disclosure of a decoding and demultiplexing circuit block which was in communication with the electrode array and was suitable to be located on the body of the user outside the wall of the sclera and attached to the sclera. In D1, this circuit block was clearly located inside the eye, most likely in the proximity of the "active retina stimulator unit". In order to attach the receiving coil and the telemetry receiver (if the latter comprised the decoding and demultiplexing circuit block, shown only

schematically in Figure 5) from the position depicted in Figure 1 of D1 to the outside wall of the sclera at the temporal side of the eye as shown at page 9 of the letter of the appellant opponent dated 20 July 2012 (shown below in point X), a number of structural modifications would be needed. These structural modifications were as follows: 1. the "active retinal stimulator unit" had to be turned by 180°, which further required reversal of the signals in order to achieve a correct image; 2. the ribbon cable connecting the stimulator unit with the telemetry receiver also had to be turned by 180°, which would induce torque between the hole, through which the ribbon cable penetrated the sclera, and the stimulator unit, with the risk of detachment of the latter; 3. since the receiving coil was perpendicular to the transmitting coil if located as suggested by the appellant opponent, the transmitting coil would also have to be repositioned in order to achieve sufficient coupling between the coils to ensure signal and power transmission; 4. the telemetry receiver had to be repositioned as well in order to avoid shielding in the RF transmission system. Accordingly, the circuit block of D1 was clearly not "suitable" to be located and attached as defined in the claim.

D9 was not novelty-destroying for claim 1 of auxiliary request 1 for the same reasons as given for D1.

D4 also failed to disclose a decoding and demultiplexing circuit block suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera. If such a circuit block were located next to the connection pad denoted by "a" and

"b" of the stimulation device depicted in Figure 4, as suggested by the appellant opponent, it would not be suitable to be attached to the outside wall of the sclera since it was stated at page 2308 that the device was adapted to the spherically shaped bulbus in a temper step before implantation, implying that it should retain this shape.

At the priority date of the patent in suit, it had been generally considered that the implanted device of a retinal prosthesis would be implanted entirely within the eye, as shown in D1, D4 and D9. No alternative arrangement had ever been suggested. D1 could be considered as the closest prior art. The objective technical problem to be solved was to provide a retinal prosthesis that was practical as a chronic implant. The solution provided by the invention was to separate the decoding and demultiplexing circuitry from the other components of the device, and to make the decoding and demultiplexing circuitry capable of being implanted at an extra-ocular location, attached to the outside wall of the sclera. None of the documents cited by the appellant opponent gave a hint towards extra-scleral attachment of one of the implantable components of a retinal prosthesis and the advantages achievable thereby.

The solution was also not obvious to the skilled person based on his common general knowledge. D24 was a statement of one of the inventors and no hint could be derived therefrom as to which one of the components of the system could be implanted at which location outside the eye. D10 was a statement representing the personal opinion of Mr. G. Richard, and it was not even

established that he had been working in the field of retinal prostheses at the priority date of the patent in suit. The handbook extract D8 merely provided the general information that hotter portions of an implantable device, where the circuitry was located, should be placed remotely from sensitive regions of the tissue. However, heat generation was not an issue in the case of a retinal implant in view of the vitreous cavity acting as a heat sink and the high level of blood supply to the eye. Even if the skilled person were to import the general statement in D8 into the context of D1, attachment of the "hotter portions" to the outside wall of the sclera was not the only solution or the obvious solution.

The device of D2 comprised an electrode which was implanted in the ciliary muscle of the eye to stimulate contraction of the ciliary muscle and thereby promote drainage of excess aqueous humour from the eye. It was entirely silent regarding a decoding and demultiplexing circuit block and did not at all address the problem underlying the invention. Its teaching would thus not have been taken in consideration by the skilled person.

The three questions proposed by the appellant opponent for referral to the Enlarged Board of Appeal were based on assumptions and did not relate to a point of law of fundamental importance. Nor was their referral necessary for ensuring uniform application of the law.

- X. The arguments of the appellant opponent are summarised as follows:

For the skilled reader of the whole description of the original application it was clear that the statement in lines 33 to 35 of page 4, cited by the appellant patent proprietor in support of the term "extra-ocular" introduced in claim 1 of the main request, referred to the embodiment depicted in Figure 6. In this embodiment, however, the decoding and demultiplexing circuit block 20 was only disclosed as being attached to the outside wall of the sclera. The term "extra-ocular components" in lines 5 and 10 of page 4 did not relate to this circuit block. Accordingly, the subject-matter of claim 1 of the main request went beyond the original disclosure.

Documents D6 to D8 were excerpts from handbooks or textbooks merely identifying and establishing what has been commonly known at the priority date. Document D9 was incorporated by reference in D4. D9 was novelty-destroying for the subject-matter claimed and thus prima facie relevant. From the declaration D10 it became apparent that surgical procedures for implanting devices in the eye which included a line penetrating the sclera on a long-term basis were well known and regularly performed in the field of ophthalmology at the priority date of the patent in suit, and that the telemetry receiver unit comprising the coil and the signal decoding circuitry disclosed in D1, D4 and D9 was suitable to be located attached to the outside of the sclera. D26 demonstrated that a wire piecing the sclera was also known specifically for retina implants. Accordingly, these documents should be admitted.

Since the hardware of the claimed device was the same as that known from D1, the sole distinction was that

the device was "suitable" for surgical implantation at another location. This effectively secured protection for a manner of surgically implanting a known device, by reciting the position on the body at which the components of the device were to be located during implantation by the medical practitioner. Even though the claims were directed to a device, Article 53(c) EPC was certainly applicable, at least if the feature "suitable to be located" was interpreted in a different way than the mere suitability of the components to be located correspondingly. This would hold not only for the assessment of novelty but also for the assessment of inventive step. In particular, the feature "suitable to be located" should not lead to a delimitation over visual prostheses of the prior art, the components of which were equally suitable to be located outside the eye, no matter whether such a location was explicitly proposed or otherwise rendered obvious for a person skilled in the art. Any deviating interpretation of the feature "suitable to be located" would be nothing else but an instruction for a surgeon as to how to implant the visual prosthesis. However, such teaching involving a surgical method had to be excluded from patentability according to Article 53(c) EPC.

The jurisprudence of the EPO had repeatedly held that the prohibition of Article 53(c) EPC was applicable irrespective of whether a claim was notionally expressed as a method or a device. In particular, in decision T 82/93, it was noted that while some claims were strictly "product" claims and other claims were strictly "method" claims, there also existed a class of claims that included features relating to both physical entities and physical activities. If such a claim

included at least one feature defining a physical activity or action constituting a step of a method for treatment of the human body by therapy, it would fall under the exclusion clause. Furthermore, decision T 775/97 concerned a case comparable to the case at issue, in which claims were directed to a device, the features of which were defined in terms of the application of the device in the body and were therefore held to relate to a surgical method. These principles had been confirmed in opinion G 1/04, where it was noted that a claim fell under the prohibition of Article 53(c) EPC if it included at least one feature defining a physical activity or action that constituted a method step for treatment of the human or animal body by surgery or therapy. Any method step for surgical treatment, irrespective of whether the claim was notionally expressed as a device or a method, rendered the subject-matter claimed unallowable under Article 53(c) EPC. It had to be ensured that an applicant could not merely draft notional "device" claims and thereby avoid the exclusion under Article 53(c) EPC on a formal basis, even though the subject-matter intrinsically concerned a method of treatment. The subject-matter of the patent in suit was essentially directed to a specific surgical application of a known retina implant system. The claims simply recited an instruction on the manner in which a known visual prosthesis was to be implanted by the surgeon.

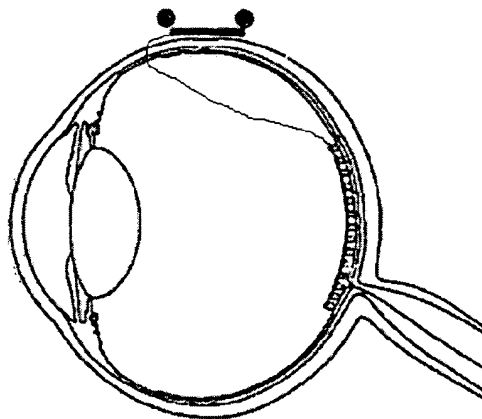
When implanting the hardware illustrated in Fig. 4 or Fig. 5 of the patent in suit, the surgeon was suddenly confronted with the problem of patent infringement. This was precisely the situation that Article 53(c) EPC was designed to prevent; namely, that medical

practitioners were inhibited or prohibited from carrying out surgical and therapeutic methods in the course of treating their patients. As stated in decision G 5/83, the use of a substance or composition for the treatment of the human or animal body by surgery or therapy was in no way different from a "method of treatment" of the human or animal body by surgery or therapy with that substance or composition. Accordingly, the actions of a surgeon in his "use" of the visual prosthesis device illustrated in drawing Figs. 4 and 5 of the patent in suit actually dictated whether or not the patent was infringed. The subject-matter of the patent in suit was thus clearly directed to a specific surgical application of a known retina implant system and therefore constituted a treatment of the human or animal body by surgery prohibited under Article 53(c) EPC.

The expression "suitable to be located/attached" could not distinguish the subject-matter defined in claim 1 of auxiliary request 1 from the implant system of D1, D4 or D9 as it did not actually imply any technical or structural limitation whatsoever to the secondary coil and/or the decoding and demultiplexing circuit block. It merely recited where they were able to be located. The term "suitable" had to be interpreted in line with the established case law, for instance T 15/91, according to which the recognition that a known device could be employed in a manner not previously described did not establish the novelty of that device if the previously unknown use did not require any change in the technical realisation of the known device compared to the known use of that device.



The telemetry receiver of D1 and D9 was also "suitable" for being located attached to the outside of the sclera. The part of the device which was to be implanted into a patient's body as disclosed in D1 (or D9) comprised a receiver unit and a stimulator unit. Both units were connected with one another by a flexible ribbon cable. The receiver unit [even though the tem "stimulator unit" was used by the appellant opponent, it is clear that the receiver unit was meant] further comprised a decoding and demultiplexing circuit block in the very same sense as for the patent in suit. An example of locating the corresponding parts outside the eye was shown in the following drawing which was based on Figure 1 of D1 but which had been slightly modified as to the position of the telemetry unit:



As shown in this modified drawing, the receiver unit was perfectly suitable to be located outside the eye and to be attached to the sclera of the right eye at its temporal side. The ribbon cable disclosed in D1 was long enough to permit this location, and since the cable was explicitly described as flexible, any torsion-induced problems as mentioned by the appellant patent proprietor would not be an issue. Signal reversal would not be necessary when the receiver unit was attached to the left eye instead of the right eye

as shown in the modified drawing. The arrangement of the receiving coil at an angle of  $90^\circ$  with respect to the external transmitting coil would still permit a coupling allowing sufficient signal and power transmission. Moreover, the external transmitting coil could also be positioned at the right temple instead of in front of the eye as shown in Figure 1 of D1. Any possible shielding effect of the receiver unit when placed as shown in the modified drawing was negligible.

D9 mentioned explicitly that the telemetry receiver unit performed the function of decoding. Accordingly, the decoding and demultiplexing circuit block was clearly not located in the proximity of the stimulator unit, but next to the receiving coil. D9 was novelty-destroying for the same reasons as was D1.

D4 was novelty-destroying as well. Figure 4 in combination with the dimensions given in Table 1 disclosed a stimulation device with a total length of 23.5 mm and comprising a connection pad for contacting microelectronic circuitry including a decoding and demultiplexing circuit block (its presence was necessarily required in an RF transmission line). The device was only 15  $\mu\text{m}$  thick and said to be formed of flexible polyimide. These dimensions and material properties clearly permitted the circuit block to be located and attached as claimed, with the thin and flexible interconnect (f) penetrating the sclera and the hardware remaining unchanged.

Accordingly, the subject-matter of claim 1 of auxiliary request 1 was not novel vis-à-vis any one of documents D1, D4 and D9.

Starting from D1 as closest prior art the skilled person had a number of incentives for electing to locate the receiver unit components as defined in claim 1 of auxiliary request 1. First it was well understood that the more components a surgeon was required to physically implant within the confines of the posterior chamber of the eye, the more complicated the implantation procedure became and the larger the intrusion required into the biology of the eye itself. Secondly, the larger the number of components which were to be implanted within an internal chamber of the eye, the more likely it became that a subsequent surgical procedure would be required to re-open the eyeball and access the components in order to repair or replace a faulty or defective component. While a surgeon had reasonably easy access to the outer surface tissues of the eyeball, accessing the internal structures of the eye typically required an incision through the sclera. Accordingly, the greater the number of components that were implanted within the eye, the larger the initial intrusion and the more likely a subsequent operation would be required to replace or repair one or more of those components. It was therefore a natural and indeed "obvious" development for an ordinary practitioner to minimise the number of components of the visual prosthesis that were required to be implanted within the posterior chamber of the eyeball itself. Thirdly, in paragraph 7 of D24, even one of the inventors himself had provided a clear hint as to the motivation for choosing to arrange the "receiver unit" of the visual prosthesis outside the sclera rather than inside the eye, by admitting that the necessary data receiver, power generator, circuitry

and electrode array that would be sufficiently small to fit entirely inside the eye were in fact not available at the priority date of the patent in suit. Finally, the power consumption of the visual implant device disclosed in D1 generated heat which had to be dissipated during the course of its operation. As evidenced by the handbook abstract D8, the skilled person generally knew that the hotter portions of an implantable device comprising heat generating circuitry should be placed remote from the sensitive regions of the tissue. It could thus be assumed that the skilled person was aware of the desirability and advantage of locating the power transmission (and decoding/demultiplexing) circuitry of the receiving unit in D1, which was a heat generating component, outside of the eye spaced from the extremely sensitive tissues of the inner eye, and in particular of the retina. For these reasons the subject-matter of claim 1 of auxiliary request 1 was already obvious from D1 taking into account common general knowledge.

Its subject-matter was further obvious from D1 in combination with D2. This document disclosed a unit 10 for electrical stimulation of the ciliary muscle of the eye, which unit 10 included an active electrode 14 connected by a conductor or lead 16 to a signal developing portion 18 of the unit. Furthermore, D2 explicitly mentioned inserting the electrode and the lead through the sclera 28 into the ciliary muscle 12, as shown in Figure 1A. D2 thus provided a good example of long-term penetration by an electrical cable through the tissue of the sclera between an intra-ocular stimulating electrode and an extra-ocular signal developing portion 18.

When starting from D9 as closest prior art, the subject-matter of claim 1 was also obvious for the same reasons as given with respect to D1.

Since D9 was cited in D4, the system described in D4 embodied the same components as those described in D9. In any case, the skilled person knew that an RF transmission system required (de)coding and (de)multiplexing. The decoding and demultiplexing circuitry would thus be included in the receiver unit which was shown in Figure 1 as being attached to the wall of the sclera, but inside the eye. The receiver coil and the decoding/demultiplexing circuitry blocks were connected to the stimulator electrode array by a thin flexible cable. The latter two parts were depicted in more detail in Figure 4, with the dimensions given in Table 1. Moreover, it was generally known that the outside wall of the sclera was well suited for the attachment of extra-ocular components. Taking into account the general knowledge of the skilled person as present with respect to D1 and the resulting motivation not to place all the components of the retinal stimulation device inside the eye, it was obvious to attach the decoding and demultiplexing circuitry to the outside wall of the sclera.

Accordingly, the subject-matter of claim 1 of auxiliary request 1 was obvious when starting from either one of documents D1, D4 and D9.

When it considered the subject-matter of claim 1 of auxiliary request 1 novel over each of documents D1, D4 and D9, the Board must have construed the feature

"suitable to be located on the body of the user outside a wall of the sclera" such that it required the prior art to reflect that particular way of locating the demultiplexing/receiver coil units outside of the sclera in order to be novelty challenging. Such a claim construction was, however, against the well-established jurisdiction of the Boards of Appeal to construe such a feature in the broadest way possible, i.e. that any prior art which was suitable (by modifying the location of the units) to be implanted such that the units may be placed in conformity with the features of claim 1, anticipated the claim. Accordingly, the Board dismissed and deviated from the well-established jurisdiction of the Boards of Appeal of the EPO, e.g. T 15/91. Insofar, the coherent practice at the EPO to construe the feature "suitable of" was in jeopardy. Therefore, the Enlarged Board of Appeal was requested to decide on the following questions:

- (1) "Does the claim construction of the Board of Appeal to construe the feature "suitable of" in a narrow way, i.e. to require prior art to specifically reflect the embodiment (here: the location of the implanted units, as claimed) to be novelty challenging?"
- (2) Or is the standard (as established previously by the Boards of Appeal) to apply that any prior art document is novelty challenging for such a feature by merely providing at least one way to be suitable for implanting at the sites as required by claim 1?"

- (3) Is the claim construction of the Board of Appeal 3.2.02 in conformity with the established jurisdiction of the Boards of Appeal not to allow claims that - as a result - hinder the surgeon to implant units at a site according to his free choice in the human patient, thereby allowing claims, which cover surgical methods - in violation of Article 53(c)?"

### **Reasons for the Decision**

1. The appeals are admissible.
2. Main request - amendments

Features a), b) and the first paragraph of feature c) of claim 1 are based on claim 1 as originally filed in combination with page 11, lines 19 to 27 of the original description as published (WO-A-99/45870). The features of this passage of the description also form part of original claims 3 and 9. The decoding and demultiplexing circuit block (20) introduced in part I of feature c) does not form part of the original set of claims, but is clearly disclosed in the above-mentioned passage of the description. The basis of the above-mentioned features has not been contested.

The location of the secondary coil 18 and the decoding and demultiplexing circuit block 20 is not defined in the original set of claims, but can be derived from Figures 5 and 6 and the corresponding part of the description (page 14, line 10 to page 15, line 1). Alternative b) of part II of feature c) corresponds to

what is depicted in Figure 5 and described in the second paragraph of page 14. No objection was raised with regard to this alternative.

In alternative a) it is defined that the secondary coil 18 and the decoding and demultiplexing circuit block 20 are suitable to be located extra-ocularly on the body of the user outside a wall of the sclera. In lines 23 to 29 of page 14, it is stated that the secondary coil 18 is **attached to the sclera** 54. At the bottom of page 14 reference is made to the extra-ocular **attachment** of the decoding and demultiplexing circuit block 20. In Figure 6, both components 18 and 20 are also clearly depicted as being attached to the sclera 54. The wording used in the claim "suitable to be located extra-ocular on the body of the user outside a wall of the sclera", however, is broader in that it merely requires a location of the two components outside the eye, but otherwise anywhere on the body of the user. The Board sees no basis in the application documents as originally filed for such a broad definition.

In the "Brief Summary of the Invention" reference is made in line 5 of page 4 to "intra-ocular and extra-ocular components". For the reader of the entire paragraph and the application as a whole it is clear that the term "extra-ocular components" in this context relates to the components of the image acquiring and transmitting portion, denoted by reference numeral 26 in Figure 1, and not to the secondary coil 18 and the decoding and demultiplexing circuit block 20. This also becomes evident from the fact that lines 7 to 12 of page 4 explicitly refer to the signal transmission



between these intra-ocular and extra-ocular components "without physical contact therebetween", i.e. the wireless radio frequency transmission.

At the bottom of page 4, the term "extra-ocular" is used with respect to "the radio frequency receiving, decoding, and demultiplexing element". This element comprises the decoding and demultiplexing circuit block defined in claim 1. From reading the entire sentence in lines 30 to 35 of page 4, again within the context of the application as a whole, it becomes clear that the first part of the sentence in fact relates to the embodiment shown in Figure 4 (not forming part of the specification of the patent in suit), whereas the second part of the sentence clearly relates to the embodiment of Figure 6, wherein, as mentioned above, the coil 18 and the circuit block 20 are attached to the sclera (obviously, the second part of the sentence cannot refer to the embodiment of Figure 5 wherein the coil 18 is not attached to the sclera but located behind the iris).

From the above it follows that the subject-matter of claim 1 of the main request is in breach of Article 123(2) EPC.

### 3. Auxiliary request 1

#### 3.1 Amendments

In alternative a) of part II of feature c) of claim 1 of this request, the contested feature "extra-ocular" in the main request has been deleted and it is specified that both the coil 18 and the circuit block

20 are suitable to be attached to the sclera, as disclosed in Figure 6 and the corresponding part of the description. Accordingly, the above objection is overcome, and the Board is satisfied that the requirements of Article 123(2) EPC are met. No objection has been raised by the appellant opponent in this regard.

### 3.2 Exception from patentability

Although all claims are directed to a visual prosthesis, i.e. an apparatus, they were objected to under Article 53(c) EPC as relating to a surgical method. The features "suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera", "suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera" and "suitable to be located implanted in the eye behind the iris" in part II of feature c) of claim 1 were regarded as relating to a method for treatment of the human or animal body by surgery, thus transforming the claim into a "disguised" method claim, even though it was notionally directed to a device.

The Board dismisses this objection for the following reasons.

Article 53(c) EPC, second sentence, specifies that the provision does not apply to products, e.g. substances and compositions, for use in the methods falling under the exception clause. In addition to substances and compositions, the claim category "products" includes

apparatus. Accordingly, the provisions of Article 53(c) EPC do not normally apply to apparatus claims.

The fact that some features of the claimed apparatus are functionally defined in relation to the body of the patient does not itself transform the apparatus claim into a method claim (T 712/93, Reasons, point 3; T 1695/07, Reasons, point 17). It is true that the actual implantation of components of the prosthesis would constitute a surgical intervention in the patient's body, but this is not what is claimed in claim 1. The claim merely defines that certain components of the prosthesis are "suitable to be located" at various locations in the patient's body. Such a definition does not except the claimed apparatus from patentability under Article 53(c) EPC.

The reasoning of T 775/97 is not applicable to the present case, as the underlying situation is entirely different. Claim 29 of the main request at issue in that case related to the use of two tubes for the manufacture of a device for use in a surgical method. Since said device was assembled inside the body by a surgical method, it was found to constitute a surgical treatment (Reasons, point 2.6). In the present case, however, the claim is not directed to a use but to an apparatus and does not refer to any manufacturing steps. No surgical step is needed to make any of the components of the claimed prosthesis. The present claim is comparable to the device claims of the auxiliary request in decision T 775/97 which were found not to fall under the exclusion clause of Article 52(4) EPC 1973 (Reasons, point 3.1).

The reasoning of T 82/93 is not applicable to the present situation either. In that case the claim objected to was directed to a method of operating a pacer including a number of features which were physical entities and a number of features defining physical activities or actions (referred to as a "hybrid claim"). At least one of these actions, viz. the use of certain sensed parameters to control the pacer rate, was considered to constitute a method of treatment of the human body by therapy, resulting in the claim defining subject-matter excluded from patentability under Article 52(4) EPC 1973 (Reasons, points 1.4 and 1.5). The present case is different in that claim 1 is not directed to a method and in that it does not comprise any features defining physical activities or actions, still less any steps defining a surgical or therapeutic treatment of the human body.

G 5/83 deals with claims directed to the **use** of a **substance or composition** for the treatment of the human or animal body and is thus also of no relevance in the present context.

The statement cited by the appellant opponent from point 6.2.1 of the Reasons of G 1/04 that a claim falls under the prohibition of Article 53(c) EPC "if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy" explicitly refers to **method** claims, and not to device claims as in the present case. Furthermore, as explained above, claim 1 does not include any such method step for treatment.

It follows that claim 1 of auxiliary request 1 does not fall under the exception clause of Article 53(c) EPC.

The issue of exception from patentability has to be decided on the basis of the given wording of the claim as indicated above (possibly taking into consideration additional information provided in the description, which was not necessary in the case at issue). Any possibly necessary interpretation of certain features of the claim (i.e. suitability of components to be located on or attached to parts of the body) for the assessment of novelty should not play a role in the decision as to whether or not a given claim falls under the exception clause, since novelty is a separate and independent patentability requirement ("Case Law of the Boards of Appeal of the EPO", 6th ed. 2010, I.A.1.2).

Also the issue of possible patent infringement, i.e. the question of whether a surgeon implanting components of the claimed device might be confronted with the problem of patent infringement and thus be hampered in his freedom when treating his patients, has to be left aside in this decision. According to opinion G 2/88 (Reasons, point 3.3) a distinction is to be made between the protection conferred by a patent as determined by the claims according to Article 69(1) EPC and the rights conferred on the patent owner in the designated Contracting States according to Article 64 EPC. The rights conferred on the proprietor of a European patent under Article 64(1) EPC *"are the legal rights which the law of a designated Contracting State may confer upon the proprietor, for example, as regards what acts of third parties constitute infringement of the patent, and as regards the remedies which are*

*available in respect of any infringement", and "the "rights conferred" by a patent are a matter **solely** for the designated Contracting States" [emphasis added]. This is confirmed in G 1/07 (Reasons 3.2.3.2), where it is stated that "any issues of infringement ultimately depend on the construction of the applicable national laws", and that there is "no term in Article 53(c) EPC which would allow concluding that hampering of the practitioner's freedom is a prerequisite for the exclusion to apply in the individual case considered. The **only** condition defined in Article 53(c) EPC for a claim to be excluded from patentability is that it contains subject-matter being a **method** for treatment of the human or animal body by surgery or therapy or a diagnostic method. If so, it is excluded from patentability and it is then irrelevant whether in the individual situation under consideration a medical practitioner would or could infringe the claim" [emphasis added]. Since the issue of possible infringement by a medical practitioner is not decisive in case of a claim directed to a method, this must a fortiori be the case for a claim to an apparatus, such as a visual prosthesis. It is well established that product protection is available for medically-related products even though it may hamper the medical practitioner's freedom to operate.*

### 3.3 Admissibility of late-filed documents

3.3.1 Documents D6 to D9 were filed by the appellant opponent with its statement of grounds of appeal. Since D6 to D8 are excerpts from textbooks or handbooks and were only filed to substantiate what was commonly known at the priority date of the patent in suit, there is no valid

reason not to admit these documents. D9 is considered to be prima facie relevant since it provides more detailed information regarding the location of the decoding and demultiplexing circuit block than D1, as detailed below under point 3.4.2. Accordingly, D6 to D9 should not be disregarded under Article 114(2) EPC. These documents are thus admitted into the proceedings.

3.3.2 Document D26 was filed by the appellant opponent with its letter of 20 July 2012, i.e. about one month before the oral proceedings were held, in order to demonstrate that lead wires piercing the sclera were not only known for implantable devices for treating glaucoma, but also for retinal implants. As shown below, this issue could be left aside when assessing novelty and inventive step. Apart from the disclosure of a trans-scleral lead forming part of a retinal stimulation device, the teaching of D26 does not go beyond that of the numerous other prior-art documents in the proceedings. Accordingly, the Board declines to admit this document under Article 114(2) EPC.

### 3.4 Novelty

#### 3.4.1 Document D1

Figures 1, 5 and 6 of D1 undisputedly disclose a visual prosthesis comprising all structural features of claim 1. Figure 1 depicts the secondary coil as being located implanted in the eye behind the iris as defined in alternative b) of part II of feature c) of claim 1. Since D1 would already be novelty-destroying if it anticipated one of the two alternatives given in the claim, the crucial issue to be decided is whether the

decoding and demultiplexing circuit block shown schematically in the block diagram of Figure 5 is "suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera", as defined in alternative b) of part II of feature c) of claim 1. According to established case law ("Case Law of the Boards of Appeal of the EPO", 6th ed. 2010, I.C.5.3.3, last paragraph), such a statement of purpose of a claimed device is to be interpreted as meaning that a known device that serves another purpose but otherwise possesses all the features listed in the patent claim is not prejudicial to the novelty of the subject-matter of the claim if the known device is unsuitable for the purpose referred to in the claim.

The exact location of the decoding and demultiplexing circuit block cannot be derived clearly and unambiguously from D1. The block diagram of Figure 5 depicts such a circuit block but, due to its merely functional character, it is not suited to reveal clear information regarding its location. Since the caption of the diagram refers to "the intra ocular stimulator with telemetry receiver" (including the receiving coil, the decoding and demultiplexing circuit block and the "stimulator" (comprising the electrode array)), it is clear that the decoding and demultiplexing circuit block must be located in the eye, but it cannot be decided whether it is located in the proximity of the stimulator or the receiver. Figure 1 represents a cross-sectional view of the right eye in a transverse plane. It depicts the receiving coil, a "telemetry receiver" and the "active retina stimulator unit" as all being located inside the eye, with the latter two units being connected by a "highly flexible ribbon



cable for power and serial data transfer inside the eye" as stated in the bottom paragraph of page 656 which relates to Figure 1. Even though the decoding and demultiplexing circuit block is neither depicted nor mentioned in this part of the description, it may be concluded that it must be located inside the eye as well, but whether it is located in the proximity of the stimulator unit or the receiver again remains open. Figure 6 shows the microelectrode structure with an enlarged view of a microelectrode with a unit denoted as "selection circuitry and stimulus generation" located in close proximity thereto, but it remains unclear whether this unit can be equated with the "the decoding and demultiplexing circuit block" in claim 1. Accordingly, it remains open where exactly this circuit block is located in D1.

Even if the decoding and demultiplexing circuit block was located next to the telemetry receiver of D1 as suggested by the appellant opponent, it is not "suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera" for the following reasons. It may in principle be possible to attach the receiving coil and the telemetry receiver (assumed to comprise the decoding and demultiplexing circuit block) to the outside wall of the sclera at the temporal side of the eye, as shown in the drawing reproduced above in point X from page 9 of the letter of the appellant opponent dated 20 July 2012 (even though this would require the stimulator to be turned by 180° and the lead connecting the stimulator and the telemetry receiver to traverse the sclera). However, in this position the telemetry receiver and the receiving coil would be oriented at an angle of 90° with respect

to the transmitting coil of the extra-ocular image acquisition system located in the spectacle frame worn by the user. Such an arrangement of the coils would be practically inoperable in a radiofrequency transmission system since the coupling for signal and power transmission between the coils would be dramatically reduced compared to the (usual) coaxial arrangement of the coils as depicted in Figure 1 of D1. High coupling is particularly crucial in case of a retinal tissue stimulator. Compensating for the loss of coupling by positioning the spectacle frame comprising the transmitting coil in front of the right temple instead of the right eye to achieve a coaxial arrangement of the coils, as suggested by the appellant opponent, would require an (unrealistic) modification of the system disclosed in D1. It follows that an attachment of the receiving coil and the telemetry receiver to the outside temporal wall of the sclera in the way suggested by the appellant opponent would not be practically feasible since it would go against the essential requirement of good coupling between the coils. For this reason alone, the decoding and demultiplexing circuit block of D1 is unsuitable to be located on the body of the user outside a wall of the sclera and attached to the sclera. Possible additional problems necessitating further modifications of the suggested extra-scleral attachment as indicated by the appellant patent proprietor, such as twisting of the ribbon cable, reversal of the signal for the turned stimulator and shielding by the telemetry receiver, therefore need not be considered.

### 3.4.2 Document D9

D9 is very similar to D1, with its Figures 1 to 3 corresponding to Figures 1, 5 and 6 of D1 and the text being somewhat less detailed except that it is stated in the bottom paragraph of page 413 that the telemetry receiver unit "decodes electrical patterns for the stimulator". This gives an indication that the decoding and demultiplexing circuit block is located next to the receiving coil. However, even if this is the case, D9 is not novelty-destroying for claim 1 for the same reasons as given above in the last paragraph of point 3.4.1.

### 3.4.3 Document D4

Figure 1 of D4 shows, on the left-hand side, an external image acquisition device and, on the right-hand side, four units, viz. a "receiver coil", a "receiver (energy and data)", an "electrode selection and encoding" and "flexible stimulation electrodes", all located inside the eye and connected to each other. Accordingly, the features of items a) and b) of claim 1 are clearly disclosed. Even though a primary transmitter coil is not shown or mentioned, the depicted receiver coil requires its presence. Taking further into account the teaching in the third paragraph of the left-hand column of page 2308, the features of the first paragraph of item c) are considered to be disclosed implicitly. However, a decoding and demultiplexing circuit block as defined in part I of item c) is neither shown nor mentioned in D4. The above-mentioned unit "electrode selection and encoding" in Figure 1 cannot be equated thereto since

it explicitly refers to encoding, rather than to decoding or demultiplexing. Anyway, it is located inside the eye, contrary to the requirement in alternatives a) and b) of part II of item c). The fact that D9 is quoted as reference [9] in the introductory part of D4 (end of the first paragraph of the left-hand column of page 2308) does not imply that the device described in D4 actually comprises the same structural components as that of D9 (which latter document explicitly discloses a decoding and demultiplexing circuit block in Figure 3). Firstly, the reference is only cursory and merely mentions that components for a ganglion cell stimulation implant were developed in several groups in the U.S. and in Germany. Secondly, the authors of D4 and D9 are entirely different. Thirdly, the researchers are not from "the same institute", as argued by the appellant opponent. Those of D4 are affiliated to the "Fraunhofer Institute for Biomedical Engineering" in St. Ingbert, whereas those of D9 are from the "Fraunhofer Institute of Microelectronic Circuits and Systems" in Duisburg and the "Institute of Infomatics VI" of the University in Bonn. Even though the two "Fraunhofer Institutes" are part of the German Fraunhofer association ("Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V."), they are separate research institutes at different locations.

The flexible stimulation device is depicted in Figure 4 of D4, with the respective dimensions given in Table 1. It comprises an "active area" with the electrodes, an "interconnect" (f) and an area designated as "connection pad" (a, b) "for contacting microelectronic circuitry" (first paragraph of right-hand column of

page 2308). This general statement, however, does not imply the presence of a **decoding and demultiplexing** circuit block. Accordingly, at least this feature distinguishes claim 1 from D4.

3.4.4 From the above it follows that none of the cited prior-art documents discloses in combination the features of claim 1 of auxiliary request 1. Its subject-matter is therefore novel within the meaning of Article 54(1) and (2) EPC.

3.5 Inventive step

3.5.1 D1 as starting point

As mentioned above, claim 1 is distinguished over D1 in that the decoding and demultiplexing circuit block is suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera. This arrangement allows easier access to the circuit block in comparison to a situation where it is located within the eye as disclosed in D1.

The objective technical problem to be solved by this distinguishing feature is to facilitate replacement or updating of the circuit block. This problem is also indicated in paragraph [0032] of the patent in suit. There is no reason to reformulate the stated problem, which is credibly solved by the distinguishing feature.

D1 itself gives no hint to depart from the disclosed concept of locating all the components of the "intra ocular stimulator" (caption of Figure 5), including the

decoding and demultiplexing circuit block, within the eye.

The assertion of the appellant opponent that the skilled person would be well aware of the fact that the circuit block, when attached to the outside wall of the sclera, is easier to explant and replace if it becomes dysfunctional, and that he would thus obviously consider such an arrangement, is based on hindsight.

In point 7 of D24 (which is a declaration of one of the inventors of the patent in suit) it is stated that the inventors were aware in 1998 of the fact that the intra-ocular space was too small to accommodate all the components of the retinal stimulation device, at which time the available components were still too large. Contrary to the view of the appellant opponent, the inventors' statement cannot be interpreted in a sense that there was a general motivation to position certain components outside the eye. Even if this was the case, it still remains open which one of the components should be placed outside the eye (with the exception of the stimulation electrodes which must be located within the eye) and where exactly this extra-ocular component was to be located and attached. Accordingly, this general statement cannot be understood to suggest that the decoding and demultiplexing circuit block should be suitable to be located outside the wall of the sclera and attached thereto.

With reference to D8 (page 523, 2nd paragraph), the appellant opponent argued that it was generally known that electronic circuitry produced heat and that hotter portions of a device should be placed "remote from the

most sensitive regions of the tissue". However, this very general teaching still leaves open where these components would have to be located, so that it does not render obvious the decoding and demultiplexing circuit block as being suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera. The issue of whether or not heat production actually presents a problem in view of the good blood supply to the eye and the vitreous cavity acting as a heat sink can thus be left unanswered.

D2 discloses an extracorporeal RF transmitting antenna 24 which is in wireless communication with an RF receiver forming part of an implantable unit having a signal developing portion 18. The latter is connected via lead 16 to a stimulation electrode 14. As shown in Figure 1A and described in column 3, lines 48 to 61, the lead 16 penetrates the sclera 28 and is inserted with the electrode into the ciliary muscle which is to be stimulated. This, however, is quite different from an electrode array for stimulating retinal tissue. More importantly, D2 is silent regarding a decoding and demultiplexing circuit block. In Figure 2, the signal developing portion 18 is shown to be "located on the body of the user outside a wall of the sclera" (yet not "attached to the sclera" as claimed). No specific advantages are mentioned in D2 with respect to this location. Accordingly, the skilled person starting from D1 had no reason to consider the teaching of D2 and, even if he did so, he would not arrive at the solution as defined in claim 1.

The Board has no doubts that trans-scleral leads were generally known in the field of ophthalmological surgical implants at the priority date of the patent in suit, as stated in Mr. Richard's declaration D10. However, his assessment of the teaching in the prior art and his opinion that the skilled person would have been inclined to reduce the number of intra-ocular components in order to obtain easier access for replacement at a later stage are not shared by the Board.

From the above it follows that the subject-matter of claim 1 is not obvious from D1 in view of common technical knowledge as evidenced by D8, D10 and D24, or in view of D2.

#### 3.5.2 D9 as starting point

Since the distinguishing feature of claim 1 over D9 is the same as over D1, as explained above in point 3.4.2, and since D9 itself also does not give any hint towards this feature, its subject-matter is not obvious, for the same reasons as indicated above in point 3.5.1.

#### 3.5.3 D4 as starting point

As mentioned in point 3.4.3, the presence of a decoding and demultiplexing circuit block is not directly and unambiguously derivable from D4. In a telemetric unit for signal and data transmission between an extracorporeal transmitter and an intracorporeal receiver as disclosed in D4, a decoding and demultiplexing circuit block was, however, standard practice, as can be seen, for instance, from Figure 5



of D1 or from Figure 3 of D9. The skilled person would thus have routinely included such a circuit block in the device of D4. It may be agreed that the circuit block would then most likely form part of the "microelectronic circuitry" to be contacted to the area designated as "connection pad" (a, b) of the flexible stimulation device depicted in Figure 4 of D4. Even though the exact correlation between "flexible retina stimulation device" shown in Figure 4 and the four interconnected intra-ocular units ("receiver coil", "receiver (energy and data)", "electrode selection and encoding" and "flexible stimulation electrodes") shown in Figure 1 is not entirely clear, there is no doubt that the decoding and demultiplexing circuit block would then be located within the eye. Accordingly, the question to be answered is whether the skilled person would obviously modify this device such that the circuit block is suitable to be attached to the outside wall of the sclera.

D4 itself gives no hint towards such an extra-scleral attachment, let alone the above-mentioned advantages achievable thereby. On the contrary, it is stated in the penultimate paragraph of the right-hand column of page 2308 that the "curvature of the device was adapted to the spherical shaped bulbus in a temper step before implantation". This statement teaches away from attaching the decoding and demultiplexing circuit block to the outside wall of the sclera. Even though the dimensions of the intra-ocular stimulation device disclosed in Table 1 of D4 are such that the skilled person could (in principle) attach the circuit block to the outside wall of the sclera, he clearly would not do so in view of said statement, which implies that any

further deformation of the geometrical shape should be avoided after the temper step performed to increase the toughness of the device. However, an extra-scleral attachment of a circuit block connected to the connection pad of the intra-ocular stimulation device of D4 would necessarily require further deformation of the device, thus going against the purpose of the temper step. For this reason alone, the subject-matter of claim 1 is not obvious from D4.

- 3.5.4 D1, D4 and D9 consistently teach to locate all implanted components of the retinal stimulator inside the eye and none of the cited prior-art documents gives a hint towards rendering one of these components, namely the decoding and demultiplexing circuit block, suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera. Accordingly, the subject-matter of claim 1 of auxiliary request 1 is based on an inventive step within the meaning of Article 56 EPC.

#### 4. Procedural issues

##### 4.1 Request for referral of questions to the Enlarged Board

When formulating its questions to be referred to the Enlarged Board of Appeal, the appellant opponent started from the premise that the present Board construed the feature "suitable to be located on the body of the user outside a wall of the sclera" in a narrow way, thereby departing from the well-established jurisprudence of the Boards of Appeal regarding the interpretation of the feature "suitable of". As explained supra in point 3.4.1, however, this is not

the case. On the contrary, the Board did follow the established approach and came to the conclusion that the decoding and demultiplexing circuit block of D1 and D9 was not "suitable to be located on the body of the user outside a wall of the sclera" (in D4 even the presence of such a circuit block was not directly and unambiguously derivable). Accordingly, questions (1) and (2) are devoid of any basis.

As detailed above in point 3.2, the claim construction of the present Board is also in conformity with the established jurisprudence of the Boards of Appeal not to allow claims directed to methods of treatment of the human body by surgery falling under the exception clause of Article 53(c) EPC. Question (3) is also based on an improper assumption and therefore unfounded as well.

Under Article 112(1) (a) EPC it is for the Boards of Appeal to refer a case to the Enlarged Board of Appeal if this appears necessary for ensuring uniform application of the law or if a point of law of fundamental importance arises. Since the present Board followed the established jurisprudence with respect to the two issues indicated above, uniform application of the law is not at issue. The questions also do not address an important point of law needing to be considered by the Enlarged Board of Appeal. It moreover appears that a general answer to the proposed questions is not possible, in particular to questions (1) and (3) since they address (presumed) specific claim constructions related to the present case. Questions as to how a patent claim is to be interpreted and understood in view of the content of the technical

teaching should not normally be referred ("Case Law of the Boards of Appeal of the EPO", 6th ed. (2010), VII.E.14.2, 3rd paragraph). Therefore, the request of the appellant opponent for referral of the three questions to the Enlarged Board of Appeal is rejected under Article 112(1) (a) EPC.

#### 4.2 Request for a legal hint

The appellant opponent requested during the oral proceedings that the Board should provide it with a "legal hint" as to which features of claim 1 of auxiliary request 1 rendered its subject-matter novel over documents D1, D4 and D9, without however providing any legal basis obliging the Board to do so. Neither is the Board aware of a legal basis under the EPC or the RPBA for such a duty of the boards, nor of any jurisprudence of the Enlarged Board of Appeal to that effect. Pursuant to Rule 102(g) EPC, the reasons for the decision are all given in the final decision. No provision of the EPC requires a Board of Appeal to advise a party in advance of the details of its conclusions on arguments presented in favour of or against a certain objection, before presenting its written decision. Moreover, the Board would thereby be assisting one particular party, in this case the appellant opponent, and thus compromising its neutrality. For these reasons, this request is rejected.

#### 4.3 Request for enlargement of the Board

The present Board consists of two technically qualified members and one legally qualified member

(Article 21(3) (a) EPC). According to Article 21(3) (b) EPC and Article 9 RPBA, a decision to enlarge the Board is to be taken if it is considered by the Board that the nature of the appeal requires it. In the present case, the Board cannot see any need for enlargement. The reason put forward by the appellant opponent for its request to enlarge the Board, viz. that it could not address the issue of inventive step properly according to the EPO standard without being given a legal hint as specified in point 4.2, lacks any legal grounds. Moreover, it does not even relate to the nature of the appeal. Accordingly, the Board rejects this request.

4.4 Request for interruption and rescheduling of the oral proceedings

For the case that the requests mentioned above under points 4.2 and 4.3 were rejected, the appellant opponent requested an interruption of the oral proceedings and the scheduling of another date in order to allow it to argue inventive step on the basis of each single potentially novelty-establishing feature of claim 1 of auxiliary request 1.

Allowing such a request would result in a substantial delay, which is contrary to the requirement of procedural economy. Since it was indicated in the Board's communication annexed to the summons to oral proceedings that the issue of inventive step would be discussed, the appellant opponent had to be prepared to present its case on that during the oral proceedings as scheduled, irrespective of which features of claim 1 were found to confer novelty. Moreover, it was quite

clear in the present case which features of claim 1 were undisputedly disclosed in each of the three documents regarded as closest prior art. These documents were neither very long nor technically complicated. They had been in the proceedings for a long time and were in fact rather similar to each other. During the oral proceedings, the appellant opponent had due opportunity to present all its various objections on inventive step and to reply to the respective comments of the appellant patent proprietor.

Accordingly, the request for interruption and re-scheduling of the oral proceedings is not justified and therefore rejected.

#### 4.5 Request for recording a statement in the minutes

Pursuant to Rule 124(1) EPC the minutes of oral proceedings must contain the essentials of these proceedings and the relevant statements made by the parties. According to the jurisprudence of the Boards of Appeal (e.g. T 71/06, Reasons, point 6), it is not the function of the minutes to record statements which a party considers to be possibly relevant, such as the statement made by the representative of the appellant opponent relating to the Board's alleged denial of the legal right to be heard. This statement does not relate to the surrender or abandonment of subject-matter and does not otherwise have any impact on the definition of the subject-matter to be dealt with by Board. It does not form part of the essentials of the oral proceedings and is not relevant for the present decision, either. Consequently, it is not a proper subject for the minutes according to Rule 124(1) EPC. Nevertheless, the

request as submitted in writing was annexed to the minutes and mentioned under the heading "Documents presented" at the beginning of the minutes, as is usual practice for ensuring an orderly keeping of the file, and the statement is thus part of the proceedings.

**Order**

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

1. The appeal of the opponent is dismissed.
2. The decision under appeal is set aside.
3. The case is remitted to the department of first instance with the order to maintain the patent on the basis of:
  - claims 1 to 29 of the auxiliary request 1 filed with letter dated 22 May 2009;
  - the description and the figures of the patent specification;
4. The request for referral of three questions to the Enlarged Board of Appeal is rejected.

The Registrar:

The Chairman:

D. Hampe

E. Dufrasne