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**Datasheet for the decision  
of 19 September 2014**

**Case Number:** T 0538/11 - 3.2.02  
**Application Number:** 02718463.9  
**Publication Number:** 1381304  
**IPC:** A61B5/00, A61B6/00, G06F19/00  
**Language of the proceedings:** EN  
**Title of invention:**  
MEDICAL DIAGNOSTIC SYSTEM  
**Applicant:**  
Koninklijke Philips N.V.  
**Headword:**

**Relevant legal provisions:**

EPC Art. 84, 111(1)  
RPBA Art. 13(1)

**Keyword:**

Claims - clarity - second auxiliary request (no) -  
first auxiliary request (yes)  
Late-filed requests - procedural economy  
Appeal decision -  
remittal to the department of first instance (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
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Case Number: T 0538/11 - 3.2.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 19 September 2014**

**Appellant:** Koninklijke Philips N.V.  
(Applicant) High Tech Campus 5  
5656 AE Eindhoven (NL)

**Representative:** Maiwald Patentanwalts GmbH  
Elisenhof  
Elisenstrasse 3  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 15 October 2010  
refusing European patent application No.  
02718463.9 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** E. Dufrasne  
**Members:** C. Körber  
D. Ceccarelli

## **Summary of Facts and Submissions**

- I. On 15 October 2010 the Examining Division posted its decision to refuse European patent application No. 02718463.9 for lack of clarity.
- II. An appeal was lodged against this decision by the applicant by notice received on 7 December 2010, with the appeal fee being paid on the same day. The statement setting out the grounds of appeal was received on 15 February 2011.
- III. With letter dated 7 May 2014, the appellant filed a "PACE request" for accelerated examination of its application.
- IV. By communication of 6 June 2014, the Board summoned the appellant to oral proceedings and forwarded its provisional opinion.
- V. Oral proceedings were held on 19 September 2014. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the second auxiliary request or, in the alternative, of the main request, both filed with letter dated 16 April 2013, or the first auxiliary request, filed during the oral proceedings, or the third auxiliary request, filed with letter dated 16 April 2013, in that order.
- VI. Claim 1 of the **second auxiliary request** reads:  
  
"An X-ray examination apparatus (1) which comprises a plurality of adjustable functions, including  
- a local group (3) of adjustable functions which involve a risk and can be adjusted only at the site of the X-ray examination apparatus (1), and

- a global group (4) of adjustable functions which can be adjusted on the basis of communication with a service center (300) remote from the X-ray examination apparatus (1)."

Claim 1 of the **main request** reads:

"A medical diagnostic system (1) which comprises a plurality of adjustable functions, including  
- a local group (3) of adjustable functions which can be adjusted only at the site of the medical diagnostic system (1), and  
- a global group (4) of adjustable functions which can be adjusted on the basis of communication with a service center (300) remote from the medical diagnostic system (1)."

Claim 1 of the **first auxiliary request** reads:

"An X-ray examination apparatus (1) which comprises a plurality of adjustable functions, including  
- a local group (3) of adjustable functions which can be adjusted only at the site of the X-ray examination apparatus (1), and  
- a global group (4) of adjustable functions which can be adjusted on the basis of communication with a service center (300) remote from the X-ray examination apparatus (1)."

Claims 2 to 5 of all these requests are dependent claims.

VII. The appellant's arguments are summarised as follows:

Contrary to the findings in point 1.7 of the reasons of the impugned decision, the term "risk" was not

ambiguous and unclear. A person skilled in the technical field of X-ray examination apparatuses knew what a "risk" was. This was evident from a publication in "MTD Medizin-Technischer Dialog" 10/2000, pages 34 to 38, where it was mentioned that under German, European and American law risk management was consistently required for medical products, and that the procedure for the risk management process was explained in the international norm DIN EN ISO 14971. The term "risk" and related terms like e.g. "risk management" were used throughout the norm ISO 14971, first edition 2000-12-15, entitled "Medical devices - Application of risk management to medical devices". The terms "risk" and related terms were also disclosed in the European Council Directive 93/42/EEC of 14 June 1993 concerning medical devices. In summary, the term "risk" was a term used in laws and norms relating to the field of medical devices, and therefore a term which was obviously clear for a person skilled in the art of X-ray examination apparatuses. In this field it was well known that the exposure of the patient and operating personnel to X-ray radiation was critical and that the movement of parts of the apparatus could also be harmful and risky.

With regard to the clarity objections raised in the impugned decision, claim 1 of the main request comprised the same wording as claim 1 of the first auxiliary request, which the Board considered to comply with Article 84 EPC in its communication of 6 June 2014. After filing the statement of grounds of appeal the appellant had recognised that apart from an X-ray examination apparatus other medical diagnostic systems such as Magnet Resonance Tomographs (MRTs) were also covered by the inventive concept. A patent had already been granted in the USA on the basis of a corresponding

claim, and it was therefore justified to re-file it in the European procedure. Accordingly, the late filing of the main request should be admitted by the Board.

The appellant's arguments presented with respect to the first auxiliary request are in essence those on which the corresponding part of the reasons of this decision is based (point 4 below).

The appellant further submitted that as the file had been pending in appeal for almost four years, the Board should issue a decision on all patentability requirements and not remit the case to the department of first instance for further prosecution. This would lead to an unacceptable delay and even the possibility of a second appeal, which was contrary to the appellant's legitimate interest in legal certainty, in particular for licensing purposes.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Second auxiliary request - clarity

Claim 1 comprises the expression that the local group of adjustable functions "involve a risk". The broad term "a risk" is ambiguous and vague in that it leaves entirely open the nature of the risk and the object or subject affected thereby. It remains a matter of subjective judgement to determine what does or does not involve a risk with respect to an "adjustable function". Such an ambiguous and ill-defined term is not acceptable in claim language, because it does not adequately define the subject-matter for which protection is sought.

The evidence cited by the appellant in order to demonstrate that the term "risk" has a clear meaning relates to standards and legal regulations in the general field of medical devices. The fact that the terms "risk", "risk management" and the like are actually disclosed and used in these documents, as stated by the appellant, does not prove that a clear technical meaning can be attributed to the entirely undefined term "a risk" as used in the claim. The mere use of a term in such kinds of documents does not imply that it has a clear technical meaning. Moreover, such regulations are generally subject to change, and the reader of the claim would be at a loss to know which regulation is to be considered.

The fact that the term "a risk" is used in the context of an X-ray examination apparatus, as claimed, does not change the above finding. Even though not explicitly stated in the claim, it may be assumed that risks associated with use of the X-ray examination apparatus are meant. However, even under these circumstances, the term does not have a well-defined technical meaning. What constitutes "a risk" of an adjustable function of an X-ray examination apparatus still remains a matter of subjective judgement.

Nor can it be said that the meaning of the general term "a risk" is well known to the skilled person in view of the few examples indicated in the description, i.e. risks related to remote activation of the X-ray source or to unsupervised setting of the stand in motion (page 2, lines 11 to 14). An X-ray examination apparatus generally comprises a great variety of adjustable functions (which may be related to the X-ray radiation itself or to other features of the



apparatus), and the skilled person is not in a position to unequivocally establish which ones "involve a risk", and which do not.

Accordingly, the expression "which involve a risk" renders claim 1 unclear, contrary to the requirements of Article 84 EPC.

3. Main request - admissibility

This request was filed with letter dated 16 April 2013, i.e. after the statement setting out the grounds of appeal was received, and thus constitutes an amendment to the appellant's case. Under Article 13(1) RPBA, the admissibility of such amendments is at the Board's discretion. This discretion is to be exercised in view of inter alia the need for procedural economy.

Compared to claim 1 of the main request filed with the statement of grounds of appeal (which corresponds to the present first auxiliary request and to the main request underlying the impugned decision), claim 1 comprises the expression "medical diagnostic system" instead of "X-ray apparatus". The appellant's statement that it had recognised that apart from an X-ray examination apparatus (as claimed in all the requests filed with the statement of grounds of appeal) "other medical diagnostic systems ... are covered by the inventive concept" is not a suitable explanation with respect to the clarity issues which formed the basis of the impugned decision. The appellant's wish to have the same wording as in the proceedings in the USA is not a legitimate justification for the late filing of such a request in separate proceedings before the boards of appeal of the EPO.

Moreover, claim 1 is in substance identical to original claim 1 which was objected to for lack of novelty vis-à-vis two prior art documents in the Examining Division's communication dated 3 July 2009, and consequently amended by the applicant in the examination proceedings without providing any argument with respect to these documents. It would run against the requirement of procedural economy to admit a request with a substantially identical independent claim filed late in appeal proceedings.

Accordingly, this request is not admitted under Article 13(1) RPBA.

4. First auxiliary request - clarity

The Board considers that the clarity objections in points 1.2, 1.3 and 1.5 of the reasons for the impugned decision are not justified.

Point 1.2 indicates that the definitions "at the site" and "remote" overlap, so that the distinction between the local group and the global group is ambiguous. However, a possible overlap of the terms "at the site" and "remote" does not result in any ambiguity. As an example, a remote control of a TV apparatus may be remote, i.e. at a distance, from the TV apparatus or at the site thereof, e.g. in the same room, but it remains a remote control. In a similar manner, the remote service center (300) of claim 1 may be located at any distance from the examination apparatus (1), and remains a remote service center regardless of the actual distance. In contrast to what is stated in point 1.5, the spatial definitions in the claim are not considered to be vague and imprecise.

According to point 1.3 "[t]he action of installing a function entails the feature of adjusting the same, at least within the normally understood broad meaning of 'adjusting'". The Examining Division gives no explanation why such "normally understood broad meaning" was employed in respect of the term "adjusting", and also gives no explanation for the finding that the action of installing a function entails the feature of adjusting the same. The Board considers that a function can only be adjusted once it is installed, and its installation therefore cannot be said to necessarily entail its adjustment. The terms "adjusting" and "installing" are clearly employed as different terms in the description at page 1, line 28 to page 2, line 14, and at page 2, lines 17 to 24, respectively. In the latter passage it is mentioned that "the installation platform is arranged for remote **installation** of adjustable functions ... such that the new **adjustment** is not yet activated" [emphasis added]. A similar explanation can be found at page 4, lines 2 to 13. Accordingly, the two terms do have a clearly distinct meaning, as also explained in the description, and the artificially broad interpretation of the claim language adopted by the Examining Division is not appropriate. The Board cannot recognise any contradiction or discrepancy with the description in this respect.

Claim 1 does not include the unclear expression "which comprise a risk" forming part of claim 1 of the second auxiliary request.

Accordingly, claim 1 of the first auxiliary request (as well as dependent claims 2 to 5) is considered to be clear and supported by the description, as required by Article 84 EPC.

5. Procedural issues

The appellant requested that the case not be remitted to the department of first instance for further prosecution. Under Article 111(1) EPC, the Board's decision to remit or not is a discretionary one.

The appellant argued that its case had already been pending in appeal proceedings for almost four years and that a remittal would give rise to an unacceptable delay in the grant of the patent, with even the possibility of a second appeal. In this respect, however, it is noted that a "PACE request" for accelerated examination was only filed on 7 May 2014. As explained in the "Notice from the Vice-President Directorate-General 3 dated 17 March 2008 concerning accelerated processing before the boards of appeal" (OJ EPO 2008, 220), the filing of such a mere request, without providing any further explanation, reasoning or documents, does not mean that the case will necessarily be regarded as urgent and treated with preference in appeal proceedings. Nonetheless, the Board issued its summons to oral proceedings just one month after the request was filed.

But the request for non-remittal was presented for the first time during the oral proceedings. The impugned decision deals with clarity only, and during the appeal proceedings the appellant has not commented at all on the cited prior art and patentability requirements. Accordingly, the request raises issues which the Board could not reasonably be expected to deal with during the oral proceedings.

In this context, the total length of the procedure in view of the appellant's legitimate interest in legal certainty, in particular for licensing purposes, is not a decisive issue.

Under the given circumstances the Board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the department of first instance.

6. Since the first auxiliary request fulfils the requirements of Article 84 EPC, as indicated above in point 4, there is no need for the Board to deal with the third auxiliary request.

## **Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated