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**Datasheet for the decision
of 23 May 2014**

Case Number: T 0623/12 - 3.2.08

Application Number: 05766902.0

Publication Number: 1763324

IPC: A61C8/00

Language of the proceedings: EN

Title of invention:

INTERNAL CONNECTION DENTAL IMPLANT

Patent Proprietor:

Keystone Dental, Inc.

Opponent:

Nobel Biocare AB

Headword:

Relevant legal provisions:

EPC Art. 113(1)
EPC R. 103(1)(a)
RPBA Art. 11

Keyword:

Right to be heard - substantial procedural violation (yes)
Reimbursement of appeal fee - (yes)

Decisions cited:

R 0001/13, G 0004/95

Catchword:



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Case Number: T 0623/12 - 3.2.08

**D E C I S I O N
of Technical Board of Appeal 3.2.08
of 23 May 2014**

Appellant:
(Patent Proprietor)

Keystone Dental, Inc.
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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 15 March 2012
revoking European patent No. 1763324 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: P. Acton
D. T. Keeling

Summary of Facts and Submissions

- I. The appellant (patent proprietor) filed a notice of appeal which was received at the EPO on 19 March 2012 against the Opposition Division's decision posted on 15 March 2012 revoking European patent EP 1 763 324. The appeal fee was paid simultaneously and the statement of grounds was received on 10 April 2012.
- II. In its decision, the Opposition Division held that claim 1 of the patent as granted (main request then on file) met the requirements of Article 123(2) EPC but that its description did not. Auxiliary requests 1 to 7 filed at the oral proceedings were admitted into the proceedings but found to contravene Article 123(2) EPC.
- III. Oral proceedings took place before the Board of Appeal on 23 May 2014.

The appellant requested:

- to set aside the decision under appeal,
- to remit the case to the Opposition Division on account of substantial violation of the right to be heard, and to reimburse the appeal fee,
- to reject the opposition, and to maintain the European patent on the basis of the Main Request filed with letter of 19 March 2012 or on the basis of one of the auxiliary requests 1 to 6 filed with letter of 19 March 2012, with the description and drawings filed in conjunction with auxiliary requests 8 on 14 February 2012, or on the basis of the patent as granted.

The respondent requested that the appeal be dismissed and not to admit the appellant's requests filed

together with the notice of appeal into the proceedings.

IV. Independent claim 1 as granted (main request underlying the appealed decision) reads:

"A dental implant comprising:
a body (13) having a longitudinal axis, a proximal end (16) and a distal end (15);
implant retaining means (18) provided on an external portion of said body (13);
an internal bore provided within a portion of said body (13), said internal bore having a proximal end at the proximal end (16) of said body (13) and a distal end;
an internally facing surface (35) having a proximal end and a distal end (33), said surface extending from near the proximal end of said internal bore toward the distal end of said internal bore, said surface being beveled inwardly toward its distal end (33);
an internally facing drive region (31) positioned within said internal bore between the distal end (33) of said internally facing surface (35) and the distal end of said internal bore, said drive region (31) including a plurality of concave lobes (38) and a plurality of convex lobes (39) alternating with said concave lobes (38), the radially outermost points of each of said concave lobes (38) lying on a circle defining a major diameter (40) and the radially innermost points of each of said convex lobes (39) lying on a circle defining a minor diameter (41), wherein at least a portion of both of said concave and convex lobes (38, 39) have either a circular or elliptical configuration;
an accommodation region (44) positioned within said internal bore and between the distal end (42) of said

drive region (31) and the distal end of said internal bore; and
an internally threaded portion (32) positioned within said internal bore and between said accommodation region (44) and the distal end (15) of said body (13), said threaded portion (32) having a diameter less than said minor diameter (41)."

Independent claim 1 of auxiliary request 1 underlying the decision under appeal reads:

"The combination of a dental implant (11) and an abutment (12) connectable to said implant (11); said dental implant comprising:

- a body (13) having a longitudinal axis, a proximal end (16) and a distal end (15);
- implant retaining means (18) provided on an external portion of said body (13);
- an internal bore provided within a portion of said body (13), said internal bore having a proximal end at the proximal end (16) of said body (13) and a distal end;
- an internally facing surface (35) having a proximal end and a distal end (33), said surface extending from near the proximal end of said internal bore toward the distal end of said internal bore, said surface being beveled inwardly toward its distal end (33) at an angle of 8° to 40° relative to said longitudinal axis;
- an internally facing drive region (31) positioned within said internal bore between the distal end (33) of said internally facing surface (35) and the distal end of said internal bore, said drive region (31) including a plurality of concave lobes (38) and a plurality of convex lobes (39) alternating with said concave lobes (38), the

radially outermost points of each of said concave lobes (38) lying on a circle defining a major diameter (40) and the radially innermost points of each of said convex lobes (39) lying on a circle defining a minor diameter (41), wherein at least a portion of both of said concave and convex lobes (38, 39) have either a circular or elliptical configuration;

- an accommodation region (44) positioned within said internal bore and between the distal end (42) of said drive region (31) and the proximal end of an internally threaded portion (32);
- wherein the internally threaded portion (32) is positioned within said internal bore and between said accommodation region (44) and the distal end (15) of said body (13), said threaded portion (32) having a diameter less than said minor diameter (41);

said abutment (12) has a proximal end (20) and a distal end (19) and comprises (Feature F):

- a first abutment surface (52) engaging said internally facing surface (35) when said dental implant (11) and said abutment (12) are connected,
- a second abutment surface corresponding to and adjacent to said drive region (31) when said dental implant (11) and said abutment (12) are connected
- a prosthesis mounting portion;
- a central bore (17) extending through at least a portion of said prosthesis mounting portion and to the distal end (19) of said abutment (12); and
- an abutment screw (14) extending through said central bore (17) and into said internally threaded bore when said dental implant (11) and said abutment (12) are connected;

wherein, when the abutment is assembled within the implant, the first abutment surface (35) and the internally facing surface (35) engage one another in a friction fit engagement providing a locking engagement between these two surfaces for providing stability between the abutment (12) and the implant (11) to preclude or reduce any rocking or micromotion between the abutment (12) and the implant (11) (Feature G)."

Differences with respect to claim 1 as granted are underlined.

Independent claim 1 of auxiliary request 2 underlying the decision under appeal differs from claim 1 according to auxiliary request 1 in that the following feature has been added to the second point under Feature F:

"the second abutment surface comprises convex lobes (46) and concave lobes (48), and wherein the length of the second abutment surface lobes (46, 48) is shorter than the length of the lobes (38, 39) of the internally facing drive region (31)" (Feature I)

Auxiliary requests 3 to 7 underlying the appealed decision all comprise Feature G and further additional features.

Claim 1 of auxiliary request 8 underlying the appealed decision differs from claim 1 of auxiliary request 2 in that it specifies in the first point under Feature F that the "first abutment surface (52) is a beveled, frustoconical surface", and in Feature G that "the first abutment surface (52) and the internally facing surface (35) engage one another in a friction fit

engagement providing tapered locking engagement between these two surfaces" (differences with respect to auxiliary request 2 underlined).

The references to Features F, G and I have been added by the Board.

V. The main request filed with letter dated 19 March 2012 together with the notice of appeal reads as follows:

"The combination of a dental implant (11) and an abutment (12) connectable to said implant (11); said dental implant comprising:

- a body (13) having a longitudinal axis, a proximal end (16) and a distal end (15);
- implant retaining means (18) provided on an external portion of said body (13);
- an internal bore provided within a portion of said body (13), said internal bore having a proximal end at the proximal end (16) of said body (13) and a distal end;
- an internally facing frustoconical surface (35) having a proximal end and a distal end (33), said surface extending from near the proximal end of said internal bore toward the distal end of said internal bore, said surface being beveled inwardly toward its distal end (33) at an angle of 8° to 40° relative to said longitudinal axis;
- an internally facing drive region (31) positioned within said internal bore between the distal end (33) of said internally facing surface (35) and the distal end of said internal bore, said drive region (31) including a plurality of concave lobes (38) and a plurality of convex lobes (39) alternating with said concave lobes (38), the radially outermost points of each of said concave

lobes (38) lying on a circle defining a major diameter (40) and the radially innermost points of each of said convex lobes (39) lying on a circle defining a minor diameter (41), wherein at least a portion of both of said concave and convex lobes (38, 39) have either a circular or elliptical configuration;

- an accommodation region (44) positioned within said internal bore and between the distal end (42) of said drive region (31) and the proximal end of an internally threaded portion (32);
- wherein the internally threaded portion (32) is positioned within said internal bore and between said accommodation region (44) and the distal end (15) of said body (13), said threaded portion (32) having a diameter less than said minor diameter (41);

said abutment (12) has a proximal end (20) and a distal end (19) and comprises:

- a first abutment surface (52) engaging said internally facing surface (35) when said dental implant (11) and said abutment (12) are connected, wherein said first abutment surface [sic] (52) is a beveled, frustoconical surface;
- a second abutment surface corresponding to and adjacent to said drive region (31) when said dental implant (11) and said abutment (12) are connected, wherein the second abutment surface comprises convex lobes (46) and concave lobes (48), and wherein the length of the second abutment surface lobes (46, 48) between their proximal end (49) and their distal end (50) is slightly shorter than the length of the lobes (38, 39) of the internally facing drive region (31);
- a prosthesis mounting portion;

- a central bore (17) extending through at least a portion of said prosthesis mounting portion and to the distal end (19) of said abutment (12); and
- an abutment screw (14) extending through said central bore (17) and into said internally threaded bore when said dental implant (11) and said abutment (12) are connected;

wherein, when the abutment is assembled within the implant, the first abutment surface (52) and the internally facing surface (35) engage one another in a friction fit engagement providing a tapered locking engagement between these two surfaces for providing stability between the abutment (12) and the implant (11) to preclude or reduce any rocking or micromotion between the abutment (12) and the implant (11)."

Differences with respect to claim 1 of auxiliary request 8 filed during the opposition proceedings are underlined.

VI. The appellant's arguments in support of the request for remittal of the case and a refund of the appeal fee can be summarised as follows:

The patent proprietor's right to be heard had not been respected by the Opposition Division, since it had not given the patent proprietor the possibility to react to objections which had been raised **for the first time** during the oral proceedings.

The minutes of the oral proceedings specified under point 8 that, when discussing the compliance of claim 1 of auxiliary request 1 with the requirements of Article 123(2) EPC, the issue of the frustoconical shape had been addressed only in respect to the abutment surface.

After the Opposition Division had come to the conclusion that claim 1 of auxiliary requests 1 to 7 did not comply with Article 123(2) EPC on the basis of an objection which could have been raised already in the written proceedings, it had given the patent proprietor only one opportunity to file a set of claims which overcame all problems related to Article 123(2) EPC.

The patent proprietor had filed a new auxiliary request 8 and only in respect to this request was the issue raised that the adjective "frustoconical" was missing with respect to the internally facing surface (35) as well.

Auxiliary request 8 was based on auxiliary request 2 which had been filed within the time limit given by the Opposition Division, i.e. one month before the oral proceedings. The objections relating to Feature I were addressed for the first time with respect to auxiliary request 8, despite the fact that the opponent had had enough time to react by addressing in writing all outstanding issues of all auxiliary requests.

Lastly, in spite of the fact that the patent proprietor had already prepared a request which took into account all deficiencies raised with respect to auxiliary request 8 for the first time during the oral proceedings, the Opposition Division had stuck to its position and did not admit the filing of any further requests. Therefore, it had not even exercised its discretion to admit a request or not. By simply prohibiting the filing of any further request it deprived the patent proprietor of the right to be heard and committed a major procedural violation.

VII. The respondent's arguments can be summarised as follows:

- a) Since auxiliary requests 1 to 7 had been filed exactly one month before the oral proceedings, the opponent had not had the opportunity to react to them within the period specified by the Opposition Division in the summons to the oral proceedings. Hence, since the oral proceedings were the only opportunity for the opponent to address these issues, the patent proprietor could expect to be confronted with new objections caused by the amendments it had introduced into the claims of the auxiliary requests.

It might have been that - as stated under point 8 of the minutes - only the issue of the frusto-conical shape of the abutment surface 52 had been addressed when discussing the allowability of the amendments introduced into claim 1 of auxiliary request 1. However, Article 113(1) EPC did not give the patent proprietor the right to receive information on all outstanding problems concerning a specific issue, but only the right to be heard on it.

- b) As a reaction to the objections relating to claim 1 of auxiliary request 1, the patent proprietor had filed a new claim 1 of auxiliary request 8 which was based on claim 1 of auxiliary request 2. By doing this the patent proprietor had not only tried to tackle the objections raised with respect to auxiliary request 1 but had also introduced additional features which had not yet been discussed. Therefore, the patent proprietor took a conscious risk of introducing further problems

into the claim, particularly given that the Opposition Division had pointed out that "the other requests may also suffer from other deficiencies under Article 123(2) EPC" (see minutes, point 13).

- c) As stated in R1/13 under point 13.2, Article 113(1) EPC does not "enshrine the possibility of a full reaction to overcome any late raised objections" but merely states that a decision can be based only on matters on which the parties concerned have had an opportunity to comment. Therefore, the Opposition Division had applied its discretion correctly in not allowing the filing of further requests and had not committed any procedural violation by doing so.

Therefore, the patent proprietor's right to be heard had been respected.

Reasons for the Decision

1. The appeal is admissible
2. Right to be heard

Article 113 EPC is the general provision that provides for the right to be heard in proceedings before the EPO. Under Article 113(1) EPC the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In inter partes proceedings this article reflects the principle that each party should have a proper opportunity to reply to the case which is

presented by an opposing party (G 4/95, point 10 of the reasons).

2.1 The Opposition Division found that the main request (patent as granted) did not comply with Article 123(2) EPC solely because some reference signs not present in the application as filed had been introduced in the drawings. They further found that claim 1 of auxiliary requests 1 to 7 and claim 1 of auxiliary request 8 (filed during the oral proceedings in the attempt to overcome the objections raised with respect to claim 1 of auxiliary request 1) likewise did not comply with Article 123(2) EPC.

2.2 Auxiliary requests 1 to 7 were found to be not allowable on the grounds that Feature G constituted an unallowable intermediate generalisation and that Figure 12 comprised reference sign "47", which was not originally disclosed. The latter objection, however, did not apply to the version intended by the patent proprietor, who had clearly stated its intention to remove the offending reference sign (see minutes, point 7).

As to Feature G, it is undisputed that, although this feature was already present in the claims filed in reply to the notice of opposition on 21 March 2011, no objection under Article 123(2) EPC in respect to this feature was raised during the written proceedings.

In particular, for the first time during the discussion of auxiliary request 1 at the oral proceedings the opponent raised the objection that claim 1 failed to define the locking engagement as being "tapered" and the first abutment surface 52 (see minutes, point 8) as

being "frustoconical", while Feature G was originally disclosed only in combination with this arrangement.

Accordingly, auxiliary requests 1 to 7 all failed by reason of an objection which could have been raised in the written procedure but was first submitted at the oral proceeding.

2.3 After the discussion of auxiliary requests 1 to 7, the opposition division gave the patent proprietor only one opportunity to file a claim in order to overcome all problems relating to Article 123(2) EPC (see minutes, point 13).

2.4 The patent proprietor decided to file auxiliary request 8, whose claim 1 was based on auxiliary request 2 (filed with letter of 12 January 2012), where Features F and G were amended with the aim of remedying the flaws of claim 1 of auxiliary request 1.

2.4.1 The Opposition Division found that claim 1 according to auxiliary request 8 still did not comply with the requirements of Article 123(2) EPC since

(a) Feature G was originally disclosed only in combination with the further features according to which the internally facing surface (35) is frustoconical and since

(b) the adjective "slightly" was missing from Feature I

2.4.2 The appellant submitted that, although the decision stated under point 8 that objection (a) relating to the frustoconical shape of the internally facing surface (35) had been raised for the second time with respect

to auxiliary request 8, this objection was actually raised for the first time in the context of auxiliary request 8. The respondent did not dispute this account of the facts.

Indeed, the minutes are silent about any objection raised with respect to this feature against auxiliary requests 1 to 7 and mention it for the first time in the discussion of auxiliary request 8 (see point 19).

Hence, the Board is satisfied that the objection relating to the frustoconical form of the internally facing surface (35) was raised for the first time with respect to claim 1 of the auxiliary request 8.

- 2.4.3 As to the further objection (b) relating to Feature I, it is undisputed that this objection was raised for the first time in the context of auxiliary request 8.
- 2.4.4 However, both objections (a) and (b) could have been raised at an earlier stage of the proceedings. As explained above, Feature G was already present in the claims submitted on 21 March 2011. Moreover, contrary to what the decision under appeal appears to suggest (see first full paragraph on page 10), Feature I was not introduced into the claims from the description for the first time in auxiliary request 8, but was already present in auxiliary request 2.
- 2.5 After auxiliary request 8 failed due to these objections, the patent proprietor was not even allowed to file a further request which could have solved them.
 - 2.5.1 The respondent argued that the patent proprietor took a conscious risk in amending the claim by inserting features which had not been discussed when dealing with

the previous requests, especially since the patent proprietor had been warned by the Opposition Division that the auxiliary requests which had not been discussed in detail might raise further problems with regard to Article 123(2) EPC.

It is correct that the patent proprietor ran a risk by basing auxiliary request 8 on auxiliary request 2, which had not been completely discussed yet. However, since there was the understanding that the patent proprietor was allowed to file only one further request, the patent proprietor was forced, in reaction to the late-filed objections concerning the failure of auxiliary requests 1 to 7, to choose one amongst those auxiliary requests as a basis for auxiliary request 8, without knowing which of them would be found to comply with Article 123(2) EPC. Hence, the risk taken by the proprietor was the consequence of the limitation to only one request imposed by the Opposition Division.

Moreover, the the Opposition Division's warning that "other requests may suffer from other deficiencies under Article 123(2) EPC" (minutes, point 13) did not provide the proprietor with a basis for an informed choice amongst auxiliary requests 1 to 7, since neither these objections nor the requests affected by them were specified.

- 2.5.2 The respondent submitted with reference to R1/13 that the right to file a request could not be derived from the fact that the objections to which it was intended to respond had been raised late. Indeed, R1/13 states under point 13.2 that Article 113(1) EPC does not "enshrine the possibility of a full reaction to overcome any late raised objections", but merely states that a decision can be based only on matters on which

the parties concerned have had an opportunity to comment. However, the case underlying R1/13 is completely different from the present one, because in the case considered by the Enlarged Board the patent proprietor was allowed, in response to a late-filed objection, to file two new requests which, after a discussion on their admissibility, were not admitted into the proceedings (see points II.4 to II.6 of the facts and submissions). In this sense the proprietor was not entitled to a full reaction, i.e. to file new requests and have them admitted into the proceedings.

By contrast, in the present case, the patent proprietor did even not have the opportunity to file the request and to comment on its admissibility.

By acting in this manner the Opposition Division did not exercise its discretion about the admissibility of the late-filed request but arbitrarily decided not to allow the request to be filed.

This arbitrary decision deprived the patent proprietor of a proper opportunity to comment on the admissibility of this further request and to reply to the late-filed objections of the opposing party. Hence, it was deprived of the right to be heard.

In view of this fundamental deficiency, the Board decides to remit the case to the Opposition Division (Article 11 RPBA).

3. Reimbursement of appeal fee

According to Rule 103(1)(a) EPC the reimbursement of appeal fees is ordered where the Board of Appeal deems an appeal allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

In the present case, the main request submitted with the grounds of appeal comprises the features whose absence was objected to by the Opposition Division. Hence, it aims at overcoming the objections under Article 123(2) EPC raised against auxiliary request 8 underlying the decision under appeal. It was the possibility of filing precisely such a request that was denied to the appellant as a result of the substantial procedural violation.

Hence, there is a self-evident causal link between the violation of the appellant's right to be heard and the necessity to appeal. Therefore, the reimbursement of the appeal fee is equitable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



A. Wolinski

M. Alvazzi Delfrate

Decision electronically authenticated