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**Datasheet for the decision
of 18 January 2019**

Case Number: T 2262/13 - 3.5.04

Application Number: 10186189.6

Publication Number: 2325803

IPC: G06T7/00

Language of the proceedings: EN

Title of invention:

Evaluating optical coherence tomography information for an anatomical structure

Applicant:

The General Hospital Corporation

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (yes)

Decisions cited:

Catchword:



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Case Number: T 2262/13 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 18 January 2019

Appellant: The General Hospital Corporation
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Representative: Quinterno, Giuseppe
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 20 June 2013
refusing European patent application
No. 10186189.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman C. Kunzelmann
Members: M. Paci
G. Decker

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 10 186 189.6, published as EP 2 325 803 A1.
- II. The decision under appeal was based on the grounds that the subject-matter of claim 1 according to the main request then on file did not meet the requirements of Articles 83, 84, 54 and 56 EPC and that the subject-matter of claim 1 according to the auxiliary request then on file did not meet the requirements of Articles 123(2), 83, 84 and 56 EPC.
- III. With the statement of grounds of appeal, the appellant filed four sets of amended claims according to a main request and first to third auxiliary requests replacing all the claims underlying the decision under appeal.
- IV. The board issued a summons to oral proceedings together with a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536). It gave its preliminary opinion that claim 1 according to each of the main and first to third auxiliary requests did not meet the requirements of Articles 123(2), 76(1), 84 and 83 EPC and expressed doubts that its subject-matter involved an inventive step as required under Article 56 EPC.
- V. The appellant did not comment on the board's objections. Instead, in a letter dated 4 December 2018, it informed the board that it would not be attending the oral proceedings.
- VI. The board held oral proceedings on 18 January 2019. As announced, the duly summoned appellant did not attend.

At the oral proceedings, the chairman noted that the appellant had requested that the decision under appeal be set aside and a European patent be granted on the basis of the claims of the main request or, in the alternative, one of the first to third auxiliary requests, all requests filed with the statement of grounds of appeal.

At the end of the oral proceedings, the chairman announced the board's decision.

VII. Claim 1 according to the appellant's **main request** reads as follows:

"A software system for evaluating at least one optical coherence tomography image which depicts at least one portion of an anatomical structure, wherein the software system has instructions comprising:

receiving first information which is data provided from a radiation remitted from the at least one portion of the anatomical structure, wherein the first information is obtained by an optical coherence tomography system;

receiving second information which is data provided from a fluorescence light remitted from the at least one portion of the anatomical structure;

generating third information by determining a relationship between the first information and the second information; and

evaluating the at least one image using (i) a histopathological algorithm or (ii) a histopathological scoring criteria, and (iii) the third information."

VIII. Claim 1 according to the appellant's **first auxiliary request** reads as follows (additions to claim 1 of the

main request are underlined, deletions are ~~struck-through~~):

"A software system for evaluating at least one optical coherence tomography image which depicts at least one portion of an anatomical structure, wherein the software system has instructions comprising:

receiving first information which is data provided from a radiation remitted from the at least one portion of the anatomical structure, wherein the first information is obtained by an optical coherence tomography system;

receiving second information which is data provided from a fluorescence light remitted from the at least one portion of the anatomical structure;

generating third information by determining a relationship between the first information and the second information; and

evaluating the at least one image using (i) a histopathological ~~algorithm or (ii) a histopathological scoring criteria~~, and (iii) the third information."

IX. Claim 1 according to the appellant's **second auxiliary request** reads as follows (additions to claim 1 of the **main request** are underlined, deletions are ~~struck-through~~):

"A software system for evaluating at least one optical coherence tomography image which depicts at least one portion of an anatomical structure, wherein the software system ~~has instructions comprising~~ is adapted to carry out the steps of:

receiving first information which is data provided from a ~~radiation~~ light remitted from the at least one portion of the anatomical structure, wherein the first

information is obtained by an optical coherence tomography system;

receiving second information which is data provided from a fluorescence light remitted from the at least one portion of the anatomical structure;

generating third information by determining a relationship between the first information and the second information; and

evaluating the at least one image using a (i) a ~~histopathological algorithm or (ii) a~~ predetermined histopathological scoring criteria, and (iii) the third information."

- X. Claim 1 according to the appellant's **third auxiliary request** reads as follows (additions to claim 1 of the **main request** are underlined, deletions are ~~struck-through~~):

"A ~~software~~ system for evaluating at least one optical coherence tomography image which depicts at least one portion of an anatomical structure, wherein the ~~software system has instructions comprising~~ is adapted to carry out the steps of:

receiving first information which is data provided from a ~~radiation~~ light remitted from the at least one portion of the anatomical structure, wherein the first information is obtained by an optical coherence tomography system;

receiving second information which is data provided from a fluorescence light remitted from the at least one portion of the anatomical structure;

generating third information by determining a relationship between the first information and the second information; and

evaluating the at least one image using a (i) a ~~histopathological algorithm or (ii) a~~ predetermined

histopathological scoring criteria, and (iii) the third information."

Reasons for the Decision

1. The appeal is admissible.

Main Request - Article 123(2) EPC

2. It is established case law that, for an amendment of a claim to be allowable under Article 123(2) EPC, it can only be made within the limits of what a person skilled in the art would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the description, claims and drawings as filed (see Case Law of the Boards of Appeal of the European Patent Office, 8th edition 2016, II.E.1.).
3. Claim 1 comprises the combination of features that first information is obtained by optical coherence tomography (OCT), second information is obtained from a fluorescence light, and third information is generated by determining a relationship between the first information and the second information.
4. In its communication under Article 15(1) RPBA annexed to the summons to oral proceedings, the board informed the appellant of its provisional opinion on the claims filed with the statement of grounds of appeal. It raised, *inter alia*, the following objection under Article 123(2) EPC against claim 1 of the main request (see point 6 of the communication):

"In the board's view, this combination of features is **not directly and unambiguous derivable** from the application as filed for the following reasons:

The application as filed mentions fluorescence only on page 4, line 23, page 8, line 24, page 9, line 3, page 25, line 24, page 26, line 12, page 29, line 9 and in original claims 4 and 13. These passages essentially disclose that the first information and/or the second information can be associated with a light remitted from the portion of the anatomical structure and that the light can be fluorescence. In none of these passages is the combination of first information obtained by OCT and second information obtained by fluorescence light disclosed.

In the statement of grounds of appeal, the appellant argued that 'original claims 2 and 4 of the PCT Application' provided support for this feature. The board notes that it is unclear whether by the expression 'the PCT Application' the appellant meant to refer to the present application as filed or to the grandparent application as filed (see point 7 below), however it does not matter because these two applications as filed had the same claims 2 and 4. In any case, the board disagrees that these two claims disclose the above specific combination of features.

Hence, claim 1 according to the main request contains subject-matter extending beyond the content of the application as filed in violation of the requirements of Article 123(2) EPC."

5. The appellant did not reply in substance to the above objection, either by providing arguments or by way of amendments to the claims.
6. After deliberation on the case in the oral proceedings of 18 January 2019, the board affirms the above view expressed in the communication under Article 15(1) RPBA that claim 1 according to the main request contains subject-matter extending beyond the content of the application as filed in violation of the requirements of Article 123(2) EPC.
7. Accordingly, the appellant's main request is not allowable.

First to third auxiliary requests - Article 123(2) EPC

8. Claim 1 according to the first auxiliary request differs from claim 1 according to the main request in that the two alternative options "(i) a histopathological algorithm or (ii) a histopathological scoring criteria" have been replaced by just one of them, namely "(i) a histopathological scoring criteria".
9. Claim 1 according to the second auxiliary request differs from claim 1 according to the first auxiliary request in that "has instructions comprising" has been replaced by "is adapted to carry out the steps of", "radiation" has been replaced by "light" and "predetermined" has been added before "histopathological scoring criteria".
10. Claim 1 according to the third auxiliary request differs from claim 1 according to the second auxiliary

request in that "software system" has been replaced by "system".

11. As explained in the board's communication under Article 15(1) RPBA, the objection under Article 123(2) EPC raised against claim 1 of the main request also applies to claim 1 according to the first to third auxiliary requests for the following reasons:

Re the first auxiliary request, the objection under Article 123(2) EPC raised against the main request applies to both alternative options (i) and (ii) in claim 1. Hence, the mere deletion in claim 1 of one of these options cannot overcome the objection.

Re the second auxiliary request, the objection under Article 123(2) EPC raised against the main request also applies to the second auxiliary request because it is assumed in this objection that the histopathological scoring criteria is determined before the evaluation step, i.e. is "predetermined".

Re the third auxiliary request, the replacement of "software system" by "system" does not address the objection under Article 123(2) EPC, which therefore remains valid.

12. The appellant did not reply in substance to the above objections, either by providing arguments or by way of amendments to the claims.
13. For the above reasons, claim 1 according to each of the first to third auxiliary requests does not meet the requirements of Article 123(2) EPC, either.

14. Accordingly, the appellant's first to third auxiliary requests are not allowable, either.

Conclusion

15. Since none of the appellant's requests is allowable, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

C. Kunzelmann

Decision electronically authenticated