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**Datasheet for the decision
of 1 July 2020**

Case Number: T 0193/17 - 3.3.05

Application Number: 06815176.0

Publication Number: 1945835

IPC: C25D3/50, A61N1/05

Language of the proceedings: EN

Title of invention:

PLATINUM ELECTRODE SURFACE COATING AND METHOD FOR
MANUFACTURING THE SAME

Patent Proprietor:

Second Sight Medical Products, Inc.

Opponent:

Pixium Vision SA

Headword:

Electrode surface coating/SECOND SIGHT MEDICAL PRODUCTS

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (yes)

Decisions cited:

T 0925/98, T 2619/11

Catchword:



Beschwerdekammern

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Case Number: T 0193/17 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 1 July 2020

Appellant: Second Sight Medical Products, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 11 November
2016 revoking European patent No. 1945835
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: T. Burkhardt
O. Loizou

Summary of Facts and Submissions

- I. The appeal lies from the opposition division's decision to revoke European Patent No. 1 945 835 for non-compliance with the requirements of Article 123(2) EPC.
- II. With their statement setting out the grounds of appeal, the patent proprietor (appellant) submitted a main request and a first auxiliary request.

Claim 1 of the main request reads as follows:

"1. An electrode comprising:
an electrode body; and
a surface coating of platinum having a rough configuration and an increase in the surface area of 5 times to 500 times of the corresponding surface area resulting from the basic geometric shape of the electrode, characterized in that said surface coating has a thickness of 0.1 μm to 4.0 μm and comprises particles of regular shape and a particle size of 0.1 μm to 2.0 μm ."

Claim 1 of auxiliary request 1 reads as follows:

"1. An electrode comprising:
an electrode body; and
a surface coating of platinum having a rough configuration and an increase in the surface area of 5 times to 500 times of the corresponding surface area resulting from the basic geometric shape of the electrode, characterized in that said surface coating has a thickness of 2.0 μm to 4.0 μm and comprises

particles of regular shape and a particle size of 0.1 μm to 1.5 μm ."

- III. The arguments of the appellant in relation to the requirements of Article 123(2) EPC may be summarised as follows:

The main request fulfilled the requirements of Article 123(2) EPC. The combination of the parameters of surface coating thickness and particle size in claim 1 were based on claims 3, 5, 9 and 10 as originally filed.

This was supported by decisions T 0925/98 and T 2619/11. In particular, no undue attention should be paid to the structure of the claims.

Auxiliary request 1 also fulfilled the requirements of Article 123(2) EPC. The combination of the parameters surface coating thickness and particle size in claim 1 had a basis in claims 5 and 10 as originally filed.

- IV. The arguments of the opponent (respondent) in relation to the requirements of Article 123(2) EPC, where relevant to the present decision, may be summarised as follows:

The main request did not fulfil the requirements of Article 123(2) EPC.

Claims 3, 5, 9 and 10 as originally filed could not be considered a valid basis, since all these claims referred directly back to claim 1 as originally filed. Consequently, the subject-matter of claim 1 was not disclosed *in combination*.

Auxiliary request 1 should not be admitted, since it should have been submitted during the opposition proceedings. Moreover, for the same reasons as the main request, auxiliary request 1 did not fulfil the requirements of Article 123(2) EPC.

- V. In two communications, the board took the preliminary view that neither the main request nor the auxiliary request met the requirements of Article 123(2) EPC. In response, and by their letters dated 18 May 2020 and 02 June 2020 respectively, the respondent and the appellant withdrew their requests for oral proceedings.
- VI. The appellant requested in writing that the decision be set aside and that the patent be maintained in amended form on the basis of the main request, or, in the alternative, auxiliary request 1, both requests submitted with the statement setting out the grounds of appeal.
- VII. The respondent requested that the appeal be dismissed.

Reasons for the Decision

- 1. Main request: Article 123(2) EPC

For the following reasons, the main request does not fulfil the requirements of Article 123(2) EPC.

- 1.1 Unlike claim 1 as originally filed, claim 1 of the main request states that the thickness of the surface coating and the particle size lie within specific ranges.

According to the appellant, the end points of these ranges are taken from different dependent claims as originally filed, namely:

- the lower limit of the surface coating thickness 0.1 μm is from claim 3
- the upper limit of the surface coating thickness 4.0 μm is from claim 5
- the lower limit of the particle size 0.1 μm is from claim 10
- the upper limit of the particle size 2.0 μm is from claim 9,

but all these dependent claims as originally filed depend *exclusively* on independent claim 1. Thus, the end points would need to be isolated from four different dependent claims.

Moreover, the appellant has not indicated any other passages to support this amendment, e.g. in the description. The board was also unable to identify any passages supporting the amendments referred to above.

Therefore, the parameters surface coating thickness and particle size, taken with the respective end points of the ranges in claim 1, are not directly and unambiguously disclosed *in combination* in the claims as originally filed.

- 1.2 The appellant refers to T 0925/98, where an end point of a general range of a parameter and an end point of the preferred range were combined in the same claim, resulting in a range from 30 to 50% (Reasons 2).

For the following reasons, however, the underlying facts and conclusions of that decision have no relevance to the case at issue.

In that case, the general and the preferred ranges were disclosed *in combination*, since independent claim 1 as originally filed disclosed a basic range of from 30 to 60%, while claim 2 as originally filed, which depended on claim 1, disclosed a preferred range of from 35 to 50%.

By contrast, in the present case the end points of the two ranges are disclosed in four different dependent claims as originally filed, which each depend exclusively on claim 1.

Moreover, T 0925/98 dealt with the range of a single parameter, whereas present claim 1 relates to the introduction of two parameters, namely the thickness of the surface coating and the particle size.

1.3 The appellant also refers to T 2619/11. However, the conclusions of that case do not apply to the case at issue either.

In T 2619/11, the claims as originally filed comprised several dependent claims, which directly or indirectly referred to the same independent claim. The subject-matter of these dependent claims was not formally claimed in combination, given the ways in which the claims depended on one another.

The board in T 2619/11 concluded that, once the feature of one dependent claim was added to the independent claim, the disclosure of several other dependent claims did not go beyond the original disclosure, since there should not be a disproportionate focus on the structure of the claims (catchword). In the light of the description and the drawings, the skilled person would

have recognised that the dependent claims dealt with variations of an embodiment and not with separate alternatives (Reasons 2.6, 2.7).

However, in the case at issue, no elements in the description or the figures have been indicated to prove that respective ranges of the surface coating thickness and the particle size are variations of a single embodiment. Nor is this apparent from the claims.

Even if, *arguendo*, these ranges were considered to be variations of a single embodiment, the end points of the ranges would need to be isolated from as many as four different dependent claims.

Therefore, in fact, the introduction of end points from the dependent claims, without anything in the description to prompt this, amounts to viewing the application as a reservoir of features to artificially create a particular embodiment, contrary to what the skilled person would have seriously contemplated.

Consequently, the main request does not meet the requirements of Article 123(2) EPC.

2. Auxiliary request 1: Article 123(2) EPC

Since, as will be shown below, auxiliary request 1 does not fulfil the requirements of Article 123(2) EPC, the question of its admissibility under Article 25(2) RPBA 2020 and Article 12(4) RPBA 2007 may be left unanswered.

According to the appellant, the new ranges of the particle size and the surface coating thickness are respectively based on claims 5 and 10 as originally

filed. Again, to this effect, no further element of the description was indicated.

Thus, while the end points are taken from only two, not four, claims, as was the case in the main request, the reasons indicated above in relation to the main request also apply to auxiliary request 1 in the same way.

In particular, the claimed combination of features was not disclosed in the application as filed, since claims 5 and 10 depend *exclusively* on independent claim 1 as originally filed.

Consequently, auxiliary request 1 also does not meet the requirements of Article 123(2) EPC.

3. In view of the above conclusions the conditional request of the appellant regarding the remittal to the department of first instance for outstanding matters other than the requirements of Article 123(2) EPC needs not be decided.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

E. Bendl

Decision electronically authenticated