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**Datasheet for the decision
of 6 May 2022**

Case Number: T 1198/17 - 3.2.02

Application Number: 06779901.5

Publication Number: 1909678

IPC: A61B18/18

Language of the proceedings: EN

Title of invention:
ESOPHAGEAL ELECTROCATHETER

Patent Proprietor:
Fiab S.P.A.

Opponent:
CIRCA Scientific, Inc.

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2)
EPC R. 103(1)(a), 106
RPBA 2020 Art. 13(2)

Keyword:

Amendments - extension beyond the content of the application
as filed (yes)

Late-filed auxiliary requests - admitted (no)

Oral proceedings - before board of appeal

Reimbursement of appeal fee - violation of the right to be
heard (no)

Obligation to raise objections - objection dismissed

Decisions cited:

G 0001/21

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1198/17 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 6 May 2022

Appellant: CIRCA Scientific, Inc.
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Representative: Aldé, Dario
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 9 March 2017
rejecting the opposition filed against European
patent No. 1909678 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: A. Martinez Möller
C. Schmidt

Summary of Facts and Submissions

- I. An appeal was lodged by the opponent against the decision of the Opposition Division rejecting the opposition.

- II. In preparation for oral proceedings, the Board sent a communication dated 5 January 2022 setting out its preliminary opinion. The Board indicated, among other points, that claim 1 of the main request comprised subject-matter extending beyond the content of the application as filed. The Board further indicated that it was minded to admit the 1st to 22nd auxiliary requests into the appeal proceedings, that the 1st to 11th auxiliary requests also comprised subject-matter extending beyond the content of the application as filed for the same reasons explained for the main request and that the objection of added subject-matter against the 12th to 22nd auxiliary requests was not convincing.

- III. In a communication dated 6 April 2022, the Board asked the parties whether they requested, agreed or disagreed that the oral proceedings be held by videoconference. With a submission dated 12 April 2022, the appellant disagreed with the oral proceedings being held by videoconference. With a submission dated 19 April 2022, the respondent disagreed with the oral proceedings being held in person. The Board informed the parties in a communication dated 29 April 2022 that the oral proceedings scheduled for 6 May 2022 would be held in person as indicated in the summons.

IV. Oral proceedings took place in person on 6 May 2022. The parties' requests at the end of the oral proceedings were as follows.

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked or, as an auxiliary measure, that the case be remitted to the department of first instance.

The appellant further requested:

- to admit documents D8-D12 filed on 6 October 2016, D13 filed with the statement of grounds of appeal and D14 filed on 26 June 2018
- to reimburse the appeal fee under Rule 103(1)(a) EPC
- not to admit the 1st to 28th auxiliary requests
- to compel the Opposition Division to correct the minutes of the oral proceedings as requested on 10 May 2017
- if the above request was not granted, to compel the Opposition Division to provide detailed and transparent grounds for not correcting the minutes
- not to admit the respondent's evidence and submissions filed during oral proceedings supporting why the invention as interpreted in the appealed decision was sufficiently disclosed
- to adjourn the oral proceedings before the Board and to order the respondent to bear the appellant's incurred costs if the Board admits the respondent's evidence and submissions filed during oral proceedings supporting why the invention as interpreted in the appealed decision was sufficiently disclosed

The respondent (proprietor) requested that the appeal be dismissed or, as an auxiliary measure, that the patent be maintained on the basis of the 1st to 22nd auxiliary requests filed with the reply to the appeal

or on the basis of the 23rd to 28th auxiliary requests filed during the oral proceedings before the Board.

The respondent further requested not to admit documents D8-D14.

V. At the oral proceedings before the Board, the respondent submitted written objections in respect of procedural defects under Rule 106 EPC. The written objections are attached to the minutes of the oral proceedings.

VI. Claim 1 of the **main request** (patent as granted) reads as follows:

"An esophageal catheter comprising:
an insertion element (1) able to be inserted into a patient's esophagus and having a distal end (2) and a sheath (3) one or more reference elements (5, 6) placed in the vicinity of or at the distal end (2) and defining a temperature detection zone (8),
at least three temperature sensors (4) fitted along the element (1) in the vicinity of the distal end (2) and mounted in predetermined positions relative to the positioning elements (5, 6) in such a way to detect and/or monitor the temperature in said temperature detection zone (8),
cables (7) contained in the sheath (3) for connection to the temperature sensors (4),
wherein three of said temperature sensors (4) are arranged in succession at equidistant points along a longitudinal axis of the insertion element (1), wherein said three equidistant temperature sensors (4) are adapted to detect a central value and the deviation from this value at two symmetrical, equidistant points."

- VII. Compared to claim 1 of the main request, claim 1 of the **1st auxiliary request** further includes the feature "configured for use in cardiac ablation operations," added after the words "An esophageal catheter".
- VIII. Compared to claim 1 of the main request, the following feature of claim 1 of the **2nd auxiliary request** has been amended as follows: "~~one or more~~ two reference elements (5, 6) placed in the vicinity of or at the distal end (2) and ~~defining~~ delimiting a temperature detection zone (8)"; moreover, the claim further includes the following feature added at the end: ", and wherein the reference elements are X-ray traceable elements whose trace can be detected outside the body."
- IX. Compared to claim 1 of the 2nd auxiliary request, claim 1 of the **3rd auxiliary request** further includes the feature "configured for use in cardiac ablation operations," added after the words "An esophageal catheter".
- X. Compared to claim 1 of the 3rd auxiliary request, claim 1 of the **4th auxiliary request** further includes the feature "suitable to correspond, in use, to a part of the esophagus contiguous with the myocardial wall to be ablated" added after the words "delimiting a temperature detection zone (8)".
- XI. Compared to claim 1 of the 2nd auxiliary request, claim 1 of the **5th auxiliary request** further includes the following feature added at the end: ", and wherein the X-ray traceable reference elements are metal electrodes for recording an electrical potential emitted by the muscular atrial walls."

XII. Compared to claim 1 of the 5th auxiliary request, claim 1 of the **6th auxiliary request** further includes the feature "configured for use in cardiac ablation operations," added after the words "An esophageal catheter".

XIII. Compared to claim 1 of the 6th auxiliary request, claim 1 of the **7th auxiliary request** further includes the feature "suitable to correspond, in use, to a part of the esophagus contiguous with the myocardial wall to be ablated" added after the words "delimiting a temperature detection zone (8)".

XIV. Claim 1 of the **8th auxiliary request** reads as follows:

"A cardiac ablation apparatus, comprising an ablation unit equipped with radiofrequency emitting electrodes, an esophageal catheter, and a unit for controlling the apparatus,
wherein the esophageal catheter comprises:
an insertion element (1) able to be inserted into a patient's esophagus and having a distal end (2) and a sheath (3),
one or more reference elements (5, 6) placed in the vicinity of or at the distal end (2) and defining a temperature detection zone (8),
at least three temperature sensors (4) fitted along the element (1) in the vicinity of the distal end (2) and mounted in predetermined positions relative to the positioning elements (5, 6) in such a way to detect and/or monitor the temperature in said temperature detection zone (8),
cables (7) contained in the sheath (3) for connection to the temperature sensors (4),
three of said temperature sensors (4) being arranged in succession at equidistant points along a longitudinal

axis of the insertion element (1), said three equidistant temperature sensors (4) being adapted to detect a central value and the deviation from this value at two symmetrical, equidistant points, and wherein the control unit is configured for enabling/disabling radiofrequency emission upon reaching one or more predetermined temperature values detected by the catheter."

- XV. Compared to claim 1 of the 8th auxiliary request, the following feature of claim 1 of the **9th auxiliary request** has been amended as follows: "~~one or more~~ two reference elements (5, 6) placed in the vicinity of or at the distal end (2) and ~~defining~~ delimiting a temperature detection zone (8)"; moreover, the feature "and the two reference elements being X-ray traceable elements whose trace can be detected outside the body," has been added immediately before the feature "and wherein the control unit ...".
- XVI. Compared to claim 1 of the 9th auxiliary request, claim 1 of the **10th auxiliary request** further includes the following feature added immediately before the feature "and wherein the control unit ...": "and the X-ray traceable reference elements being metal electrodes for recording an electrical potential emitted by the muscular atrial walls,"
- XVII. Compared to claim 1 of the 8th auxiliary request, claim 1 of the **11th auxiliary request** further includes the following feature added at the end: ", and wherein the apparatus comprises a visual and/or audible alarm activated automatically when a preset value of critical temperature is reached."

- XVIII. The **12th to 22nd auxiliary requests** correspond to the 1st to 11th auxiliary requests with the following amendments in two features: "~~at least~~ three temperature sensors (4)" and "wherein ~~three of~~ said three temperature sensors (4)" (in the 20th to 22nd auxiliary requests, the second feature does not include the word "wherein").
- XIX. The **23rd to 28th auxiliary requests** correspond respectively to the 13th, 16th and 19th to 22nd auxiliary requests with the additional feature "wherein said temperature sensors (4) are three in numbers,". In the 23rd and 25th auxiliary requests, the feature has been added immediately after the wording "for connection to the temperature sensors (4),". In the 24th and 26th to 28th auxiliary requests, the feature has been added after the wording "to detect and/or monitor the temperature in said temperature detection zone (8),".
- XX. The appellant's arguments relevant to the present decision can be summarised as follows.

Amendments

There was no disclosure in the application as filed for "at least three temperature sensors" as defined in claim 1 of each of the main request and the 1st to 11th auxiliary requests. The feature created a new range based on a value isolated from an embodiment having precisely three temperature sensors in a specific arrangement.

Similar considerations applied to claim 1 of the 12th to 22nd auxiliary requests because the components were only "comprised" in the oesophageal catheter. Hence,

the deletion of the wording "at least" was a pseudo-limitation which made no difference either in terms of the extent of protection or the technical information because the claim still required a catheter with a minimum of three temperature sensors, but the catheter could comprise an arbitrary number of additional temperature sensors which could be located anywhere on the device and serve a different purpose.

Admittance of the 23rd to 28th auxiliary requests

The objection of added subject-matter had been raised at the beginning of the first-instance proceedings. There were no exceptional circumstances justifying new requests addressing this objection at this stage of the appeal proceedings. The 23rd to 28th auxiliary requests should thus not be admitted.

Minutes of the oral proceedings before the Opposition Division

The minutes of the oral proceedings before the Opposition Division were incorrect. The events indicated in points 3.3 and 3.4 of the minutes only occurred after the decision on novelty had been announced. Following the appellant's request for correction of the minutes, the Opposition Division neither corrected them nor provided sufficient grounds for rejecting the request for correction.

Reimbursement of the appeal fee

In contrast to what was indicated in points 3.3 and 3.4 of the minutes of the oral proceedings, the Opposition Division informed the parties for the first time of its interpretation of claim 1 after announcing its decision

on novelty. Neither at the summons nor at the oral proceedings before the decision on novelty was any clear indication provided that the Opposition Division intended to interpret the feature in a different way to the parties. The Opposition Division thus failed to base its decision on grounds and evidence on which the opponent had an opportunity to present comments, thus infringing the opponent's right to be heard and justifying the reimbursement of the appeal fee.

Format of the oral proceedings

The scheduled oral proceedings should be maintained as in-person oral proceedings, which was the default option and the gold standard. There was no general emergency in Germany, and the parties were not hindered from travelling to and attending oral proceedings.

Objection under Rule 106 EPC

Several statements in the respondent's objections under Rule 106 EPC were false or misleading. In particular, the appellant had not stated at the oral proceedings that including the features of claim 8 as originally filed would define a sufficient limitation. Moreover, the appellant had explicitly argued at the oral proceedings that none of the auxiliary requests overcame the objection of added subject-matter.

XXI. The respondent's arguments relevant to present the decision can be summarised as follows.

Amendments

The range "at least three" for the number of temperature sensors was based on the original range "at

least two" with the deletion of the single embodiment of "two". Moreover, the passage on page 2, lines 26-28 of the original application was to be read to mean that there were three temperature sensors having a specific purpose, without excluding the presence of other sensors.

Claim 1 of the 12th auxiliary request did not comprise the wording "at least", thus overcoming the objection of added subject-matter. The extent of protection under Article 69 EPC and possible claim interpretations in potential infringement proceedings played no role when deciding on added subject-matter.

Admittance of the 23rd to 28th auxiliary requests

The Board had surprisingly changed its mind on the 12th to 22nd auxiliary requests compared to in its clear preliminary opinion. The appellant filed new arguments with the submission of 21 February 2022, so the respondent should also be allowed to file new requests. The 12th to 22nd auxiliary requests had already aimed at overcoming the objection, and the additional amendment of the 23rd to 28th auxiliary requests clearly overcame the objection by excluding any other temperature sensors, as the appellant itself had acknowledged during the oral proceedings.

Minutes of the oral proceedings before the Opposition Division and reimbursement of the appeal fee

As explained in writing, according to the recollection of the respondent's representative, the Opposition Division had informed the parties before the start of the discussion of novelty that it considered that the claim differed from the prior art as regards the last

feature of claim 1. Hence, no violation of the right to be heard in first-instance proceedings had occurred, and the appeal fee was not to be reimbursed.

Format of the oral proceedings

The respondent submitted in writing that it disagreed with holding the oral proceedings in person. The pandemic was not over, any travelling or personal meeting involved a risk of contracting COVID-19. Restrictions were still present throughout Europe. During the pandemic, the personal situation of the representative meant that the obligation to travel for in-person oral proceedings went beyond ordinary practice. A change of representative was not a viable option because the current representative could recall what had happened in the opposition proceedings and in particular at the oral proceedings. Moreover, the case involved no complex issues, so there were no reasons why the oral proceedings had to be held in person. Hence, holding the oral proceedings by videoconference was the most appropriate choice.

Objection under Rule 106 EPC

The respondent's right to be heard had been violated.

Firstly, the Board's announcement at the oral proceedings that the 1st to 22nd auxiliary requests comprised added subject-matter went against the Opposition Division's finding and against the Board's clear preliminary opinion and was surprising. The respondent had not had an opportunity to provide arguments in support of the 14th to 22nd auxiliary requests. Only after the decision had been made did the Chair provide the parties with an opportunity to

provide arguments for all auxiliary requests. The 23rd to 28th auxiliary requests should have been admitted for reasons of fairness.

Secondly, Mr Aldé - the respondent's representative during the first-instance proceedings - was based in Italy and was prevented from attending in person because of the COVID-19 pandemic. The respondent's request for holding the oral proceedings by videoconference had not been granted by the Board. The representatives present for the respondent had not attended the oral proceedings before the Opposition Division and could thus not comment on several statements made by the appellant.

Reasons for the Decision

1. The invention

In cardiac ablation operations, radio frequency irradiations are applied to the atrial walls to restore normal functioning of the electrical conduction of the heart. These irradiations cause tissue heating, and excessive heating may cause swelling which may lead to serious complications. Hence, the heating level reached during cardiac ablation operations must be controlled (see paragraphs [0001]-[0006] of the patent specification).

The patent in suit teaches that the anatomical proximity between the oesophagus and the left atrial wall can be used to measure the atrial temperature by means of an oesophageal catheter, thus reducing the risk for patients undergoing cardiac ablation operations (see paragraphs [0009]-[0010] of the patent specification).

The invention as defined in claim 1 as granted deals with an oesophageal catheter comprising an insertion element, one or more reference elements, at least three temperature sensors and cables. The temperature sensors are fitted in the vicinity of the distal end of the insertion element. Three of the temperature sensors are arranged in succession at equidistant points along a longitudinal axis of the insertion element and are adapted to detect a central value and the deviation from this value at two symmetrical, equidistant points.

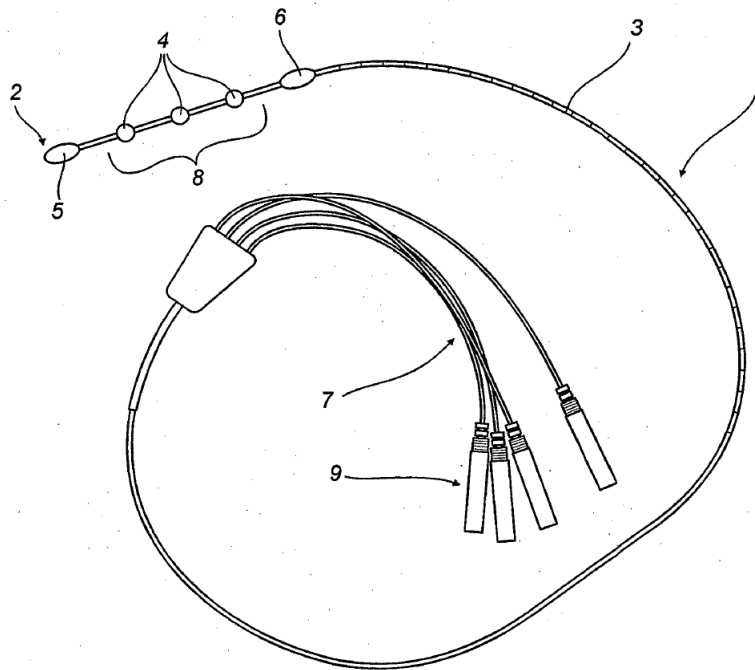


Figure 1 of the patent specification shows an embodiment of a catheter with three temperature sensors 4 between reference elements 5 and 6.

2. Amendments

2.1 Main request

Claim 1 of the main request defines an oesophageal catheter comprising, among other elements, the features "at least three temperature sensors (4) fitted along the element (1) ... in such a way to detect and/or monitor the temperature in said temperature detection zone" and "wherein three of said temperature sensors (4) are arranged ...". These features were not in claim 1 as originally filed and convey the technical information that further temperature sensors, which are not "arranged in succession at equidistant points along a longitudinal axis of the insertion element" and "adapted to detect a central value and the deviation from this value at two symmetrical, equidistant points", may be present.

The respondent argued that the range "at least two temperature sensors" in claim 1 of the application as originally filed had been modified by deleting the case of two temperature sensors, thus resulting in a restriction of the originally claimed range. However, this is not the relevant question to assess whether claim 1 comprises added subject-matter. The relevant question is whether the amendment was made only within the limits of what a person skilled in the art would derive directly and unambiguously, using common general knowledge, from the application as filed.

The respondent also argued that the embodiment of Figure 1 and the paragraph on page 2, lines 26-28 of the application as filed provided a basis for the amendment. The paragraph was to be read to mean that there were three temperature sensors having a specific purpose ("there are three temperature sensors 4 which can ..."), without excluding the presence of further sensors.

However, the paragraph on page 2, lines 26-28 does not unambiguously disclose that the catheter may comprise temperature sensors other than the three temperature sensors with their specific arrangement and function. This paragraph describes the embodiment of Figure 1 which shows a catheter with three sensors, without any indication that other temperature sensors would be included. Moreover, the three temperature sensors in the embodiment of Figure 1 are positioned in a specific arrangement serving a specific purpose, namely to "detect a central value and the deviation from this value at two symmetrical, equidistant points", as described in the cited paragraph. The three temperature sensors defined in claim 1 thus fulfil the function disclosed in the application as filed, namely to detect and/or monitor the temperature in a defined zone. Further sensors dedicated to a different function or purpose are not disclosed in the application as originally filed. The choice of having three temperature sensors is thus associated to their function in the embodiment, so that the person skilled in the art would not have recognised the "three" temperature sensors as a feature which could be extracted from the embodiment to modify the lower limit of the range "at least two temperature sensors" in original claim 1.

Hence, claim 1 contains subject-matter which extends beyond the content of the application as filed, so that the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted.

2.2 1st to 11th auxiliary requests

Claim 1 of each of the 1st to 11th auxiliary requests likewise comprises the feature "at least three

temperature sensors", resulting in added subject-matter for the same reasons indicated for the main request.

2.3 12th to 22nd auxiliary requests

In claim 1 of each of the 12th to 22nd auxiliary requests, among other amendments, the wording "at least three temperature sensors" was replaced with "three temperature sensors". According to the respondent, this overcame the issue of added subject-matter caused by the range "at least three temperature sensors".

The Board reaches a different conclusion. As argued by the appellant, the oesophageal catheter is defined in claim 1 of each of the 12th to 22nd auxiliary requests as comprising a certain number of elements. In patent language, the words "comprising" (12th to 18th auxiliary requests) and "comprises" (19th to 22nd auxiliary requests, where the catheter is claimed as part of a cardiac ablation apparatus) indicate that the listed elements do not define an exhaustive list of all the elements in the catheter. Hence, the oesophageal catheter defined as comprising three temperature sensors in claim 1 of each of the 12th to 22nd auxiliary requests must have a minimum of three temperature sensors but can have a larger number of temperature sensors. That is, also after the deletion of "at least" in claim 1, the subject-matter of claim 1 is not limited to a catheter having exactly three temperature sensors.

Both the scope of the claim and the technical information conveyed to the reader are thus the same as for claim 1 of the main request as regards the number of temperature sensors.

Therefore, for the same reasons provided for the main request above, claim 1 of each of the 12th to 22nd auxiliary requests contains subject-matter which extends beyond the content of the application as filed.

3. Admittance of the 23rd to 28th auxiliary requests

3.1 The respondent filed the 23rd to 28th auxiliary requests during oral proceedings before the Board to address the issue of added subject-matter related to the number of temperature sensors. The requests constitute an amendment to the respondent's appeal case which shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the respondent (Article 13(2) RPBA 2020).

3.2 The respondent argued that the filing of the 23rd to 28th auxiliary requests was a reaction to the Board having surprisingly changed its mind compared to in its clear preliminary opinion on the issue of added subject-matter for the 12th to 22nd auxiliary requests.

The Board does not share this view. By its nature, a preliminary opinion can change. This change is objectively not a surprising event justifying filing new requests. Moreover and most importantly, even if the Board's preliminary opinion had indicated that the 12th to 22nd auxiliary requests comprised added subject-matter, any auxiliary requests filed afterwards would have been filed after notification of the summons to oral proceedings, and their admittance would be subject to Article 13(2) RPBA 2020. Therefore, the Board holds that a deviation from the preliminary opinion does not define exceptional circumstances within the meaning of Article 13(2) RPBA 2020.

- 3.3 The respondent submitted that it would be unfair to admit the appellant's new arguments on added subject-matter filed on 21 February 2022 and not to admit the new auxiliary requests filed by the respondent.

Notwithstanding the fact that the respondent did not request to disregard the appellant's submission dated 21 February 2022, this submission did not raise a new objection but merely refined the arguments supporting the objection of added subject-matter against the 12th to 22nd auxiliary requests. The appellant had raised and substantiated this objection in its submission dated 26 June 2018 (see page 3, last two paragraphs as well as the first paragraph of section "Auxiliary requests 12 to 22" on page 29). Such a refinement of arguments does not constitute an amendment to the appellant's appeal case and can thus not constitute exceptional circumstances justifying the admittance of auxiliary requests subsequently filed by the respondent.

- 3.4 The respondent further argued that the 23rd to 28th auxiliary requests *prima facie* overcame the lack of compliance with Article 123(2) EPC and that the appellant had expressed this view at the oral proceedings.

However, neither the alleged *prima facie* compliance nor an alleged statement by the appellant justifies admitting auxiliary requests filed at such a late stage of the proceedings.

- 3.5 In conclusion, there are no exceptional circumstances within the meaning of Article 13(2) RPBA 2020. Hence,

the Board decided not to admit the 23rd to 28th auxiliary requests.

4. Minutes of the oral proceedings before the Opposition Division

The minutes of the oral proceedings before the first-instance department are not part of the appealed decision, nor do they constitute a decision which does not terminate proceedings within the meaning of Article 106(2) EPC. They fall under the responsibility of the first-instance department and are, as such, not open to review by the boards. Nor is the Opposition Division's communication dated 11 August 2017 rejecting the requested correction of the minutes part of the appealed decision and, as such, it is not open to review by the boards.

This Board is thus competent neither to order a correction of the minutes nor to require the Opposition Division to further argue why the requested correction was rejected. Hence, these requests of the appellant cannot be granted.

5. Reimbursement of the appeal fee

It is undisputed that, at the oral proceedings, the Opposition Division informed the parties at the beginning of the discussion on novelty that documents D1-D7 did not seem to disclose the last feature of claim 1 (point 3.1 of the minutes). It is also undisputed that the appellant/opponent presented arguments on how this feature was to be construed (point 3.2 of the minutes). These arguments were addressed in point 1.3 of the appealed decision.

Hence, also if points 3.3 and 3.4 of the minutes are disregarded, the minutes reflect that the appellant/opponent had the opportunity to comment on the issue under dispute and that its submissions were duly considered.

Moreover, if at the oral proceedings the appellant/opponent was surprised by the Opposition Division's conclusion on novelty based on this interpretation and was of the opinion that it had not been given the opportunity to argue the point, it could have requested the Opposition Division to reopen the debate on novelty to be able to provide arguments.

Hence, the Board is not convinced by the appellant's submission that its right to be heard was infringed in opposition proceedings. The appellant's request for reimbursement of the appeal fee under Rule 103(1)(a) EPC is thus rejected.

6. Other procedural requests

There were a number of procedural requests made by both parties for which either no decision was needed or the decision was irrelevant for the outcome of the case. In particular, the Board did not grant the appellant's conditional requests that the oral proceedings be adjourned and that the appellant's incurred costs be borne by the respondent.

These requests were not granted because the Board, in agreement with its preliminary opinion expressed in point 3.1 of the communication dated 5 January 2022, did not accept the interpretation of claim 1 indicated in the appealed decision. The respondent's evidence and arguments on sufficiency of disclosure according to

that interpretation were thus irrelevant for the conclusion on sufficiency of disclosure. Therefore, their admittance did not justify an adjournment of the oral proceedings.

7. Format of the oral proceedings

7.1 The oral proceedings were originally scheduled in person. The maintenance of this format was subsequently requested by the appellant with a submission dated 12 April 2022, referring to G 1/21 and submitting that the parties were not hindered from travelling to and attending oral proceedings at the EPO.

On 19 April 2022, the respondent submitted that it did not agree with holding the oral proceedings in person and provided supporting arguments, referring to the pandemic.

Hence the Board had to decide which of these opposing requests should be granted.

7.2 In accordance with Article 15a(1) RPBA 2020, the Board may decide to hold oral proceedings by videoconference if the Board considers it appropriate to do so, either upon request by a party or of its own motion. Hence, there is no absolute right of a party to have oral proceedings conducted in a specific format, either by video conference or in person. The discretionary nature of this decision was confirmed by the Enlarged Board of Appeal in G 1/21, point 50.

In that decision, the Enlarged Board of Appeal also considered that the choice of format for the oral proceedings was more than just an organisational matter. Since videoconferences did not provide the same

level of communication possibilities as in-person oral proceedings, a party may have good reasons to prefer in-person oral proceedings to a videoconference (G 1/21, point 46). Without doubt, in-person oral proceedings provide the opportunity to be heard in accordance with Article 113 EPC and Article 6 ECHR. Since it is also the format that the legislator had in mind when Article 116EPC was drafted, in-person hearings should be the default option, and parties can only be denied this option for good reasons (G 1/21, point 45). As for the possible good reasons, the Enlarged Board of Appeal stated, *inter alia*, that there must be circumstances specific to the case that justify the decision not to hold the oral proceedings in person. These circumstances should relate to limitations and impairments affecting the parties' ability to attend oral proceedings in person at the premises of the EPO (G 1/21, points 47 and 49).

7.3 In the case at hand, the Board is not aware of any travel restrictions which would have affected the ability of the respondent's representative to attend, nor has the respondent submitted any.

It is correct that attending oral proceedings in person and travelling to them may have involved a certain risk of contracting COVID-19. However, at the date of the oral proceedings, generally applicable restrictions no longer applied in Germany or Italy, where the representative requesting the videoconference was based. Hence, daily activities such as shopping, a family member attending an educational institution, etc. also involved a risk of contracting COVID-19, as well as other infectious diseases for that matter. Thus, the Board considered that travelling to and attending oral proceedings at the EPO premises, where

precautionary measures were still in place, did not involve an increased risk of contracting COVID-19 compared to the above-mentioned everyday activities. Hence, the Board holds that there were no general circumstances related to limitations and impairments affecting the parties' ability to attend.

The respondent's representative submitted details of his personal situation, excluded from the public file at his request. These details are considered by the Board to describe a common personal situation that does not constitute exceptional circumstances which impaired the ability of the respondent's representative to attend oral proceedings in person.

7.4 Hence, there were neither general nor particular circumstances related to limitations and impairments affecting the parties' ability to attend that justified denying the appellant's request to have in-person oral proceedings. Therefore, the Board decided to hold the oral proceedings in person.

7.5 For the sake of completeness, the Board notes that hybrid oral proceeding, in which one party takes part remotely while the other party and the board are present in the hearing room, were not possible for technical reasons. At the date the oral proceedings took place, the boards were not able to offer this type of oral proceedings with interpretation, as was required in this case.

8. Objections under Rule 106 EPC

The objections under Rule 106 EPC comprise two points: one relating to the 12th to 28th auxiliary requests ("Hilfsanträge 12 bis 22 sowie 23 bis 28") and another

concerning the right to be heard and Mr Aldé ("Verweigerung rechtliche [sic] Gehörs betreffend Herrn Aldé"). The first point, however, relates to two different issues: firstly, the 12th to 22nd auxiliary requests and the possibility to present comments; secondly, the (non)-admittance of the 23rd to 28th auxiliary requests. These issues will thus be treated separately in the following.

8.1 12th to 28th auxiliary requests

8.1.1 In the objection under Rule 106 EPC, the respondent acknowledges that it had the opportunity to present its arguments on the 12th and 13th auxiliary requests. However, the respondent states (see 6th and 7th paragraphs under point 1) that at the oral proceedings it only had an opportunity to provide comments on the 12th and 13th auxiliary requests but not on the 14th to 22nd auxiliary requests (respectively, on the 13th to 22nd auxiliary requests according to paragraph 11).

8.1.2 This is factually incorrect.

8.1.3 Firstly, prior to announcing the Board's conclusion that the main and the 1st to 22nd auxiliary requests comprised added subject-matter, the Chair had invited the parties to comment on added subject-matter for all requests. Each party decided which requests it addressed in its submissions.

8.1.4 Secondly, the issue of added subject-matter related to the number of temperature sensors was discussed in the written proceedings for all requests, including the 12th to 22nd auxiliary requests.

At no moment in the written or oral proceedings did a party or the Board refer to any difference concerning the number of sensors between the 12th to 13th auxiliary requests and the 14th to 22nd auxiliary requests, nor is any such difference apparent. Instead, a difference between the claim wording with "at least" (main and 1st to 11th auxiliary requests) and without "at least" (12th to 22nd auxiliary requests) was addressed by both parties at the oral proceedings.

Hence, while it is possible that a representative of the respondent was subjectively surprised by the conclusion of the Board on added subject-matter of the 12th and 13th auxiliary requests (1st paragraph on page 2 of the objection), there was no objective reason to assume that this conclusion would not apply also to the 14th to 22nd auxiliary requests.

- 8.1.5 Thirdly, after announcing the Board's conclusion and upon the respondent indicating its surprise and that it had not been able to present its arguments for the 14th to 22nd auxiliary requests, the Chair indicated that the announcement of a conclusion did not constitute a final decision and, in view of the apparent misunderstanding by the respondent, reopened the debate and invited the parties to provide any outstanding arguments. However, the parties, in particular the respondent, did not have any additional arguments on added subject-matter to provide. Instead, the respondent requested a break to prepare a new auxiliary request, this request being granted. Hence, the respondent had ample and repeated opportunity to provide arguments on the issue of added subject-matter for all requests, and its right to be heard regarding added subject-matter of the 14th to 22nd auxiliary requests was not violated.

8.2 23rd to 28th auxiliary requests

The respondent submits that the 23rd to 28th auxiliary requests should have been admitted into the proceedings for reasons of fairness ("Aus Gründen der Fairness"). The respondent failed, however, to indicate on which of the grounds under Article 112a(2) EPC or the procedural defects in accordance with Rule 104 EPC the objection under Rule 106 EPC with regard to the non-admittance of these requests should be based. The Board cannot see any basis either. The Board notes that the respondent provided arguments in support of the admittance of these auxiliary requests and that these arguments were considered by the Board when deciding on the issue (see the reasoning in point 3. above). Hence, the decision not to admit these auxiliary requests also did not infringe the respondent's right to be heard.

8.3 Violation of the right to be heard related to Mr Aldé

8.3.1 Following the Board's communication indicating that the scheduled oral proceedings would be held in person, the respondent authorised two new representatives for the oral proceedings. Hence, the respondent was duly represented at the oral proceedings.

Indeed, at the beginning of the oral proceedings, the respondent's representatives indicated that they no longer objected to the oral proceedings taking place in person and that they were well prepared to discuss the case.

It was only after the Chair had announced that the 23rd to 28th auxiliary requests were not admitted into the appeal proceedings that the respondent submitted, in

its written objections under Rule 106 EPC, that its right to be heard had been infringed because the in-person oral proceedings had prevented Mr Aldé (the respondent's representative during the first-instance proceedings) from replying to the appellant's comments on the oral proceedings before the Opposition Division.

However, at no point during the oral proceedings did the respondent submit that the presence of Mr Aldé as its representative or witness was necessary. Therefore, the Board is of the opinion that no violation of the right to be heard related to Mr Aldé took place.

- 8.3.2 The Board additionally notes that the only points on which the representative of the respondent could have possibly requested to hear Mr Aldé relate to events at the oral proceedings before the Opposition Division ("... zu denen sich die Herren Weigel und Huber nicht äussern konnte [sic], da sie bei der Einspruchsverhandlung nicht anwesend waren") which were discussed in the context of a possible reimbursement of the appeal fee in view of an alleged violation of the right to be heard of the appellant in the opposition proceedings ("Im Rahmen des Einspruchsverfahrens brachte der Vertreter der Einsprechende schwerwiegende Argumente vor, sein Recht auf rechtliches Gehör sei verletzt worden"). However, the respondent raised the written objection under Rule 106 EPC after the Board had announced its conclusion that the appellant's request for reimbursement of the appeal fee was not to be granted. Hence, there is the remarkable situation that the respondent's objection is directed to an alleged infringement of the respondent's right to be heard on an issue which was decided, as the respondent had wished, against the appellant. It is thus not apparent to the Board how the respondent could be

adversely affected by the fact that Mr Aldé did not participate in this discussion.

8.4 It follows that the Board is not convinced by any of the objections raised under Rule 106 EPC. The objections are thus dismissed.

Order

For these reasons it is decided that:

- 1) The decision under appeal is set aside.
- 2) The patent is revoked.
- 3) The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated