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**Datasheet for the decision
of 2 September 2021**

Case Number: T 1364/18 - 3.2.08

Application Number: 05776367.4

Publication Number: 1771122

IPC: A61C7/08

Language of the proceedings: EN

Title of invention:

SYSTEM FOR PERSONALIZED ORTHODONTIC TREATMENT

Patent Proprietor:

DENTSPLY SIRONA Inc.

Opponent:

Bernhard Förster GmbH

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2), 123(3)

Keyword:

Grounds for opposition - added subject-matter (yes)
Amendments - added subject-matter (yes) - broadening of claim
(yes) - inescapable trap (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1364/18 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 2 September 2021

Appellant: DENTSPLY SIRONA Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 28 March 2018
revoking European patent No. 1771122 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Foulger
Members: A. Björklund
Y. Podbielski

Summary of Facts and Submissions

- I. The appeal was filed by the patent proprietor against the decision of the opposition division to revoke the European patent 1 771 122.

The opposition division decided that the subject-matter of claim 1 of the main request and of auxiliary request 2 then on file extended beyond the content of the application as originally filed (Articles 100(c) and 123(2) EPC), and that the subject-matter of claim 1 of auxiliary request 1 was neither clear (Article 84 EPC) nor sufficiently disclosed (Article 83 EPC).

- II. Oral proceedings by videoconference were held before the Board on 02 September 2021.

- III. At the end of the oral proceedings the parties' requests were as follows:

The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, as an auxiliary measure, that the patent be maintained on the basis of auxiliary request 2 filed during the oral proceedings before the opposition division, or auxiliary request 3 filed with the statement setting out the grounds of appeal.

The respondent (opponent) requested that the appeal be dismissed.

- IV. Claim 1 of the main request (patent as granted) reads:

"A system for correcting malocclusions to an end arch form comprising at least one activator (10) embedded in a polymeric or elastic inner shell (11) and an outer-shell (12) wherein said outer-shell (12) is at least partially in the desired end arch form such that said outer-shell (12) acts as a force module (**feature A**), and wherein a retaining device is formed into the outer-shell (12) to hold the inner shell (11) and outer-shell (12) together while allowing removal without damaging the shells (**feature B**)."

Claim 1 of auxiliary request 2, with amendments compared to claim 1 of the main request underlined, reads:

"A tray system for correcting malocclusions to an end arch form comprising at least one activator (10) embedded in a polymeric or elastic inner shell (11) and an outer-shell (12) wherein said outer-shell (12) is at least partially in the desired end arch form such that said outer-shell (12) acts as a force module (**feature A'**), and wherein a retaining device is formed into the outer-shell (12) to hold the inner shell (11) and outer-shell (12) together while allowing removal without damaging the shells (**feature B**), wherein the retaining device includes locking and removal bends placed in the outer-shell for holding the inner shell, and wherein the outer-shell has finger grips so the patient can remove the tray (**feature C**)."

Claim 1 of auxiliary request 3, with additions compared to claim 1 of auxiliary request 2 highlighted and deletions struck-through, reads:

"A tray system for correcting malocclusions to an end arch form comprising at least one activator (10)

embedded in a polymeric or elastic inner shell (11) and an outer-shell (12) wherein said outer-shell (12) is a tray in the form of dentition and at least partially in the desired end arch form such that said outer-shell (12) acts as a force module (**feature A'**), and wherein ~~a retaining device is formed into the outer-shell (12) to hold the inner shell (11) and outer-shell (12) together while allowing removal without damaging the shells~~ locking and removal bends are placed in the outer shell (12) to hold inner and outer shells (11, 12) together, and wherein the outer shell (12) has finger grips so the patient can remove the tray (**feature C'**)."

The feature designations have been added by the Board in bold.

- V. The appellant's arguments, as far as relevant for the decision, can be summarised as follows:

Main request - Article 100(c) EPC

Claim 1 as granted had a basis in claim 1 and paragraph [0021] of the application as filed.

In view of paragraphs [0002], [0003], [0006], [0008] and [0009] of the application as filed, it was disclosed that the application concerned a system for correcting malocclusions which was removable from the teeth.

The inner and outer shells of this system must be held together to allow removal from the teeth without damage to the shells. This was achieved by the retaining device disclosed in paragraph [0021]. The bump also disclosed in this paragraph was not involved in holding

the shells together but was an optional feature which could make the removal of the system easier in certain situations, as indicated by the bump being described "to allow easier removal...". The omission of the bump in Feature B of claim 1 as granted did thus not lead to an extension beyond the content of the application as filed.

Auxiliary request 2 - Article 123(2) EPC

The generic and specific implementations of the retaining devices and the bump in paragraphs [0021] and [0022] respectively had the same positions and the same functions. The terms "formed in" of paragraph [0021] and "placed in" of paragraph [0022], used to describe the provision of the generic and the specific retaining device respectively in the outer shell, had the same technical meaning in the field of removable systems for correcting malocclusions. Furthermore, a finger grip necessarily had some sort of protrusion which could be gripped by a finger and therefore was a specific type of bump. Both of these features had the function of making a removal "easier" which underlined that the finger grip was a specific type of bump. Paragraph [0022] thus disclosed specific implementations of the retaining device and the bump described generally in paragraph [0021].

The specific implementations of the retaining device and bump were defined in feature C of claim 1 of auxiliary request 2 which thus had a basis in the application as filed.

Auxiliary request 3 - Article 123(3) EPC

The scope of claim 1 of auxiliary request 3 was limited compared to claim 1 as granted.

The locking and removal bends of feature C' were limiting compared to the retaining device of feature B of claim 1. Furthermore, the finger grip allowed the patient to remove the tray and it was implicit that the removal was without damaging the shells.

The scope of claim 1 of auxiliary request 3 was thus restricted compared to claim 1 as granted.

VI. The respondent's arguments, as far as relevant for the decision, can be summarised as follows:

Main request - Article 100(c) EPC

Feature B did not have a basis in paragraph [0021] of the application as filed since it was only disclosed in conjunction with "a bump to allow easier removal without damaging the shells". It was thus the bump which was disclosed as allowing removal without damaging the shells and its omission in feature B constituted an unallowable generalisation.

The subject-matter of claim 1 as granted therefore extended beyond the content of the application as filed.

Auxiliary request 2 - Article 123(2) EPC

The terms "formed in" of paragraph [0021] and "placed in" of paragraph [0022] had different meanings. Furthermore, a finger grip was not necessarily a bump, it could also be implemented as e.g. an indentation or a friction material.

Hence, paragraph [0022] did not disclose specific embodiments of the retaining device and bump of paragraph [0021] but these two paragraphs rather disclosed two distinct embodiments. It followed that feature B which allegedly was based on paragraph [0021] and feature C, allegedly based on paragraph [0022] were not disclosed in combination in the application as filed.

Claim 1 of auxiliary request 2 therefore extended beyond the content of the application as filed.

Auxiliary request 3 - Article 123(3) EPC

In claim 1 of auxiliary request 3, feature C' had replaced feature B.

The wording "...retaining means formed into the outer shell..." of feature B and "...locking and removal bends are placed in the outer shell..." of feature C' had different meanings.

Furthermore, the finger grip was neither part of the retaining device nor the locking and removal bends. It was thus no longer required that a retaining device, generic or specific, allowed removal without damaging the shells.

The scope of the claim had therefore been extended compared to claim 1 as granted.

Reasons for the Decision

1. Main request - Article 100(c) EPC

1.1 According to the appellant, feature B of claim 1 of the main request was disclosed in paragraph [0021] of the application as filed.

1.2 The second sentence of this paragraph reads: "At the time the outer shell is formed, a retaining device will be formed into the outer shell and a bump to allow easier removal without damaging the shells."

This wording is ambiguous regarding the contributions of the retaining device and the bump "to allow easier removal without damaging the shells". Furthermore, the word "easier" does not as such indicate that the bump is an optional feature which is not involved in allowing removal of the shells without damage.

Paragraph [0021] therefore neither explicitly nor implicitly discloses that the retaining device in itself (without the bump) allows removal without damaging the shells as defined in feature B. This feature is thus not directly and unambiguously derivable from paragraph [0021].

The subject-matter of claim 1 of the main request (patent as granted) consequently extends beyond the content of the application as originally filed (Article 100(c) EPC).

2. Auxiliary request 2 - Article 123(2) EPC

2.1 The appellant submitted that the terms "formed in" and "placed in" used to describe the generic and specific retaining devices of the outer shell in paragraphs [0021] and [0022] of the application as filed had the same meaning within the field of systems for correcting

malocclusions. However, the appellant did not substantiate this assertion with any further evidence.

2.2 The wording of paragraph [0021] states that "At the time the outer shell is formed, a retaining device will be formed into the outer shell...". This implies that the retaining device is formed at the same time as the outer shell, i.e. as an integral part of the outer shell.

By contrast, paragraph [0022] describes how "Several new ideal trays are made and the locking and removal bends placed in the outer shell...". This implies that the outer shells are formed and thereafter separate locking and removal bends are placed in and attached to the outer shell. These locking and removal bends are thus not unequivocally a specific form of retaining means formed in the outer shell as described in paragraph [0021].

Furthermore, while a finger grip, as described in paragraph [0022], can be a bump, there are also other types of finger grips, for instance depressions. While both a bump and a depression have a surface which can be used for gripping by a finger, they are distinct and differing geometries. A finger grip is therefore not unequivocally a specific form of a bump.

Consequently, it is not directly and unambiguously derivable from the application as filed that paragraph [0022] describes a more specific implementation of the embodiment of paragraph [0021]. It follows that the combination of features B and C from paragraphs [0021] and [0022], which do not necessarily concern the same embodiment, lead to a combination of features which was

not unambiguously disclosed in the application as filed.

The subject-matter of claim 1 of auxiliary request 2 therefore extends beyond the content of the application as filed (Article 123(2) EPC).

3. Auxiliary request 3 - Article 123(3) EPC

For the reasons set out above with respect to auxiliary request 2, it is not directly and unambiguously derivable from the application as filed that "locking and removal bends ... placed in the outer shell" of feature C' of auxiliary request 3 are a specific and more limited implementation of a "retaining device formed into the outer shell" of feature B of the patent as granted. Since the claim no longer requires that a retaining device is "formed into" the outer shell but instead defines that a specific type of retaining device "is placed" in the outer shell, claim 1 of auxiliary request 3 encompasses subject-matter which was not encompassed by claim 1 as granted.

Furthermore, feature C' no longer requires the specific type of retaining device to hold the inner shell and outer shell together while allowing removal without damaging the shells as required by feature B of the granted patent.

Consequently, the scope of claim 1 of auxiliary request 3 has been extended in comparison with the scope of claim 1 of the patent as granted, contrary to the requirements of Article 123(3) EPC.

4. For the reasons set out above, none of the requests are allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Magliano

M. Foulger

Decision electronically authenticated