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**Datasheet for the decision
of 21 October 2021**

Case Number: T 0045/19 - 3.5.05

Application Number: 08770891.3

Publication Number: 2156351

IPC: G06F19/00

Language of the proceedings: EN

Title of invention:

DATABASE DESIGN FOR COLLECTION OF MEDICAL INSTRUMENT
PARAMETERS

Applicant:

Johnson & Johnson Surgical Vision, Inc.

Headword:

Same parameters values across all programs/JOHNSON&JOHNSON

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - (no)



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Case Number: T 0045/19 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 21 October 2021

Appellant: Johnson & Johnson Surgical Vision, Inc.
(Applicant) 1700 E. St. Andrew Place
Santa Ana, CA 92705-4933 (US)

Representative: Carpmaels & Ransford LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 10 July 2018
refusing European patent application No.
08770891.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: E. Konak
E. Mille

Summary of Facts and Submissions

I. The appeal is against the examining division's decision to refuse the application. The examining division decided that claims 1 and 9 of the main request and the first and second auxiliary requests did not meet the requirements of Article 123(2) EPC and were not new (Article 54 EPC) with regard to the following document:

D1: US 2003/093503 A1

II. With its statement setting out the grounds of appeal, the appellant re-filed the requests on which the contested decision was based. It requested that the decision be set aside and that a patent be granted on the basis of one of the requests. It requested oral proceedings as an auxiliary measure.

III. In its preliminary opinion issued in preparation for the oral proceedings, the board raised objections under Articles 84 and 56 EPC to all requests.

IV. Oral proceedings were held before the board.

V. Claim 1 of the main request reads as follows:

"A method for maintaining collections of medical systems settings, comprising:
storing medical system programs and all associated medical configuration parameter values in a database configured with multiple levels of organization, each level of organization comprising medical data items;
establishing a logical relationship between medical data items at each level of organization, including

establishing a logical relationship between users at a higher level or [sic] organization and programs stored at lower levels of the organization;
presenting a user with available medical system choices at each level of organization;
enabling the user to select a particular medical program from the stored medical programs from among the available medical system choices presented at each level of organization;
enabling the user to alter or adjust each configuration parameter of the selected medical program; and
populating the same values for the altered or adjusted configuration parameters consistently across all programs logically related to the user."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the word "users" in the second step of the claimed method was replaced by "surgeon names".

Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 2 in that the text "the altered or adjusted" in the last step of the claimed method was replaced by the text "a sub-set of".

Reasons for the Decision

1. The board agrees with the appellant that claim 1 of the main request differs from D1 in the feature of "populating the same values for the altered or adjusted configuration parameters consistently across all programs logically related to the user". None of the passages cited in the contested decision discloses this feature.

2. In its statement setting out the grounds of appeal, the appellant submitted that two effects of this distinguishing feature were that the number of steps required to configure the same parameter across multiple programs was reduced and that the medical system to which the parameters related operated in a way that was consistent across different programs. The appellant formulated the objective technical problem as allowing the surgeon to flexibly control the surgical instrument's behaviour during a medical procedure/operation.
3. In its preliminary opinion, the board did not agree with the appellant's formulation of the objective technical problem since it could not be derived from the distinguishing feature. Populating all programs with the same value seemed instead to decrease the surgeon's flexibility. At the oral proceedings, the appellant argued that the surgeon had more flexibility in that their workload was reduced and thus they had more freedom and an improved user experience.
4. In this regard, the board had already referred in its preliminary opinion to page 11, lines 16-22 of the description. This passage states that it is extremely unlikely that a surgeon would desire to configure the foot pedal differently for each of their stored programs. Therefore, the invention allowed them to alter their parameter values once "in lieu of altering values for each program stored in the program name level of the organization". However, this indicates that the distinguishing feature provides indeed for the mere automation of what a surgeon would otherwise have to do manually, namely individually altering the value of a parameter for each program to the same value that

they desire to have throughout their programs. The effects brought forward by the appellant, i.e. reducing the number of required steps, reduced workload, free capacity and operational consistency, are usual effects of automation.

5. It is established case law of the boards of appeal that the mere automation of functions performed manually by human operators is in line with the general trend in technology and thus cannot be considered inventive (see "Case Law of the Boards of Appeal of the European Patent Office", Ninth Edition, July 2019, I.D.9.19.5). The appellant argued at the oral proceedings that this invention was not a case of non-inventive automation. Conventional wisdom would have dictated that surgeons appreciated more control over every parameter in surgical procedures, rather than an automatic parameter change performed on their behalf. The invention therefore had a surprising effect. However, whether a community of human operators in a particular field wished the functions they perform manually to be automated is of no relevance to the assessment of inventive step. Therefore, the board is not convinced by the appellant's arguments.

6. For these reasons, the subject-matter of claim 1 of the main request does not involve any inventive step (Article 56 EPC). Since the auxiliary requests were filed merely to address the examining division's objections of added subject-matter, they also lack an inventive step for the same reasons.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated