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**Datasheet for the decision
of 2 May 2023**

Case Number: T 2054/19 - 3.2.02

Application Number: 14188200.1

Publication Number: 3005942

IPC: A61B5/053, A61B8/08, A61B5/145,
A61B5/1477, A61B5/0408

Language of the proceedings: EN

Title of invention:

Method for the detection and characterisation of bubbles in liquids and device therefor, resp.system

Applicant:

ARISTOTLE UNIVERSITY OF THESSALONIKI-
Research Committee

Relevant legal provisions:

EPC Art. 113(1), 94(3), 111(1)
EPC R. 103(1)(a)

Keyword:

Substantial procedural violation
Reimbursement of appeal fee
Remittal to the department of first instance



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Case Number: T 2054/19 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 2 May 2023

Appellant: ARISTOTLE UNIVERSITY OF THESSALONIKI-
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 25 January 2019
refusing European patent application No.
14188200.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: Y. Podbielski
S. Dennler

Summary of Facts and Submissions

The appeal lies from the decision of the examining division posted on 25 January 2019 to refuse European patent application No. 14188200.1.

The appellant argued in their statement of grounds of appeal *inter alia* that their right to be heard had been violated, because the examining division had proceeded to refuse the application without giving them an opportunity to react to the objections of lack of novelty and inventive step on which the decision was based. The facts relevant to this issue are set out in the reasons below.

The Board issued a communication on 14 February 2023. It expressed the view that a substantial procedural violation had occurred in the proceedings before the examining division, which justified that the case be remitted to the examining division for further prosecution and that the appeal fee be reimbursed. The appellant was invited to comment within a specified period. No reply was received in that period.

Reasons for the Decision

A party's right to be heard is enshrined in Article 113(1) EPC. That Article provides that decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

The right to be heard also includes the right not to be surprised by a decision which was taken against the expectation that the proceedings would be continued (Case Law of the Boards of Appeal, 10th edition 2022, III.B.2.5).

Relevant facts

Following the filing of the application, a European search report accompanied by a search opinion was issued on 5 October 2015. It was based on claims 1-15 as originally filed. Objections were raised under Articles 84, 53(c), 54 and 56 EPC. Regarding novelty, the subject-matter of independent claims 1 and 12 was considered not new in view of D1 (points 2.1.1.1 and 2.1.1.2 of the search opinion).

The applicant filed an amended set of claims on 13 October 2016 and provided arguments in support of novelty and inventive step.

Examination of the file started in September 2017.

The only substantive communication from the EPO during examination was the examining division's communication pursuant to Article 94(3) EPC dated 6 October 2017. It was based on claims 1-18 filed on 13 October 2016. The examining division raised objections under Rule 137(4) and 137(5) EPC and noted that claims 1-9 and 11-18 related to a completely different method and device than the claims originally filed. Only dependent claim 10 complied with Rule 137(5) EPC. The two paragraphs under the heading "Procedure" included the following statements:

"In view of the above objection it is not at present practicable to carry out a full examination of the application." (point 3.1)

"Should the Applicant however insist on obtaining a patent on one of the claims which were found not to be patentable, a refusal under Article 97(2) EPC is to be expected." (point 3.2)

A new set of claims was filed on 2 August 2018 comprising one independent and two dependent claims. Independent claim 1 bore close resemblance to the combination of claim 1 as originally filed and dependent claim 10 filed on 13 October 2016.

On 25 January 2019 the examining division decided to refuse the application. The decision was based on claims 1-3 filed on 2 August 2018. The examining division concluded that the subject-matter of claim 1 was not new in view of D1 and that none of the dependent claims could be considered inventive. In its reasoning (point 9.1), it relied on the views expressed in the European search opinion, as it considered claim 1 filed on 2 August 2018 to be identical in scope to claim 1 as originally filed, and thus to claim 1 objected to in the European search report.

Violation of the right to be heard

The immediate refusal of the application following the communication under Article 94(3) EPC amounts to a violation of the right to be heard for the reasons set out below.

The communication under Article 94(3) EPC concerned an entirely different set of claims compared to the one underlying the decision, and indicated that it was "at present not practicable to carry out a full examination of the application". When the applicant sought to remedy these deficiencies by filing a new set of claims, they could expect that the examination proceedings would be continued.

The applicant had neither been made aware that the examining division considered the scope of claim 1 before it to be identical to the scope of claim 1 as originally filed, nor of the fact that it relied on the search opinion. The sentence "*Should the Applicant however insist on obtaining a patent on*

one of the claims which were found not to be patentable, a refusal under Article 97(2) EPC is to be expected." stood at the end of a communication concerning a different set of claims and could thus not be read as an unambiguous reference to the search opinion which had been issued two years earlier. Where an examining division relies on arguments made in a search opinion, it must do so in a manner which is clear and unambiguous. There should be no doubt to an ordinary reader about what is meant.

Even if the examining division had made a proper reference to the search opinion, the Board notes that there are differences between the decision and the search opinion in the assessment of novelty. The decision (point 9.3) refers to page 12, line 5-9, of D1 as disclosing a "method of electrical impedance spectroscopy for non-invasive bubbles detection as well as estimation of their size and corresponding gas volumetric fraction, in the human body". The search opinion had failed to identify any specific disclosure of that feature in D1.

The appellant argued in its submission dated 13 October 2016 (page 3, 8th paragraph) that D1 only disclosed the appearance of gas bubbles in blood during decompression, but failed to disclose a quantitative estimation ability. This argument, whilst made in the context of a different set of claims, is also relevant to the claims as originally filed and to the claims underlying the decision. The decision fails, however, to address this argument. It instead points to the above-mentioned passage which in fact does not disclose that feature, since "indicating the appearance of gas bubbles in blood of the mammal", as disclosed in that passage, is different from the claimed "estimation of their size and corresponding gas volumetric fraction". Hence, the argument is neither explicitly nor implicitly addressed.

For all these reasons the appellant was taken by surprise by the timing and the content of the decision. The Board considers these shortcomings to amount to a substantial procedural violation justifying remittal to the examining division for further prosecution and reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the examining division for further prosecution.

The appeal fee is reimbursed.

The Registrar:

The Chairman:



K. Götz-Wein

M. Alvazzi Delfrate

Decision electronically authenticated