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**Datasheet for the decision  
of 17 February 2022**

**Case Number:** T 2612/19 - 3.2.08

**Application Number:** 16197945.5

**Publication Number:** 3158967

**IPC:** A61C7/08

**Language of the proceedings:** EN

**Title of invention:**

TREATMENT PLANNING AND PROGRESS TRACKING SYSTEM AND METHODS

**Applicant:**

Align Technology, Inc.

**Relevant legal provisions:**

EPC Art. 53(c)

**Keyword:**

Exceptions to patentability - (yes)

**Decisions cited:**

G 0001/07, T 0329/94



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Case Number: T 2612/19 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 17 February 2022**

**Appellant:** Align Technology, Inc.  
(Applicant) 2820 Orchard Parkway  
San Jose, CA 95134 (US)

**Representative:** Grünecker Patent- und Rechtsanwälte  
PartG mbB  
Leopoldstraße 4  
80802 München (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 29 March 2019  
refusing European patent application No.  
16197945.5 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairwoman** P. Acton  
**Members:** C. Vetter  
F. Bostedt

## Summary of Facts and Submissions

- I. The appeal was filed by the applicant (appellant) against the decision of the examining division to refuse the patent application in suit.
- II. The examining division had decided that the subject-matter of claim 1 fell within the exceptions to patentability under Article 53(c) EPC.
- III. Oral proceedings were held before the Board and conducted by videoconference.
- IV. The appellant (applicant) requested that the decision under appeal be set aside and that a patent be granted based on the claims filed under cover of the letter of 19 October 2017.
- V. Claim 1 of this request reads as follows (feature designation in square brackets added by the Board):  
  
[M1] A method of managing delivery of an orthodontic treatment plan, comprising:  
[M2] receiving (202) information about a dental condition of a patient;  
[M3] generating (206) a treatment plan for a patient, the plan comprising  
a plurality of successive tooth arrangements for moving teeth along a treatment path from an initial arrangement toward a selected final arrangement,  
the plan further comprising  
a series of one or more treatment phases to move teeth along the treatment path;

[M4] providing (210) a set of appliances according to the planned arrangements for at least one treatment phase;

[M5] tracking (212) progression of the patient's teeth along the treatment path,

[M6] the tracking comprising comparing a digital representation of an actual arrangement of the patient's teeth following administration of a set of appliances to a planned arrangement

[M7] to determine if the actual arrangement of the teeth substantially matches the planned tooth arrangement.

VI. The appellant's arguments, as far as they are relevant to the present decision, can be summarised as follows.

The appellant did not maintain its argument that an orthodontic treatment step is not necessarily to be considered a treatment of the human or animal body by therapy within the meaning of Article 53(c) EPC. It instead argued that the claimed method referred to a method of *managing the delivery* of a treatment plan. According to the appellant, claim 1 only mentioned steps performed *before* and *after* an actual treatment (the administration of appliances to a patient) so that the exceptions to patentability under Article 53(c) EPC did not apply. The administration of appliances to a patient was a prerequisite for performing the claimed method, but this did not *per se* exclude the claimed method from patentability under Article 53(c) EPC as established in decisions G 1/07 and T 329/94.

## Reasons for the Decision

1. Exceptions to patentability (Article 53(c) EPC)
  - 1.1 It is correct that the claimed method does not explicitly refer to a method for orthodontic treatment of a patient but instead to a method of managing delivery of an orthodontic treatment plan (see feature [M1]). Furthermore, the wording of claim 1 does not explicitly mention a method step which would be considered a step for treatment of the human or animal body by therapy within the meaning of Article 53(c) EPC.
  - 1.2 However, it is not necessary for a claim to explicitly refer to a therapeutic method or to explicitly mention a therapeutic method step for the subject-matter of the claim to be excluded from patentability. It is sufficient that the claimed method encompasses such a step (see G 1/07, grounds 4.1 to 4.3, for surgical method steps).

Decision G 1/07 states the following under point 4.3.1 of the Reasons:

"Article 84 EPC in conjunction with Rule 43 EPC requires that the claims shall define the matter for which protection is sought. Hence, the claim should explicitly specify all of the essential features needed to define the invention. Furthermore, the claim must be clear (G 1/04, point 6.2 of the Reasons). Under Article 84 EPC, whether or not a step being or encompassing a surgical step excluded from patentability can be omitted either by using positive wording for such omission like "pre-delivered" or by simply leaving it

out from the claim depends on whether the claimed invention is fully and completely defined by the features of the claim without that step. That requires an assessment of the individual case under consideration."

- 1.3 In the case at hand, no objection under Article 84 EPC had been raised by the examining division. However, irrespective of such an objection, if essential features of the invention are missing from the claim, these must be read into the claimed method when assessing whether it falls under the exceptions of patentability in accordance with Article 53(c) EPC.

It must therefore be clarified whether the claimed invention is fully and completely defined by the features of claim 1. For this purpose, the description, among other elements, must be consulted.

- 1.4 The invention relates to orthodontics. An objective of orthodontics is to move a patient's teeth to positions where function and/or aesthetics are optimised. Traditionally, appliances such as braces are applied to the patient's teeth by an orthodontist or dentist, and the set of braces exerts continual force on the teeth and gradually urges them toward their intended positions (A-publication, paragraph [0003]).

- 1.5 Claim 1 concerns a method of managing delivery of an orthodontic treatment plan **[M1]**. As argued by the appellant, the claim only mentions steps effectively performed before (features **[M2]** to **[M4]**) and after (features **[M5]** to **[M7]**) the actual treatment, i.e. the application of the appliances to the patient's teeth. However, as conceded by the appellant, the treatment step is a *prerequisite* for the claimed method to be

applicable. This is not only evident from the wording of the claim and in particular from the step of comparing a digital representation of an actual arrangement of the patient's teeth *following administration of a set of appliances* to a planned arrangement (feature **[M6]**). For this step to be carried out, it is inevitable that the appliances have been applied to the patient's teeth beforehand. It is also evident from the flowchart in Figure 3A and the corresponding description (A-Publication, paragraphs [0021] to [0023]). Omitting the step 210 of administering appliances would render the step 212 of progress tracking meaningless since there would be no progress that could be tracked.

It follows that administering a set of appliances (the application of the appliances to the patient's teeth) is an essential feature of the invention. This method step must therefore be seen to be encompassed by the claimed method because otherwise the claimed invention would not be fully and completely defined by the features of the claim (see G 1/07, point 4.3.1 of the Reasons).

- 1.6 The appellant argued that the administration of appliances to a patient as a prerequisite for performing the claimed method does not *per se* exclude the claimed method from patentability under Article 53(c) EPC. The appellant referred to decision G 1/07, point 4.3.2 of the Reasons, and in particular to decision T 329/94 mentioned there. In T 329/94, it was held that if the claimed subject-matter is confined to operating an apparatus for performing a method with the technical aim of facilitating blood flow towards a blood extraction point, the operating method has no therapeutic purpose or effect and, therefore, is not

excluded from patentability. This view was confirmed by G 1/07, even in light of the fact that the application of the device as such needed a surgical step to be practised on the body (G 1/07, point 4.3.2 of the Reasons). The appellant concluded that the prerequisite of a surgical step could not be considered different from the prerequisite of a treatment by therapy, meaning that in the case at issue the administration of appliances as a prerequisite for the claimed method could not lead to the claimed method being excluded from patentability.

- 1.7 It is to be noted that point 4.3.2 of the Reasons of decision G 1/07 deals exclusively with cases in which the invention only concerns the *operating of a device* without any functional link between the claimed method and the effects produced by the device on the body. These cases are different from the current case where the claim is not directed to the operation of a device. The principles developed for these cases, therefore, cannot be applied offhand to the current case.

Moreover, decision G 1/07 stated under point 4.3.2 of the Reasons why these cases are considered particular (emphasis added):

"Methods which are merely directed to the operating of a device without themselves providing any functional interaction with the effects produced by the device on the body are teachings in which the performance of a physical activity or action that constitutes a method step for treatment of a human or animal body by surgery or therapy is not required in order for the teaching of the claimed invention to be complete."



In the case at issue, however, the teaching of the claimed invention is not complete without the step of administering a set of appliances to the patient. In fact, claimed method steps [M5] to [M7] are interwoven and therefore functionally linked with the administration of appliances as they deal directly with its result, namely the *actual arrangement of the patient's teeth following administration of a set of appliances.*

Hence, the principles developed by the case law cited under point 4.3.2 of the Reasons of G 1/07 cannot be applied to the current case.

1.8 The subject-matter of claim 1, therefore, is excluded from patentability under Article 53(c) EPC.

## Order

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairwoman:



S. Lichtenvort

P. Acton

Decision electronically authenticated