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

Case Number: T 1037/20 - 3.2.02

Application Number: 14809688.6

Publication Number: 3076890

IPC: A61B18/18, A61N5/06, A61B18/00

Language of the proceedings: EN

Title of invention:
SKIN TREATMENT APPARATUS UTILISING INTENSE PULSED LIGHT (IPL)

Patent Proprietor:
iPulse Limited

Opponent:
Spectrum Brands, Inc.

Headword:

Relevant legal provisions:
EPC Art. 54, 56
RPBA 2020 Art. 12(6)

Keyword:

Late-filed requests - admitted in first-instance proceedings

(no) - error in use of discretion at first instance

(no) (yes) - admitted (no) (yes)

Novelty - auxiliary request (yes)

Inventive step - auxiliary request (yes)

Decisions cited:

Catchword:



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Case Number: T 1037/20 - 3.2.02

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

Appellant: iPulse Limited
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 24 February
2020 revoking European patent No. 3076890
pursuant to Article 101(3)(b) EPC**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: D. Ceccarelli
C. Schmidt

Summary of Facts and Submissions

- I. The proprietor appealed against the Opposition Division's decision to revoke the patent.
- II. The Board summoned the parties to oral proceedings and sent a preliminary opinion. After receipt of the preliminary opinion, the parties withdrew their requests for oral proceedings, which were cancelled by the Board.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of one of the main request and the first to third auxiliary requests, all filed with the statement of grounds of appeal on 6 July 2020.

The respondent requested that the appeal be dismissed.

- III. The following documents are relevant to this decision:

D2: WO 02/085229 A2
D3: EP 0 885 629 A2
D6: US 4,853,600 A
D9: WO 2013/173516 A1

- IV. **Claim 1 of the main request** reads as follows.

"A skin treatment apparatus comprising a light source comprising

- a light emitting element (20) for transmitting light energy to the skin and a charge storage device (20) for discharging an energy dose to the light emitting element; characterised in that the skin treatment

apparatus further comprises:

- at least one sensor (32, 57) for measuring a parameter of the skin;
- a control system (28, 80) configured to determine a treatment energy dose to be delivered, this being derived using the sensor measurement;
- wherein the control system (28, 80) is arranged to control charging of the charge storage device (20) prior to and/or at the same time as determination of the treatment energy dose; and
 - i) wherein the control system (28, 80) is arranged to terminate free discharge of the charge storage device (20) upon delivery of the treatment energy dose and before discharge is complete; and/or
 - ii) wherein the charge storage device comprises a plurality of individual charge storage elements (20), and the control system is arranged to control discharge of the plurality of individual charge storage elements (20) to deliver the treatment energy dose; and/or
 - iii) wherein the control system (28, 80) is arranged to enable charging of the charge storage device (20) in a two or more stage operation, wherein in a first stage charging is to an intermediate energy level, and in a second or further stage to an energy level sufficient to deliver the treatment energy dose."

Claim 1 of the first auxiliary request reads as follows.

"A skin treatment apparatus comprising a light source comprising

- a light emitting element (20) for transmitting light energy to the skin and a charge storage device (20) for discharging an energy dose to the light emitting element; characterised in that the skin treatment apparatus further comprises:
- at least one sensor (32, 57) for measuring a parameter of the skin;
- a control system (28, 80) configured to determine a treatment energy dose to be delivered, this being derived using the sensor measurement;
- wherein the control system (28, 80) is arranged to control charging of the charge storage device (20) prior to and/or at the same time as determination of the treatment energy dose; and
 - i) wherein the charge storage device comprises a plurality of individual charge storage elements (20), and the control system is arranged to control discharge of the plurality of individual charge storage elements (20) to deliver the treatment energy dose; and/or
 - ii) wherein the control system (28, 80) is arranged to enable charging of the charge storage device (20) in a two or more stage operation, wherein in a first stage charging is to an intermediate energy level, and in a

second or further stage to an energy level sufficient to deliver the treatment energy dose."

Claims 2 to 14 are dependent claims.

- V. The appellant's arguments relevant to the decision may be summarised as follows.

Main request

The main request corresponded to auxiliary request 2 submitted during oral proceedings in the first-instance proceedings in response to the Opposition Division's change of interpretation of D2 and D3 over its former preliminary opinion. The Opposition Division had not admitted this request. However, in accordance with the case law, an amendment at a later stage in the proceedings was justifiable if it was an appropriate and immediate reaction to unforeseeable developments in the proceedings which did not lie in the responsibility of the party submitting the amendment. Moreover, the discretion not to admit auxiliary requests should, as a rule, be limited to exceptional cases in which the filing of the auxiliary request could be said to amount to an abuse of procedural rights. For these reasons, the Opposition Division should have admitted auxiliary request 2 into the proceedings.

Furthermore, the main request had been incorporated in the grounds of appeal. The Board and the respondent therefore had had sufficient time to review it. Thus, in accordance with the case law, the Board could admit the claims of the main request into the appeal proceedings at its discretion, even though those claims had not been admitted in the first-instance

proceedings.

First auxiliary request

Claim 1 of the first auxiliary request was derived from a combination of claims 1 and 3 as granted. Its subject-matter was novel over D2 and D3. These documents did not disclose a control system arranged to control the charging of the charge storage device prior to and/or at the same time as determination of the treatment energy dose. They did not disclose a charge storage device comprising a plurality of individual charge storage elements, a control system arranged to control discharge of the plurality of individual charge storage elements to deliver a treatment energy dose or a control system arranged to enable charging of the charge storage device in a two or more stage operation in which in a first stage charging is to an intermediate energy level, and in a second or further stage, to an energy level sufficient to deliver the treatment energy dose.

These distinguishing features addressed the objective technical problem of applying a treatment energy dose to the skin with both safety and efficacy, even by an unskilled user.

D6 was not analogous art. It related to a flash apparatus that allowed controlled emission of the colour temperature of light from a flash tube independent of the quantity of light emitted, this being particularly suitable for producing exposures with an optimal colour temperature. Faced with the objective technical problem, the person skilled in the art would not have considered D6.

Hence, the subject-matter of claim 1 of the first auxiliary request was novel and inventive.

- VI. The respondent's arguments relevant to the decision may be summarised as follows.

Main request

The main request corresponded to auxiliary request 2 filed during the oral proceedings before the Opposition Division. This request had not been admitted into the proceedings for the reasons set out on pages 9 and 10 of the decision. The Opposition Division had exercised its discretion correctly in not admitting this request, and there were no circumstances which justified admission of this request into the appeal. Hence, this request should not be admitted pursuant to Article 12(6) of the RPBA 2020.

First auxiliary request

The subject-matter of the first auxiliary request was derived directly from subject-matter in the claims as granted. There were no objections to the admission of the first auxiliary request into the appeal proceedings. There were no further observations on this request.

Reasons for the Decision

1. The patent

The patent relates to a skin treatment apparatus comprising a light source.

Skin treatment apparatuses employing light, in particular intense pulse light, can be used for cosmetic purposes, such as depilation or skin rejuvenation, or for therapeutic purposes, such as the treatment of acne.

The claimed apparatus comprises a light emitting element for transmitting light energy to the skin and a charge storage device for discharging an energy dose to the light emitting element.

The light emitting element could be in the form of a flashlight energised by a pulse of energy released by the charge storage device in the form of a capacitor.

The apparatus further comprises a sensor for measuring a parameter of the skin and a control system configured to determine a treatment energy dose to be delivered. The energy dose is derived from the sensor measurement.

Different skin types, for example, depending on skin tone, require or can withstand different energy levels. The sensor is intended to assist in the provision of an energy level which ensures effective and safe treatment.

The control system is arranged to control charging of the charge storage device prior to and/or at the same time as the determination of the treatment energy dose. According to the patent (paragraph [0008]), this should reduce the delay between the sensor measurement and the application of the light treatment, this also having an impact on the safety of use as it reduces the likelihood that the apparatus is moved relative to the skin after the measurement and before the energy pulse is discharged.

According to claim 1 of the first auxiliary request, the charge storage device comprises a plurality of individual charge storage elements, and the control system is arranged to control discharge of the plurality of individual charge storage elements to deliver the treatment energy dose, and/or the control system is arranged to enable charging of the charge storage device in a two or more stage operation in which in a first stage charging is to an intermediate energy level, and in a second or further stage, to an energy level sufficient to deliver the treatment energy dose.

These features also have an impact on the charging of the charge storage device up to the necessary energy level and on the delay between the sensor measurement and the application of the light treatment.

2. Main request

The main request corresponds to auxiliary request 2 filed in the first-instance proceedings.

The respondent objected to the admittance of this request, which was filed during the oral proceedings before the Opposition Division, after the Opposition Division had reached the conclusion that the subject-matter of claim 1 of the then pending auxiliary request 1 did not involve an inventive step over D2 (together with D3 to which D2 refers), in combination with the common general knowledge. The Opposition Division did not admit auxiliary request 2.

Under Article 12(6) RPBA 2020, the Board must not admit requests not admitted in the proceedings leading to the

decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or the circumstances of the appeal case justify their admittance.

In the impugned decision, the Opposition Division explained why the subject-matter of claim 1 of auxiliary request 1 did not involve an inventive step and went on to explain that auxiliary request 2 had been filed late and did not solve, on a *prima facie* basis, the objection of lack of inventive step (point 2.3 spanning pages 9 and 10 of the impugned decision). It stated that the additional feature provided in claim 1 of auxiliary request 2, compared to auxiliary request 1, was disclosed in document D3. Hence, the Opposition Division duly motivated its use of discretion in not admitting auxiliary request 2.

The appellant's arguments that auxiliary request 2 should have been admitted by the Opposition Division because it had been a reaction to the Opposition Division's change of interpretation of D2 and D3 over its former preliminary opinion and that auxiliary requests should generally be admitted are not convincing.

First, a deviation from a preliminary opinion, in view of further submissions of the parties during the oral proceedings, is not an unforeseeable development of a case. Moreover, a condition to be satisfied by a late-filed request for admittance, for procedural economy, is the *prima-facie* suitability of the request to overcome the outstanding objections. The Opposition Division's explanation that this was not the case, alone, justifies the use of discretion in not admitting auxiliary request 2.

For these reasons, the main request is not admitted into the appeal proceedings, in accordance with Article 12(6) RPBA 2020, which applies also to submissions re-filed with the statement of grounds of appeal.

3. First auxiliary request

3.1 The first auxiliary request corresponds to auxiliary request 3 filed before the Opposition Division.

The Opposition Division did not admit auxiliary request 3 stating that it had been filed late and that the same conclusions as those reached for the then pending auxiliary request 1 applied on a *prima facie* basis.

Auxiliary requests 1 and 3 pending in the first-instance proceedings differed in that one of three alternatives was deleted in auxiliary request 3. However, the reasons provided for lack of inventive step of claim 1 of auxiliary request 1 were based on the obviousness of this deleted alternative. Hence, they could not apply to the subject-matter of claim 1 of the then pending auxiliary request 3.

The Opposition Division observed that in the preliminary opinion before the oral proceedings, it had stated that the remaining two alternatives in the claim were not inventive when starting from D9. However, the reasoning starting from D9 in that opinion was for a claim which did not comprise the further limitation that the control system is arranged to control charging of the charge storage device prior to and/or at the same time as determination of the treatment energy

dose. Moreover, in the impugned decision, the Opposition Division itself stated that it had changed its view on the objections starting from D9 (point 2.2 on page 8 of the impugned decision).

The Opposition Division further observed that the same conclusions as those reached for claim 1 of auxiliary request 1 applied to claim 1 of auxiliary request 3 when starting from D2 (together with D3). This was because D6 disclosed one of the alternatives in the claim. However, the Opposition Division did not explain - not even on a *prima facie* basis - why this should be the case. Simply stating that a feature missing in a document was present in another document is not a sufficient reason on which an inventive-step objection can be based. The reference to the respondent's submissions in the notice of opposition does not help as also those submissions, in substance, merely state that D6 discloses the missing feature (point 21 of the notice of opposition). Moreover, the Opposition Division had stated, in the preliminary opinion before the oral proceedings, that the subject-matter of claim 1 of the granted patent was inventive when starting from D2 or D3 (point 2 of that opinion).

In conclusion, the Opposition Division, in not admitting auxiliary request 3, made an error in the use of its discretion because it used the *prima facie* criterion (as prescribed by the Guidelines, E-VI.2.2.3) but did not explain why the request, *prima facie*, was not allowable. Merely stating that a request is *prima facie* not allowable is not sufficient.

Finally, the respondent expressly stated that it had no objections to the admissibility of the first auxiliary request on appeal.

For these reasons, the Board admits the first auxiliary request into the appeal proceeding in accordance with Article 12(6) RPBA 2020.

- 3.2 In the impugned decision, the Opposition Division held that the subject-matter of claim 1 of the then pending main request lacked novelty over D2 read in conjunction with D3.

However, the subject-matter of claim 1 of the first auxiliary request on appeal, which is derived from a combination of granted claims 1 and 3, is novel (Article 54(1) and (2) EPC) over D2, even when read in conjunction with D3.

- 3.2.1 D2, cited in paragraphs [0002] and [0003] of the patent, discloses a skin treatment apparatus with a light source in the form of a flashlight (the embodiment shown in Figure 6, described starting from page 14, line 10), the apparatus comprising a light emitting element (flashlight 103) for transmitting light energy to the skin and a charge storage device (capacitor C in Figure 1 of D3, referred to in D2, page 14, lines 29 to 30) for discharging an energy dose to the light emitting element. The apparatus further comprises a sensor for measuring a parameter of the skin and a control system configured to determine a treatment energy dose to be delivered, this being derived using the sensor measurement (page 2, lines 2 to 8).
- 3.2.2 D2, also in view of D3, does not disclose that the control system is arranged to control the charging of the charge storage device prior to and/or at the same time as determination of the treatment energy dose.

D2 does not disclose either that the charge storage device comprises a plurality of individual charge storage elements, that the control system is arranged to control discharge of the plurality of individual charge storage elements to deliver the treatment energy dose, or that the control system is arranged to enable charging of the charge storage device in a two or more stage operation in which in a first stage charging is to an intermediate energy level, and in a second or further stage, to an energy level sufficient to deliver the treatment energy dose.

- 3.3 In the impugned decision, the Opposition Division held that the subject-matter of claim 1 of the then pending auxiliary request 1 lacked an inventive step over the combination of D2, read in conjunction with D3, and the common general knowledge, and that the subject-matter of claim 1 of the first auxiliary request on appeal lacked an inventive step, on a *prima-facie* basis, over the combination of D2, read in conjunction with D3, and D6.

The distinguishing features of the subject-matter of claim 1 of the first auxiliary request over D2, read in conjunction with D3, contribute to the reduction of the delay between the sensor measurement and the application of the light treatment. The provision of a plurality of charge storage elements makes it possible to modulate the charging, for example, by keeping some of the storage elements always charged before the sensor measurement takes place and charging others, if needed, after the measurement. The same holds true for the provision of a two or more stage operation: the charge storage device could be kept at a first charge level before the sensor measurement takes place and

then charged further, if needed, after the measurement.

The objective technical problem solved by the distinguishing features is therefore making the apparatus more efficient and also safer as the likelihood that the apparatus is moved relative to the skin after the sensor measurement and before the energy pulse is discharged is reduced (paragraph [0008], second sentence and paragraph [0010] of the patent).

There is no evidence that the person skilled in the art of skin treatment apparatuses would have implemented the distinguishing features of the subject-matter of claim 1 of the first auxiliary request in the apparatus according to D2, read in conjunction with D3, to solve the objective technical problem in view of the common general knowledge.

In the impugned decision, the Opposition Division stated that D6 disclosed a control system arranged to enable charging of a charge storage device in a two or more stage operation in which in a first stage charging is to an intermediate energy level, and in a second or further stage, to an energy level sufficient to deliver a treatment energy dose. However, D6 concerns a flash apparatus with colour temperature control for obtaining better pictures by a camera when a flashlight is used (column 2, lines 7 to 11; column 5, lines 39 to 46 and 61 to 63; and column 6, lines 15 to 19). D6 belongs therefore to a different technical field and teaches no solution to the objective technical problem. The person skilled in the art would not have considered D6 at all.

It follows that the subject-matter of claim 1 of the first auxiliary request is inventive (Article 56 EPC) when starting from D2, read in conjunction with D3, in

combination with the common general knowledge or D6.

- 3.4 It follows that there are no objections, either maintained by the respondent or raised by the Opposition Division in the impugned decision, which prejudice the maintenance of the patent on the basis of the claims of the first auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to maintain the patent on the basis of the claims according to the first auxiliary request, filed with the statement of grounds of appeal on 6 July 2020, and a description and drawings to be adapted.

The Registrar:

The Chairman:



A. Chavinier-Tomsic

M. Alvazzi Delfrate

Decision electronically authenticated