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**Datasheet for the decision  
of 16 October 2023**

**Case Number:** T 1598/20 - 3.2.02

**Application Number:** 16701198.0

**Publication Number:** 3242587

**IPC:** A61B5/00, A61B5/0205,  
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A61B5/1455

**Language of the proceedings:** EN

**Title of invention:**  
MOBILE WEARABLE MONITORING SYSTEMS

**Applicant:**  
Burton, David

**Relevant legal provisions:**  
EPC Art. 109(1), 111(1), 123(2)  
RPBA 2020 Art. 11

**Keyword:**  
Amendments - added subject-matter (no)  
Interlocutory revision - department of first instance should  
have rectified decision (yes)  
Remittal - (yes)

**Decisions cited:**

T 0139/87



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Case Number: T 1598/20 - 3.2.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 16 October 2023**

**Appellant:** Burton, David  
(Applicant) 30-40 Flockhart Street  
Abbotsford, Victoria 3067 (AU)

**Representative:** Handsome I.P. Ltd  
27-28 Monmouth Street  
Bath BA1 2AP (GB)

**Decision under appeal:** **Decision of the examining division of the  
European Patent Office posted on 4 February 2020  
refusing European patent application No.  
16701198.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

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

## **Summary of Facts and Submissions**

I. The appeal was filed by the applicant ("the appellant") against the decision of the examining division to refuse its patent application on the sole ground that claim 1 of the main and only request then on file (namely, the claims filed with the submission of 13 January 2020) comprised added subject-matter in breach of Article 123(2) EPC.

II. Notice of appeal was received on 30 March 2020. The appeal fee was paid on the same day.

With the statement of grounds of appeal, received on 28 May 2020, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the new main request filed with the statement of grounds of appeal, which were to replace those on which the decision under appeal was based.

The appellant also requested oral proceedings if the board of appeal was "minded to refuse the application".

III. By EPO Form 2701 dated 17 July 2020, the examining division ordered that the decision under appeal would not be rectified and that the case was to be referred to the Board of Appeal without delay in accordance with Article 109(2) EPC.

IV. The claims of the new main request filed on appeal with the statement of grounds of appeal differ from those of the main request filed with the submission of 13 January 2020, on which the decision under appeal was

based, only in that claim 1 is amended as follows (amendments highlighted by the Board):

"A mobile sleep health monitoring system comprising:  
a wearable forehead sensor strip comprising a sensor for monitoring EEG signals of an individual;  
means for determining sleep parameters of the individual from the EEG signals;  
a sensor for measuring body temperature;  
means for determining the individual's biological circadian rhythm from the measured body temperature;  
means for determining sleep quality and circadian clock factors of the individual from the sleep parameters and biological circadian rhythm;  
a wearable indicator system wirelessly interconnected with the wearable forehead sensor strip to enable dynamic data exchange, the wearable indicator system configured for displaying sleep quality and circadian clock factors; and  
characterised by:  
means for establishing ~~a first quality of~~ typical or high-quality sleep of a subject via sleep survey performance assessments or diagnostic assessments sleep sessions;  
~~characterised in that~~ wherein sleep quality comprises the amount of REM sleep or deep sleep based on sleep time elapsed versus the ~~first quality of sleep~~ typical or high-quality sleep."

- V. Reference is made to the patent application as filed, published under WO 2016/110804 A1 ("the original application").

## **Reasons for the Decision**

### **1. Admissibility of the appeal; admittance of the new main request**

1.1 The appeal is admissible.

1.2 As explained by the appellant in the statement of grounds of appeal, the amendments made in the new main request filed on appeal clearly address the objection of added subject-matter raised by the examining division, for the first time, in the decision under appeal. Therefore, although this new main request is to be regarded as an amendment within the meaning of Article 12(4) RPBA 2020, the Board decides to admit it into the proceedings.

### **2. Added subject-matter**

2.1 As set out in points 1 to 7 of the reasons for the decision under appeal, the examining division refused the application on the sole ground that the wording of claim 1 of the main and only request then on file, namely the claims filed with the submission of 13 January 2020, used the generic expression "first quality of sleep" rather than the terms "typical sleep" and "high-quality sleep" originally disclosed on page 75, lines 1-5 of the original application. The examining division objected that there was no basis in the original application for this substitution of terms and that for this reason claim 1 infringed Article 123(2) EPC.

2.2 In the new main request filed with the appellant's statement of grounds of appeal, the originally disclosed wording "typical or high-quality sleep", to

which the examining division had pointed in the decision, was reintroduced into claim 1. This clearly overcomes the examining division's objection under Article 123(2) EPC.

2.3 Since the only objection on which the refusal of the application was based has manifestly been remedied, the appeal is allowable and the decision under appeal is to be set aside.

2.4 The Board points out that, in such circumstances, the examining division should have considered the appeal admissible and well founded and, consequently, should have rectified the decision under Article 109(1) EPC. Indeed, the first-instance department has no discretion in applying the provision of Article 109(1) EPC which stipulates that the department whose decision is contested "shall rectify its decision" if it considers the appeal to be admissible and well founded. In particular, the fact that there may be other objections which have not been removed but which were not the subject of the contested decision cannot preclude the application of Article 109(1) EPC (see in this respect T 139/87, point 4).

**3. Request for grant of a patent; remittal to the examining division for further prosecution**

3.1 The appellant requested that a patent be granted on the basis of the amended claims filed with the statement of grounds of appeal.

However, only the compliance of "[t]he amendments filed with the letter dated 13.01.2020" with Article 123(2) EPC was considered in the decision under appeal (see points 1 and 6 of the reasons). In particular, it is

not evident from the decision whether the examining division considered the other features still claimed in claim 1 and in the dependent claims to comply with Article 123(2) EPC. The Board notes in this respect that the minutes of the oral proceedings before the examining division state (see point 2) that the subject-matter of claim 1 was examined for compliance with Article 123(2) EPC, but do not mention that a similar assessment was also made for the dependent claims. Indeed, neither the remaining features of claim 1 nor those of the dependent claims are discussed in the contested decision.

Furthermore, the decision under appeal does not address the other requirements of the EPC, in particular those relating to clarity, novelty and inventive step.

3.2 For these reasons, and having regard to the primary object of the appeal proceedings, which is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020), the Board considers that special reasons within the meaning of Article 11 RPBA 2020 exist for remitting the case to the examining division for further prosecution, in accordance with Article 111(1) EPC.

3.3 The appellant made an auxiliary request for oral proceedings in case the Board was minded to refuse the application. This is not the case and, in any event, according to established case law, remittal for further prosecution is not considered as being adverse to the appellant (see Case law of the Boards of Appeal, 10th edition, III.C.4.5). In view thereof, there is no need to hold oral proceedings before the Board.



## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:



A. Chavinier-Tomsic

M. Alvazzi Delfrate

Decision electronically authenticated