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**Datasheet for the decision
of 29 September 2023**

Case Number: T 1819/20 - 3.2.02

Application Number: 16020280.0

Publication Number: 3275366

IPC: A61B5/05, G01R33/02

Language of the proceedings: EN

Title of invention:
REFRACTIVE ULTRASOUND SCANNER

Applicant:
CERAGOS Electronics & Nature

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 12(6), 13(1), 13(2)

Keyword:
Amendments - added subject-matter (yes) - allowable (no)
Amendment after summons - taken into account (no)

Decisions cited:
G 0002/10



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1819/20 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 29 September 2023

Appellant: CERAGOS Electronics & Nature
(Applicant) 23, Chemin Alphonse Daudet
06800 Cagnes-sur-Mer (FR)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 19 May 2020
refusing European patent application No.
16020280.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: S. Dennler
C. Schmidt

Summary of Facts and Submissions

I. This appeal was filed by the applicant ("the appellant") against the decision of the Examining Division to refuse European patent application No. 16020280.0. The reason for the decision was that the claims of the main and then sole request (claims filed with the submission of 15 March 2020) comprised added subject-matter, contrary to Article 123(2) EPC (points II.2 to II.3 of the decision).

In an *obiter dictum* (section III of the decision), the Examining Division raised further objections under Article 123(2) EPC to the claims and the description of the main request.

II. The Board summoned the appellant to attend oral proceedings, and gave its preliminary opinion on the main request in its communication under Article 15(1) RPBA 2020.

III. During the oral proceedings before the Board, which took place by videoconference on 29 September 2023, the appellant reintroduced the originally filed set of claims as an auxiliary request.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request underlying the appealed decision or, alternatively, on the basis of the newly filed auxiliary request.

IV. Claim 1 of the main request (claim 1 filed with the submission of 15 March 2020) reads as follows:

"1. A new method to non-invasively analyze unprepared internal tissues (especially non-ferromagnetic and un-polarized tissues), including the steps of:

- magnetizing the tissues to analyze (from 0.01 to tens of micro-Tesla) using a permanent magnet or coil,
- simultaneously and progressively providing a focused Ultrasound beam to each spatial location of the analyzed tissue (or tissue part) using an ultrasound emitter
- detecting the variation of the magnetic field induced by the ultrasound beam at each location of the focal point using a search coil or Anisotropic Magneto-Resistor (AMR)"

V. The claim request that was re-filed as an auxiliary request during the oral proceedings before the Board is the claim request that was originally filed. It contains the indication "Claims:", followed by three unnumbered paragraphs, which read as follows:

"A new method to analyze and visualize internal tissues by using refracted waves instead of echoed/reflected waves.

Refracted Ultrasound waves can be monitored using Magnetic sensors provided tissues to be analyzed are slightly magnetized using a permanent magnet or a coil with a ferrite kernel.

Compared to current technology it offers the following advantages:

- *One way Ultrasound waves providing an increased depth of tissue analysis*
- *Significant decrease of artifacts linked to Reflected waves is expected because only transmitted waves are monitored and direction of*

Ultrasound waves are better set as perpendicular to the tissues surface

- *Ultrasound waves will "follow" tissues with lower reflection coefficient like Blood in vessels providing a complementary analysis to present systems*
- *Less complex Ultrasound transducer circuitry can be envisaged"*

VI. The arguments put forward by the appellant in support of its main and auxiliary requests are dealt with in the section below.

Reasons for the Decision

1. Main request - added subject-matter

1.1 Claim 1 of the main request states, *inter alia*, that the claimed method is a method to non-invasively analyse "unprepared" internal tissues.

The appellant did not dispute that the application as originally filed did not address tissue preparation at all and, in particular, was completely silent on the option of specifically applying the method to "unprepared" tissues.

1.2 Instead, the appellant argued that whether the tissues were prepared or not was irrelevant to the method, which could be carried out equally well in either case. Moreover, the tissues on which the claimed method was performed were necessarily either prepared or unprepared. Therefore, the appellant asserted, the explicit mention of one of these implicit alternatives in claim 1 did not extend the scope of the method as originally claimed.

The Board disagrees.

In order to comply with Article 123(2) EPC, amendments to the original application documents, irrespective of their context, can only be made within the limits of what a person skilled in the art would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application documents as originally filed; this forms the "gold standard" for assessing any amendment for its compliance with Article 123(2) EPC (see G 2/10, point 4.3 of the Reasons).

Contrary to the appellant's view, the absence of information in the original disclosure as to which of several alternatives is envisaged cannot constitute a direct and unambiguous disclosure of one of these alternatives. Thus, the feature that the method of claim 1 is for analysing "unprepared" internal tissues presents the person skilled in the art with new information which was not originally disclosed.

- 1.3 The appellant also argued that the amendments made to the claims as originally filed were merely for clarification or to distinguish the invention from the prior art. However, this is irrelevant and does not overcome the above-mentioned requirements of assessment in accordance with the "gold standard".

In addition, the Board points out that there are specific conditions for the allowability of such negative features, so-called "disclaimers", under Article 123(2) EPC (see decisions cited in the Case Law of the Boards of Appeal, 10th edition, 2022,

II.E.1.7.2 a)). The appellant did not provide any reason demonstrating how these conditions were fulfilled in the present case for the feature "unprepared", nor can the Board find any such reason.

1.4 The same reasoning and conclusion applies to the further features of claim 1 that the claimed method can be performed to analyse "non-ferromagnetic" and "un-polarized" internal tissues, as set out in the Board's communication under Article 15(1) RPBA 2020 (see in particular points 4.1 and 5).

1.5 At least for these reasons, the subject-matter of claim 1 of the main request does not meet the requirement of Article 123(2) EPC, as the Examining Division held in the decision under appeal.

2. Auxiliary request - admittance

2.1 During the oral proceedings before the Board, after the main request was found to be unallowable, the appellant reintroduced the originally filed claim request as an auxiliary request for consideration by the Board.

The originally filed claim request had not been maintained in the course of the examination proceedings, but had been successively replaced by other claim requests and finally by the claims of the main request filed on 15 March 2020, on which the decision under appeal was based.

2.2 Reintroduction of the originally filed claim request as an auxiliary request at the oral proceedings before the Board constitutes an amendment of the appellant's appeal case, the admittance of which at this late stage

of the appeal proceedings is subject to Article 13(2) RPBA 2020.

According to this provision, any amendment to a party's appeal case made at this stage shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned. When exercising its discretion, the Board may also have regard to the criteria set out in Article 13(1) RPBA 2020, in particular whether the amendment is detrimental to procedural economy.

Furthermore, according to Article 12(6) RPBA 2020, the Board shall not admit requests which were no longer maintained in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

- 2.3 Contrary to the appellant's argument, the fact that the application was refused solely on the ground that it did not meet the requirement of Article 123(2) EPC, and the fact that the appellant's intention in amending the application was merely to clarify it and to distinguish it from the prior art, do not constitute exceptional circumstances justifying a return to the claim request as originally filed, especially since the latter was not maintained during the examination proceedings.

Moreover, reverting to the claim request as originally filed and remitting the case to the Examining Division for further prosecution would be tantamount to entirely restarting the examination proceedings, which would be detrimental to procedural economy.

The Board therefore decides not to admit the auxiliary request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Moser

M. Alvazzi Delfrate

Decision electronically authenticated