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**Datasheet for the decision
of 9 November 2021**

Case Number: T 0519/21 - 3.5.04

Application Number: 15196783.3

Publication Number: 3026639

IPC: G06T19/20, A61B5/00

Language of the proceedings: EN

Title of invention:

DIFFERENTIAL MAPPING OF A BODY ORGAN

Applicant:

Biosense Webster (Israel) Ltd.

Headword:

Relevant legal provisions:

EPC Art. 113(1)
EPC R. 111(2)
RPBA 2020 Art. 11

Keyword:

Appealed decision - sufficiently reasoned (no)
Right to be heard - opportunity to comment (no)
Remittal - fundamental deficiency in first-instance
proceedings (yes)

Decisions cited:

Catchword:



Beschwerdekkammern

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Chambres de recours

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Case Number: T 0519/21 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 9 November 2021

Appellant: Biosense Webster (Israel) Ltd.
(Applicant)
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2066717 Yokneam (IL)

Representative: Carpmaels & Ransford LLP
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 20 November 2020 refusing European patent application No. 15196783.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair: B. Willems
Members: A. Seeger
B. Müller

Summary of Facts and Submissions

- I. The appeal was brought against the examining division's decision to refuse European patent application No. 15 196 783.3, published as EP 3 026 639 A1.
- II. Proceedings before the department of first instance
 - (a) The examining division issued a summons to attend oral proceedings. In a communication annexed to the summons, objections under Article 54(1) and (2) EPC were raised against claims 1 to 8 and 10 to 15, and under Article 56 EPC against claim 9 of the then sole request.
 - (b) In response to the summons, the applicant submitted a set of claims according to a first auxiliary request.
 - (c) On 22 September 2020 the examining division issued a brief communication raising objections under Article 52(2) (d) and (3) EPC against claims 1 and 5 of the main request and first auxiliary request, under Article 54(1) and (2) EPC against claims 1 to 8 and 10 to 15 of the main request, and claims 1 to 8 and 10 to 14 of the first auxiliary request, and under Article 56 EPC against claim 9 of the main request and first auxiliary request (see decision under appeal, point 8).
 - (d) On 1 October 2020, oral proceedings were held by videoconference. During the oral proceedings, the applicant filed a set of claims entitled "NEW AUXILIARY REQUEST 1 - 1/10/20", which the examining division admitted into the proceedings. Further, the applicant filed a set of claims entitled "AUXILIARY REQUEST 2 - 1/10/20", which the examining division did not admit into the

proceedings. At the end of the oral proceedings, the examining division clarified the final requests. The examining division took the view that the "NEW AUXILIARY REQUEST 1 - 1/10/20" was filed to replace the first auxiliary request filed in response to the summons. This implied that the latter had been withdrawn. The applicant objected, stating that it had not withdrawn the first auxiliary request filed in response to the summons.

- (e) On 17 November 2020 minutes of the oral proceedings were issued.
- (f) By letter dated 1 December 2020 the applicant requested a correction of the minutes of the oral proceedings.
- (g) On 29 January 2021 corrected minutes of the oral proceedings were issued.

III. The applicant (appellant) filed notice of appeal. With the statement setting out the grounds of appeal, the appellant filed claims according to a main request and claims according to first to third auxiliary requests. According to the appellant, the main request was identical to the main request on which the decision under appeal was based, except for minor corrections in dependent claims 8 and 9. The appellant requested that the decision under appeal be set aside and that a European patent be granted on the basis of the claims of the main request, or, alternatively, on the basis of the claims of one of the first to third auxiliary requests. If the main request was not allowable, the appellant requested oral proceedings. Further, the appellant requested reimbursement of the appeal fee.

IV. In a communication dated 26 July 2021 the board informed the appellant of its preliminary opinion that the requirements of Article 113(1) and Rule 111(2) EPC

had been infringed during the first-instance proceedings. The board expressed its intention to remit the case to the department of first instance in accordance with Article 111(1) EPC and Article 11 RPBA 2020, and to order reimbursement of the appeal fee. The appellant was invited to comment on this preliminary opinion and to inform the board whether the auxiliary request for oral proceedings was maintained, since oral proceedings did not appear to be expedient.

v. By letter dated 13 September 2021, the appellant withdrew its request for oral proceedings before the board in the event that the board confirmed its preliminary opinion and remitted the application to the examining division and reimbursed the appeal fee.

Reasons for the Decision

1. The appeal is admissible.
2. Main request - objection under Article 52(2) (d) and (3) EPC
- 2.1 Rule 111(2) EPC provides that appealable decisions are to be reasoned. It is established case law that inadequate reasoning constitutes a substantial procedural violation (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019 ("Case Law"), V.A.9.5.9).
- 2.2 Point 1.1 of the impugned decision states: "Claims 1 and 5 relate to a method for mapping a body organ. This is presentation of information as such that falls under the exclusion from patentability (Article 52(2) (d) and (3) EPC)."

No further statements in respect of this objection are made.

2.3 The board finds that the objection raised in point 1.1 lacks reasoning. The first sentence therein paraphrases the first line of claims 1 and 5 (in the version filed by the appellant with the statement setting out the grounds of appeal). The second sentence therein ends by expressing the fact that presentation of information as such falls under the exclusion from patentability. The only part linking the claimed subject-matter and this exclusion is the statement "This is". However, simply stating that the claimed subject-matter is a presentation of information as such is a legal conclusion that is not supported by any reasoning.

2.4 The board notes that in exceptional situations the assessment of the claimed subject-matter may be so trivial that a conclusion on its own can be considered to suffice. This may be the case in particular if the conclusion is not contested.

However, claims 1 and 5 contain a step of "*displaying (106) the 3D map*". It is at least debatable whether this displaying step implies the presence of technical means, e.g. a display.

Further, according to the corrected minutes of the oral proceedings, the appellant provided arguments as to why the subject-matter of claims 1 and 5 fulfilled the requirements of Article 52(2) (d) and (3) EPC (see corrected minutes, page 1, fifth and sixth paragraphs).

Therefore, the board finds that the assessment in this case is not trivial and, in addition, it has been contested.

2.5 In view of the above, point 1.1 of the impugned decision is limited to a legal conclusion (see point 2.3 above) without in particular addressing the counter-arguments provided by the appellant during the oral proceedings. The decision is thus inadequately reasoned.

2.6 Therefore, the board concludes that point 1.1 of the impugned decision contravenes the requirements of Rule 111(2) EPC and hence constitutes a procedural violation.

3. Main request - objections under Article 54(1) and (2) EPC

3.1 Under Article 113(1) EPC, the 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.

3.2 In the communication annexed to the summons, the examining division objected that the subject-matter of claim 1 lacked novelty over the disclosure of document D2.

In this objection, the examining division referred to paragraph [0063] of document D2 as disclosing the following feature of claim 1: "*receiving from a user, a selection of a type of rendering for a 3D map of a body organ*".

3.3 In the brief communication dated 22 September 2020, the examining division objected again that the subject-matter of claim 1 lacked novelty over the disclosure of document D2.

This time, the examining division referred to paragraphs [0069] and [0070] of document D2 as disclosing the feature of claim 1 quoted in point 3.2 above.

3.4 In point 1.2 of the impugned decision, the examining division objected once more that the subject-matter of claim 1 lacked novelty over the disclosure of document D2.

The examining division referred therein to paragraphs [0069], [0070] and [0073] of document D2 as disclosing the feature of claim 1 quoted in point 3.2 above.

3.5 Hence, the objection of lack of novelty as raised in the impugned decision referred to passages of document D2 which were clearly different to the passages referred to in the corresponding objection raised in the communication annexed to the summons.

3.6 Therefore, the board finds that the objection of lack of novelty raised against claim 1 in the impugned decision was a new objection of which the applicant, in essence, became aware no earlier than in the brief communication dated 22 September 2020.

3.7 The board concurs with the appellant that, realistically, the first opportunity that a comment could have been made in relation to this new objection was during the oral proceedings on 1 October 2020 (see

statement setting out the grounds of appeal, page 6, last paragraph).

3.8 However, according to the corrected minutes of the oral proceedings, no objection of lack of novelty of the main request was raised during the oral proceedings (see corrected minutes of oral proceedings, page 6, section "MAIN REQUEST"). Rather, those minutes state:

The proceedings resume at 10h35 and the chairman informs the applicant's representative that the examining division has reached the conclusion that independent claims 1 and 5 of the main request do not fulfil the requirements of Article 52 (2) (d) and (3) EPC.

The minutes then recount a discussion on certain auxiliary requests and the issue of which requests were the pending requests. Finally, the minutes state, under the heading "DECISION":

The chairman pronounce [sic] the decision taken by the examining division: The Application is refused under Article 97(2) EPC since the subject-matter of claims 1 and 5 of the **main request** (filed on 30-09-2019) **falls under the exclusions from patentability according to Article 52(2) and (3) EPC**, and **none of the main request** and auxiliary request 1 (filed on 01-10-20, 10h49) **meets the requirements of Article 52(1) EPC**. . . .

3.9 According to the corrected minutes, the main request was thus initially declared to have been refused on the basis of Article 52 (2) (d) and (3) EPC only. The debate then immediately moved on to "AUXILIARY REQUEST 1 (27 August 2020)", and the main request was not discussed again. It was only at the end of the oral proceedings that the Chair announced that the main request was also refused on the basis of Article 52(1) EPC, without even making it clear in connection with which further provision of the EPC, i.e. whether an objection of lack of novelty under Article 54 EPC - possibly the one raised in the above-

mentioned brief communication - was maintained. At this time it would in any case have been too late for the appellant to provide comments on novelty.

As a consequence, the board finds that the appellant was not given an opportunity to comment on the new objection of lack of novelty raised against claim 1 of the main request in point 1.2 in the decision under appeal. While the objection, in essence, had previously been raised in the brief communication of 22 September 2020, the minutes give no indication that the appellant was alerted in the oral proceedings to the fact that the examining division maintained that objection.

3.10 Therefore, the board concludes that point 1.2 of the impugned decision infringes Article 113(1) EPC.

3.11 In summary, the decision under appeal contains two objections against claim 1 of the main request.

The first objection, based on Article 52(2) (d) and (3) EPC, contravenes the requirements of Rule 111(2) EPC (see point 2.6 above).

The second objection, based on Article 54(1) and (2) EPC, contravenes the requirements of Article 113(1) EPC (see point 3.10 above).

In the impugned decision no other objections were raised against claim 1 of the main request.

3.12 Hence, the main request was found to be not allowable based only on objections which involved procedural violations.

4. Remittal of the case to the department of first instance
 - 4.1 Under Article 11 RPBA 2020 a "*Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.*"
 - 4.2 The board finds that the procedural violations set out in points 2.6 and 3.10 above, which taint the assessment of the main request by the examining division in full (see point 3.12 above), are fundamental deficiencies in the proceedings before the examining division. Therefore, special reasons present themselves for remitting the case to the department of first instance for further prosecution.
 - 4.3 Further, the main request was found to be not allowable without sufficient reasoning and without giving the applicant the opportunity to present comments which could then have been considered in the decision. Hence, the board is not in a position to provide a meaningful review of the examining division's decision.
 - 4.4 Therefore, the board remits the case to the department of first instance for further prosecution in accordance with Article 111(1) EPC and Article 11 RPBA 2020.
5. Reimbursement of the appeal fee
 - 5.1 In order to render the reimbursement of the appeal fee equitable, a causal link must exist between the alleged procedural violation and the decision of the department

of first instance that necessitated the filing of an appeal (see Case Law, V.A.9.7.1). This link exists, given that the main request was found to be not allowable based only on objections which involved procedural violations (see point 3.12 above).

5.2 Thus, the board finds that reimbursement of the appeal fee is equitable.

6. Further requests

Since the board has decided to remit the case to the department of first instance and to reimburse the appeal fee on the basis of the procedural violations concerning the main request that constitute fundamental deficiencies in the proceedings, it is immaterial whether further procedural violations occurred concerning the lower-ranking requests.

7. The appellant stated that it withdrew its request for oral proceedings before the board in the event that the board confirmed its preliminary opinion and remitted the application to the examining division and reimbursed the appeal fee.

The board is therefore in a position to issue a decision without holding oral proceedings in the appeal proceedings.

8. Conclusion

As a result of the infringement of Article 113(1) and Rule 111(2) EPC, the board remits the case to the department of first instance in accordance with Article 111(1) EPC and Article 11 RPBA 2020, and orders the reimbursement of the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

K. Boelicke

The Chair:

B. Willems



Decision electronically authenticated