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**Datasheet for the decision
of 1 August 2023**

Case Number: T 1564/21 - 3.5.05

Application Number: 18193599.0

Publication Number: 3506298

IPC: G16H40/63, G16H40/67,
G16H40/20, G16H50/70, G16H40/40

Language of the proceedings: EN

Title of invention:

SURGICAL HUB COORDINATION OF CONTROL AND COMMUNICATION OF
OPERATING ROOM DEVICES

Applicant:

Ethicon LLC

Headword:

Substantial procedural violation

Relevant legal provisions:

EPC R. 111(2), 103(1) (a)
RPBA 2020 Art. 11

Keyword:

Appealed decision - sufficiently reasoned (no) - substantial procedural violation (yes)

Remittal - fundamental deficiency in first-instance proceedings (yes)

Reimbursement of appeal fee - equitable by reason of a substantial procedural violation



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Case Number: T 1564/21 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 1 August 2023

Appellant: Ethicon LLC
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Representative: Carpmaels & Ransford LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 9 April 2021
refusing European patent application No.
18193599.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair N. H. Uhlmann
Members: E. Konak
K. Kerber-Zubrzycka

Summary of Facts and Submissions

I. The appeal is against the examining division's decision to refuse the application. The contested decision is a decision according to the state of the file, which states that the applicant had been informed of the reasons why the application did not meet the requirements of the EPC in the communication dated 10 December 2020. The communication in question is the annex to the summons to oral proceedings, in which the examining division raised objections under Articles 84 and 56 EPC and Rule 43 EPC against the main request and auxiliary requests 1 to 3.

II. With the statement setting out the grounds of appeal, the appellant re-filed the main request and auxiliary requests 1 to 3 on which the contested decision is based, and filed new auxiliary requests 4 to 11. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of one of these requests. As an auxiliary measure, it requested oral proceedings.

III. The board summoned the appellant to oral proceedings.

In its preliminary opinion pursuant to Article 15(1) RPBA, the board informed the appellant that it was minded to remit the case to the examining division, since fundamental deficiencies in the examination proceedings were apparent to the board (Article 11 RPBA).

In reply, the appellant withdrew its request for oral proceedings in favour of the case being remitted to the examining division and the appeal fee being reimbursed.

The scheduled oral proceedings were thus cancelled.

- IV. The wording of the claims of the requests is not relevant to this decision.

Reasons for the Decision

1. Rule 111(2) EPC requires that decisions which are open to appeal be reasoned. According to the established case law of the Boards of Appeal, in order to meet the requirements of Rule 111(2) EPC a decision should contain arguments justifying its finding in a logical sequence. This is to enable the applicant, and in the event of an appeal the board of appeal, to examine whether the decision could be considered to be justified or not. As the appellant also submitted, the applicant and/or the board should not be forced to speculate as to the possible reasons for a negative decision.

2. In the case at hand, as the appellant rightly argued, the contested decision lacks a logical chain of reasoning, forcing both the appellant and the board to speculate as to the possible reasons for the refusal.

It appears that the main reasons for refusal are objections under Articles 84 and 56 EPC. Since the objections under Article 84 EPC are scattered throughout the decision, the reader must first try to reconstruct the complete list of objections under Article 84 EPC from disparate passages. Article 84 EPC requires that the claims be clear, concise and supported by the description. Having collected the list

of objections under Article 84 EPC from disparate passages, the reader must further speculate which requirement(s) of Article 84 EPC is/are not met. For example, the objection under point 5 states that "the description is silent about" a feature, then adds that a certain paragraph of the description "vaguely mentions" this feature but "without providing any further technical support of this functionality". The reader can speculate that the specific requirement of Article 84 EPC which is not met could be the support by the description, but since the examining division adds that the description mentions this feature, this appears not to be the case. The reader can speculate that the real objection instead concerns sufficiency of disclosure, but this would have been an objection under Article 83 EPC. Since there is no substantiation as to why the details in the description are not sufficient, this remains a speculation. Further objections under points 6.8, 6.8.1 and 7.2 follow a similar pattern.

The other main reason for refusal seems to be the objections under Article 56 EPC. Here, the examining division merely states that the formulated objective technical problem "cannot be solved by the claimed invention due to a total lack of required technical information" and that "the whole of claim 1 is built on a wish of a hypothetical device". The reader must again speculate whether the real objection is about sufficiency of disclosure, since this reasoning has nothing to do with inventive step. As to the alternative reasoning provided with reference to documents D2, D4 and D5, the cited passages, where they exist at all, have nothing to do with the problem of pairing devices in a surgical hub environment that the examining division had identified, and thus lack a logical chain of reasoning.

Such reasoning does not meet the requirements of Rule 111(2) EPC. Rule 111(2) EPC gives parties to EPO proceedings a fundamental procedural right to be provided with the reasons for a decision. A breach of Rule 111(2) EPC is a fundamental deficiency constituting special reasons for remittal within the meaning of Article 11 RPBA (see Case Law of the Boards of Appeal of the European Patent Office, 10th edition, July 2022, V.A.9.4.4 b)).

3. The appellant had submitted the following in its statement setting out the grounds of appeal: *"For the avoidance of doubt, we are not requesting remittal and we are not formally alleging that any substantial procedural violation has taken place. We are also not requesting a refund of the appeal fee. However, owing to the poor reasoning that has plagued examination proceedings on this application, we are requesting that the Board exercise its discretion to allow us to file further requests (in addition to or in replacement of the current claim requests) in the event that it raises new objections or presents a logical chain of reasoning that was lacking in the examining division's decision."*

However, as the board informed the appellant in its preliminary opinion pursuant to Article 15(1) RPBA, the deficiencies identified above amount to fundamental deficiencies, thus indeed to a substantial procedural violation. Furthermore, in view of the primary object of appeal proceedings, to review the decision under appeal in a judicial manner, a party's appeal case must be directed to requests on which the decision under appeal was based (Article 12(2) RPBA), which in the case at hand are the main request and auxiliary requests 1 to 3. An appellant is not at liberty to

bring about the shifting of its case to the appeal proceedings, by, among other things, filing further requests, even if the examination proceedings might have been frustrating. Conceding such freedom to an appellant would jeopardise the proper distribution of functions between the examining divisions and the boards of appeal and allow a kind of "forum shopping". In this regard, the board noted that the examining division's statement under point 1 of the communication dated 10 December 2020 (also cited by the appellant), which reads "For the shake [sic] of procedural efficiency and economic use of resources - also of the EPO - it is recommended to consider an appeal [emphasis by the board] based on a written decision.", was an unacceptable invitation for such forum shopping.

The appellant thereupon replied that it was in favour of the case being remitted to the examining division.

4. For these reasons, the case is to be remitted to the examining division for further prosecution. In view of the substantial procedural violation in the examination proceedings, reimbursement of the appeal fee in full is equitable (Rule 103(1)(a) EPC).

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.
3. The appeal fee is to be reimbursed in full.

The Registrar:

The Chair:



K. Götz-Wein

N. H. Uhlmann

Decision electronically authenticated