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**Datasheet for the decision
of 18 April 2024**

Case Number: T 1774/21 - 3.2.08

Application Number: 08798416.7

Publication Number: 2182898

IPC: A61F7/02, A61F7/10, A61F7/00,
A61H9/00, A61H23/02

Language of the proceedings: EN

Title of invention:
MONITORING THE COOLING OF SUBCUTANEOUS LIPID-RICH CELLS, SUCH
AS THE COOLING OF ADIPOSE TISSUE

Patent Proprietor:
Zeltiq Aesthetics, Inc.

Opponent:
Patentree, Lda

Relevant legal provisions:
RPBA 2020 Art. 13(2)
EPC Art. 123(2)

Keyword:

Amendment after communication - request for non-admittance of objection constitutes amendment to the party's appeal case - exceptional circumstances (no) - no obligation to assess and decide on admittance of objection ex officio
Amendments - allowable (no)

Decisions cited:

T 1006/21, T 0018/21, T 0755/16

Catchword:

Article 13(2) RPBA 2020 - request for non-admittance of objection - see Point 1.



Beschwerdekammern

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Case Number: T 1774/21 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 18 April 2024

Appellant: Patentree, Lda
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
23 July 2021 concerning maintenance of the
European Patent No. 2182898 in amended form.**

Composition of the Board:

Chairwoman P. Acton
Members: G. Buchmann
F. Bostedt

Summary of Facts and Submissions

- I. The opposition division decided that European patent No. EP 2 182 898 in amended form fulfilled the requirements of the EPC.
- II. The opponent filed an appeal against this decision.
- III. Oral proceedings took place before the Board on 18 April 2024.
- IV. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.
- V. The respondent (patent proprietor) requested as its main request that the appeal be dismissed, i.e. that the patent be maintained on the basis of the claims of former auxiliary request 8, which had been maintained by the opposition division or, in the alternative,

that the patent be maintained on the basis of the claims of one of five auxiliary requests:
 - auxiliary request 1 corresponding to former auxiliary request 9 filed with the reply to the statement of grounds of appeal,
 - auxiliary request 2 corresponding to former auxiliary request 12 filed with the reply to the statement of grounds of appeal,
 - auxiliary request 3 corresponding to former auxiliary request 13 filed with the reply to the statement of grounds of appeal,
 - auxiliary request 4 filed by letter dated 10 March 2024,

- auxiliary request 5 filed by letter dated
10 March 2024.

VI. Claim 1 of the **main request** reads as follows. The
amendments compared to claim 1 as filed are indicated.
The numbering of the features has been added by the
Board.

1

"A non-invasive treatment device (104) for
transdermally removing heat from subcutaneous lipid-
rich cells of a subject, comprising:

2

a treatment unit, configured to contact an area of skin
of a patient, that removes the heat from subcutaneous
lipid-rich cells located below the contacted area of
skin;

3

a detection unit, in communication with the treatment
unit, that measures a temperature of an interface
between the treatment unit and the area of skin;

4

and a control unit that ~~modifies operation of the
treatment unit upon determining at least a partial
freezing of the skin, wherein the control unit modifies
the operation of the treatment unit~~ determines a
freezing event of the skin based upon receiving an
indication from the detection unit of a positive change
an increase in temperature of the interface,

5

and is configured to differentiate between this
increase in temperature associated with a freezing
event of the skin and a temperature increase associated
with a movement event of the treatment device

6

wherein the control unit modifies the operation of the treatment unit upon receiving the indication from the detection unit of the increase in temperature of the interface associated with a freezing event of the skin to counteract or prevent freezing of the skin."

VII. Auxiliary request 1

Based on the main request, the term "treatment device" in Feature 5 has been amended to "treatment unit".

VIII. Auxiliary requests 2 and 3

These requests are identical to the main request and auxiliary request 1 respectively, apart from the fact that the words "or prevent freezing" have been deleted from Feature 6.

IX. Auxiliary requests 4 and 5

These requests are based on the main request or on auxiliary request 2 respectively, wherein Feature 5 has been deleted and Feature 6 has been amended to Feature 6' according to which

"the control unit modifies the operation of the treatment unit upon receiving the indication from the detection unit of the increase in temperature of the interface associated with a freezing event of the skin to counteract [or prevent freezing] of the skin, wherein the device is configured to differentiate between (i) an increase in temperature associated with a freezing event of the skin and (ii) a temperature increase associated with a movement event of the

treatment unit."

- X. The arguments of the appellant can be summarised as follows:

Request that the "new line of attack" under Article 123(2) EPC not be admitted

The "new line of attack" concerning Feature 5 was *prima facie* relevant and should be admitted into the proceedings. In addition, the respondent had responded in substance to this objection in its reply and only later filed the request that this objection not be admitted, namely after the Board's communication under Article 15(1) RPBA 2020.

Amendments - Article 123(2) EPC

Feature 5, according to which the control unit "is configured to differentiate between this increase in temperature associated with a freezing event of the skin and a temperature increase associated with a movement event of the treatment device," extended the subject-matter beyond the content of the application as originally filed.

There was no basis in the application for the fact that it was the control unit which differentiated between a temperature increase caused by freezing and a temperature increase caused by movement of the device.

Auxiliary requests 4 and 5 - Admittance

Auxiliary requests 4 and 5 ought not to be admitted according to Article 13(2) RPBA 2020. No exceptional circumstances were presented by the respondent which

would justify their being taken into account by the Board.

XI. The arguments of the respondent can be summarised as follows:

Request that the "new line of attack" under Article 123(2) EPC not be admitted

The "new line of attack" concerning Feature 5 had been raised for the first time in the statement setting out the grounds of appeal. It ought not to be admitted into the appeal proceedings. The request for non-admittance, filed by letter prior to the oral proceedings, was to be taken into account by the Board. Even if this request was not "admitted", the Board was under an obligation to assess and decide on the question of admittance of the new objection.

Amendments - Article 123(2) EPC

Feature 5 did not contravene Article 123(2) EPC because it could be directly and unambiguously derived from paragraphs [0032] and [0062] of the application as originally filed.

Auxiliary requests 4 and 5 - Admittance

The respondent argued that it was an exceptional circumstance that the Board had taken account of the new line of argumentation under Article 123(2) EPC (see above). The Board had done this in spite of the fact that the objection ought not to have been admitted into the appeal proceedings.

Reasons for the Decision

1. Request that the "new line of attack" under Article 123(2) EPC not be admitted
 - 1.1 Together with the statement setting out the grounds of appeal, the appellant raised an objection that Feature 5, according to which the control unit "is configured to differentiate between this increase in temperature associated with a freezing event of the skin and a temperature increase associated with a movement event of the treatment device", extended the subject-matter of the claim beyond the content of the application as originally filed.
 - 1.2 The respondent requested with its letter dated 10 March 2024 that this "new line of attack" under Article 123(2) EPC not be admitted into the proceedings, as it had been raised for the first time in the statement setting out the grounds of appeal (Article 12(2), (4), (6) RPBA 2020).
 - 1.3 Relevance of Article 13(2) RPBA 2020
 - 1.3.1 The respondent's request that the "new line of attack" not be admitted was not part of its initial appeal case, as this request was not filed with its reply to the statement setting out the grounds of appeal. The respondent had in fact replied to this "new line of attack" with counter arguments (see point 1.3 of the respondent's reply to the statement of grounds of appeal, page 5).

The request for non-admittance was filed only later, namely in response to the Board's communication in

preparation of the oral proceedings and therefore after the point in time specified in Article 13(2) RPBA 2020.

The question was whether admittance of this request fell within the scope of Article 13(2) RPBA 2020 and - if so - whether there were exceptional circumstances which would allow admittance of this request.

- 1.3.2 In the context of the RPBA 2020 the term "requests" includes requests for non-admission of, for example, an objection (contrary to what is suggested in T 1006/21, Reasons 25 to 27, where "procedural requests" such as requests for non-admission would appear to be excluded from the scope of "amendments" within the meaning of Articles 12 and 13 RPBA 2020). In particular, the term "requests" is not limited to texts of patent applications or patents. If this were the case, the text of the provisions (in particular, Article 12(2), (3) and (6) RPBA 2020) would have specified this and would not have used the general term "requests". Indeed, when the RPBA 2020 seeks to specifically address the issue of amended texts of patent applications or patents, it expressly refers to "an amendment to a patent application or patent" (see Article 12(4), fourth sentence, or Article 13(1), fourth sentence, RPBA 2020). This understanding is also confirmed in the Explanatory remarks to Article 12(2) RPBA 2020, which read: "The term 'requests' in this context is not limited to amended texts of patent applications or patents" (see Supplementary publication 2, OJ EPO 2020, 17).

Therefore, a request for non-admittance of an objection, as in the present case, constitutes an amendment to the party's appeal case if the request was not filed in the initial stage of the appeal

proceedings (i.e. with a party's statement setting out the grounds of appeal, or a reply thereto) but only during the subsequent stage of the appeal proceedings, and its admittance is therefore governed in the present case by Article 13(2) RPBA.

- 1.3.3 The present Board considers itself to be in line with the approach taken by decisions T 0018/21 and T 0755/16, both of which applied Article 13(2) RPBA 2020 to the circumstances of their cases.

In T 0018/21, the Board did not admit the opponent's request that the patent proprietor's main request not be admitted (see Reasons 2.).

In T 0755/16, the patent proprietor had first commented in substance on a document filed by the opponent and only later requested that this document not be admitted (similar to the circumstances of the present case), and the Board decided that this request by the patent proprietor was an amendment to its appeal case and did not admit it into the proceedings (Reasons 3.)

- 1.4 Exceptional circumstances

The respondent argued that the late-filed request for non-admittance of the "new line of attack" should be admitted into the proceedings due to exceptional circumstances. The appellant had namely failed to identify the "new line of attack" as an amendment in its statement setting out the grounds of appeal and to give reasons why it had not been raised before the opposition division, contrary to what was required by Article 12(4) RPBA 2020. Therefore, it had been difficult to recognise that there had been an amendment within the meaning of Article 12(4) RPBA 2020 at all.

The lateness of the respondent's request should be weighed against the appellant's failure to comply with the requirements of the RPBA.

The appellant countered that this objection was not "new" as it had been made during oral proceedings before the opposition division, and that the respondent's current representative could not know this because at the time the respondent had been represented by a different representative.

Even assuming in the respondent's favour that this objection was indeed raised for the first time in the appellant's statement setting out the grounds of appeal, the circumstances of the present case are not exceptional and cannot justify filing of the respondent's request for non-admittance only after the Board's communication. The mere fact that the appellant (allegedly) did not comply with the requirements of the RPBA (here Article 12(4), third sentence, RPBA 2020) is not a valid excuse for the respondent to request non-admission of the objection only after the Board's communication. It is for the party itself to assess whether there is - in its opinion - an amendment to the other party's case and, if this is the case, how to respond to it, for example whether to file a request for non-admission or - as was done in the present case by the respondent in its reply - to address the "new" objection on its merits. The alleged difficulty in recognising that there was an amendment is not sufficient reason to explain why the request for non-admittance had not been filed in the reply to the statement of grounds of appeal, or later in response to the appellant's letter of 15 September 2022 (in which the appellant reiterated the objection, see pages 2 to 4), but instead only after the Board's communication,

i.e. at the stage of Article 13(2) RPBA 2020.

1.5 Whether the Board is obliged, *ex officio*, to assess and decide on admittance of the "new line of attack"

1.5.1 During the oral proceedings before the Board, the respondent argued that, even if its request for non-admittance were rejected by the Board, the Board was under an obligation, *ex officio*, to assess and decide on admittance of the "new line of attack".

1.5.2 A board of appeal may examine of its own motion, and decide of its own motion, on the question of whether an objection was filed "late", for example filed for the first time in the appeal proceedings. This is so because the Board is not restricted to the facts, evidence and arguments provided by the parties and the relief sought (Article 114(1), second sentence, EPC).

Moreover, Article 114(2) EPC gives the Board the power to "disregard facts or evidence" (for example, facts submitted in relation to an objection) which are not submitted in due time. Indeed, Article 114(2) EPC states that the EPO, and therefore a board of appeal, "may" do so. This also means, however, that a Board is **not obliged** under this provision *ex officio* to examine whether a submission was made "in due time".

Such an obligation may also not be inferred from the principle of *ex officio* examination laid down in Article 114(1), first sentence, EPC. In general, the principle of *ex officio* examination is to be applied in opposition appeal proceedings in a more restrictive manner (cf. G 9/91, Reasons 18), which is due to the fact that such proceedings may be regarded as essentially party-driven. In addition, this principle

does not go so far as to require a Board to examine and to decide on the question of whether, for example, an objection was late filed. Such an understanding of Article 114(1), first sentence, EPC would be difficult to reconcile with the power given under Article 114(2) EPC, namely a power that may or may not be used.

1.5.3 Also in this context, the Board is aware of T 1006/21. The statement in Reasons 27 of this decision implies that the question of admittance must be taken up by a Board *ex officio*. For the reasons given above, the present Board disagrees with such an approach.

1.6 For the foregoing reasons, and in application of the power given to the Board under Article 13(2) RPBA 2020, the Board decided not to take the respondent's request into account.

The above-mentioned objection under Article 123(2) EPC against Feature 5 is examined in the present proceedings and is addressed below.

2. Amendments - Article 123(2) EPC

2.1 The appellant's objection was that Feature 5, according to which the control unit "is configured to differentiate between this increase in temperature associated with a freezing event of the skin and a temperature increase associated with a movement event of the treatment device" went beyond the application as originally filed.

In particular, there was no basis in the application for the fact that it was the control unit which differentiated between a temperature increase caused by freezing, and a temperature increase caused by movement

of the device.

2.2 According to the respondent's arguments, this feature was based essentially on paragraphs [0032] and [0062] of the description as originally filed.

2.3 Paragraph [0032] discloses that "[t]he system may be configured to differentiate between this increase in temperature [i.e. due to movement] and a temperature increase associated with a treatment event [i.e. freezing]" and that "the system may ... in the case of a temperature increase associated with freezing, take any number of actions based on that detection as described elsewhere herein."

The system (or device) consists of several units, and paragraph [0032] does not specify which one of these units performs the differentiation mentioned in Feature 5. Paragraph [0032] mentions neither a control unit nor a detection unit which would send an indication to the control unit.

Paragraph [0062] does not mention a "control unit" either. Instead, paragraph [0062] describes a "controlling device 240" which communicates with a "treatment device 104". These two devices form a treatment system as shown in Figure 2. In contrast, the claimed treatment device comprises three "units": a treatment unit, a detection unit and a control unit. Due to this inconsistency, it is not possible to directly and unambiguously derive that the controlling device 240 of paragraph [0062] corresponds to the control unit of the claim. Therefore, irrespective of the question of whether the "controlling device 240" performs any differentiation between different events, it is not possible to infer any function of the

"control unit" mentioned in the claim from the "controlling device 240".

2.4 The respondent further argued that the "controlling component 340", which forms part of the controlling device 240, should be regarded as the control unit mentioned in the claim. This controlling component 340 differentiated between the two types of temperature increase as required by Feature 5.

However, the second half of paragraph [0062] explains that it is the "monitoring component 330" that "may identify when a treatment event occurs or may estimate when one will occur using the system described herein. Upon receipt of such identification, the monitoring component 330 may alert the controlling component 340 which may perform an action to alter or pause the treatment." This means that it is not the controlling component 340 which takes the decision whether a "treatment event" has occurred, but the monitoring component 330. At the same time, it is also the monitoring component 330 which performs the temperature measurements which, according to the claim, are required to be associated with the detection unit.

Therefore, it cannot be derived from paragraph [0062] that the control unit of claim 1 differentiates between an increase in temperature associated with a freezing event of the skin and a temperature increase associated with a movement event of the treatment device, as required by Feature 5.

2.5 The respondent also referred to paragraph [0078]. This paragraph describes a method step in which the system determines a freezing event. This passage does not specify which one of the components of the system

performs this determination, and it cannot be derived that it is the control unit.

- 2.6 Finally, the respondent pointed out that claim 1 comprised a treatment unit, a detection unit and a control unit. It was thus self-evident that a function like the differentiation between different events was not performed by a measurement unit or a treatment unit. Therefore, it could only be performed by the control unit.

However, this is not "self-evident", in particular in light of the fact that it is not consistent with paragraph [0062], according to which the monitoring component is responsible for the decision about the occurrence of treatment events.

- 2.7 Therefore, Feature 5 extends the subject-matter beyond the content of the application as originally filed, and claim 1 of the main request thus contravenes Article 123(2) EPC.

- 2.8 Since Feature 5 is present in auxiliary requests 1-3, the above reasons apply also to these requests.

Therefore, claim 1 of auxiliary requests 1-3 contravenes Article 123(2) EPC.

3. Auxiliary requests 4 and 5 - Admittance

- 3.1 Auxiliary requests 4 and 5 were filed by letter dated 10 March 2024 and therefore their admittance is governed by Article 13(2) RPBA 2020.

- 3.2 The respondent argued that it was an exceptional circumstance that the Board had taken the new objection

under Article 123(2) EPC (see above) into account. The Board had done this in spite of the fact that the objection ought not to have been admitted into the appeal proceedings.

- 3.3 However, as already mentioned above, the respondent had addressed this objection in its reply to the statement setting out the grounds of appeal. Furthermore, it did this without mentioning that this objection ought not to be admitted into the proceedings.

Additionally, in its reply to the statement setting out the grounds of appeal, the respondent limited itself to arguments against said objection and refrained from filing any auxiliary request in this respect.

- 3.4 Therefore, neither the objection itself nor the fact that the Board also took this objection into account can come as a surprise to the respondent.

The fact that the Board took an objection into account, which the respondent had addressed in its reply by providing counter-arguments (without contesting its admittance), does not constitute an exceptional circumstance which would justify the admittance of auxiliary requests 4 and 5 under Article 13(2) RPBA 2020.

- 3.5 Therefore, auxiliary requests 4 and 5 were not admitted into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairwoman:



C. Moser

P. Acton

Decision electronically authenticated