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**Datasheet for the decision  
of 25 January 2024**

**Case Number:** T 0546/22 - 3.2.02

**Application Number:** 15709457.4

**Publication Number:** 3113703

**IPC:** A61B17/66, A61M5/142

**Language of the proceedings:** EN

**Title of invention:**  
IMPLANTABLE DEVICE

**Patent Proprietor:**  
MPS Micro Precision Systems AG

**Opponent:**  
maxon international ag

**Headword:**

**Relevant legal provisions:**  
EPC Art. 100(c), 111(1), 123(2)  
RPBA 2020 Art. 11

**Keyword:**  
Grounds for opposition - added subject-matter (no)  
Remittal - special reasons for remittal - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0546/22 - 3.2.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 25 January 2024**

**Appellant:** MPS Micro Precision Systems AG  
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**Representative:** Grünecker Patent- und Rechtsanwälte  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 20 January 2022  
revoking European patent No. 3113703 pursuant to  
Article 101(3) (b) EPC**

**Composition of the Board:**

**Chairman** M. Alvazzi Delfrate  
**Members:** D. Ceccarelli  
C. Schmidt

## **Summary of Facts and Submissions**

I. The patent proprietor appealed against the Opposition Division's decision to revoke the European patent for added subject-matter in all requests.

The patent was opposed on the grounds of added subject-matter, insufficient disclosure, lack of novelty and lack of inventive step.

II. Oral proceedings took place on 25 January 2024.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or on the basis of one of auxiliary requests 1 to 3, filed with the statement of grounds of appeal dated 24 May 2022. It further requested remittal of the case to the Opposition Division for consideration of novelty and inventive step if the Board concluded that the main request did not include added subject-matter.

The respondent requested that the appeal be dismissed. It further agreed with the appellant's request that the case should be remitted to the Opposition Division if novelty and inventive step had to be considered.

III. **Claim 1 of the main request** reads as follows:

"Implantable device (10,13,15) comprising a driving unit (25) and a kinematic assembly (27) joined together: the driving unit (25) comprising an electric motor (35) driving a first magnetic rotor (37); the kinematic assembly (27) comprising a second magnetic rotor (41), magnetically coupled to said first magnetic

rotor (37) such that it can be rotationally driven by the motor (35), and an actuator driven by the second rotor (41), wherein an hermetic capsule (20) encloses the driving unit (25), the electric motor, and the first rotor; and wherein the second magnetic rotor (41) is outside the hermetic capsule (20); the hermetic capsule (20) further including a control unit (33) arranged for driving the electric motor (35), and a remote control system based on wireless communication for remotely controlling the control unit (33)."

IV. The appellant's arguments relevant to this decision may be summarised as follows.

The feature in claim 1 of the main request of the hermetic capsule including a control unit arranged for driving the electric motor did not include added subject-matter for the reasons given in the impugned decision.

The feature in claim 1 of the main request of the hermetic capsule including a remote control system based on wireless communication for remotely controlling the control unit did not include added subject-matter either. Page 4, lines 20 and 21 of the application as filed disclosed a driving unit fully enclosed in a hermetic capsule. Page 7, line 10 disclosed that the driving unit comprised "a remotely-controllable command circuit". In the application as filed, the expression "remote control system" meant only the receiver of the control. The expressions "remote control system", "remotely-controllable command circuit", "command circuit" and "remote control" indicated a circuit or a system in the hermetic capsule (page 7, lines 10 to 32 of the

application as filed). It followed that they indicated only the receiver of the control. In other words, the expression "remote control system" indicated a system controllable from a remote location, not a system that controls from a remote location or a system comprising both a controlled portion and a controlling portion. The same interpretation had to be applied to the feature of the hermetic capsule including a remote control system in claim 1 of the main request. It would not make any technical sense to have a remote control system including a transmitting and a receiving part both within the hermetic capsule. The respondent's assertion that the passage on page 7, lines 10 to 30 of the application as filed mentioned remote control systems which would not work if the receiving part was fully included in the hermetic capsule was not correct. In any case, this assertion was of no relevance for the assessment of added subject-matter. It could at most relate to sufficiency of disclosure. However, sufficiency of disclosure had not been questioned by the respondent on appeal.

V. The respondent's arguments relevant to this decision may be summarised as follows.

The feature in claim 1 of the main request of the hermetic capsule including a control unit arranged for driving the electric motor was a non-allowable intermediate generalisation. The embodiment described on page 8, line 31 to page 9, line 4 from which the feature had been extracted comprised a number of further features functionally and structurally linked to the hermetic capsule including a control unit arranged for driving the electric motor which had not been included in the claim. The control unit had only been disclosed as an electronic control unit comprising

a motor drive subunit for driving the motor. Moreover, a rechargeable energy storage and a receiving antenna connected to the control electronic unit for wirelessly receiving energy necessary for the functioning of the implantable device and for picking up AC or RF signals generated by a transmitting antenna and an external module so that the signals are rectified by the control unit and stored in storage means had a functional and/or structural link to the claimed control unit.

The feature in claim 1 of the main request of the hermetic capsule including a remote control system based on wireless communication for remotely controlling the control unit had no basis in the application as filed. A remote control system had a clear and unambiguous meaning and comprised two parts: a transmitter and a receiver. This meaning was not put into question but even confirmed by the application as filed (page 7, lines 14 and 15). A control system with a transmitter and a receiver both located in the hermetic capsule could function if a further remote control was provided outside the capsule. A remote control system with a transmitter and a receiver both located in the hermetic capsule was not disclosed in the application as filed. The remote control (external control unit 90 in the application as filed) for the control unit was placed outside the hermetic capsule. A remote control system as claimed could not consist of an antenna alone because the antenna alone could not control the control unit. Page 7, lines 10 to 30 of the application as filed, referred to by the appellant, did not disclose the claimed feature. This passage mentioned a "remotely-controllable command circuit" comprised in the driving unit. However "remotely-controllable command circuit", "command circuit" and "remote control" mentioned in the passage did not mean

the same as "remote control system". The passage on page 7, lines 10 to 30 of the application as filed even mentioned remote control systems which would not work if the receiving part was fully included in the hermetic capsule. For example, the system employing two magnetic field sensors would require a certain distance between the two sensors and could not be implemented within the hermetic capsule. Similarly, a system involving a wireless data link, such as a near field communication system, would not work if the transmitter was outside the hermetic capsule because the distance from the receiver would be too large.

### **Reasons for the Decision**

1. The patent

The patent is for an implantable device. According to the description, this could be an orthopaedic distractor for the correction of the length of bones or skeletal elements by relative displacement of bone parts. An embodiment is depicted in Figure 1 of the patent, reproduced below.

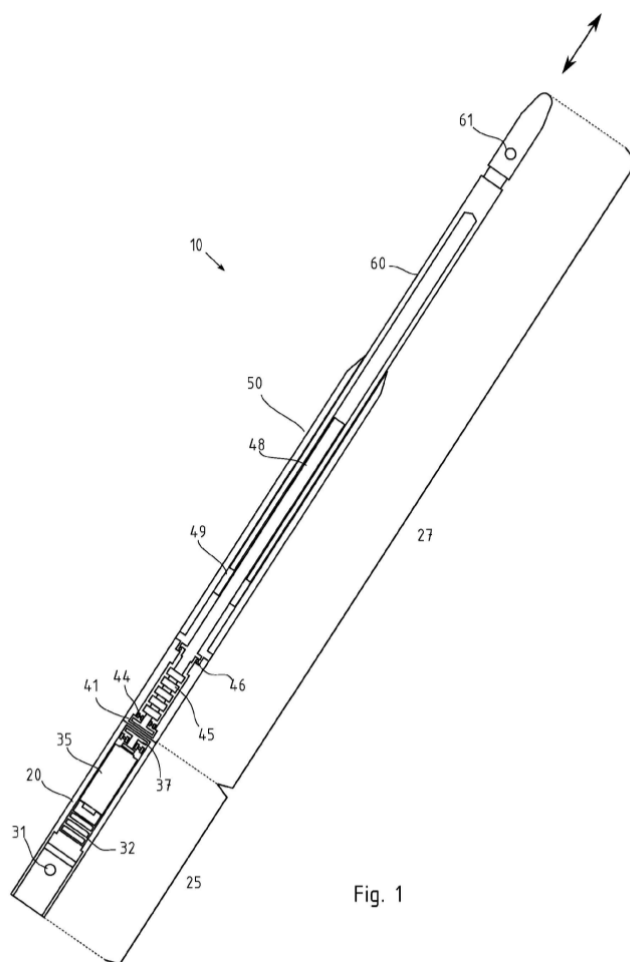


Fig. 1

The implantable device comprises a driving unit (25) and a kinematic assembly (27) joined together. The driving unit comprises an electric motor (35) driving a first magnetic rotor (37), and the kinematic assembly comprises a second magnetic rotor (41) magnetically coupled to the first magnetic rotor.

The implantable device further comprises an actuator driven by the second magnetic rotor. Due to the magnetic coupling between the first and the second magnetic rotors, the actuator can be rotationally driven by the electric motor.

The driving unit, the electric motor and the first

rotor are enclosed in a hermetic capsule (20), whereas the second magnetic rotor is outside the hermetic capsule.

The hermetic capsule further includes a control unit arranged for driving the electric motor and a remote control system based on wireless communication for remotely controlling the control unit.

The hermetic capsule prevents the ingress of body fluids into the driving unit, effectively preventing any contact between the component of the driving unit and body tissue. This should ensure the biocompatibility of the implant containing an electric motor and circuitry for its control (paragraphs [0004] and [0014] of the patent).

2. Main request - added subject-matter

2.1 The respondent argued that claim 1 of the main request comprised added subject-matter because the feature of the hermetic capsule including a control unit arranged for driving the electric motor was a non-allowable intermediate generalisation.

The Opposition Division concluded that this feature did not add subject-matter. The Board agrees with this conclusion.

As observed by the Opposition Division, the feature in question is based on claim 12 and page 8, line 31 to page 9, line 4 of the application as filed, and the expressions "control electronic unit 33" (page 8, line 32), "electronic circuit 33" (page 9, line 1) and "control unit (33)" (claim 12) are used interchangeably to denote the same features.

The respondent's argument that the embodiment described on page 8, line 31 to page 9, line 4 comprised a number of further features which had not been included in the claim is not convincing as claim 12 as filed defines the control unit without these other features. Although claim 12 does not define that the control unit is within the hermetic capsule, this is disclosed in the passage spanning pages 8 and 9 of the application as filed mentioned above. The additional features mentioned by the respondent do not become inextricably linked to the control unit only because this is defined to be within the capsule. As regards the argument that the claim should recite "electronic control unit" instead of "control unit", this is a mere matter of semantics. For the person skilled in the art, a control unit for driving an electric motor, in the context of the claim and the patent in general, must be "electronic".

- 2.2 The respondent argued that claim 1 of the main request comprised added subject-matter also because the feature "a remote control system based on wireless communication for remotely controlling the control unit" had no basis in the application as filed.

The Opposition Division was convinced by this objection. The Board is not.

The respondent argued that the application as filed did not disclose a remote control system comprising a transmitter and a receiver both located in the hermetic capsule. In the claim, however, the defined remote control system does not mean both a transmitter and a receiver. This was already pointed out by the Opposition Division in the impugned decision (page 6,

second paragraph). To have both a transmitter and a receiver for the remote control of the control unit in the hermetic capsule would make no technical sense. The control of the control unit has to take place remotely from the hermetic capsule. This would not be possible if the transmitter was inside the capsule. The respondent's argument that a further transmitter could be provided is not convincing. The first transmitter within the capsule would still make no technical sense. Hence, a claim interpretation according to which a remote control system with both a transmitter and a receiver had to be within the hermetic capsule is excluded by the person skilled in the art.

In context, what the claim defines is that the receiving part of the remote control is in the hermetic capsule. This receiving part is what the claim defines as the remote control system, i.e. a system controllable from a remote location as the appellant put it. The passage on page 7, lines 14 and 15 referred to by the respondent does not contradict this interpretation as it merely states that "several remote control systems can be accommodated in the frame of the invention". Whether in other contexts a remote control system may comprise a transmitter and a receiver is of no relevance for the current case.

A remote control system within the hermetic capsule within the meaning of claim 1 has a basis on page 7, lines 10 to 30. Leaving aside considerations of a semantic nature, this passage interchangeably uses the expressions "remotely-controllable command circuit" and "remote control system[s]" and generally discloses that the remote control system may be comprised by the driving unit. Since the driving unit is originally disclosed as being within the hermetic capsule (page 4,

lines 20 and 21, as pointed out by the appellant, or claim 1 originally as filed, for example), the feature does not include any added subject-matter.

The respondent's argument that the passage on page 7, lines 10 to 30 of the application as filed mentioned remote control systems which would not function if the receiving part was fully included in the hermetic capsule is of no relevance for the assessment of added subject-matter. This passage discloses remote control systems, such as systems employing radio transmission or ultrasound, which would clearly function. As the appellant observed, whether other remote control systems, disclosed as such, may or may not function may at most relate to sufficiency of disclosure but not to added subject-matter. However, no objection of lack of sufficiency against the feature in question was raised by the respondent on appeal.

- 2.3 In conclusion, the subject-matter of claim 1 of the main request does not include added subject-matter.

Hence, the ground for opposition under Article 100(c) EPC does not prejudice the maintenance of the patent according to the main request.

3. It follows that the decision under appeal, which was only based on objections of added subject-matter, is to be set aside.

The Opposition Division did not consider in its decision the objections on the other grounds for opposition raised by the respondent.

In view of the primary object of the appeal proceedings to review the decision under appeal in a judicial

manner (Article 12(2) RPBA 2020) and the requests of the parties, there are special reasons within the meaning of Article 11 RPBA 2020 which justify remittal of the case to the Opposition Division for further prosecution under Article 111(1) EPC.

## Order

### For these reasons it is decided that:

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

The Registrar:

The Chairman:



A. Chavinier-Tomsic

M. Alvazzi Delfrate

Decision electronically authenticated