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**Datasheet for the decision  
of 14 October 2024**

**Case Number:** T 2535/22 - 3.4.02

**Application Number:** 16753905.5

**Publication Number:** 3338077

**IPC:** G01N21/49, A61B5/08

**Language of the proceedings:** EN

**Title of invention:**

SYSTEM AND METHOD FOR LASER BASED INTERNAL ANALYSIS OF GASES  
IN A BODY OF A HUMAN

**Applicant:**

Neola Medical AB

**Headword:**

**Relevant legal provisions:**

EPC Art. 84, 113(1)

**Keyword:**

Right to be heard - violation (no)

Clarity - (yes)

Remittal to the department of first instance - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 2535/22 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 14 October 2024**

**Appellant:** Neola Medical AB  
(Applicant) Ideon Gateway, vån 9  
Scheelevägen 27  
223 63 Lund (SE)

**Representative:** KIPA AB  
Drottninggatan 11  
252 21 Helsingborg (SE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 3 June 2022  
refusing European patent application No.  
16753905.5 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chair** B. Müller  
**Members:** C. Kallinger  
H. Bronold

## **Summary of Facts and Submissions**

- I. The applicant lodged an appeal against the decision of the examining division refusing European patent application No. 16 753 905.
- II. The examining division did not admit the main request and auxiliary requests 1, 2 and 4 to 8 into the proceedings, held that the subject-matter of claim 1 of auxiliary request 3 was not originally disclosed (Article 123(2) EPC) and that claim 1 of auxiliary request 3a was not clear (Article 84 EPC).
- III. With their statement of grounds of appeal, the appellant requested to set aside the examining division's decision and to remit the case to the examining division for further examination.  
  
As auxiliary requests, the appellant further requested to set aside the examining division's decision and to grant a patent on the basis of the requests on which the decision was based or on the basis of the requests filed in response to the summons for oral proceedings before the examining division.
- IV. In a communication pursuant to Article 15(1) RPBA the board set out its preliminary view.
- V. In a letter dated 13 September 2024 the appellant requested to proceed based on auxiliary request 3a and withdrew all higher-ranking requests and the request for oral proceedings.

VI. The appellant's final requests therefore are to set aside the examining division's decision and to grant a patent on the basis of the claims filed as auxiliary request 3a during the oral proceedings on 16 March 2022.

As an auxiliary measure, the appellant requests to set aside the examining division's decision and to grant a patent on the basis of claims according to further, lower-ranking auxiliary requests.

VII. As the appellant withdrew its request for oral proceedings, the decision is issued in writing without holding oral proceedings.

### **Reasons for the Decision**

1. Right to be heard - Article 113(1) EPC

1.1 The appellant argued that they had been deprived of a fair hearing and their right to be heard had been violated.

New objections relating to a lack of clarity were raised by the examining division in a telephone conversation on 14 March 2022, i.e. only two days before the oral hearing, and that the majority of these objections could have been raised in the opinion accompanying the summons to oral proceedings. In this respect the appellant referred to a passage from the Guidelines for examination (section E-III 8.3.3.3) that stated:

In examination proceedings, the annex to the summons to oral proceedings must include all the objections that are likely to be discussed during oral proceedings and indicate that amended claims in response to the communication will have to be examined at the oral

proceedings for compliance with the EPC. This ensures that the applicant's right to be heard (Art. 113(1)) is respected and that the proceedings are not delayed unnecessarily if an applicant does not attend oral proceedings.

The appellant further argued that based on the understanding of these objections from the telephone call, new requests had to be hastily prepared and submitted on 15 March 2022.

They had been deprived of a fair hearing and their right to be heard had been violated, especially as the examining did not fully acknowledge that they raised these objections only two days before the hearing and still applied the clear allowability criterion for examining if the new requests were allowable.

This criterion was too strict considering the short time the applicant had to prepare the new requests in view of new objections raised in view of Article 84 EPC. Either the requests should have been "allowed in", or the requests should have been considered allowable if they overcame the objections raised by the examiner over telephone on 14 March 2022.

As a consequence, for this reason alone, the decision should be set aside and the case remitted back to the examining division for further examination.

1.2 The board is not convinced by the appellant's arguments, but holds that the examining division's decision complies with the right to be heard as embodied in Article 113(1) EPC.

Pursuant to Article 113(1) EPC,

The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

With respect to the examination proceedings, the board observes the following:

With a letter dated 20 October 2021 the examining division summoned to oral proceedings and informed the appellant about objections based on Articles 54 and 56 EPC with respect to the single set of claims filed in electronic form on 3 March 2021.

Between this summons to oral proceedings and the oral proceedings before the examining division held on 16 March 2022, several e-mails were exchanged and two consultations by telephone took place on 14 March 2022 and 15 March 2022 between the appellant and the first examiner (see the results of consultation by telephone and respective annexes sent 23 March 2022, 30 March 2022, 31 March 2022 and 1 April 2022).

In the period between the summons to oral proceedings and the oral proceedings, the appellant filed the following amended claims:

- On 16 February 2022 (i.e. the final date for making written submissions or amendments): Main request and auxiliary requests 1 to 3.

- On 15 March 2022 (i.e. the day before the oral proceedings): Main request and auxiliary requests 1 to 8 replacing the previous requests on file.

During the oral proceedings before the examining division on 16 March 2022 all requests filed on 15 March 2022, i.e. on the day before the oral proceedings, were discussed with respect to their admittance and, for those admitted, with respect to their allowability under Articles 123(2) and 84 EPC (see minutes of oral proceedings).

The decision under appeal is therefore based on objections discussed during the oral proceedings, i.e. on grounds on which the appellant had an opportunity to present their comments.

With respect to the question whether the appellant had been given enough time to prepare new requests, the board notes the following.

When an applicant submits amended claims in response to the summons to oral proceedings, they have to be aware that their admittance and, if admitted, their allowability will be discussed during the oral proceedings. The applicant can then react to new objections, e.g. by filing further amended claims during the oral proceedings. If the applicant is of the opinion that they do not have enough time for an adequate response during the oral proceedings, it is their duty to either request more time or a postponement of the oral proceedings.

The board notes that in the present case the appellant filed a further amended set of claims according to auxiliary request 3a one day before the oral

proceedings, which was admitted and discussed in substance by the examining division.

The minutes of the oral proceedings do not indicate that the appellant asked for more time or requested postponement of the oral proceedings.

The board is therefore of the opinion that the appellant has not established that it had not been given enough time to react to all objections on which the appealed decision is based.

As a further consequence, the board does not concur with the appellant that either the requests should have been "allowed in" or have been considered allowable if they overcame the objections raised by the examiner over telephone on 14 March 2022. No matter whether "allowed in" relates to the main request and auxiliary requests 1, 2 and 4 to 8 that were not admitted to the proceedings or/and auxiliary requests 3 and 3a that were admitted but not allowed, as stated, it would have been for the appellant to request more time for defending its case if it had so wished.

In conclusion, the board is of the opinion that the examining division did not violate the appellant's right to be heard as embodied in Article 113(1) EPC.

2. Auxiliary request 3a

Claim 1 of auxiliary request 3a reads as follows (in the claim, the feature discussed with respect to lack of clarity has been highlighted by the board) :

*"A system for measuring free gas in a lung of a subject based on absorption spectroscopy, comprising:*

*an introducing member comprising a distal end and the introducing member is a nasogastric feeding tube adapted to be inserted into an oesophagus of the subject;*

*a light source for emitting light with a wavelength associated with an absorption band of the free gas;*

*an optical fibre comprises a distal end and a proximal end, the optical fibre is embedded into a wall of the introducing member and is connectable at the proximal end to the light source and the distal end is a light emitting end; the optical fibre is arranged in the introducing member so that the light emitting end is arranged proximally and at a distance from the distal end of the introducing member, so that **when in use, the distance positions the light emitting end of the fiber close to the lung for delivering the light to the lung** while the distal end of the introducing member is positioned in the stomach;*

*a detector unit adapted to be positioned on a skin surface for detecting light, at a surface of the chest, which has been transmitted from the light emitting end through the lung of the subject;*

*a control unit for evaluating the detected transmitted light for determining the free gas or a concentration of the free gas in the lung of the subject."*

2.1 Clarity - Article 84 EPC

- 2.1.1 The examining division held that independent claim 1 was not clear.

The clarity objection was against the feature that *"when in use, the distance positions the light emitting end of the fiber close to the lung for delivering the light to the lung"*. In this context, the expression *"close to the lung"* had a broad meaning encompassing positions anywhere between the nose of the patient and its stomach. Therefore, the skilled person was not taught where to arrange the light emitting end of the optical fiber in the feeding tube so that free gas could actually be measured.

Also, the feature *"for delivering the light to the lung"* did not provide a clear instruction for the skilled person where to place the light emitting end in the feeding tube as it did not allow to deduce structural limitations of the position of the light emitting end. From a manufacturer's point of view, it was therefore not possible to deduct the scope of protection of the claim.

- 2.1.2 The appellant argued that the feature *"close to the lung for delivering the light to the lung while the distal end of the introducing member is positioned in the stomach"* was clear.

- 2.1.3 The board finds the examining division's line of argument not convincing and agrees with the appellant for the following reasons.

The feature objected to defines that the light emitting end of the fiber has to be *"close to the lung for*

*delivering the light to the lung*". The skilled person readily understands that this defines a position within a distance from the lung such that light can be delivered to the lung. It is therefore clear for the skilled person which positions are encompassed in claim 1 and that e.g. positioning a fiber end at the nose of a patient would not fall within the scope of *"close to the lung for delivering the light to the lung"*.

Moreover, the board notes that claim 1 according to auxiliary request 3a further defines that a detector unit for detecting light at a surface of the chest is provided *"which has been transmitted from the light emitting end through the lung of the subject"* which at least when read together with the feature objected to provides a clear definition of where the light emitting end has to be positioned.

Regarding the objection of a *"result to be achieved"* the board notes the following: As acknowledged by the examining division, a device that works for one patient may not work for another patient. As indicated by the applicant, patients may be of different sizes such that e.g. a newborn infant requires a different arrangement of the light emitting end in the feeding tube than an adult. The board therefore agrees that the position of the light emitting end of the optical fiber cannot be defined by concrete structural limitations without unduly restricting the scope of the claim.

In addition, the functional statement *"close to the lung for delivering the light to the lung"* does not claim the underlying technical problem but is a functional definition which provides the skilled person with sufficiently clear instructions to put it to practice without undue burden.

In conclusion, the board is not convinced by the examining division's finding that the feature that the light emitting end of the fiber, *"when in use"*, is positioned *"close to the lung for delivering the light to the lung"* is unclear.

## 2.2 Remittal - Article 111(1) EPC

Pursuant to Article 111(1) EPC, *"Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution."*

Under Article 11 RPBA, a case is not to be remitted to the department whose decision was appealed unless special reasons present themselves for doing so. This provision should be read in conjunction with Article 12(2) RPBA which states that the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner.

In the summons to oral proceedings before the examining division, the examining division raised objections with respect to Articles 54 and 56 EPC. During these oral proceedings, the applicant filed amended claims according to auxiliary request 3a. With respect to this request, the appealed decision exclusively dealt with the above discussed objection under Article 84 EPC against claim 1.

As set out above, the board does not agree with the examining division's finding in this respect.

However, neither other potential clarity objections against claim 1 or the dependent claims nor novelty and inventive step of the claimed subject-matter have been assessed yet.

Not remitting the case to the examining division would require the board to perform these tasks in both first- and last-instance proceedings and to effectively replace the examining division rather than review the contested decision in a judicial manner as prescribed by Article 12(2) RPBA. It follows that special reasons within the meaning of Article 11 RPBA present themselves.

Therefore, the board, exercising its discretion under Article 111(1), second sentence, EPC in conjunction with Article 11 RPBA, remits the case to the examining division for further prosecution on the basis of auxiliary request 3a.

3. Further auxiliary requests

As the board considers the decision regarding auxiliary request 3a to not be well-founded, there is no need to deal with the further lower-ranking auxiliary requests.

## 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 on the basis of the claims according to auxiliary request 3a as filed during the oral proceedings before the examining division on 16 March 2022.

The Registrar:

The Chair:



L. Gabor

B. Müller

Decision electronically authenticated