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D E C I S I O N
of 17 December 2002

Case Number: T 0589/00 - 3.4.2

Application Number: 94304948.6

Publication Number: 0636915

IPC: G02B 23/24, G02B 26/08, A61B 1/00

Language of the proceedings: EN

Title of invention:
A borescope

Patentee:
KEYMED (MEDICAL & INDUSTRIAL EQUIPMENT) LIMITED

Opponent:
EFER

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56, 114(2)

Keyword:
"Novelty, inventive step (confirmed)"
"Late-filed evidence (not admitted)"

Decisions cited:
-

Catchword:
-



Case Number: T 0589/00 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 17 December 2002

Appellant: EFER
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 April 2000
rejecting the opposition filed against European
patent No. 0 636 915 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: E. Turrini
Members: A. G. Klein
B. J. Schachenmann

Summary of Facts of Submissions

I. European number 0 636 915 (application No. 94 304 948.6) was granted with a set of claims of which claim 1, the only independent claim, reads as follows:

"1. Apparatus (1) for use as a borescope comprising a tube (2) having a distal end (3) which is insertable in use into an inaccessible location and a proximal end (4) connected to a housing (5), a viewing port (6) adjacent the distal end and an associated reflector (7) through which an object at the inaccessible location may be laterally viewed in use, an image relaying means (9) operable to relay an image of the object to a viewing means (10) provided in the housing, a scanning means (25) operable to rotate the reflector relative to the housing about a rotation axis (27) extending longitudinally of the tube, focusing means (26,28,31) operable to adjust the position of the viewing means relative to the housing in the direction along an optical axis (27) defined by the viewing means and an image inverter (24) operable to correct image inversion created by the reflector, wherein the inverter is rotatably mounted in the housing for rotation about the optical axis, the scanning means is further operable to provide the rotation of the inverter synchronously with the rotation of the reflector, and wherein the viewing means comprises an ocular lens (11) received in an ocular mount (12) with respect to which the inverter is fixedly connected at a location proximal to the ocular lens."

II. The patent was opposed on the grounds under Article 100(a) EPC that its subject-matter was not novel in view of the testing of a so-called "Thoraco Polypin" system by a medical doctor, Dr Dumon, in a hospital, before the filing date of the patent and that it did not involve an inventive step in view *inter alia* of the contents of the following documents:

D1: "Technoscopes", data sheet for a Richard Wolf technoscope, marked "III-89";

D3: EP-A-0 374 031; and

D4: US-A-3 005 452.

III. The opposition was rejected by the opposition division.

IV. The appellant (opponent) filed an appeal against the decision rejecting its opposition.

With its statement of grounds of appeal of 2 August 2000 and its letter of 14 May 2001, the appellant submitted a number of new pieces of evidence namely:

- a third declaration by Dr Dumon dated 31 August 2000;
- a letter from the Richard Wolf company dated 31 July 2000;
- a declaration by Mr Lounkevitch dated 7 April 2001; and
- five patent documents.

- V. Oral proceedings were held on 17 December 2002 at which the appellant requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained unamended (main request) or that the patent be maintained in amended form according to one of the auxiliary requests 1 to 6 filed with the letter dated 18 November 2002.

The Board announced its decision at the end of the oral proceedings.

- VI. The arguments put forward by the appellant in support of its requests can be summarised as follows.

The new pieces of evidence filed with the statement of grounds of appeal and the following letter of 14 May 2001 should be admitted into the proceedings. They are highly relevant, they have been filed as soon as practicable in the circumstances, and their late-filing neither constituted any procedural abuse nor resulted in any delay in the appeal proceedings. The new documents in particular have not been filed to support any new ground for opposition and the appellant does not rely on any new facts either. The documents have been introduced merely to dissipate the doubts raised in the decision under appeal against the public character of the prior disclosure of the invention by the appellant and against the state of the art at the filing date of the patent.

The subject-matter of claim 1 of the patent in suit lacks novelty in view of the non-confidential disclosure of the appellant's Thoraco Polypin system to Dr Dumon for testing in a hospital. The various

declarations by Dr Dumon, Mr Cosatti and Mr Lounkevitch clearly and consistently establish the lack of confidentiality of this disclosure, and the fact that the construction details of the tested endoscope were perfectly understood by the persons involved. In particular, against a common prejudice amongst patent specialists that manufacturing companies are well aware of the necessity of keeping prototype constructions confidential before applying for a patent, such patent-awareness was certainly not shared by the appellant's company at the time when the disclosure to Dr Dumon occurred. In addition to the explanations given freely to Dr Dumon, the endoscope remained at the hospital for a period of about one week during which technical assistants such as those responsible for the cleaning and sterilization of endoscopic apparatuses had ample opportunity to examine and dismantle the Thoraco Polypin device. The mere availability of this device to these third persons also amounts to an anticipating disclosure.

Concerning inventive step, document D1 discloses a borescope having a distal end with a reflector which is rotatable relatively to the instrument's housing. In order to avoid transmission of an inverted image to the viewing means at the proximal end of the housing, an inverter must be provided in the housing as is known for instance from documents D3 and D4. Such inverter must be rotatable in synchronism with the reflector, and claim 1 of the patent in suit in this respect defines no more than an obvious design choice of a mechanical arrangement achieving the required synchronized rotation of the inverter and reflector.

VII. The respondent for its part contested the admissibility of the evidence filed by the appellant with its statement of grounds of appeal and its letter of 14 May

2001, submitting in particular that the new declarations by Dr Dumon and Mr Lounkevitch already constituted the appellant's third attempt to substantiate unconvincing allegations telling continuously changing and mutually contradicting stories, which amounted to unacceptable abuse of the proceedings.

Concerning the alleged disclosure to Dr Dumon of a device in accordance with claim 1 of the patent in suit, the declarations considered in the opposition procedure clearly established a relationship based on mutual trust between Dr Dumon and the appellant's company, which inherently excluded any non-authorized transmission of information to the public. In addition, the Thoraco Polypin device was merely lent for a limited period of time to Dr Dumon and then returned to the appellant's company, which thus always kept full control over it. Concerning the extent to which the claimed features could have been disclosed to Dr Dumon, there was no conclusive evidence in the file that Dr Dumon's knowledge of the Thoraco Polypin construction - beyond the functionalities immediately apparent to him when using the endoscope - also extended to the details of its internal structure.

In respect of the issue of inventive step, the respondent denied that the instrument of document D1 necessarily included an inverter and that the teaching of documents D3 or D4 in any way hinted at the claimed arrangement.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility into the proceedings of the late-filed evidence*

With its statement of grounds of appeal of 2 August 2000 and its letter of 14 May 2001, the appellant for the first time submitted a number of new pieces of evidence, namely:

- a third declaration by Dr Dumon dated 31 August 2000;
- a letter from the Richard Wolf company dated 31 July 2000 referring to an unidentified "technoscope having the reference 6.08030.093";
- a declaration by Mr Lounkevitch dated 7 April 2001; and
- five patent documents.

The Board, having thoroughly scrutinized the above late-filed pieces of evidence, reached the conclusion that, for the following reasons, none of them was of such relevance to the issues to be decided and of such conclusiveness that it could decisively influence the decision to be made.

Concerning first the new declaration by Dr Dumon, the statement of the grounds of appeal indicates that it was first drafted in English, and then translated into French and signed. The representative of the appellant at the oral proceedings could not tell the Board who was the author of the document, because he had taken the file over from a former representative who had retired since. According to the respondent, this former representative had indicated during the oral proceedings held before the opposition division that he

had drafted the second declaration by Dr Dumon dated 13 January 2000. The Board therefore is not convinced that the late-filed third declaration actually reflects Dr Dumon's spontaneous recollection of what happened in December 1992.

In addition, on the essential issue of how Dr Dumon gained knowledge of the details of the internal optical and mechanical construction set out in claim 1 of the patent in suit, the declaration fails to offer any definite statement, but comprises instead mere speculations of what Dr Dumon in August 2000 thinks must have happened 8 years ago: "I will certainly have been interested in seeing how a particular product is constructed and it is unconceivable but that it will either have been taken to pieces either by me or Mr Cosatti during our discussion", "if a company had not wanted to show me the interior of a product then, frankly, I probably would have lost interest in collaborating with them", "it would have been inconceivable but that we would have taken the item to pieces and had a play with it and its pieces just to see how it worked", "at my visits, I am absolutely certain that we would have looked at drawings of the proposed product and at the sample at various stages in its production", "it is inconceivable but that I would have been shown the interior of the product as well as the exterior and would have wanted to dismantle it, reassemble it and generally handle it with a view to seeing how it might function in practice" (see the English version of the declaration filed with the statement of grounds of appeal).

As concerns the letter from the Richard Wolf company, the appellant at the oral proceedings explicitly indicated that he would no longer rely upon it.

The declaration by Mr Lounkevitch who allegedly attended the presentation of the Thoraco Polypin endoscope by Mr Cosatti to Dr Dumon, casts further doubts on the reliability of Dr Dumon's recollection. Dr Dumon had indeed never mentioned the presence at the presentation of any witnesses other than members of his medical team. Moreover, although Mr Lounkevitch describes the details of the internal structure of the endoscope as explained by Mr Cosatti during the presentation, he had at that time apparently no particular reason to suspect that these details could be of any importance. The fact that he nevertheless perfectly recalls these details after more than 9 years therefore seems quite surprising, and it cannot be excluded that the declaration mixes up actual recollection and additional information gained from a recent meeting at which Dr Dumon informed Mr Lounkevitch of the present patent litigation (see Mr Lounkevitch's letter dated 7 April 2001 to Mr Rovegno, the President of the appellant's company, the first and the second paragraphs).

Finally, none of the five additional citations filed with the appellant's statement of grounds relates to a borescope of the type concerned in the present case, namely with a distal reflector capable of rotating relatively to the housing of the instrument about a rotation axis extending longitudinally of the tube.

Since for the above reasons the late-filed pieces of evidence in the Board's view could not decisively influence the decision to be made, their admission into the appeal procedure, which might cause substantial delay as a result of the case being remitted to the first instance to allow proper assessment by two instances, would not be justified in the circumstances.

Accordingly, these new pieces of evidence shall be disregarded as provided for in Article 114(2) EPC.

3. *Novelty*

- 3.1 The appellant's objection of lack of novelty is based primarily on the alleged disclosure of a Thoraco Polypin endoscope comprising all the features of claim 1 of the respondent's main request to Dr Dumon at the Sainte Marguerite Hospital in Marseille in December 1992 by Mr Cosatti, then Director of production of the company Rosebud of which the appellant is a daughter company.

The respondent did not contest that a Thoraco Polypin prototype comprising the features of claim 1 was actually presented to Dr Dumon and lent to him for a week for test purposes, but it denies that these facts amounted to a public, non-confidential disclosure of the device and that the structural details set out in claim 1 have actually been made available to Dr Dumon.

Independently of the question whether the Thoraco Polypin device was presented and lent to Dr Dumon on a confidential or a non-confidential basis, the Board could not find in the documents submitted by the appellant any convincing evidence that the internal design features set out in claim 1, in particular the receiving of the ocular lens in an ocular mount with respect to which a rotatably mounted inverter is fixedly connected at a location proximal to the ocular lens were actually disclosed to Dr Dumon.

In particular, the first declaration by Dr Dumon dated 10 December 1998 on this point only states that Mr Cosatti presented the apparatus and explained in details its optical design and its mode of operation

(see point 8 of the declaration), without any specific indication whatsoever of which details had been explained to him. In his second declaration dated 13 January 2000, Dr Dumon states which features of the endoscope were either apparent to him or had been explained by Mr Cosatti, in the form of a list which almost word for word reproduces the wording of claim 1 of the patent as granted. This in the Board's view is a strong indication that the list of features allegedly disclosed to Dr Dumon is not an objective picture of his recollection of what he had understood from the presentation made to him in December 1992, but was strongly influenced by the knowledge of the patent filed later by the respondent. The respondent in this respect submitted that the appellant's former representative had admitted during the oral proceedings held before the opposition division that he had himself drafted the declaration, which in consideration of the formulation of the declaration seems highly probable.

Also the first declaration by Mr Cosatti dated 10 December 1998 in respect of the details presented to Dr Dumon only indicates that the Thoraco Polypin prototype was presented with a view to explaining its design and mode of operation (see point 11 of the declaration), which is confirmed again in his second declaration of 13 January 2000.

The Board notes that there is no suggestion in any of the pieces of evidence in the file that construction drawings of the Thoraco Polypin endoscope were shown to Dr Dumon, or that the endoscope was dismantled in his presence to show its internal arrangement. The respondent in this respect also convincingly submitted at the oral proceedings that it is quite unlikely that the endoscope could have been dismantled for examination purposes because such procedure would

certainly have jeopardised the proper alignment of its optical components, its internal cleanness and its fluid-tightness.

The fact that Dr Dumon did not himself dismantle the endoscope is further confirmed by his handwritten letter dated 17 December 1992 to the appellant's company as attached to Mr Cosatti's first declaration, in which he summarises his observations during the test of the Thoraco Polypin prototype. Amongst the negative points, he describes a severe lack of fluid-tightness. The presence of fluid internally of the endoscope was not identified by disassembling the device, but as indicated explicitly in the letter became apparent merely from a blurring of the image after the third cleaning of the endoscope in a cleaning solution (see page 2 of the letter, second paragraph).

For the above reasons, the appellant failed to provide conclusive evidence that the features of claim 1 in accordance with the respondent's main request have actually been disclosed to Dr Dumon in December 1992.

- 3.2 During the oral proceedings held before the Board, the appellant for the first time suggested that the inner construction of the endoscope might also have been rendered available to the public by the mere fact that the endoscope remained for one week at the Sainte Marguerite Hospital in Marseille in December 1992 where it was accessible e.g. to the technicians responsible for its sterilization between operations. The appellant did not provide any evidence supporting this submission or establishing the conditions under which the prototype endoscope lent to Dr Dumon was actually stored at the hospital. The availability of this endoscope to the public during the period at which it

was kept at the Sainte Marguerite Hospital as alleged by the appellant cannot in these circumstances but be regarded as mere speculation.

- 3.3 The appellant in the opposition proceedings and in the written appeal proceedings also invoked the disclosure of a so-called "Richard Wolf" endoscope against the novelty of the subject-matter of claim 1 of the respondent's main request, but it explicitly renounced to pursuing this line of argumentation at the oral proceedings of 17 December 2002.

In view of the comparative description of the mechanism of the Richard Wolf endoscope and of the endoscope of the patent in suit given in the introductory portion of document GB-A-2 342 462, a patent filed in the name *inter alia* of the President of the appellant's company as referred to in the communication of the Board annexed to the summons to attend oral proceedings, the Board is satisfied that the former endoscope did not anticipate the latter.

4. *Inventive step*

The appellant submitted that the skilled person would in an obvious way have derived the apparatus of claim 1 of the respondent's main request from the device disclosed in document D1, in view in particular of the disclosure in documents D3 and D4.

Document D1, however, discloses a borescope - which incidentally appears to correspond to the "Richard Wolf" endoscope referred to above - comprising a tube having a distal end with a viewing port and an associated reflector and a proximal end connected to a housing. The housing, as shown at the right side of the only figure, comprises a connecting piece for a glass

fibre light guide at the end of the housing adjacent the proximal end of the tube, an ocular with a connecting cone for accessories at its opposite end and a setting knob for focusing means in between. The connecting piece for the light guide can be either fixed or rotatable (see the penultimate paragraph).

The Board cannot concur with the appellant's view that the reflector of this known device can rotate relatively to the housing. Quite on the contrary, it is precisely because the reflector and the tube are rigidly connected to the housing and can thus only be rotated together with the latter, that it might be desirable to use a rotatable piece for the connection of the light guide, in order to avoid winding of the glass fibres about the housing when rotating the reflector.

Document D1 does not disclose whether the housing comprises an inverter, but if this was the case, there is no obvious reason why it should be rotatably mounted in the housing within the meaning of claim 1, in the absence of any corresponding rotatability of the reflector relative to this housing.

Document D3 discloses an endoscope having an inverter rotatably mounted in the housing (see Figure 4) and, in the variant shown in Figures 6 and 7, a reflector mounted at the distal end of the tube and capable also of being rotated together with this tube, relatively to the housing. There is however no scanning means or other mechanical link operable to provide synchronous rotation of the inverter and reflector within the meaning of claim 1.

Finally, document D4 discloses a nasolaryngoscope comprising both a reflector and an inverter, none of which however is rotatable relatively to the housing.

Since none of documents D1, D3 and D4 discloses or suggests any means for synchronously rotating a reflector and an inverter relatively to the housing of an apparatus of the type of an endoscope or borescope, no combination of these documents can lead to the claimed subject-matter.

The other documents in the file, no longer relied upon by the appellant, do not come closer to the claimed subject-matter.

For these reasons, the subject-matter of claim 1 in accordance with the respondent's main request involves an inventive step within the meaning of Article 56 EPC.

5. The grounds for opposition invoked by the appellant do not therefore prejudice the maintenance of the patent unamended and, accordingly, the opposition was rightly rejected by the opposition division (Article 102(2) EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

E. Turrini