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D E C I S I O N
of 29 September 2005

Case Number: T 0988/03 - 3.4.01

Application Number: 98304722.6

Publication Number: 0885629

IPC: A61N 5/06

Language of the proceedings: EN

Title of invention:

Light pulse generating apparatus and cosmetic and therapeutic phototreatment

Applicant:

Danish Dermatologic Development A/S

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 111(1)

Keyword:

"Amendments - added subject-matter (no) "

"Decision re appeals - remittal (yes) "

Decisions cited:

-

Catchword:

-



Case Number: T 0988/03 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 29 September 2005

Appellant: Danish Dermatologic Development A/S
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DK-2970 Horsholm (DK)

Representative: Smart, Peter John
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 May 2003
refusing European application No. 98304722.6
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: B. Schachenmann
Members: G. Assi
R. Bekkering

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal, received on 9 July 2003, against the decision of the examining division, dispatched on 26 May 2003, refusing European patent application No. 98304722.6 (publication number 0 885 629). The fee for the appeal was paid on 9 July 2003. The statement setting out the grounds of appeal was filed on 29 August 2003.
- II. In the contested decision, the examining division held that, with regard to claim 1 of the main request and the auxiliary request then on file, the requirements of Article 123(2) EPC were not met.
- III. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of a main request and auxiliary requests I and II, respectively. The claims, description pages and drawings according to the main request correspond to those of the main request rejected by the examining division in the decision under appeal. The claims of the auxiliary requests I and II were filed with the grounds of appeal.

In the alternative, the appellant requested that the application be remitted to the examining division for further examination.

Moreover, the appellant requested that oral proceedings be appointed *"before any rejection of the current appeal in relation to the main request takes place"*.

IV. The wording of claim 1 of the main request reads as follows:

"Apparatus for producing pulses of light for use in cosmetic or therapeutic phototreatment of the human or animal body comprising a housing (20), a gas filled arc lamp light source (13) operable to produce pulses of light having a pulse duration of from 10 to 70 msec to provide a light flux of at least 250 J/cm²/sec, a light output path defined by said housing, a filter (24) in said light output path for filtering undesired light output frequencies from said light to produce a filtered light for transmission to said body, a light guide (27) in the form of a transparent block extending from said housing to abut an area of the skin of a human or animal in use, wherein said filter comprises water for filtering out undesired skin heating wavelengths from said light and further comprises a short wavelength cut off filter (25) removing wavelengths below 510 nm."

Reasons for the Decision

1. The appeal is admissible.
2. *Decision under appeal*

In the decision under appeal, the only objection, on the basis of which the application was refused, consisted in that claim 1 of the main request and the auxiliary request then on file were amended in such a way that they contained subject-matter extending beyond the content of the application as filed (Article 123(2))

EPC). The issue concerned was the omission of the feature concerning a convex curved distal end of the claimed light guide. In particular, the examining division took the view that, in the application as filed, "*The description is surprisingly consistent with respect to the light guide and no passage concerning the light guide as such can be found which does not mention its convex curved distal end*" (decision under appeal, page 3, point 2.1, second paragraph).

3. *Article 123(2) EPC*

3.1 Main request

3.1.1 The examining division's decision is not based on a proper interpretation of the whole disclosure of the application as filed.

3.1.2 The application as filed discloses various aspects of the invention. A "*second aspect*" concerns the light guide, in particular its distal end that may be shaped in a convex or a concave manner (page 4, line 16 to page 5, line 9). The convex and the concave shapes are variants, i.e. alternatives, the convex shape being advantageous in a depilation treatment (page 3, line 25 to page 4, line 4; page 4, lines 16-24; page 23, lines 11-27), the concave shape being preferred for the treatment of vascular lesions (page 4, line 31 to page 5, line 9; page 23, lines 29-34). Moreover, the convex curved distal end is presented as being advantageous over a flat distal end (page 3, lines 21-24).

3.1.3 An embodiment of the invention is shown in Figures 2 and 3 illustrating transverse and longitudinal cross-sections, respectively, along orthogonal planes, of a photo-treatment apparatus. As the examining division correctly underlined, these Figures 2 and 3 "*are primarily related to the construction of the entire light source*". The Figures show, *inter alia*, the provision of a light guide 27 according to the second aspect of the invention (page 4, lines 16-24), a chamber 24 filled with water according to the first aspect (page 2, line 19 to page 3, line 6), a lamp 13 which represents a feature common to any of the various aspects (page 10, lines 17-20), and a non-interference filter 25 according to a further aspect (page 13, line 31 to page 14, line 3).

The embodiment of Figures 2 and 3 should be understood in the context of the whole disclosure. An essential point in this respect thus consists in that the various aspects of the invention may be used "*separately or in any combination*" (page 2, lines 15-17). Moreover, as the appellant submitted, according to the description (page 23, lines 11 and 12) the apparatus "*may*" include a light guide with a curved distal end according to Figure 10. The skilled person would understand this disclosure as an indication that the feature concerning the curved distal end is facultative. Indeed, the light guides represented on Figures 10 and 11 are both suitable for use in the apparatus of Figures 2 and 3, depending on the desired application, i.e. depilation or vascular treatment.

Anyhow, even if Figures 2 and 3 were taken in isolation and interpreted as transverse and longitudinal cross sections through a photo-treatment apparatus according to the invention (page 16, line 29 to page 17, line 2), the examining division's understanding that these Figures "*do not exclude a convex curved end of the light guide*" is not convincing. Indeed, a skilled person would come to the conclusion that in these figures the distal end of the light guide can only be flat. A convex curved shape is clearly excluded.

3.1.4 In reaction to an objection of lack of unity raised by the search division, the appellant paid an additional search fee for original claims 10, 11 and 27 concerning an apparatus with a light guide having a convex curved distal end. In the decision under appeal (page 3, point 2.1, third paragraph), the examining division argued that "*the applicant himself never contemplated any other light guide than one which has a convex curved distal end, as is apparent from his request for an additional search*". This argument is irrelevant for the question of admissibility of the omission of the feature at issue. Indeed, admissibility has to be verified on the basis of the content of the application as filed and not the party's intentions.

3.1.5 In conclusion, the amendments in the main request are in conformity with the requirements of Article 123(2) EPC.

3.2 Auxiliary requests I and II

An examination of the auxiliary requests is not necessary in view of the conclusion reached with regard to the main request.

4. *Further prosecution*

Even if, during the examination procedure, the issue of inventive step was addressed by the examining division in the communication of 3 July 2002, the decision under appeal was only based on the ground that the provisions of Article 123(2) EPC were not met with regard to claim 1 of the requests then on file.

For these reasons, the Board grants the appellant's request that the case be remitted to the examining division for further prosecution (Article 111(1) EPC, second phrase, second alternative). The appellant thus has the opportunity to present its case before two instances. Under these circumstances, there is no need for holding the oral proceedings conditionally requested by the appellant.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the main request.

The Registrar:

The Chairman:

R. Schumacher

B. Schachenmann