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D E C I S I O N
of 17 March 2006

Case Number: T 0625/04 - 3.2.02

Application Number: 96929687.0

Publication Number: 0851743

IPC: A61B 17/39

Language of the proceedings: EN

Title of invention:

Apparatus for ablation of a selected mass

Applicant:

Rita Medical Systems, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 113(1)

Keyword:

"Substantial procedural violation (yes)"

"Reimbursement of the appeal fee (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0625/04 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 17 March 2006

Appellant:

Rita Medical Systems, Inc.
967 North Shoreline Boulevard
Mountain View
CA 94043 (US)

Representative:

Meldrum, David James
D Young & Co
120 Holborn
London EC1N 2DY (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 11 February 2003
refusing European application No. 96929687.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: S. Chowdhury
U. Tronser

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division dated 11 December 2003 to refuse European patent application No. 96929687.0.

The application was refused on the grounds that the claim 1 did not meet the inventive step requirement of Article 52(1) EPC.

- II. On 10 February 2004 the appellant (applicant) lodged an appeal against the decision and paid the prescribed fee on the same day. On 13 April 2004 a statement of grounds of appeal was filed.

The primary request of the Appellant (Applicant) is that the Decision be set aside on the grounds of a substantial procedural violation and that the application be remitted to the Examining Division for further consideration, and the reimbursement of the appeal fee.

Reasons for the Decision

1. The appeal is admissible.
2. Substantial procedural violation
 - 2.1 In communications pursuant to Article 96(2) EPC dated 7 October 2002 and Rule 71a dated 16 June 2003, the examining division raised different objections to the application, including an objection under Article 52(1) EPC. It cited documents D1 (EP-A-0 502 268), D2 (DE-A-

38 38 840), and D3 (US-A-4 565 200) in support of its arguments that the subject-matter of claim 1 did not involve an inventive step.

The applicant replied to each of these communications, and in response to the attack under Article 52(1) EPC it argued that, whereas the application related to apparatus for ablating tissue with RF antennas, the cited documents related to different medical fields and should not be invoked to attack under Article 52(1) EPC claims relating to ablation apparatus.

In particular, the applicant argued, D1 related to an electrosurgical device for cutting tissue and cauterising/coagulating the resulting wound area, D2 related to a high frequency coagulating device, and D3 related to a device for making heat lesions. A person skilled in the art when attempting to create an improved tissue ablation apparatus would not combine the teachings of these documents and arrive at the claimed invention.

In response to the specific argument that ablation, on the one hand, and tissue cauterising/coagulating and making heat lesions, on the other hand, are different technologies involving different mechanisms for treating tissue, and cannot be readily mixed, the examining division made no written response.

The minutes of the oral proceedings also do not record that this point was addressed by the examining division, even though it was pressed by the applicant, at the oral proceedings, and the applicant even presented documentary evidence (Academic Press Dictionary of

Science and Technology, page 452, Chambers Dictionary of Science and Technology (Chambers 1999), and Mirian Webster Dictionary Online) in support of its argument. The only doubt that the examining division expressed at the oral proceedings in this respect was regarding which feature of the claimed apparatus rendered it an ablation apparatus, which doubt the application dispelled by referring to the first line of claim 1, which recites "An ablation apparatus".

2.2 In examining the question of inventive step it is a fundamental principle applied in the EPO that a reason should be given why the person skilled in the art would combine the teachings of two or more documents in order to arrive at the subject-matter of a claim. In the case of the so-called "Problem and Solution Approach" used at the EPO the objective technical problem and its solution, for example, could incite the skilled person to combine documents.

It was the applicant's argument that this principle was not observed by the examining division in the present case because the skilled person would not combine documents relating to different technologies than the present application, but this argument went unanswered during the examination procedure.

It was only in the decision to refuse the application that the examining division addressed this question for the first time, citing a document (Dorland's Illustrated Medical Dictionary), also for the first time, in support of its contention that "coagulation is considered to fall under the terms of ablation in the sense of destructive heat treatment".

2.3 It is clear, therefore, that the decision of the examining division was based on grounds and evidence on which the applicant did not have an opportunity to present its comments, in breach of Article 113(1) EPC. This is a substantial procedural violation.

The appellant's primary request is, therefore, allowed.

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 the first instance for further prosecution.
3. A reimbursement of the appeal fee is ordered.

The Registrar

The Chairman:

V. Commare

T. K. H. Kriner