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**Datasheet for the decision  
of 12 June 2008**

**Case Number:** T 1389/05 - 3.2.02

**Application Number:** 96932596.8

**Publication Number:** 0957793

**IPC:** A61B 18/04

**Language of the proceedings:** EN

**Title of invention:**

Argon plasma flex-endoscopy coagulator

**Patentee:**

Erbe Elektromedizin GmbH

**Opponent:**

Dr. Jerome Canady

**Headword:**

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**Relevant legal provisions:**

EPC Art. 56, 100(c), 108, 123(2)  
EPC R. 103(1)a)

**Relevant legal provisions (EPC 1973):**

EPC R. 55, 99

**Keyword:**

"Admissibility of the opposition (yes)"  
"Inventive step (yes)"  
"Reimbursement of appeal fee (refused)"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 1389/05 - 3.2.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.02  
of 12 June 2008

**Appellant:** Erbe Elektromedizin GmbH  
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**Respondent:** Dr. Jerome Canady  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 7 September 2005  
revoking European patent No. 0957793 pursuant  
to Article 102(1) EPC 1973.

**Composition of the Board:**

**Chairman:** T. Kriner  
**Members:** M. Noel  
M. J. Vogel

## Summary of Facts and Submissions

I. European patent No. 0957793 was revoked by decision of the opposition division dated 7 September 2005 on the basis of Article 123(2) EPC, and of Article 56 EPC on the grounds that its subject-matter did not involve an inventive step vis a vis the closest prior art document

D1 DE-A-4 139 029, in combination with documents

D5 "Technology of Argon Plasma Coagulation with Particular Regard to Endoscopic Applications, by G. Farin et al, End. Surg. 2, 1994, P. 71 - 77, or

D4 US-A-5 330 469.

II. The appellant (patentee) lodged an appeal against this decision by notice received on 31 October 2005 and paid the appeal fee on the same day. A statement setting out the grounds of appeal was filed on 30 December 2005.

III. Oral proceedings were held on 12 June 2008. At the end of the oral proceedings the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside, that the patent be maintained on the basis of claim 1 filed as claim 1 of the first auxiliary request on 13 May 2008, claims 2 to 15, description and drawings as granted, and that the appeal fee be reimbursed.

The respondent (opponent) requested that the appeal be dismissed.

IV. Claim 1 at issue reads as follows:

"An electrosurgical unit for achieving coagulation of tissue which can be attached to or removed from a working channel (7) of an endoscope (1) having a proximal end and an opposing distal end, comprising an argon reservoir (31);

a flexible, hollow tube (2) having a longitudinal axis disposable in one of the working channels (7) of the endoscope (1), the tube (2) having a diameter which is less than the diameter of the working channel (7) through which it is inserted, the tube (2) including:

a distal end and an opposing proximal end, each end of the tube (2) having an opening (9), the tube having an inside and outside,

wherein the tube (2) can be positioned within the endoscope (1) such that a portion of the tube (2) including the opening (9) at distal end of the tube (2) protrudes beyond the opening at the distal end of the endoscope (1) and such that a gas stream exits from the opening (9) at the distal end of the tube (2) in order to establish an inert gas atmosphere between the distal end of the tube (2) and a region of the tissue (18) to be coagulated, and an electrode (8, 23) for ionizing the inert gas positioned inside the tube (2) and offset from the opening at the distal end of the tube (2) a predetermined minimum safety distance, such that the electrode (8, 23) cannot come in contact with the tissue (18);

**characterized in that**

means (35, 40) for adjusting a first flow rate for standby operation and for a second flow rate during subsequent activation are provided between the argon reservoir (31) and said tube (2)."

V. The parties presented the following arguments

(i) The appellant

The opposition was not admissible as being not sufficiently substantiated. In particular it was not sufficient to state that document D1 disclosed a device as defined in the preamble of claim 1 as granted, since this did not constitute an adequate reasoning within the meaning of Article 108 EPC. Also the ground for opposition under Article 100(c) EPC was not clearly identified as such in the pieces of documents filed for opposition, since there was only a reference to an extension of scope according to Article 123(2) EPC. Hence it was impossible to understand the reasoning of the opponent.

Starting from D1 which disclosed an electrosurgical device having the features placed in the preamble of claim 1, the problem to be solved was to avoid blood entering the tube during use of the device. This problem was solved by the characterizing features of claim 1. The reformulation of the objective problem by the opposition division, with the view to support a lack of inventive step, was based on hindsight and therefore not acceptable.

D5 disclosed a coagulation device which produced two different gas flow rates but was working in a way

different from that of the present patent. As it was mentioned in D5, foot switches were provided for activating the argon gas source and the HP-generator simultaneously, so that when the activation of the device was interrupted, both the ionisation and the gas flow were interrupted and blood was allowed to penetrate into the tube of the endoscope. The device of D5, thus, was unable to provide a suitable solution to the above problem and, as a consequence, the subject-matter of claim 1 was not derivable from a combination of the teachings of D1 and D5. The same applied to D4.

Reimbursement of the appeal fee was justified by reason of a substantial procedural violation. Firstly the contested decision was based on legal considerations which were clearly contrary to the established case law of the boards of appeal of the EPO. Secondly the opposition division did not concern itself with the salient features of the patent in suit and thus denied the appellant the opportunity of being heard, in particular on the significance of the standby operation mode as opposed to the subsequent activation mode as performed in the present patent.

(ii) The respondent

The opposition was admissible since the grounds of opposition raised under Articles 100(a) and 100(c) (Article 123(2)) EPC were sufficiently substantiated in the statement filed by the respondent on 30 December 2004, in compliance with Article 108 EPC together with Rule 99(2) EPC, so that the patent proprietor and the opposition division could easily understand the opponent's objections.

The solution as it results from the characterizing portion of claim 1 under dispute was restricted to merely provide two subsequent gas flow rates, each adapted to the current operating mode of the device. With respect to D1 which was regarded as the closest state of the art, the solution as broadly claimed was known *per se* from documents D4 or D5 and close at hand to a person skilled in the art.

In particular D5 disclosed an argon plasma coagulator for achieving coagulation of tissue, which was capable of producing two gas flow rates, i.e. an ionisable argon gas jet having low velocity and a higher gas flow rate for blowing fluids off the tissue surface, respectively, as recited on page 74 and illustrated in Fig. 6a of D5. Since the skilled person would immediately recognize that the provision of two gas flow rates was suitable to solve the problem underlying the patent in suit, the subject-matter of claim 1 was obvious in the light of a combination of D1 and D5.

## **Reasons for the decision**

1. The appeal is admissible.
  
2. *Admissibility of the opposition*

The opposition was filed by means of a completed EPO form 2300.1 and by paying the opposition fee within the nine months time-limit prescribed by Article 99(1) EPC. The notice of opposition therefore fulfilled the formal requirements imposed by Rule 55(a) and (b) EPC 1973.

Moreover said form was correctly marked off with the grounds of opposition according to Articles 100(a) and (c) EPC in connection with Articles 56 and 123(2) EPC, respectively, on which the opposition was based. Finally the form was accompanied by a statement (eight pages) setting out the reasons why, according to the respondent, the patent did not meet the requirements of the EPC as far as Articles 56 EPC and 123(2) EPC are concerned.

It is true that the statement of opposition is not correct in that on page 2 a reference to the "extension of scope" according to Article 123(2) EPC is made and that Article 100(c) EPC is not mentioned. However, the matter dealt with in the following paragraphs is clearly concerned with a possible extension of the patented subject-matter beyond the content of the application as filed. Hence it is immediately clear for a skilled reader that these paragraphs refer to the ground of opposition according to Article 100(c) in conjunction with Article 123(2) EPC.

Furthermore it is not understandable why the statement that D1 discloses all features of the preamble of claim 1 should not be sufficient to understand the opponent's argumentation with respect to inventive step, in particular since the patent in suit itself acknowledges this fact (see column 2, lines 9 and 10). Consequently the appellant's objections cannot jeopardize the admissibility of the opposition which is perfectly clear and intelligible in all other respects and therefore also meets the requirements of Rule 55(c) EPC 1973.



Lastly the board wants to emphasize that any subjective difficulties encountered for understanding the statement of grounds of opposition or the supporting reasons are of no relevance when assessing admissibility.

3. *Amendments*

With respect to the version as granted, claim 1 has been amended by introducing the expression "an argon reservoir (31)" after the word "comprising" in the preamble and by adding the words "between the argon reservoir (31) and said tube (2)" at the end of the characterizing portion.

All these features are supported by the application as originally filed, in particular by Fig. 1a and the text on page 13, lines 23 to 26. Therefore, the requirements of Article 123(2) EPC are met.

4. *Inventive step*

D1 represents the closest prior art document. As agreed by both parties it discloses an electrosurgical unit for achieving coagulation of tissue having all the features contained in the preamble of claim 1.

In the device according to D1, an argon gas stream exits from the opening of the tube which protrudes from the endoscope in order to establish an inert gas atmosphere between the distal end of the tube and a region of the tissue to be coagulated. However, no means are provided for adjusting the gas flow rate

according to the operating mode. For an endoscopic use of the device in which low gas flow rates are required (see patent column 7, line 57 to col. 8, line 2), blood may enter into the tube due to overpressure in the blood cavity or due to capillary forces (see patent specification, paragraphs [5], [6] and [36], lines 26 to 31).

With respect to this state of the art the problem underlying the present invention is to avoid blood entering the tube of the endoscope during use of the device, as stated in paragraph [7] of the present patent.

D5 relates to argon plasma coagulation in relation to endoscopic applications. With reference to Fig. 6a and the paragraph quoted on page 74 "Argon gas Source", the device disclosed in D5 comprises, in its simplest version, a gas cylinder and a valve for reducing the pressure to a value appropriate to the intended application. A relatively low gas flow rate is sufficient to produce an ionisable argon gas jet. This flow rate corresponds in the present device as claimed to the second flow rate which is produced during the activation operation.

Moreover, couple finger or foot switches are provided in D5 (see the bottom of page 73) for activating the argon gas source and the HF-generator, so that activating the HF generator also automatically activates the argon gas source. In other words, both sources are activated simultaneously, which means that the production of a stream of gas is necessarily associated with the production of HF current. As a

consequence, when the flow of gas is interrupted because e.g. coagulation has been achieved, blood may enter into the tube, which is just what the invention seeks to avoid.

Referring back to the cited passage on page 74 of D5, a second operating mode is mentioned, whereby a higher gas flow rate is produced for blowing fluids off the tissue surface in order to facilitate coagulation by means of a control valve. However it cannot be derived therefrom with certainty whether this blowing operation is performed separately (successively) or simultaneously with the ionisation phase, knowing that, as mentioned above, a gas stream is normally associated with a HF-current discharge. In the first alternative (separately) a standby operation could be identified also in D5 since, like the present patent (see paragraph [36], lines 31 to 35), standby and activation modes are clearly performed separately and exclude each other. However, even if a kind of standby could be identified in D5, it is not one of the type falling within the meaning of the present patent. The reasons are as follows:

In D5, fluids are blown off the tissue surface, which implies that a relatively high pressure gas be used. Contrary to that, in the present patent (see col. 7, l. 52 to 55 and col. 8, l. 6 to 9) the gas flow rate should not be increased to a value sufficient to clear natural fluids because of the danger of embolism if the supplied gas were to penetrate into the blood vessels. Since the claimed device is specifically designed to be used with an endoscope, i.e. using low pressure gas flow, the standby mode referred to in the present

patent requires that a stream of gas be produced at a pressure just sufficient to prevent body fluids from entering into the tube of the endoscope, in accordance with the problem set. As a consequence, the feature of claim 1 "for adjusting a first flow rate for standby operation", when correctly interpreted in the light of the description, is not disclosed nor suggested by the blowing operation mode referred to in D5.

D4 does not come closer than D5 and, therefore, this document does not need further consideration.

From the foregoing it results that the subject-matter of claim 1 involves an inventive step vis a vis the state of the art, in accordance with Article 56 EPC.

5. *Reimbursement of the appeal fee*

According to Rule 103(1)(a) EPC the appeal fee is to be reimbursed where the boards deem the appeal to be allowable and if such a reimbursement is equitable by reason of a substantial procedural violation. These two conditions have to be satisfied cumulatively for a reimbursement to be ordered.

In the Board's view, however, these two conditions are not met. In this respect, it still remains questionable whether, as submitted by the appellant, the reformulation of the technical problem underlying the present invention on behalf of the opposition division constitutes a procedural violation and whether reimbursement of the appeal fee has to be ordered also when the appeal is deemed to be allowable only partially.

It is the Board's opinion that in the present situation reimbursement of the appeal fee is not equitable. As a matter of fact the appellant strove to maintain the patent mainly as granted and auxiliarily in the last modified version. Only the fact, as submitted by the Board at the oral proceedings, that Article 123(2) EPC was raised in the first place by the opposition division against claim 1 as granted whereas the statement of grounds of appeal is silent about this issue, led the appellant to withdraw its main request and to pursue the proceedings on the basis of the first auxiliary request. The withdrawal of the main request, therefore, is in no way related to a procedural violation but rather to the ground of opposition pursuant to Article 100(c) EPC. On the basis of the above considerations the Board, therefore, does not see any reason to diverge from the established jurisprudence as far as equity is concerned and to order reimbursement of the appeal fee.

## 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 to maintain the patent on the basis of the following documents:
  - claim 1, filed as first auxiliary request on 13 May 2008
  - claims 2 to 15 as granted
  - description and drawings as granted.
3. The request for reimbursement of the appeal fee is rejected.

The registrar

The chairman

V. Commare

T. Kriner