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**Datasheet for the decision
of 21 September 2010**

Case Number: T 1435/06 - 3.2.02

Application Number: 00935390.5

Publication Number: 1182985

IPC: A61C 5/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for filling a dental root canal

Applicant:

Denfotex Ltd.

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 54(3)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty (no)"

Decisions cited:

T 0303/90, T 0637/92

Catchword:

-



Case Number: T 1435/06 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 21 September 2010

Appellant: Denfotex Ltd.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 February 2006
refusing European application No. 00935390.5
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: M. Noël
Members: C. Körber
M. J. Vogel

Summary of Facts and Submissions

- I. By its decision posted on 22 February 2006 the Examining Division refused European patent application No. 00935390.5 for lack of novelty.
- II. An appeal was lodged against this decision by the applicant by notice received on 20 April 2006 with the appeal fee being paid on the same day. The statement setting out the grounds of appeal was received on 29 June 2006.
- III. Oral proceedings were held on 21 September 2010, at the end of which the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 5 filed on 10 January 2006 and claims 6 to 16 filed with letter of 8 August 2005, i.e. the version refused by the Examining Division.
- IV. The following document, representing state of the art under Article 54(3) EPC, is considered in the present decision:

D1: WO-A-00/62701.

- V. Claim 1 of the main request reads:

"A dental root canal sterilising and sealing kit comprising:-

(a) a flowable photosensitiser which is absorbed by bacteria;

(b) an optical fibre (4,20) having a portion (5,21) at or close to the distal end which is shaped to spread radiation around and along a dental root canal (2) said

fibre being adapted for introduction into a root canal so that the tip is capable of reaching the apical third of the root canal, said optical fibre being connectable proximally with means (41) for generating laser light capable of being absorbed by the photosensitiser; and (c) obturating means for sealing the canal (2)."

Claims 2 to 16 are dependent claims.

VI. The appellant's arguments may be summarised as follows:

The term "dental root canal sterilising and sealing kit" in claim 1 imported the feature of use in root canals unequivocally as an absolute requirement and a specific, purposively limiting feature, to be distinguished from mere suitability for the stated purpose. D1 only related to the treatment of carious lesions with simple spherical cavities in the dentine, which were entirely different from excavated root canals with many side branches, or laterals. An optical fibre designed for caries treatment was clearly distinguishable from that for an endodontic procedure, as was apparent from technique sheets 1 to 3, provided by the applicant to dentists, and from a letter of one of the inventors (Mr. G. Pearson) and the two articles cited therein, all supplied together with the statement of grounds of appeal.

The reference to the root canal at page 8 of D1 was erroneous, as became clear from the first priority document of D1. The fact that the treatment of root caries was also contemplated in D1 did not imply that the disclosed device was actually used in the root canal.

The claimed optical fibre was clearly not the same as that of D1. The spherical, isotropic tip disclosed in D1 would provide less than optimum illumination and reduced activation of the photosensitiser in an elongate root canal, unless carefully moved up and down by the dentist during use. Accordingly, the fibre of D1 did not have a portion at or close to the distal end, which was shaped to spread radiation around and along a dental root canal, as defined in claim 1 in suit. With respect to the obturating means, there was no suggestion in D1 that the materials disclosed therein were suitable for sealing the root canal.

Reasons for the Decision

1. The appeal is admissible.
2. Novelty

Document D1 discloses a dental root canal sterilising and sealing kit comprising:

- (a) a flowable photosensitiser which is absorbed by bacteria (page 4, lines 1 to 7);
- (b) an optical fibre 4 having a portion 5 at or close to the distal end which is shaped to spread radiation around and along a dental root canal (page 8, lines 17 to 19), said fibre being adapted for introduction into a root canal so that the tip is capable of reaching the apical third of the root canal, said optical fibre being connectable proximally with means 41 for generating laser light capable of being absorbed by the photosensitiser; and

(c) obturating means (page 4, lines 7 to 9; page 5, line 16) for sealing the canal.

The term "dental root canal sterilising and sealing kit" does not imply any limitations further than that the claimed kit is to be suitable for sterilising and sealing the root canal. The Board considers that the wording "dental root canal sterilising and sealing kit" is in fact equivalent to the wording "kit of parts for use in sterilising and sealing a dental root canal", employed by the applicant in a previous version of the claim during examination proceedings. This interpretation implies that the intended use of the kit is taken into consideration when assessing novelty, namely to the extent that any kit disclosed in the prior art which is unsuitable for this use is not prejudicial to the novelty of the subject-matter of the claim (T 637/92, point 4.5 of the reasons).

In the present case, the claim is clearly directed to a product, viz. a kit, and the wording "dental root canal sterilising and sealing" before the term "kit" does not change the product claim into a use claim (cf. T 303/90, points 3.1.2 and 3.2 of the reasons). Moreover, a mere difference in wording as in the claim in suit is insufficient to establish novelty (see also Case Law of the Boards of Appeal of the EPO, 6th edition 2010, I.C.3.2.1).

There is no reason to believe that the above-cited reference in D1 to the root canal on page 8, lines 17 to 19, is erroneous or does not represent the technical reality intended by its author. On the contrary, there are various references to the treatment of root caries

(page 5, lines 2 and 18; page 27, lines 1 to 2; claim 5), indicating that the disclosure of D1 is not limited to the treatment of normal caries in the dentine, but that treatment of the root is also envisaged. Contrary to the appellant's assertion, the priority documents of D1 do not belong to the disclosure content of D1 and are not to be taken into account when assessing novelty.

Furthermore, the spherical portion or tip 5 at the distal end of the fibre 4 disclosed in D1 is shaped to spread radiation "around and along" a dental root canal. Since the light is spread around an arc of up to 360° (page 5, line 6 from the bottom), a certain portion of the radiation is spread laterally, i.e. radially from the longitudinal axis of the fibre and thus "around a dental root canal", and another portion forwardly, i.e. in the direction of the longitudinal axis and thus "along a dental root canal". This is even more clearly the case when a configuration as described in the penultimate paragraph of page 8 is used, wherein the reflective outer layer of the optical fibre is removed over a certain distance from the distal end, thus forming an isotropic light-emitting tip. For the skilled reader it is implicit that the laterally spread radiation necessarily also reaches any side branches or laterals of the root canal. Moreover, the wording of the claim does not require that the radiation is spread around and along the entire dental root canal.

The fibre 4 as disclosed in D1 is furthermore adapted for introduction into a root canal so that the tip 5 is capable of reaching the apical third of the root canal. This becomes evident from lateral dimensions of the tip (800 microns or less) disclosed in the penultimate

paragraph of page 4 of D1, which are the same or even smaller than those mentioned in the penultimate paragraph of page 25 of the present patent application.

Finally, the obturating means disclosed in D1 are also suitable for sealing the root canal, as defined in feature (c) of claim 1 in suit. Contrary to the appellant's assertion, it is not necessary that D1 comprises an explicit suggestion that the materials described there are suitable for use in dental root canals.

The evidence provided with the statement of grounds of appeal with respect to distinctions between endodontic procedures and the treatment of dental caries does not reveal any differences that are reflected in the wording of claim 1 in suit.

It follows that document D1 takes away the novelty under Article 54(3) EPC of the subject-matter of claim 1.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Sauter

M. Noël