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**Datasheet for the decision
of 5 August 2008**

Case Number: T 0235/07 - 3.2.02

Application Number: 98929016.8

Publication Number: 0989868

IPC: A61M 1/00

Language of the proceedings: EN

Title of invention:

Inner ear fluid transfer and diagnostic system

Applicant:

Direct Corporation

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 52(1), 54, 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty (yes)"

"Remittal to the first instance"

Decisions cited:

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Catchword:

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Case Number: T 0235/07 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 5 August 2008

Appellant:

Direct Corporation
10240 Bubb Road
Cupertino
CA 95014 (US)

Representative:

Ostertag, Ulrich
Patentanwälte
Ostertag & Partner
Epplestr. 14
D-70597 Stuttgart (DE)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 21 August 2006
refusing European application No. 98929016.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: S. Chowdhury
A. Pignatelli

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dated 21 August 2006 to refuse European patent application No. 98 929 016.8.

The primary ground of refusal was that the subject-matter of claim 1 then on file lacked novelty, having regard to document D1 (US-A-5 421 818).

II. On 21 October 2006 the appellant (applicant) lodged an appeal against the decision and paid the prescribed fee on the same day. On 22 December 2006 a statement of grounds of appeal was filed.

III. Oral proceedings before the Board were held on 5 August 2008.

The appellant requests that the decision under appeal be set aside and that the case be remitted to the examining division to grant a patent on the basis of claims 1 to 22 filed during the oral proceedings.

IV. Independent claim 1 reads as follows:

"A medical treatment apparatus for transferring fluid materials into and out of the inner ear (404) of a living human subject through the round window niche (410) and the round window membrane (406) of the human subject, the treatment apparatus comprising:

at least one fluid conduit (16; 50; 102) comprising a first end (20; 52; 104), a second end (22; 54; 106), and an internal passageway (26; 60; 112) extending

continuously through the fluid conduit (16; 50; 102) from the first end (20; 52; 104) to the second end (22; 54; 106) of the fluid conduit (16; 50; 102);

a cover member (12) sized to block the passage of fluid materials into and out of the round window niche (410) during use of the said apparatus; wherein

the at least one fluid conduit (16; 50; 102) passes through the cover member (12); and

the cover member (12) has a thickness (T1) of 0,1 mm to 0,7 mm and is made from a material which is selected from silicone rubber, latex rubber or plastic;

and wherein

the cover member (12) is formed as a disk being perpendicular to the axis of the at least one fluid conduit (16; 50; 102)."

Claims 2 to 22 are dependent claims.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

Claim 1 is based on the embodiment described with reference to Figures 1 to 4 and 9 and includes the subject-matter of original claim 29 amplified by the following features:

- a) The apparatus is for human subjects,
- b) The cover member blocks the passage of fluids
- c) The thickness dimension and material of the cover member, and
- d) The cover member is formed as a disk perpendicular to the axis of the fluid conduit.

These amendments are supported by the following respective passages of the application as originally filed (WO-A-98/56434):

- a) Page 8, line 22
- b) Page 35, line 3
- c) Page 35, lines 14 to and 21
- d) These features may be taken from the Figures, especially Figure 2. A disk, in the context, is a circular plate.

For these reasons claim 1 meets the requirement of Article 123(2) EPC.

3. *Clarity*

Claim 1 defines the size of the cover member by reference to the round window niche of an ear, whose size varies considerably between a human infant and an adult. Nevertheless, the surgeon will, in practice, have a range of sizes of the apparatus available and select an appropriate size in a given ear after measurement of the ear's dimensions. The claim is not considered to be unclear in this respect.

4. *Novelty*

The features c) and d) are not disclosed in the document D1, for which reason the claimed apparatus is novel.

5. *Remittal to the department of the first instance*

Claim 1 includes the new features c) and d) which presumably have not been searched. Moreover, the examining division has not examined this claim as regards the inventive step requirement of Article 52(1) EPC. For these reasons the case must be remitted for further examination.

The Board wishes to stress that only claim 1 has been examined at appeal, and only as regards the requirements of Articles 84 and 123(2) EPC, and Articles 52(1) and 54 EPC.

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 claim 1 according to the request filed during the oral proceedings.

The Registrar

The Chairman

V. Commare

T. Kriner