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**Datasheet for the decision  
of 3 May 2011**

**Case Number:** T 1837/07 - 3.2.02

**Application Number:** 97916831.7

**Publication Number:** 0929257

**IPC:** A61B 5/05

**Language of the proceedings:** EN

**Title of invention:**

Method for verifying efficacy of manipulative therapy

**Applicant:**

Jasao Corporation

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

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

EPC Art. 116, 111

EPC R. 68, 86(3), 67

RPBA Art. 11

**Keyword:**

"Lack of reasoning (yes)"

"Procedural violation (yes)"

"Remittal (yes)"

**Decisions cited:**

T 0034/90, T 0872/90, T 0182/88, T 0183/89, T 0731/93,

G 0009/91

**Catchword:**

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Case Number: T 1837/07 - 3.2.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.02  
of 3 May 2011

**Appellant:** Jasao Corporation  
Suite 703  
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Abilene, TX 79601 (US)

**Representative:** Lawrence, John  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 15 June 2007  
refusing European patent application  
No. 97916831.7 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** M. Noël  
**Members:** P. L. P. Weber  
A. Pignatelli

## Summary of Facts and Submissions

I. The appeal of the applicant is lodged against the decision of the Examining Division dated 15 June 2007 to refuse the application because its subject-matter did not comply with the requirements of Articles 52(4), 84, 123(2) and 54 or 56 EPC 1973.

The appeal was filed on 24 August 2007 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 23 October 2007.

II. The appellant requests:

- that the decision under appeal be set aside and
- that a patent be granted on the basis of the set of claims according to a main request, or as a subsidiary measure on the basis of the set of claims according to one of four auxiliary requests, all filed with the statement setting out the grounds of appeal.
- a refund of the appeal fee pursuant to Rule 67 EPC 1973

III. Brief history of the case

- (a) In two communications dated 21 December 2004 and 3 April 2006, the Examining Division considered independent claims 1 and 17 according to the main request to infringe the provisions of Articles 84 and 123(2) EPC.

- (b) In its response dated 10 October 2006 the appellant requested that oral proceedings be held in the event that the Examining Division was minded to refuse the application.
- (c) By summons of 31 October 2006 the appellant was summoned to attend oral proceedings planned for 15 January 2007. In the annex to the summons the Examining Division mentioned that, regarding the main request, the objections under Articles 84 and 123(2) EPC 1973 would have to be discussed and that the auxiliary requests 1 to 3 then on file seemed not to comply with Article 123(2) EPC 1973.
- (d) On 9 January 2007 the appellant informed the Examining Division that it would not attend the oral proceedings and requested, as an additional auxiliary request 4, allowance of the originally filed claims.
- (e) Oral proceedings were held on 15 January 2007 in the absence of the appellant. According to the minutes sent to the appellant on 19 January 2007, during the oral proceedings, the Examining Division:
- confirmed the objection under Article 52(4) EPC 1973 (the method comprises a surgical step) raised in the first communication against claims 1 and 18 as originally filed,
  - raised for the first time an objection under Article 52(4) EPC 1973 against claims 1 and 17 according to the main request,

- confirmed the objections raised earlier under Articles 84 and 123(2) EPC 1973 against claims 1 and 17 of the main request,
  - confirmed the Article 123(2) EPC 1973 objection raised earlier against auxiliary requests 1 to 3 of 10 October 2006,
  - raised for the first time a lack of inventive step objection against claims 1 and 17 of the main request on the basis of an acknowledgment of general prior art in the introductory part of the description of the application,
  - informed the appellant that it was given an additional opportunity to comment on the new objections in writing,
  - informed the appellant that amendments which were not prima facie allowable might not be admitted into the proceedings pursuant to Rule 86(3) EPC 1973.
- (f) The appellant filed a response with its comments on 29 May 2007. It requested grant of a patent on the basis of the same main request or on the basis of two new auxiliary requests. An amended description was filed as well. Further it requested the suspension of the examination proceedings in view of the (then pending) referral G1/07 and still further it requested new oral proceedings to be held in the event that the Examining Division way minded to decide to refuse the application.
- (g) On 15 June 2007 the Examining Division issued a decision to refuse the application. In its decision the Examining Division

- found that originally filed claims 1 and 18 and claims 1 and 17 according to the main request infringed Article 52(4) EPC 1973.
- found that claims 1 and 17 of the main request infringed Articles 84 and 123(2) EPC 1973.
- found that claims 1 and 17 of the main request were not inventive over the prior art mentioned in the introductory part of the description,
- did not admit the two new auxiliary requests into the proceedings because they prima facie infringed Articles 52(4), 84 and 123(2) EPC 1973:  
*"Since the first auxiliary request is clearly not allowable under Art. 52(4), 84 and 123(2) EPC and the second auxiliary request is clearly not allowable under Art. 84 and 123(2) EPC, the examining division exercises the discretionary power conferred by Rule 86(3) EPC and does not admit these excessively late-filed sets of claims into the procedure ... "*
- did not suspend the examination proceedings and refused to arrange second oral proceedings.

IV. The arguments of the appellant can be summarised as follows:

The appellant's right to be heard had not been observed because the second oral proceedings requested by the appellant were not held, and because the decision under appeal was based on grounds on which the appellant had had no opportunity to comment with regard to the first and second auxiliary requests. Further the decision under appeal was not fully reasoned, because apart from "excessive late filing" no reasons were given as to why the first and second auxiliary requests presented with

letter of 29 May 2007 were clearly unallowable despite the fact that the appellant had commented on the allowability of the requests in the above letter, and in spite of the fact that the Examining Division had invited the appellant, in the communication of 19 January 2007, to comment on the minutes of the oral proceedings previously held on 15 January 2007. The Examining Division thus additionally also exercised its discretion under Rule 86(3) EPC 1973 wrongly.

- V. The different versions of claim 1 of interest for the decision read as follows:

Claim 1 according to the main request before the Examining Division reads as follows:

"1. A method for verifying the efficacy of a manipulative process comprising:  
comparing a post-manipulation response to a baseline response,  
wherein a patient is subjected to a first dermatomal somatosensory evoked potentials test to establish the baseline response; and  
wherein the patient is subjected to a second dermatomal somatosensory evoked potentials test to establish a post-manipulation response after a first nerve root compression relief manipulative process has occurred on the patient."

Originally filed claim 1 reads as follows:

"1. A method for verifying the efficacy of manipulative therapy comprising:

performing a first dermatomal somatosensory evoked potentials test on a patient to establish a baseline response;  
performing a first manipulative therapy technique on the patient; and  
performing a second dermatomal somatosensory evoked potentials test on the patient."

Claim 1 according to the first auxiliary request before the Examining Division reads as follows:

" 1. A method for verifying the efficacy of manipulative therapy comprising:  
performing a first dermatomal somatosensory evoked potentials test on a patient to establish a baseline response;  
performing a first manipulative therapy technique on the patient; and  
performing a second dermatomal somatosensory evoked potentials test on the patient,  
characterised by comparing transmission times of nerve impulse signals through the body of a patient to the cerebral cortex by performing the second dermatomal somatosensory evoked potentials test to transmission times measured by performing the first dermatomal somatosensory evoked potentials test."

Claim 1 according to the second auxiliary request before the Examining Division reads as follows:

1. A method for verifying the efficacy of manipulative therapy comprising:



performing a first dermatomal somatosensory evoked potentials test on a patient to establish a baseline response;  
performing a first manipulative therapy technique on the patient; and  
performing a second dermatomal somatosensory evoked potentials test on the patient,  
characterised by comparing transmission times of nerve impulse signals through the body of a patient to the cerebral cortex by performing the second dermatomal somatosensory evoked potentials test to transmission times measured by performing the first dermatomal somatosensory evoked potentials test,  
with the exception of methods including the step of performing a first manipulative therapy technique on the patient."

## **Reasons for the Decision**

1. The appeal is admissible.

Since the impugned decision was issued before entry into force of the new version of the EPC, it has to comply with the procedural provisions of the EPC 1973, in force at the date of said decision.

2. Compliance with Rule 68(2) EPC 1973

According to Rule 68(2) EPC 1973 the decisions of the European Patent Office open to appeal shall be reasoned. The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a first instance department

(see inter alia T 34/90 (OJ 1992, 454) and G 9/91 (OJ 1993, 408)). A reasoned decision issued by the first instance department meeting the requirements of Rule 68(2) EPC 1973 is accordingly a prerequisite for the examination of the appeal.

In the present case, according to the decision the first and the second auxiliary requests were not introduced into the proceedings pursuant to Rule 86(3) EPC 1973 because the Examining Division considered that the first auxiliary request was clearly not allowable under Articles 52(4), 84 and 123(2) EPC 1973 and that the second auxiliary request was clearly not allowable under Articles 84 and 123(2) EPC 1973 (see point III (g) above).

It is constant jurisprudence of the boards of appeal that a decision which hinges upon the exercise of the deciding department's discretion must also be reasoned, see e.g. T 0872/90. In the present decision there is however no explanation whatsoever as to which of the claims and which of the features are the subject of the objections and what exactly the objections are. No legal or factual reasons for the finding are set out in the decision. Thus, the Examining Division failed to provide any reasoning in support of its decision not to admit the first and second auxiliary requests, as required under Rule 68(2) EPC 1973 (see T 182/88 (OJ EPO 1990, 287), T 183/89). Thus Rule 68(2) EPC 1973 has been violated by the first instance.

3. Application of Rule 86(3) EPC 1973

Pursuant to Rule 86(3), first sentence, EPC 1973, after receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend once the description, claims and drawings provided that the amendment is filed at the same time as the reply to the communication.

Hence, under this provision, amendments have to be considered by the Examining Division even if they are not specifically aimed at answering the objections raised in the first communication. A fortiori amendments aimed at answering such objections must be taken into account.

Pursuant to Rule 86(3), second sentence, EPC 1973, only further amendments require the consent of the Examining Division.

It is recalled that under Rule 51(3) EPC 1973, any communication under Article 96(2) EPC 1973 shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent. This applies in particular for the first communication. This means that if, for whatever reason, the Examining Division chooses not to mention all the grounds in the first communication and mentions some of them only in a further communication, this communication is the first communication for these reasons according to Rule 86(3) EPC 1973 and the Examining Division cannot refuse to consider an attempt to overcome these newly raised objections in the subsequent response of the applicant.

In the present case, apart from the objections under Articles 84 and 123(2) EPC 1973 against claim 1 of the main request already raised earlier, the Examining Division raised the objections under Articles 52(4) and 56 EPC 1973 against this same claim for the first time in the minutes of the oral proceedings, sent on 19 January 2007, and then as the next step refused to consider the first and second auxiliary requests filed with the answer to the minutes. As a matter of fact the first and second auxiliary requests were not introduced into the procedure because the Examining Division had "warned" the appellant in the minutes of the oral proceedings that "amendments which are not prima facie allowable may not be admitted into the proceedings pursuant to Rule 86(3)" and, as already mentioned above, the Examining Division considered that the requests were clearly not allowable under Articles 52(4), 84 and/or 123(2) EPC 1973 and moreover were late filed.

However, in the opinion of the Board, at least the second auxiliary request must be considered as an attempt to overcome all objections raised by the Examining Division against claim 1 of the main request:

- the objections under Articles 84 and 123(2) EPC 1973 because the original wording of the first part of claim 1 has been maintained, which part was never objected to under Article 84 EPC 1973, and;
- this originally filed wording can obviously not infringe Article 123(2) EPC 1973;
- the objection under Article 56 EPC because additional features have been introduced into claim 1, and
- the objection under Article 52(4) EPC 1973 because a disclaimer has been introduced into claim 1.

For this reason the Board is of the opinion that the provision of Rule 86(3), second sentence, EPC 1973, is in fact not applicable to the second auxiliary request at all as the objections of lack of inventive step and exclusion from patentability under Article 52(4) EPC 1973 against claim 1 of the main request were raised for the first time in the communication (i.e. the minutes of the oral proceedings) preceding the refusal to introduce the second auxiliary request into the proceedings.

These minutes of the Examining Division have to be considered as the first communication within the meaning of Rule 86(3), first sentence, EPC 1973, with regard to these objections, and hence, claim 1 according to the second auxiliary request filed with letter of 29 May 2007 being an attempt to overcome the objections made in these minutes, there is no room to refuse these claims under Rule 86(3), second sentence, EPC 1973.

Rule 86(3) EPC 1973 thus has not been applied in a reasonable way in relation to the second auxiliary request, and this is an additional procedural violation.

4. In its letter of 29 May 2007, the appellant requested that oral proceedings be held in the event that the Examining Division was minded to refuse the application, and the Examining Division refused the application in writing without holding oral proceedings.

Pursuant to Article 116(1) EPC 1973 oral proceedings shall take place at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings.

The boards of appeals have often stated that, where oral proceedings are requested in examination, opposition and appeal proceedings, they have to be appointed. There is no room for the application of any discretionary power by the relevant department.

The only exception to the above mentioned principle is in Article 116(1), second sentence, EPC 1973, which stipulates that the European Patent Office may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

However as mentioned above, the Examining Division should at least have introduced the second auxiliary request into the proceedings, which clearly would have changed the subject of any further oral proceedings. For this reason oral proceedings should have been held as requested by the applicant, see e.g. T 0731/93. This represents an additional procedural violation.

5. Since fundamental deficiencies are apparent in the first instance proceedings and no special reasons exist for doing otherwise the Board remits the case to the first instance for further prosecution pursuant to Article 111 EPC 1973 and Article 11 of the Rules of Procedure of the Boards of Appeal in the version which entered into force on 13 December 2007 (OJ EPO 2007, 536).

6. Reimbursement of the appeal fee (Rule 67 EPC 1973)

The appeal is allowed insofar as the decision under appeal is set aside. Since the decision of the first

instance clearly contravened Rule 68(2) EPC 1973, Rule 86(3) EPC 1973 and Article 116 EPC 1973, and the appellant had to appeal in order to obtain a fully reasoned decision, to have its auxiliary requests considered and to have oral proceedings held, it is equitable to reimburse the appeal fee pursuant to Rule 67 EPC 1973.

## **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. The appeal fee is reimbursed.

The Registrar:

The Chairman:

D. Sauter

M. Noël