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**Datasheet for the decision
of 24 June 2011**

Case Number: T 1912/08 - 3.2.02

Application Number: 04015303.3

Publication Number: 1598026

IPC: A61C 5/02

Language of the proceedings: EN

Title of invention:

Root canal reamers for handpieces with reaming portions more than 16 mm long

Applicant:

Sweden & Martina S.p.a.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 84, 108, 113

EPC R. 99

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility (yes)"

"Clarity (no)"

Decisions cited:

T 0624/09, T 0407/02, T 1907/08

Catchword:

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Case Number: T 1912/08 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 24 June 2011

Appellant: Sweden & Martina S.p.a.
Via Veneto, 10
I-35020 Due Carrare (PD) (IT)

Representative: Gustorf, Gerhard
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D-84036 Landshut (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 19 March 2008
refusing European patent application
No. 04015303.3 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: D. Valle
Members: P. L. P. Weber
J. Geschwind

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal on 16 May 2008 against the decision of the examining division posted on 19 March 2008 to refuse the application. The fee for the appeal was paid on 26 May 2008 and the statement setting out the grounds for appeal was received on 15 July 2008.
- II. The application was refused - inter alia - on the basis of Article 84 EPC because the first auxiliary request taken as a basis for the decision comprised a claim 1 attempting:

"to define the subject-matter of the invention with respect of a second, unclaimed entity, namely human teeth. The length of the reaming section has been made dependent on the size of the human tooth because it is claimed that the length must be such that *"said reaming section is effective on the apical portion of said root canal and at least a further part of the same reaming section is simultaneously effective on the coronal portion of said root canal"*. Teeth are not considered to be standardized entities nor are they of equal size, since they vary within the mouth of the patient from the incisor to the molars. Chipping or breaking of teeth provides for even more variability in the dimensions of teeth, as does the difference between baby teeth and adult teeth and between healthy and unhealthy teeth. It is not possible to infer clearly from this part of claim 1 what technical features, if any, can be understood and used as a way to delimit the invention."

See decision under appeal, point 2.1 of the grounds, first full paragraph of page 3.

III. The applicant requested that the decision under appeal be set aside and that a patent be granted on the basis of a set of new claims submitted with the statement of grounds.

IV. Claim 1 of the sole request reads as follows:

"Root canal reamer for use in handpieces, having an apical reaming portion and a coronal reaming portion with at least two cutting blades (L) and with progressively increasing diameter and constant taper angle, the cutting blades (L) covering both the apical portion and the coronal portion, wherein the whole reaming length (A) exceeds the ISO standard length of 16 mm and reaches a maximum length of 30 mm."

Reasons for the Decision

1. *Admissibility*

The appeal is admissible.

According to Article 108 EPC, notice of appeal shall be filed within two months of notification of the decision. Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations.

According to Rule 99 EPC the notice of appeal shall contain:

- (a) the name and the address of the appellant as provided in Rule 41, paragraph 2(c);
- (b) an indication of the decision impugned; and
- (c) a request defining the subject of the appeal.

Furthermore, in the statement of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based.

The statement of the appellant that he is appealing against the decision refusing the patent application together with the request to set aside the decision is tantamount to a statement that he wishes that the decision is set aside in its entirety, with the aim to get a patent on the basis of the request presented, (see T 624/09 of 8 April 2011, point 1.2 of the reasons and T 407/02, point 1.1 of the reasons).

Furthermore, in the statement setting out the grounds for appeal the appellant has made an attempt to overcome the objection raised by the decision under appeal and has filed new claims. He has in particular addressed the objection of lack of clarity with the wording: "A set of new claims is submitted, claim 1 of which defines the features of the invention in a clearer manner". He has further addressed the objection of lack novelty and the issue of inventive step in

detail, discussing the prior art and the inventive solution brought forward by the invention, (see the whole statement of grounds besides the introductory sentence concerning the objection of clarity cited above).

Consequently the appeal is admissible since the appellant has in particular indicated the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based.

Therefore, the question to be answered in the present case is not about the admissibility of the appeal, but to determine whether the appeal is allowable or not, that is whether the arguments brought forward by the appellant are relevant and well-founded or not. In the second case, this would lead to a dismissal of the appeal (see, for example T 1907/08 of 2 February 2011, point 1 of the reasons).

2. *Clarity*

The decision under appeal found that claim 1 of the first auxiliary request lacked clarity because it defined a reamer on the basis of the apical and coronal portion of the human tooth, see the summary of facts and submissions above, point II.

The new claim 1 still defines the reamer as having an apical and a coronal portion (with at least two cutting blades covering both the apical and the coronal portion). That is the definition of the reamer is still

dependent on the apical and the coronal portion of the human tooth.

The objection of the first instance of lack of clarity was correctly reasoned since it is not possible to clearly define a reamer on the basis of the human tooth, being the size of the human tooth extremely variable and depending on the age of the subject, the type of the tooth (incisive, canine, molar) and the health of the tooth itself, as clearly stated in the decision under appeal.

The appellant in its statement of grounds addresses the objection of lack of clarity with the sole sentence:

"A set of new claims is submitted, claim 1 of which defines the features of the invention in a clearer manner".

The appellant did not bring forward any new argument or fact which could lead to a different founding on this issue.

Therefore the objection of lack of clarity raised by the first instance has to be confirmed.

3. *Procedural matters*

The Board is of the opinion that a decision can be issued directly since the appellant has been given the right to be heard for the following reasons (Article 113 EPC).

The objection on which the present decision is based (lack of clarity) is known by the appellant, being a ground for refusal in the decision under appeal. The appellant could have reacted to this objection in the statement of grounds, what he has not done in the present case. Furthermore, according to Article 12(1) RPBA the appellant is deemed to have presented his completed case with the statement of grounds for appeal. That means that it can be assumed that he has given all the arguments considered by him as relevant in order to support his case.

Furthermore he has not requested oral proceedings. He has further not requested any preliminary communication from the Board before any final decision be taken, nor he seems to be legitimately expecting such a communication at all, so that it is assumed that he wishes that the appeal be prosecuted only in writing.

There is finally no formal obligation from the Board to issue a communication, all the more since the Board intends to issue a decision based on facts and arguments already on file, so that the appellant can not argue that the decision would take him by surprise.

Accordingly the Board decides to issue a direct negative decision on this case.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Sauter

D. Valle