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**Datasheet for the decision
of 12 July 2011**

Case Number: T 1919/08 - 3.2.02
Application Number: 03780180.0
Publication Number: 1649824
IPC: A61C 7/12
Language of the proceedings: EN

Title of invention:

Improvements to an auxiliary element for the segmental distalization of the canine-to-molar posterior maxillary area in orthodontic treatments

Applicant:

Orthodontic Research and Development, S.L.

Headword:

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Relevant legal provisions:

EPC Art. 83, 84, 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Sufficiency of the disclosure (yes, after amendments)"

"Clarity (yes, after amendments)"

"Extended subject-matter (no, after amendments)"

Decisions cited:

-

Catchword:

-



Case Number: T 1919/08 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 12 July 2011

Appellant: Orthodontic Research and Development, S.L.
C/San Pedro Claver, 22
E-08017 Barcelona (ES)

Representatives: Durán Moya, Carlos
Durán-Corretjer
Còrsega, 329
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E-08037 Barcelona (ES)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 February 2008
refusing European patent application
No. 03780180.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: D. Valle
Members: C. Körber
M. J. Vogel

Summary of Facts and Submissions

I. On 18 April 2008 the appellant (applicant) lodged an appeal against the decision of the Examining Division posted 22 February 2008 to refuse its European patent application No. 03780180.0 for lack of support in the original disclosure (Article 123 (2) EPC), lack of clarity (Article 84 EPC) and because the invention was not disclosed in a manner sufficiently clear and complete in order to be carried out by a person skilled in the respective technical field (Article 83 EPC). In particular, the reference to the "*main patent*" as given in the description contained neither country, nor applicant name, nor it was clear whether this number was the application number or the publication number or the applicant's own enumeration of the reference document. The appeal fee was paid simultaneously and the statement setting out the grounds for appeal was received on 20 June 2008.

II. At the beginning of the oral proceedings before the Examining Division held on 14 December 2007 the appellant's representative, a German authorised European patent attorney, declared to act on the basis of a sub-authorisation of the appellant's Spanish main representatives. This sub-authorisation was at that time already on the way to the EPO, but was not yet in the file.

Therefore the Chairwoman announced that: "the oral proceedings shall continue in the normal way except that no decision can be pronounced in the end. Instead, the decision is issued in writing once the missing authorisation is filed/received". After the missing

authorisation was submitted and checked the Examining Division announced the contested decision in writing.

- III. On request of the appellant the Board of Appeal summoned to oral proceedings to be held on 12 July 2011. In an communication annexed to the summons the Board expressed doubts whether the German representative of the appellant was duly authorised in so far as he acted only on the basis of a sub-authorisation of the appellant's Spanish representatives, who, however, were not entitled to do so according to their authorisation on file which did not include the authorisation to give sub-authorisation. Furthermore the Board objected, that the appellant had only submitted a faxed copy instead of the original of the sub-authorisation as required by the directive of the President of the EPO of 12 July 2007 (OJ EPO 2007, 128).

Finally the Board maintained the objections of the Examining Division under Articles 123 (2) EPC and 84 EPC with respect to claim 1 of the main request and - restricted on Article 123 (2) EPC - of the auxiliary request.

- IV. By a letter dated 10 June 2011 the appellant made in response to that communication further observations with respect to the issues raised by the Board. In addition it submitted a declaration dated 23 May 2011 confirming that its Spanish representatives were entitled to sub-authorise his German college. Its arguments in writing and as upheld during the oral proceedings can be shortly summarised as follows:

First of all it argued that the sub-authorisation submitted during the proceedings was valid due to the attached letter dated 23 May 2011 signed by Luis Carriere, Administrator of the company Orthodontic Research and Development, S. L. (applicant). This letter confirms that the applicant had the intention just from the start of the patent application to grant sub-authorisations to whom the representatives would deem necessary, and that the sub-authorisations given in examination proceedings and in the appeal proceedings were made with permission of the applicant.

Secondly the elimination of the reference to a Spanish document from claim 1 as originally filed made the claims clear and complying with Article 83 EPC. In addition the amended claims were supported by the original disclosure, in particular by paragraphs 1 to 3 of the description and by the figures 1 to 3.

V. In the end of the oral proceedings of 12 July 2011 the appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of claims 1 to 3 filed during the oral proceedings.

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

"Auxiliary element for the segmental distalisation of the canine-to-molar posterior maxillary area in orthodontic treatments which comprises a median segment and a distal segment articulated by the combination of a ball joint formed in one end of the median segment within a recess of the distal segment, characterized in that the ball joint of the median segment is spherical

with two diametrically opposed planar faces in the position of polar segments of the sphere."

Reasons of the decision

1. *Sub-authorisation of the appellant's representative*
 - 1.1 The Board - having considered all the relevant facts concerning the authorisations of the appellant's representatives - comes to the conclusion that the question whether the representative, who had acted before the Examining Division and the Board of Appeal, was actually validly sub-authorised by the documents on file, in particular the letter of the applicant dated 23 May 2011, can be left open.
 - 1.2 Following the case law of the Boards of Appeal on this issue, the appellant was entitled to legitimately expect throughout the proceedings before the EPO to have been represented by a legally authorised representative, in particular after the first instance had expressly delayed the announcement of its decision in writing until after the receipt of a valid sub-authorisation within the set time limit (one month). With this behaviour, the first instance gave rise to a legitimate expectation of the applicant/appellant that the sub-authorisation filed by fax at the EPO on 13 December 2007 was valid and could no longer be contested by the Examining Division, or later, by the Board of Appeal. These circumstances make it mandatory for the Board not to raise further objections against the validity of the authorisation of the representative at a stage of the procedure when a decision could no

longer be appealed (see also T 1378/05 and "Case Law of the Boards of Appeal of the EPO", 6th Edition 2010, VI.I.4.2).

2. *Formal issues*

2.1 Claim 1, as filed during the oral proceedings before the Board, is based on the description, page 1, first three paragraphs and on the figures. Claims 2 and 3 correspond to the original claims.

2.2 The claims are also clear (Article 84 EPC) and the disclosure of the invention is sufficient (Article 83 EPC). The objections of the first instance regarding the main request were based on the fact that the claims contained a reference to a Spanish document (Patente principal n° 200102210). This reference has been now deleted and replaced by the designation of the claimed device and of the associated technical features, all expressly mentioned in paragraph [0002].

2.3 Therefore, since the above objections have been overcome, the Board decides that the application is now in line with Articles 83, 84 and 123 (2) EPC.

3. *Further prosecution*

The first instance did not deal in particular with the issue of novelty and inventive step. Therefore, following the request of the appellant, and in order to give the appellant the chance of two instances in the proceedings, the Board decides to remit the case to the first instance for further prosecution. It is expressly mentioned that the Board is of opinion that the

description has still to be adapted to the newly filed claims. In particular, paragraph 8 of the published application does not yet comply with the claims. Furthermore, in paragraph 1, the reference to the Spanish document should be preferably made more explicit by stating that this document represents the closest state of the art.

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 the claims 1 to 3 filed during the oral proceedings before the Board.

The Registrar:

The Chairman:

D. Sauter

D. Valle