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**Datasheet for the decision  
of 11 December 2013**

**Case Number:** T 1367/09 - 3.4.01

**Application Number:** 00928146.0

**Publication Number:** 1185336

**IPC:** A61N1/372

**Language of the proceedings:** EN

**Title of invention:**

TELEMETRY SYSTEM FOR IMPLANTABLE MEDICAL DEVICES

**Applicant:**

Medtronic, Inc.

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 84, 116(1), 113(1)

EPC Art. 123(2)

EPC R. 115(2)

RPBA Art. 15(1), 15(3)

**Keyword:**

Oral proceedings - non-attendance of party

Right to be heard - non-attendance at oral proceedings

**Decisions cited:**

G 0010/93, T 0991/07, T 1704/06, T 0546/08, T 0823/04,

T 1059/04

**Headnote:**

I. In ex parte appeal proceedings a board has the power to enforce any grounds for refusal of an application, in particular grounds which the examining division did not consider at all or held to be satisfied (G 0010/93). Said grounds will be communicated to the appellant in writing, for example with a communication under Article 15(1) RPBA, and/or orally during scheduled oral proceedings.

The board's communication, however, has a preliminary character and does not have to be exhaustive. Thus, should the board, when reconsidering a case shortly before the oral proceedings in preparation thereof, identify new grounds for refusal of the application that were not mentioned in its previous communication, said new grounds will have to be discussed during the oral proceedings, the aim of which is not a simple repetition of what was already submitted in writing.

II. In ex parte appeal proceedings, if a duly summoned appellant does not attend the scheduled oral proceedings, the board, in view of the principle of procedural economy, shall not be obliged to delay its decision by reason only of the appellant's absence at the oral proceedings (Article 15(3) RPBA). Due to its absence, the appellant waives the opportunity to present its comments on new grounds which were not mentioned in the communication under Article 15(1) RPBA but are decisive for the decision. In such a case, the board's decision dealing with said new grounds, on which the appellant has not presented its comments, does not contravene the principle of the right to be heard (Article 113(1) EPC 1973).



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Case Number: T 1367/09 - 3.4.01

**D E C I S I O N  
of Technical Board of Appeal 3.4.01  
of 11 December 2013**

**Appellant:** Medtronic, Inc.  
(Applicant) 710 Medtronic Parkway  
Minneapolis, MN 55432-5604 (US)

**Representative:** Hughes, Andrea Michelle  
Dehns  
St Bride's House  
10 Salisbury Square  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 23 December 2008 refusing European patent application No. 00928146.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** G. Assi  
**Members:** T. Zinke  
C. Schmidt

## Summary of Facts and Submissions

- I. The appeal filed on 2 March 2009 lies from the decision of the examining division, posted on 23 December 2008, refusing European patent application No. 00 928 146.0 published with the publication No. 1 185 336 (WO-A-2000/066220). The appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 4 May 2009.
- II. In the decision under appeal, the examining division held that the subject-matter of the pending claim 1 did not fulfil the requirements of Article 56 EPC 1973.
- III. In the notice of appeal the appellant (applicant) requested that the decision under appeal be set aside and a patent be granted on the basis of the claims "as annexed" to the decision under appeal.
- IV. With the statement setting out the grounds of appeal the appellant specified that a patent be granted on the basis of a set of claims 1 to 10 filed with the statement of grounds, these claims corresponding to those underlying the decision under appeal. Moreover, the appellant provisionally requested oral proceedings.  
  
With the statement setting out the grounds of appeal the appellant also submitted that the claims were both novel and inventive over the prior art, even taking into account common general knowledge.
- V. On 29 July 2013 the Board issued a summons to oral proceedings scheduled to take place on 11 December 2013.

VI. On 14 August 2013 the Board issued a communication under Article 15(1) RPBA drawing attention to issues to be discussed.

The Board held that the subject-matter of claim 1 on file appeared to lack an inventive step (Article 56 EPC 1973). In this context, when assessing the meaning of the feature of claim 1 "*each antenna comprising two antenna elements mounted to the housing and located orthogonal to each other*", the Board noted that the application (as originally filed) did not mention any particular technical effect in relation to said feature (Board's communication, II.2.4). The Board doubted that the technical effect would consist in providing "*polarisation diversity*", as alleged by the appellant in the grounds of appeal (Board's communication, II.2.4.1; grounds of appeal, page 2, first full paragraph). Rather, in the Board's view, there seemed to be no possibility to claim "*spatial diversity*" and "*polarisation diversity*" without infringing Article 123(2) EPC (Board's communication, II.2.4.3).

VII. With a letter dated 11 November 2013 the appellant withdrew the request for oral proceedings. No response to the Board's communication under Article 15(1) RPBA was submitted.

VIII. The oral proceedings were held on 11 December 2013, as scheduled. As previously announced during a telephone conversation with the Board's registrar, the representative of the appellant did not attend.

IX. Claim 1 of the appellant's request reads as follows:

*"An external device for using in communication with an implantable medical device, comprising:*

*a device controller (4, 6);  
a housing (11);  
an orthogonally polarized antenna array (12, 13, 14, 15) to provide spatial diversity to the housing;  
an RF transceiver (38) operating at defined frequency, coupled to the antenna array;  
means (44) for encoding signals to be transmitted to the implantable device, coupled to an input of the transceiver;  
means for decoding signals received from the implantable device, coupled to an output of the transceiver; and  
means (27) for displaying demodulated signals received from the implanted device; characterised in that the antenna array comprises two antennas spaced a fraction of the wavelength of the defined frequency from one another, each antenna comprising two antenna elements mounted to the housing and located orthogonal to one another; and  
wherein the device controller includes means (32) for selecting which of the two antennas is coupled to the transceiver."*

## **Reasons for the Decision**

1. The appeal is admissible.
2. Article 84 EPC 1973
  - 2.1 In the present case, when preparing the communication pursuant to Article 15(1) RPBA the Board did not raise the issue of Article 84 EPC 1973. Nevertheless, when reconsidering the case in preparation for the oral proceedings the Board noted that Article 84 EPC 1973 should indeed be addressed in the oral proceedings due to the fact that, when re-reading claim 1 on file, the

feature "*orthogonally polarized antenna array (12, 13, 14, 15) to provide spatial diversity to the housing*" appeared to lack clarity and support by the description.

As already stated, the representative of the appellant did not attend the oral proceedings. The question thus arises whether the present decision may cite the new ground of Article 84 EPC 1973 against the grant of a patent without contravening the principle of the right to be heard (Article 113(1) EPC 1973).

This question can be answered by considering the following legal aspects.

#### 2.1.1 Article 116(1), first sentence, EPC 1973

Pursuant to Article 116(1), first sentence, EPC 1973, "*Oral proceedings shall take place either 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.*"

This provision complies with the principle of the right to be heard (Article 113(1) EPC 1973). It also complies with the principle of procedural economy by allowing a board to reach a decision as quickly as possible. Consequently, in ex parte appeal proceedings a duly summoned appellant should not expect that a board will automatically cancel scheduled oral proceedings in a case in which the appellant withdraws its request for oral proceedings (T 0823/04, Reasons, 1; T 1059/04, Reasons, 1).

In the present case, notwithstanding the appellant's withdrawal of its request for oral proceedings, the

Board considered it appropriate to maintain the oral proceedings as scheduled.

2.1.2 Decision G 0010/93 (OJ 1995, 172)

In the decision G 0010/93 (OJ 1995, 172; Reasons, 3) the Enlarged Board of Appeal held that *"In contrast to opposition appeal proceedings, the judicial examination in ex parte proceedings concerns the stage prior to grant and lacks a contentious nature. It relates to the examination of the requirements for the grant of a patent in proceedings in which only one party - the applicant - is involved. The instances responsible must ensure that the conditions for patentability exist. In ex parte proceedings, therefore, the boards of appeal are restricted neither to examination of the grounds for the contested decision nor to the facts and evidence on which the decision is based, and can include new grounds in the proceedings. This applies to both the patentability requirements which the examining division did not take into consideration in the examination proceedings and those which it indicated in a communication or in a decision to refuse the application as having been met."*

It follows from this decision that in the present case the Board has the power to enforce any grounds against the grant of a patent independently of those put forward by the examining division in examination proceedings.



2.1.3 Rule 115(2) EPC and Article 15(3) RPBA (Article 11(3) RPBA 2003)

Rule 115(2) EPC provides that *"If a party duly summoned to oral proceedings before the European Patent Office does not appear as summoned, the proceedings may continue without that party."*

In this respect, Article 15(3) RPBA should also be considered, which requires that *"The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case."*

The explanatory notes to this Article of the RPBA (CA/133/02 dated 12 November 2002, page 20) state, in particular, that *"This provision does not contradict the principle of the right to be heard pursuant to Article 113(1) EPC since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity."*

Thus, in the present case, the fact that oral proceedings went ahead as scheduled and a decision was taken at the end of those proceedings is in accordance with both Rule 115(2) EPC and Article 15(3) RPBA.

2.1.4 Communication under Article 15(1) RPBA

According to this provision, *"If oral proceedings are to take place, the Board may send a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other*

*observations that may help concentration on essentials during the oral proceedings."*

In the communication under Article 15(1) RPBA of 14 August 2013 the Board stated in section I.III: *"It is emphasized that this preliminary assessment is intended merely as a guide and does not bind the Board in any manner (Article 17(2) RPBA)."*

In view of the preliminary nature of the communication it is evident that the Board is not restricted to discussing only the grounds put forward in the communication during the oral proceedings.

Arguing that the Board could not raise new grounds in absence of the appellant at the oral proceedings would amount to denying the Board the power to examine a case without limitations (G 0010/93) and/or to contravene the principle of procedural economy.

#### 2.1.5 Jurisprudence of the boards of appeal

It is established jurisprudence of the boards of appeal that an appellant which submits amended claims before the oral proceedings and subsequently does not attend these proceedings should not be surprised by a decision based on grounds which might be enforced against such claims in its absence (T 0991/07, Reasons, 2; T 1704/06, Reasons, 7; T 0546/08, Reasons, 2). In these decisions, it is emphasized that the purpose of oral proceedings is to give a party the opportunity to present its case. However, the party gives up this opportunity if it does not attend the oral proceedings (T 0546/08, Reasons, 2.2).

Moreover, it is commonly accepted that the scope of oral proceedings cannot be reduced to that of simply repeating what has already been put forward in writing.

2.1.6 In view of the foregoing, the following conclusions are drawn.

In ex parte appeal proceedings a board has the power to enforce any grounds for refusal of an application, in particular grounds which the examining division did not consider at all or held to be satisfied (G 0010/93). Said grounds will be communicated to the appellant in writing, for example with a communication under Article 15(1) RPBA, and/or orally during scheduled oral proceedings.

The board's communication, however, has a preliminary character and does not have to be exhaustive. Thus, should the board, when reconsidering a case shortly before the oral proceedings in preparation thereof, identify new grounds for refusal of the application that were not mentioned in its previous communication, said new grounds will have to be discussed during the oral proceedings, the aim of which is not a simple repetition of what was already submitted in writing.

In ex parte appeal proceedings, if a duly summoned appellant does not attend the scheduled oral proceedings, the board, in view of the principle of procedural economy, shall not be obliged to delay its decision by reason only of the appellant's absence at the oral proceedings (Article 15(3) RPBA). Due to its absence, the appellant waives the opportunity to present its comments on new grounds which were not mentioned in the communication under Article 15(1) RPBA but are decisive for the decision. In such a case, the board's decision dealing with said new grounds, on

which the appellant has not presented its comments, does not contravene the principle of the right to be heard (Article 113(1) EPC 1973).

For these reasons, in the present decision the Board can decide the case on the basis of Article 84 EPC 1973 without contravening the principle of the right to be heard. Attention is thus drawn to the following.

- 2.2 Present claim 1 includes the amendment "*an orthogonally polarized antenna array (12, 13, 14, 15) to provide spatial diversity to the housing*" which is crucial in that, according to the appellant, it represented a feature distinguishing the present invention from the state of the art on file.

It is commonly accepted that in ex parte proceedings a claim shall be clear per se, i.e. without having to rely on the description for its interpretation, and shall be supported by the description. However, in the Board's view, claim 1, when read per se, lacks clarity and support by the description.

First, the claimed feature "*to provide spatial diversity to the housing*" does not make sense, so that claim 1 lacks clarity. An interpretation in the light of the description could lead to the finding that a word like "*mounted*" might be missing. The feature in question could then be read as "*an orthogonally polarized antenna array (12, 13, 14, 15) to provide spatial diversity mounted to the housing*".

Moreover, the meaning of the claimed feature "*an orthogonally polarized antenna array (12, 13, 14, 15)*" is obscure in that it is not apparent how an antenna "*array*" could be "*orthogonally polarized*". Again, an

interpretation in the light of the description could lead to the understanding that a plurality of antennas arranged in an array is claimed, the antennas providing orthogonally polarized electromagnetic waves.

Furthermore, the scope of claim 1 is unduly broad because it covers an extremely large number of possible embodiments. In this respect, attention is drawn to, for example, the number of the antennas (according to common understanding, the further feature of claim 1 that the antenna array "*comprises*" two antennas does not exclude the possibility that more than two antennas are provided), the definition of the antennas (again, the further feature of claim 1 that each antenna "*comprises*" two antenna elements does not exclude the possibility that more than two antenna elements are provided), and the arrangement of the antennas and antenna elements with respect to each other (in particular, in the case of more than two antennas and more than two antenna elements for each antenna). The description of the application as originally filed does not provide any support for such a broad scope.

Hence, claim 1 lacks clarity and support by the description.

Furthermore, it should be noted with regard to the embodiments shown in Figures 1A, 2A and 4, which all fall under the scope of claim 1, that the orthogonal arrangement of the antenna elements would not necessarily provide orthogonally polarized electromagnetic waves. Indeed, an orthogonal arrangement of two antenna elements could emit waves with a relative polarization other than orthogonal, depending on, for instance, the phases of the signals which are fed to the antenna elements.

2.3 For these reasons, claim 1 according to the appellant's request does not meet the requirements of Article 84 EPC 1973.

3. Article 123(2) EPC

3.1 The Board is aware of the fact that the above finding that claim 1 according to the appellant's request does not meet the requirements of Article 84 EPC 1973 is sufficient for concluding that the request is not allowable. As already stated above, the present decision does not contravene the principle of the right to be heard despite the introduction of Article 84 EPC 1973 only at the oral proceedings.

Nevertheless, for the sake of argument the Board holds it appropriate to deal with the further ground according to Article 123(2) EPC, especially in view of the conclusion drawn below in this respect. These additional remarks are made in view of the peculiarity of the present case that the Board's communication pursuant to Article 15(1) RPBA mentioned *inter alia* Article 123(2) EPC but not Article 84 EPC 1973. In the following assessment, claim 1 has been interpreted in the manner referred to in paragraph 2.2 above.

3.2 When entering the European regional phase of the present application the applicant filed amended claims. In particular, the original feature "*an antenna array mounted to the housing*" of claim 1 was replaced with "*an orthogonally polarized antenna array (12, 13, 14, 15) to provide spatial diversity to the housing*". Although the applicant failed to mention a basis for the amendment, the examining division did not raise an

objection against this amendment under Article 123(2) EPC.

Claim 1 as filed with the statement setting out the grounds of appeal still includes said amendment. Consequently, the problem of disclosure of said amendment was addressed for the first time in the Board's communication pursuant to Article 15(1) RPBA.

- 3.3 The whole application as originally filed does not mention either the term "*polarization*" or any related term. Indeed, this also applies for the mention of any "*polarization*" effect. As already stated above, the orthogonal arrangement of two antenna elements of an antenna does not necessarily result in an orthogonal polarization because the relative polarization of the emitted electromagnetic waves depends on, for instance, the phase of the signals fed to antenna elements.

Also the feature "*orthogonally polarized antenna array*" cannot be inferred, either explicitly or implicitly for a skilled person, from the application as originally filed.

The same applies for the feature "*orthogonally polarized antenna array to provide spatial diversity*".

Neither is the Board able to find any disclosure in the originally filed application supporting a combination of the features "*spatial diversity*" and "*polarization diversity*", which, as argued in the statement setting out the grounds of appeal, characterised the present invention. Nor did the appellant mention any.

3.4 For these reasons, claim 1 according to the appellant's request does not meet the requirements of Article 123(2) EPC.

4. In conclusion, the appellant's request is not allowable.

### Order

#### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



R. Schumacher

G. Assi

Decision electronically authenticated