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**Datasheet for the decision
of 6 September 2013**

Case Number: T 0726/10 - 3.2.02

Application Number: 99924133.4

Publication Number: 1082060

IPC: A61F 9/00

Language of the proceedings: EN

Title of invention:

In-line air humidifier, a system for humidifying air and methods related thereto

Applicant:

JOHNS HOPKINS UNIVERSITY

Headword:

-

Relevant legal provisions:

EPC Art. 109(1), 111(1), 113(1), 116

Keyword:

"Claims substantially amended on appeal overcoming the grounds for refusal by the Examining Division"

"Interlocutory revision"

"Obiter Dictum not forming part of the grounds for refusal"

"Remittal (yes)"

Decisions cited:

T 0139/87, T 0047/90, T 0794/95, T 1640/06

Catchword:

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Case Number: T 0726/10 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 6 September 2013

Appellant: JOHNS HOPKINS UNIVERSITY
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 November 2009
refusing European patent application
No. 99924133.4 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: E. Dufrasne
Members: D. Ceccarelli
P. L. P. Weber

Summary of Facts and Submissions

- I. The appellant lodged an appeal against the decision of the Examining Division, dispatched on 11 November 2009, to refuse European patent application No. 99 924 133.4.
- II. The Examining Division held that the subject-matter of claim 1 lacked novelty over the disclosure of document US-A-5,320,096 (D1). As a result, the application did not meet the requirements of Articles 52 and 54 EPC. In an obiter dictum, the Examining Division expressed the view that the term "selectively" in claim 1 was not clear, that the subject-matter of claims 2 to 4 was not novel over the disclosure of document D1 and that claims 6 to 8 did not fulfil the requirements of Rule 43 EPC.
- III. Claims 1 and 5 of the set of claims on which the decision was based read respectively as follows.
1. An in-line humidifier for humidifying a gas for infusion into a patient eye comprising:
a housing 22 having an inlet and outlet connection 26a, 26b in communication with an interior of the housing 22 through which is flowed a gas in one direction extending between the inlet connection 26a to the outlet connection 26b;
a humidifier section 24 disposed within the housing 22, the humidifier section 24 including a material that can releasably retain liquid therein; and
wherein the humidifier section 24 is disposed within the housing 22 so the gas entering through the inlet connection 26a flows through the humidifying section 24 in one direction, whereby the flowing gas can be

humidified by the material, and so the humidified gas exits the housing 22 via the outlet connection 26b and is delivered to the eye, where the flowing gas is selectively humidified by at least some of the liquid releasably retained within the material.

5. A system for humidifying a gas for infusion into a patient eye comprising:

an in-line humidifier and a gas source 12 interconnected thereto, the in-line humidifier comprising the in-line humidifier in accordance with any one of claims 4-7.

IV. The notice of appeal was received on 21 January 2010 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 10 March 2010.

V. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 7 as submitted with the statement setting out the grounds of appeal. As an auxiliary measure, the appellant requested oral proceedings in case the Board could not follow the appellant's argumentation and/or could not grant a patent based on said claims 1 to 7.

VI. Claim 1 as filed with the statement setting out the grounds of appeal reads as follows:

A system 10 for humidifying gas for infusion into a patient eye comprising:
a gas source 12;
an in-line humidifier 20 comprising a housing 22 having

an inlet and outlet connection 26a, 26b in communication with an interior of the housing 22, and a humidifier section 24 disposed within the housing 22, the humidifier section 24 including a material that can releasably retain liquid therein; a gas inflow instrument 4; and tubing 16 extending (a) between the gas source 12 and inlet connection 26a and (b) between the outlet connection 26b and gas inflow instrument 4, wherein the gas source 12, tubing 16, in-line humidifier, and gas inflow instrument 4 are configured and arranged such that gas only flows in one direction from the gas source 12, through the tubing 16, into the in-line humidifier 20 via inlet connection 26a, through the humidifier section 24, out of the in-line humidifier 20 via the outlet connection 26b, through the tubing 16 and out of the gas inflow instrument 4 into the eye, whereby the flowing gas is selectively humidified as it flows through the in-line humidifier 20 by at least some of the liquid releasably retained within the material, and wherein the gas is supplied to the eye via the gas inflow instrument 4 at a pressure between 0 and 100 mm Hg.

VII. The appellant's arguments are summarised as follows.

Claim 1 was directed to a system for humidifying gas for infusion into a patient's eye as claimed in claim 5 of the request which formed the basis for the impugned decision. In the latter, the Examining Division had raised no objections to said claim 5.

Document D1 related to a filtering device for a connection to the respiratory tract of a patient and did not disclose a system for humidifying gas for infusion into a patient's eye as recited in claim 1. The subject-matter of claim 1 was therefore novel.

Reasons for the Decision

1. The appeal is admissible.
2. According to Article 109(1) EPC "[i]f the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision".
3. According to the established case law of the boards of appeal, an appeal is to be considered well founded if the objections on which the refusal of the application was based are overcome by the main request of the appeal. Other possible irregularities do not preclude rectification of the decision, since an applicant should have the right of examination in two instances (for example T 139/87, T 47/90, T 794/95).
4. Claim 1 of the request which formed the basis for the impugned decision has been amended such that present claim 1 is now directed to a system for humidifying gas for infusion into a patient eye comprising a gas source, as defined in former claim 5.
Moreover, present claim 1 comprises further additional features. In particular, a gas inflow instrument is now also defined as allowing the gas to be supplied to the

eye via the gas inflow instrument at a pressure between 0 and 100 mm Hg.

5. As the appellant correctly remarks, claim 5 was not objected to in the impugned decision.

6. The decision under appeal explains that document D1 discloses an in-line humidifier for humidifying a gas. More particularly, however, document D1 concerns a system for connection to the respiratory tract of a patient comprising a filtering device in the form of a so-called heat and moisture exchanger connected to a tracheal tube on one side and to a mechanical breathing device, such as a respirator, on the other side. According to D1, "heat and moisture exchangers operate in such a way that the moisture of the air exhaled by the patient is accumulated and stored in an air-permeable material and thereafter partly evaporates during inhalation and is returned to the patient in the air inhaled". The aim of the invention of document D1 is, in particular, "to provide [such] a filtering device which [...] takes up a small volume while still having good bacteria-filtering and heat/moisture exchanging qualities". From the disclosure of document D1 it cannot be derived how the system of document D1 could be suitable for humidifying gas for infusion into a patient eye. This aspect is not addressed in the impugned decision either. The quantity of air circulating in the heat and moisture exchanger of document D1 (several litres every respiration, corresponding to the patient's lung capacity) does not seem to be comparable to the quantity suitable for infusion into an eye. Additionally, from a reading of document D1 the Board cannot establish the disclosure

of a gas inflow instrument out of which gas flows into the eye at a pressure between 0 and 100 mm Hg.

7. Hence, at least due to the amendments mentioned above, the novelty objection over document D1, on which the impugned decision is based, does not apply to the subject-matter of claim 1.

8. In an obiter dictum in the impugned decision and in the preceding written procedure, the Examining Division held that the term "selectively", which is still present in claim 1 as now on file, lacked clarity. Moreover, it was held that claims 6 to 8, the features of which are now present in claims 1, 5 and 6, did not fulfil the requirements of Rule 43 EPC. However, the impugned decision is not based on grounds of which objections of non-compliance with Article 84 and Rule 43 EPC form part.

9. As already found in decision T 1640/06, objections that do not form part of the grounds for a refusal of an application, in particular objections in obiter dicta, can be meant as voluntary information to an applicant on the preliminary opinion of the Examining Division. This could assist the applicant if it came to subsequently considering said objections in detail. For this reason, it is in particular not necessary that the applicant is given an opportunity to present comments according to Article 113(1) EPC on said objections, nor that said objections are considered in oral proceedings according to Article 116 EPC, in order for the Examining Division to arrive at a final decision. Accordingly, the Board is of the opinion that the question whether or not the claims filed with the

statement setting out the grounds of appeal take into account the remarks made in the obiter dictum is irrelevant for deciding whether interlocutory revision should be granted or not.

10. Hence, the Examining Division should have considered the appeal to be admissible and well founded in view of the reasons forming the basis of the impugned decision and should have rectified said decision in accordance with Article 109(1) EPC.
11. In accordance with Article 111(1) EPC, it is left to the Board to decide whether to exercise the competence of the department which was responsible for the decision appealed or to remit the case to that department for further prosecution. In this evaluation, the right of a party to two instances has to be considered. In view thereof, the Board decides to remit the case to the department of first instance for further prosecution.
12. The Examining Division should examine whether the present request fulfils all the requirements of the EPC. In particular, since the amendments involve a substantial shift of the subject-matter of the independent claim, other documents dealing with the administration of air under pressure into the interior of a patient's eye might have to be analysed in more detail.

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 first instance for further prosecution.

The Registrar:

The Chairman:

D. Hampe

E. Dufrasne