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**Datasheet for the decision
of 8 July 2014**

Case Number: T 0953/11 - 3.2.02

Application Number: 03257752.0

Publication Number: 1428473

IPC: A61B6/03, A61B6/02

Language of the proceedings: EN

Title of invention:

Full field digital tomosynthesis method and apparatus

Applicant:

GENERAL ELECTRIC COMPANY

Headword:

Relevant legal provisions:

EPC Art. 111(1)

EPC R. 137(3)

RPBA Art. 13(1)

Keyword:

Late-filed request - admitted (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0953/11 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 8 July 2014

Appellant: GENERAL ELECTRIC COMPANY
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Representative: Szary, Anne Catherine
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 30 November
2010 refusing European patent application No.
03257752.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman E. Dufrasne
Members: M. Stern
C. Körber

Summary of Facts and Submissions

- I. The applicant lodged an appeal against the decision of the Examining Division dispatched on 30 November 2010 refusing European application No. 03 257 752.0.

- II. In a first communication dated 16 December 2005 during the examination proceedings, the Examining Division raised the objection that the claims defined five different inventions which lacked unity of invention in the sense of Article 82 EPC.

In its reply dated 26 June 2006, the applicant did not contest this objection, limited the claims to "invention 2" and requested the examination to proceed on the basis of these claims. Accordingly, the examination was carried out on the basis of "invention 2", which, as presented in two further communications issued by the Examining Division, revealed a lack of novelty over documents D2, D3 and D4, and (in the last of these communications) a lack of inventive step in view of the combination of documents D2 and D1.

With a reply dated 17 April 2009, the applicant filed amended claims which the Examining Division found not to be admissible under Rule 137(3) EPC since they encompassed an invention ("invention 5") for which no search fees had been paid (annex to the summons to oral proceedings dated 25 March 2010). Without contesting this finding, the applicant withdrew its request for oral proceedings and requested a decision according to the state of the file. A decision refusing the application was then issued, referring to the annex to the summons.

III. Notice of appeal was received on 31 January 2011 and the fee for appeal was paid on that same day. The statement setting out the grounds of appeal was received on 11 April 2011.

In the statement of grounds of appeal, the appellant did not provide any counter-argument to the reason for refusal, but filed various requests containing amended claims which were no longer based on the inadmissible "invention 5".

IV. In its provisional opinion dated 4 March 2014 annexed to the summons to oral proceedings, the Board questioned the admissibility of the claims of the different requests under Rule 137(3) EPC in conjunction with Article 111(1) EPC.

V. With its letter dated 6 June 2014, the appellant filed a new main request replacing all previous requests.

VI. Oral proceedings were held on 8 July 2014.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request filed with letter dated 6 June 2014.

VII. Claim 1 of the main request reads as follows:

"A tomosynthesis system (1) for forming a three dimensional image of an object (2), comprising:

an X-ray source (11) adapted to irradiate the object with a beam of X-rays from a plurality of positions along an arc shaped path (4) in a sector;

an X-ray detector (13) positioned relative to the X-ray source to detect X-rays transmitted through the object; and

a processor (21) which is adapted to generate a three dimensional image of the object based on X-rays detected by the detector;

wherein:

the X-ray detector (13) is adapted to move relative to the object (2) along a linear path (7) and to rotate in a housing (14) about a y-direction (8); and

the X-ray source (11) is also adapted to move relative to the object (2) about an axis of rotation (12) in the y-direction (8) along the arc shaped path (4) in a rotation plane perpendicular to the y-direction (8) and about a radial direction (5) so as to cause the source (11) to move in a non-arc shaped path in three dimensions;

wherein the tomosynthesis system (1) is adapted to irradiate the object with the beam of X-rays having a focal spot that follows the non-arc shaped path relative to the X-ray detector (13)."

VIII. The arguments of the appellant are summarised as follows:

- The main request, filed in replacement of the previous requests, related to invention 2. The basis for the claims was found in the previous third auxiliary request and in the description of the published application on column 4, lines 1 to 3, 10 to 22, 49 to 52, and column 8, lines 53 to 55. The claims had been further amended compared to the previous third auxiliary request so as to further distinguish them from the cited prior-art documents. None of the cited prior art documents, either alone or in any combination, disclosed or suggested the use of an X-ray

beam focal spot following a non-arc shaped path in three-dimensions relative to an X-ray detector with a view of addressing the objective technical problem of providing a higher resolution tomographic imaging system and method.

- During oral proceedings it was explained that different US attorneys had been in charge of the prosecution of the present case. This was the reason for the various choices of inventions to be examined, and for the late-filed present main request.

- The skilled person would easily understand what claim 1 defined, in particular considering Figure 1 and using common general knowledge as evidenced by patent documents D1, D2 and D4, where the same terminology for designating the axes was used.

Reasons for the Decision

1. Admissibility of the appeal

The impugned decision found the claims then on file to be inadmissible under Rule 137(3) EPC because they were based on one of the originally filed non-unitary inventions ("invention 5") for which no search fees had been paid.

The claims of the various requests filed with the statement of grounds of appeal, as well as the current claims, are based on various inventions which are different from "invention 5" and for which search fees have been paid. Hence, even if the statement of grounds of appeal does not provide any arguments concerning the reasons given in the impugned decision, the Board

considers the appeal to be admissible since the claims (of all requests) filed with the statement of grounds of appeal, and the current claims filed in replacement of all former claims, self-evidently deprive the contested decision of its factual basis that the invention claimed had not been searched.

2. *Admissibility of the main request*

2.1 As indicated above (point II), in a first communication the Examining Division objected that the original claims comprised five non-unitary inventions in the sense of Article 82 EPC and asked the applicant to state which of the searched inventions ("invention 1" to "invention 4") should be the basis for the further prosecution of the application. In reply thereto, the applicant limited the claims to "invention 2" and requested that the examination should proceed on the basis of these claims.

Accordingly, the examination was carried out on the basis of "invention 2", which, as presented in two further communications issued by the Examining Division, revealed a lack of novelty over documents D2, D3 and D4, and (in the last of these communications) a lack of inventive step in view of the combination of documents D2 and D1.

In response to these findings, the applicant filed amended claims which were based on a different, non-searched invention ("invention 5"), which the Examining Division, based on decision G 2/92, rejected in the contested decision as inadmissible under Rule 137(3) EPC.

2.2 With the statement of grounds of appeal, the appellant filed amended sets of claims which no longer corresponded to (inadmissible) "invention 5". In particular, two sets of claims were based on "invention 1", another set of claims was based on "invention 4", and a further one reverted to (the previously examined) "invention 2" in combination with "invention 1".

2.3 Claim 1 of the current main (sole) request is an amended claim based on "invention 2" which was filed only about one month before the oral proceedings and incorporates additional features extracted from the description.

Thus, the question is now whether reverting back to (examined) "invention 2" is admissible under the present circumstances, which, as explained above, are primarily characterised by filing amended claims at a late stage in the appeal proceedings after having requested the Board to examine several other non-unitary inventions. The appellant indicated that different US attorneys had been in charge of the prosecution of the present case, which was the reason why the examination of different inventions had been requested, and why the present request had been filed late. The Board considers, however, that the appellant's own decision to change its attorneys cannot serve as a valid reason for conducting the proceedings against the requirement of procedural economy.

2.4 In accordance with established practice, the Board could however exercise its discretion to admit the present late-filed request in the appellant's favour, provided that the request is clearly allowable in the

sense that it does not introduce new objections under the EPC and overcomes all outstanding ones.

This, however, is not the case here, as a prima facie consideration of the clarity requirements under Article 84 EPC of claim 1 reveals. In claim 1, the X-ray detector is defined as being adapted to move along a linear path and to rotate in a housing about a y-direction, without however specifying what the "y-direction" should be, in particular in relation or in contrast to the "linear path". Furthermore, the X-ray source is defined as being adapted to move about an axis of rotation in the (said) y-direction and about a radial direction. Especially in the absence of a definition of the "radial direction", the definition of the movement "about a radial direction" also appears prima facie to be unclear.

The Board cannot accept the appellant's argument that since patent documents D1, D2 and D4 use the same terminology and reflect the skilled person's common general knowledge, the claim would be easily understood. In accordance with established case law, individual patent documents do not constitute evidence of the skilled person's common general knowledge, and certainly do not ensure that the terminology employed in the present case is clear in the sense of Article 84 EPC.

Since the Board does not find claim 1 to be clearly allowable under Article 84 EPC, the question whether its subject-matter is also clearly novel and inventive is left open. The Board notes, however, that answering that question at this late stage of the proceedings would have been particularly hampered by the fact that the appellant has not submitted, at any time throughout

the appeal proceedings, any specific analysis or discussion of the patentability of the claimed subject-matter having particular regard to each of the prior-art documents cited in the examination proceedings (point 2.1 above).

2.5 The Board consequently does not admit the main request into the proceedings under Article 111(1) and Rule 137(3) EPC.

2.6 The Board reaches the same conclusion also in application of Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA). This article gives a Board the discretion to admit and consider new requests presented by an appellant after it has filed its grounds of appeal. The Board must exercise that discretion in view of, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

Therefore, requests filed very late (*i.e.* shortly before the oral proceedings, as in the present case) will be admitted under Article 13(1) RPBA only if they are *prima facie* allowable ("Case Law of the Boards of Appeal", 7th edition 2013, IV.E.4.2.1). For the reasons indicated under point 2.4 above, this is not the case here.

Consequently, also under Article 13(1) RPBA the Board does not admit the main request.

2.7 Since the main (sole) request is not admitted into the proceedings, the appellant's request that a patent be granted on the basis of this request is refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated