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**Datasheet for the decision
of 24 September 2015**

Case Number: T 0418/12 - 3.2.02

Application Number: 04741728.2

Publication Number: 1631203

IPC: A61B17/32, A61B18/14

Language of the proceedings: EN

Title of invention:
ELECTRONIC COAGULATION SCALPEL

Patent Proprietor:
Telea Electronic Engineering S.R.L.

Opponent:
Olympus Winter & Ibe GmbH

Headword:

Relevant legal provisions:

EPC Art. 123(2)
EPC R. 103(1)(a)

Keyword:

Added subject-matter (yes) - all requests
Reimbursement of appeal fee (no)

Decisions cited:

G 0001/93, T 0384/91, T 0112/95, T 1066/98



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Case Number: T 0418/12 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 24 September 2015

Appellant: Telea Electronic Engineering S.R.L.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 21 December
2011 revoking European patent No. 1631203
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman E. Dufrasne
Members: M. Stern
D. Ceccarelli

Summary of Facts and Submissions

- I. The patent proprietor lodged an appeal against the decision of the Opposition Division dispatched on 21 December 2011 revoking European patent No. 1631203.
- II. The Opposition Division had revoked the patent because none of the requests then on file met the requirements of either Article 123(2) or 123(3) EPC. In particular, it held that the feature "line voltage network" infringed Article 123(2) EPC, and since it was included in claim 1 of the patent as granted, its elimination went against the provisions of Article 123(3) EPC.
- III. Notice of appeal was filed on 17 February 2012 and the fee for appeal was paid the same day. A statement setting out the grounds of appeal was received on 20 April 2012. With the latter statement the appellant requested, inter alia, the refund of the appeal fee due to a violation of Article 113(1) EPC by the Opposition Division.
- IV. Oral proceedings were held on 24 September 2015.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or, in the alternative, one of auxiliary requests I to V, all filed with letter dated 20 April 2012, and auxiliary requests VI and VII, filed with letter dated 3 July 2015.

The respondent (opponent) requested that the appeal be dismissed.

- V. Claim 1 of the **main request** reads as follows:

"1. An electronic scalpel comprising:
a manipulator (41) for clotting organic tissues and at least an electrode (42) to close an electric circuit connected thereto, said electric circuit comprising:
- a rectifying circuit (20) fed by a line voltage network, supplying a voltage (201) to a radio frequency circuit;
- a radio frequency circuit (30) comprising at least an electronic switch (305) fed by said voltage (201), said electronic switch being controlled by a pilot circuit (306),
characterized in that said radio frequency circuit has as output a resulting wave (301) formed by the combination of a generally square carrier wave (304) and a modulating wave, said resulting wave circulating in said electric circuit, said electric circuit being wide band resonant at the frequency of said carrier wave wherein the carrier wave has the main frequency at 4 MHz and wherein the resonant circuit on the carrier frequency is of the wide pass-band type so as to let pass even if dampened, at least the second and the third harmonic of the carrier wave relative to the signal of the resulting wave (301)."

Claim 1 of **auxiliary request I** reads as claim 1 of the main request, with the features of the first indent replaced by:

"a rectifying circuit (20) fed by a mains voltage from a line voltage network, supplying a voltage (201) to a radio frequency circuit".

Claim 1 of **auxiliary request II** reads as claim 1 of the main request, with the features of the last portion of the characterising portion after the expression "the frequency of said carrier wave" replaced by:

"wherein the carrier wave has the main frequency at 4 MHz and wherein the resonant circuit contains a transformer with a suitable number of turns so that the resonance coefficient is lower than 1, preferably between 0.4 and 0.6."

Claim 1 of **auxiliary request III** reads as claim 1 of auxiliary request II, with the features of the first indent replaced by:

"a rectifying circuit (20) fed by a mains voltage from a line voltage network, supplying a voltage (201) to a radio frequency circuit".

Claim 1 of **auxiliary request IV** reads as claim 1 of the main request, adding at the end the following expression:

"and wherein the resonant circuit contains a transformer with a suitable number of turns so that the resonance coefficient is lower than 1, preferably between 0.4 and 0.6".

Claim 1 of **auxiliary request V** reads as claim 1 of auxiliary request IV, with the features of the first indent replaced by:

"a rectifying circuit (20) fed by a mains voltage from a line voltage network, supplying a voltage (201) to a radio frequency circuit".

Claim 1 of **auxiliary request VI** reads as claim 1 of the main request, with the features after the expression "the frequency of said carrier wave" removed.

Claim 1 of **auxiliary request VII** reads as claim 1 of auxiliary request VI, with the features of the first indent replaced by:

"a rectifying circuit (20) fed by a mains voltage from a line voltage network, supplying a voltage (201) to a radio frequency circuit".

VI. The arguments of the appellant relevant for the present decision are summarised as follows:

The feature "line voltage network" which was not disclosed in the application as filed had been added to the application during examination. The original application did not claim a device fed by a specific power source, so the power source had never been considered as being essential to the invention. A "line voltage network" in the current language was a network which provided a "mains voltage" ("line voltage" was a synonym for "mains voltage"). Thus, a rectifying circuit fed by a "line voltage network" instead of being fed by a "mains voltage" further limited the claim to a mains voltage deriving from a "line voltage network".

However, the added feature merely limited the protection conferred by the patent as granted without providing a technical contribution to the subject-matter of the claimed invention within the meaning of G 1/93. Thus, it could not be regarded as subject-matter extending beyond the content as originally filed. The use of a line voltage **network** had no particular technical effect and could never be considered as an inventive choice. The undisclosed added feature had no particular advantageous technical effect and could therefore give the patentee no

unwarranted advantage in further litigation. In particular, the added features did not cooperate with the other features of the claim in order to have an influence on the solution (the presence of harmonics in the waveform at the manipulator). Reference was made to decisions T 1066/98, T 112/95 and T 348/91 on how "technical contribution" had to be interpreted.

Reimbursement of the appeal fee was requested, since the Opposition Division did not provide the patentee with an opportunity to argue at oral proceedings on the technical relevance or technical contribution of the undisclosed added feature ("line voltage network"). This amounted to a violation of Article 113(1) EPC.

VII. The arguments of the respondent are mainly those on which the reasons for the present decision are based.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request - Article 123(2) EPC*
 - 2.1 The original application (WO-A-2004/107994) is concerned with an electronic scalpel with a rectifying circuit and an RF circuit for emitting a square current wave of predetermined amplitude and frequency. The description explains on page 2, lines 9 to 14 that the wave form is of relevance to transfer to the tissue to be coagulated the right amount of energy without collapse of the blood vessel. According to the original application, in particular original independent claim 4 and page 2, lines 32 to 33, the scalpel comprises "a *rectifying circuit (20) fed by the mains voltage,*

supplying a voltage (201) to a radio frequency circuit".

- 2.2 In contrast to this, the scalpel according to claim 1 of the main request comprises *"a rectifying circuit (20) fed by **a line voltage network**, supplying a voltage (201) to a radio frequency circuit"* [emphasis added by the Board].
- 2.3 According to established case law, an amendment will be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art.
- 2.4 The original application does not disclose any source of the mains voltage which feeds the rectifying circuit of the claimed electronic scalpel. In particular, it does not disclose a line voltage "network" (this feature had only been added to the application during examination proceedings). The original application is entirely silent as to the nature of the source of the mains voltage, or line voltage. Such an undisclosed source does not necessarily have to be a "network" as claimed, but may just as well be a local emergency power generator or a battery. Depending on the nature of the voltage source, the internal resistance of the source will vary, which may influence the quality factor of the claimed resonant electric circuit of the electronic scalpel.

- 2.5 The undisclosed feature of a line voltage "network" is therefore an added sound technical feature which further limits the electronic scalpel as disclosed in the application as filed.
- 2.6 Whilst the appellant did not dispute that this feature had been added to the application during the examination proceedings, it argued that it did not provide a "technical contribution" to the invention within the meaning of G 1/93. In this decision, the issue of an added feature limiting the protection conferred by the patent, and which did not provide a technical contribution to the invention, was found not infringe Article 123(2) EPC (Order, point 2.).
- 2.7 In the present case, however, as explained above, the added technical feature of a line voltage "network" is a sound technical limitation of the original subject-matter. In the Board's view, this technical limitation self-evidently provides a "technical contribution".
- 2.7.1 Contrary to one of the arguments put forward by the appellant, whether the added limiting technical feature contributes to an inventive step or not is irrelevant for the question of added subject-matter. In particular, during the life span of the patent, other prior art may become known for which the technical feature could prove to be of advantage to the patentee. As explained in T 384/91 (Reasons, point 5), which was cited by the appellant, prior-art documents should not be taken into account when deciding whether the added feature could give rise to an unwarranted advantage to the proprietor.
- 2.7.2 Moreover, following T 1066/98 (Reasons, point 4.5) cited by the appellant, it cannot be ruled out with a

sufficient degree of certainty that the added undisclosed feature may provide an advantageous technical effect giving the proprietor an unwarranted advantage in future litigation.

- 2.7.3 The appellant argued, moreover, with reference to T 112/95, that for a technical contribution there had to be a functional interaction between the added feature and the other elements solving the technical problem underlying the invention.

The Board rejects this argument for the reason that it would allow any undisclosed technical feature to be added to an application or a patent as long as the feature is perceived as not providing a functional interaction with other elements solving the technical problem underlying the invention.

- 2.8 As a consequence, the Board comes to the conclusion that claim 1 of the main request does not fulfill the requirements of Article 123(2) EPC.

3. *Auxiliary requests I to VII*

- 3.1 The rectifying circuit as defined in claim 1 of the main request is also defined in claim 1 of auxiliary requests II, IV and VI. Hence, for the reasons given above, these requests are not allowable under Article 123(2) EPC either.

- 3.2 The scalpel according to claim 1 of auxiliary requests I, III, V and VII comprises *"a rectifying circuit (20) fed by a mains voltage from a line voltage network, supplying a voltage (201) to a radio frequency circuit"*.

3.3 In so far as claim 1 of these auxiliary requests includes the feature of a line voltage "network" as the source of the mains voltage, the objection under Article 123(2) EPC given above applies mutatis mutandis to auxiliary requests I, III, V and VII.

4. *Reimbursement of the appeal fee*

Rule 103(1) (a) EPC stipulates as a precondition for reimbursement of the appeal fee that the appeal must be allowable. It is clear from the wording and purpose of the provision that "allowable" is to be understood as meaning that the Board follows the relief sought by the appellant, in other words that it allows the latter's requests.

Since this precondition is not fulfilled in the present case for the aforementioned reasons, the requested reimbursement 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