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**Datasheet for the decision  
of 19 December 2013**

**Case Number:** T 0429/12 - 3.2.08

**Application Number:** 02748481.5

**Publication Number:** 1404244

**IPC:** A61C1/08

**Language of the proceedings:** EN

**Title of invention:**

METHOD FOR MANUFACTURING A SUPRASTRUCTURE AND A CORRESPONDING  
DRILL JIG

**Patent Proprietor:**

Dental Vision BVBA

**Opponent:**

Nobel Biocare AB

**Headword:**

**Relevant legal provisions:**

EPC Art. 53(c), 100(a)  
EPC R. 81(1), 103(1)(a)

**Keyword:**

Grounds for opposition - discretion of opposition division  
Reimbursement of appeal fee - substantial procedural violation  
(no)  
Exceptions to patentability - method for treatment by surgery

**Decisions cited:**

G 0009/91, G 0001/95, G 0001/07, T 0836/08, T 0923/08,  
T 0266/07

**Catchword:**



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Case Number: T 0429/12 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 19 December 2013**

**Appellant:**  
(Patent Proprietor)

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**Respondent:**  
(Opponent)

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 15 December  
2011 revoking European patent No. 1404244  
pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman:** T. Kriner  
**Members:** M. Alvazzi Delfrate  
C. Schmidt

## **Summary of Facts and Submissions**

- I. By its decision given to the post on 15 December 2011 the opposition division revoked European patent No. 1 404 244.

The opposition division held that the subject-matter of the patent lacked novelty (main request then on file), was excluded from patentability under Article 53(c) EPC (auxiliary requests 1, 3 and 4 then on file) or did not comply with the requirements of Article 123(2) EPC (auxiliary request 2 then on file).

- II. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division on 20 February 2012, paying the appeal fee on the same day. The statement of grounds of appeal was filed on 25 April 2012.

- III. Oral proceedings before the Board of Appeal were held on 19 December 2013.

- IV. The appellant requested that the decision under appeal be set aside and the case be remitted to the first instance and that the appeal fee be reimbursed. As auxiliary requests the appellant requested that the decision under appeal be set aside, that the patent be maintained as granted or on the basis of one of auxiliary requests 1 to 5, all filed with letter of 25 April 2012, or on the basis of one of auxiliary request 6 or 7, both filed with letter of 19 November 2013.

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

V. Independent claims 1 and 8 of the **patent as granted** read as follows:

"1. Method for producing an aligning plate (3) with at least one aperture (4) for drilling a hole (5) in the bone of a lower or an upper jaw (1) through said aperture (4) for fixing an implant (9,10) in said bone, wherein the location of anatomical structures of said jaw (1) relative to at least one reference element (2) fixed to said bone is determined, whereby means are provided on the aligning plate (3) for enabling to fix the latter to the reference element (2) and whereby, taking into account the determined location of the anatomical structures, the position of said aperture (4) in the aligning plate (3) is determined in such a way that critical anatomical structures, such as nerve bundles, will not be touched during the drilling of said hole (5) when the aligning plate (3) is fixed to the reference element (2)."

"8. Method for producing a superstructure (7) provided with artificial teeth (8), which superstructure can be fitted on at least one implant (9,10), which is provided in the oral cavity of a person and is fixed in the bone of a lower or an upper jaw (1) and for producing an aligning plate (3) with at least one aperture (4) for drilling a hole (5) in the bone of said jaw (1) through said aperture (4) for fixing said implant (9,10) in said bone, wherein

- an impression is made of said jaw (1) with at least one reference element (2) that is fixed to the bone of the jaw (1), and

- a provisional model for said superstructure (7) is made on the basis of this impression,

- whereby a three-dimensional image is made of said jaw (1) together with this provisional model and said reference element (2), and whereby said three-dimensional image is processed electronically and the location of anatomical structures of said jaw (1) relative to said reference element (2) fixed to said bone is deduced from this three-dimensional image,

- whereby it is then determined at what position and according to what orientation said implant (9,10) can be placed in the jaw (1) without touching critical anatomical structures, such as nerve bundles, and on basis of this information, said aligning plate (3) is produced with said aperture (4) with a suitable orientation and diameter to allow said hole (5) to be drilled in the bone of the jaw through this aperture (4) in such a way that critical anatomical structures, such as nerve bundles, will not be touched during the drilling of said hole (5), whereby means are provided on the aligning plate (3) for enabling to fix the latter to the reference element (2) and

- whereby the abovementioned superstructure (7) is produced by means of a so-called rapid prototyping technique starting from said provisional model and from the desired position of the implant (9,10) relative to the reference element (2)."

Claims 1 and 8 of **auxiliary request 1** differ from claims 1 and 8 of the patent as granted by the addition (underlined) that the reference element

"has been" fixed to the bone.

Claims 1 and 8 of **auxiliary request 2** differ from claims 1 and 8 of the patent as granted by the additional feature that the reference element is

"not formed by a tooth"

Claims 1 and 7 of **auxiliary request 3** differ from claims 1 and 8 of the patent as granted by the additional feature that the reference element is

"formed by a screw"

Claim 1 of **auxiliary request 4** differs from claim 1 of the patent as granted by the addition that the aperture is for drilling a hole in the bone of a

"toothless" lower or upper jaw.

**Auxiliary request 5** differs from auxiliary request 4 in that also claim 8 contains the addition that the aperture is for drilling a hole in the bone of a

"toothless" lower or upper jaw.

Claims 1 of **auxiliary requests 6 and 7** correspond respectively to claim 8 of auxiliary request 1 and claim 7 of auxiliary request 3.

VI. The videos available under the following links have been referred to by the appellant:

V1: <http://www.youtube.com/watch?v=m5lucB29nlg;>

V2: <http://www.youtube.com/watch?v=SSoq3GSrqDI;>

V3: <http://www.youtube.com/watch?v=pG9SKo9psuY;> and

V4: <http://www.youtube.com/watch?v=afWexQCmbQs>.

VII. The appellant's arguments can be summarised as follows:

*Introduction of the ground of opposition under Article 53(c) EPC into the proceedings*

The ground of opposition under Article 53(c) EPC, which contrary to the opposition division's view was not the same ground of opposition as lack of novelty and inventive step, was introduced for the first time by the opposition division during the oral proceedings when considering the first auxiliary request then on file. However, the objection based on this ground was not caused by the amendments, since it would have been possible to raise it also in respect of the claims as granted. Moreover, this ground was not prima facie relevant, since the claims did not comprise an explicit step which could be regarded as a surgical step. This lack of relevance was also made clear by the fact that neither the opposition division nor the opponent raised objections under Article 53(c) EPC in the written proceedings. However, according to G 9/91 new grounds of oppositions could be introduced by the opposition division only if they were prima facie relevant. Therefore, the introduction of this ground of opposition constituted a substantial procedural violation.

Moreover, the fact that the objection under Article 53(c) EPC was raised for the first time during the oral proceedings, without any warning to that effect during the written proceedings, took the patent proprietor by surprise, so that its right to be heard had been



violated. This also represented a substantial procedural violation.

Hence, the objection under Article 53(c) EPC should be disregarded, the case should be remitted to the opposition division in a different composition and the appeal fee should be reimbursed.

*Patent as granted*

In any event, even if the objection based on Article 53(c) EPC were to be considered, it could not lead to the revocation of the patent. The step of fixing a reference element to the bone was not listed among the steps of the method according to claim 1 of the patent as granted. Since this method concerned the production of an aligning plate, the fixing of the reference element was a step to be carried out before the claimed method but not part of it. The situation was similar to that considered in decision T 266/07, where the introduction of a contrast agent was not considered to be part of the claimed method, despite the fact that this contrast agent was necessary to the acquisition of the images treated in that method.

Nor could decision T 923/08 lead to a different conclusion, since this decision dealt with a different situation and was in contradiction with decision T 836/08, which applied to the present case.

The present case was comparable to the situation considered in the Guidelines for Examination, G.II. 4.2, according to which the manufacture of prostheses or artificial limbs could be patentable, although the stump to which that prosthesis was to be applied

resulted from a surgical intervention, since this surgical operation was not part of the claimed method.

In summary, Article 53(c) EPC was not a hindrance to the patentability of the claimed method, since the step of fixing a reference element to the bone was not part of the claimed method.

Moreover, even if this step were considered to be part of the claimed method, there was no reason to revoke the patent. The step of fixing said element was namely a minor intervention of little invasiveness which did not involve substantial health risk. This step, which involved the fixation of a small screw to the bone surfaces was rather to be compared to safe treatments such as piercing, i.e. treatments which, in accordance with G1/07, were of a non-surgical nature. The videos under the links V1 to V4 which showed this treatment supported this opinion.

Therefore, Article 53(c) EPC could not justify the revocation of the patent as granted.

#### *Auxiliary requests*

The same considerations applied to the auxiliary requests.

VIII. The arguments of the respondent can be summarised as follows:

#### *Introduction of the ground of opposition under Article 53(c) EPC into the proceedings*

It was true that the ground of opposition under Article 53(c) EPC was raised by the opposition division for the

first time during the oral proceedings. However, it was within the power of the opposition division to raise a new ground of opposition under Rule 81(1) EPC. Therefore, there was no reason to disregard the objections raised under Article 53(c) EPC. Moreover, the appellant was obviously not taken by surprise, since no adjournment of the oral proceedings had been requested.

*Patent as granted*

The method according to claim 1 as granted made use of a reference element, for instance a screw, fixed to the bone of the jaw. Accordingly, it was essential to fix this element to the bone. Therefore, this step, which was carried out solely for the purposes of the claimed method, was part of this method.

Moreover, this step, which involved the insertion of a screw into the bone, was clearly of a surgical nature.

Hence, the claimed method was not patentable in view of Article 53(c) EPC. The decisions cited by the appellant were not applicable to the present case since they concerned different situations.

*Auxiliary requests*

The same considerations applied to the auxiliary requests.

**Reasons for the Decision**

1. The appeal is admissible.

2. Introduction of the ground of opposition under Article 53(c) EPC into the proceedings

2.1 The issue of exclusion from patentability under Article 53(c) EPC was raised for the first time at the oral proceedings before the opposition division.

Although Article 100(a) EPC makes reference to the requirements of novelty and inventive step and to the exceptions to patentability according to Article 53 EPC, these provisions form separate individual legal bases for objecting to the maintenance of a patent, i.e. different grounds for opposition (see decision G 1/95, OJ EPO 1996, 615, points 4.2 to 4.6 of the Reasons). Therefore, even though objections concerning lack of novelty and inventive step were raised already in the notice of opposition, the objection under Article 53(c) EPC introduced a fresh ground of opposition into the opposition proceedings.

2.2 According to decision G 9/91 (OJ EPO 1993, 408) an opposition division may, in cases where prima facie there are clear reasons to believe that such ground is relevant and would in whole or in part prejudice the maintenance of the European patent, of its own motion raise a ground for opposition not covered by the notice of opposition (see point 16 of the Reasons). These principles have been incorporated into the EPC 2000 in Rule 81(1) EPC, which provides that grounds for opposition not invoked by the opponent may be examined by the opposition division of its own motion if they would prejudice the maintenance of the European patent. Accordingly, it was within the discretionary power of the opposition division to introduce a fresh ground of

opposition based on the provisions of Article 53(c) EPC.

- 2.3 If the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in an appeal, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way as the department of first instance. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion if the board concludes it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see Case Law of the Boards of Appeal of the European Patent Office, 7th edition 2013, IV.E. 3.6).

In the present case, albeit not literally stated in the decision under appeal, it is apparent that the opposition division considered that this ground was prima facie highly relevant and would prejudice the maintenance of the patent, as it rejected the first auxiliary request on this basis (see also the minutes, page 2, first paragraph). Therefore, the division has exercised its discretionary power according to the principles set out in Rule 81(1) EPC and G 9/91. Consequently, the mere fact that the opposition division introduced of its own motion the fresh ground of opposition under Article 100(a) in combination with Article 53(c) EPC does not constitute a substantial procedural violation.

2.4 Nonetheless, it remains to be established whether or not the introduction of this ground at the oral proceedings without any warning to that effect during the written proceedings deprived the appellant of its right to be heard.

It is clear from the minutes (see page 2) that after the opposition division raised this issue the oral proceedings were interrupted. It is true that after the break the appellant objected that this new ground had not been introduced before. It did not, however, request an adjournment of the oral proceedings or even a further interruption of the oral proceedings to prepare its reply to this objection. On the contrary, the appellant argued on the substance of the Article 53(c) EPC objection. Hence, the appellant was not deprived of its right to be heard, since it had the opportunity to present its comments both on the introduction of this fresh ground of opposition and on the substance of the objection based on it.

2.5 Therefore, the introduction of the ground of opposition under Article 53(c) EPC during the oral proceedings did not represent a substantial procedural violation. Accordingly, there is no reason to remit the case to the opposition division and reimburse the appeal fee, and the objection under Article 53(c) EPC has to be considered also in the appeal proceedings.

3. Patent as granted

3.1 Article 53(c) EPC stipulates that methods for treatment of the human or animal body by surgery are not patentable. In order for this exclusion to apply, it is not necessary that a claim be directed to the treatment by surgery as such or even that this treatment is one

of the method steps listed in the claim; it is sufficient that the claimed method encompasses such a step (see decision G1/07, OJ EPO 3/2011, 134; points 3.2 and 4.1 of the Reasons).

Whether a given treatment is encompassed in a claimed method and whether it represents a surgical treatment has to be assessed on a case-by-case basis.

3.2 In the present case, claim 1 as granted is directed to a method for producing an aligning plate for drilling a hole in the bone of a jaw wherein the location of anatomical structures of the jaw relative to at least one reference element fixed to the bone is determined. In the preferred embodiment of this method the reference element is a screw fixed in the bone of the jaw (see paragraph [0011] and claim 2).

3.3 The videos to which the links V1 to V4 have been provided show that a screw may be fixed by a dentist to the bone of his own jaw. However, they do not demonstrate that this step is not a treatment by surgery, because it is possible, if necessary, for a doctor to carry out some surgical interventions on himself.

As a matter of fact the step under consideration is an invasive step representing a substantial physical intervention on the body, since it involves the fixation of a screw in the bone of a jaw. Moreover, as acknowledged in the patent in suit (see for instance paragraph [0002] and claim 1) the jaw exhibits anatomical structures which should not be damaged, such as nerve bundles or blood vessels. Therefore, the operation of fixing a screw in the bone of the jaw

entails a substantial health risk and cannot be regarded as a safe treatment, such as piercing.

Accordingly, the Board is satisfied that the step of fixing the reference element in the bone jaw is of a surgical nature.

- 3.4 It remains to be established whether the claimed method encompasses this step. The answer to this question is not apparent from the wording of the claim, which neither explicitly defines fixing the reference element or a screw as a step of the claimed method nor explicitly excludes it.

Under these circumstances it is appropriate to assess, inter alia with the help of the description, whether or not this step belongs to the claimed activity, namely the production of an aligning plate with an aperture for drilling a hole in the bone of a jaw.

The provision of a reference element fixed to the bone, preferably in the form of a screw, is not only required for the claimed method, which uses this element to determine the location of anatomical structures of the jaw, but represents the gist of the invention, since it makes possible to achieve the advantages over the prior art acknowledged in the patent (see for instance paragraph [0042] of the patent in suit).

Moreover, the step of fixing the reference element to the bone serves the sole purpose of using this element in the production of the aligning plate. In other words, this step would not be carried out if no aligning plate were to be produced.



Therefore, the fixation of this reference element to the bone is a step that definitely belongs to, in other words is encompassed by, the claimed production of an aligning plate.

3.5 The decisions cited by the appellant fail to convince the Board to the contrary.

3.5.1 Claim 1 underlying decision T 836/08 of 12 May 2011 concerned a method for tracking the position of the distal end of a bone guide wire, using a medical optical tracking and navigation system. It is true that the board found that, while this meant that a reference apparatus had to be attached to, and the wire introduced into, the bone, these steps were not part of the claimed method (see point 3 of the Reasons).

However, the conclusions drawn in this decision are different from those reached in decision T 923/08 of 2 August 2011. In the latter decision the board concluded that where a method for determining measurements of the human or animal body necessarily entailed a surgical step consisting of fixing to the human or animal body a measuring device indispensable for performance of the method, that step had to be deemed an essential feature of the method which was covered by such a method, even if none of the claimed method features expressly related to this step (see point 2.3 of the Reasons).

When these decisions are considered together, it is clear that each case must be carefully assessed on its own merits. Hence, the conclusions of case T 836/08, which deals with the operation of a device, are not applicable to the present situation, which concerns the production of an aligning plate.

3.5.2 Nor can the conclusions drawn in case T 266/07 of 25 June 2010 be applied to the present case. The patent application considered in that case claimed a method for producing a magnetic resonance angiogram of selected vasculature in a subject, wherein a contrast agent has previously been introduced into the selected vasculature. Therefore, the step of introducing the contrast agent not only was not functionally related to the operation of the magnetic resonance imaging (MRI) system to which the claim was directed, but also, contrary to the present case, was explicitly excluded from it by the claim wording.

3.5.3 The presently claimed method is also not comparable to the manufacture of prostheses or artificial limbs to be applied on a stump mentioned in the Guidelines for Examination, as submitted by the appellant. While it is accepted that in some cases the stump to which an artificial limb is applied may result from a surgical treatment, this treatment is primarily aimed at maintaining the health of the patient without necessarily serving to produce the prosthesis. By contrast, in the present case, as explained above, the sole purpose of fixing a reference element to the bone is the production of the aligning plate.

3.6 Accordingly, the method of claim 1 of the main request encompasses a step which represents a method of treatment of the human body by surgery. Therefore, it is excluded from patentability in view of Article 53(c) EPC.

4. Auxiliary requests

The same reasons apply, *mutatis mutandis*, to claim 1 of each of the auxiliary requests. Therefore, these requests too are not allowable in view of Article 53(c) EPC.

## Order

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

The appeal is dismissed.

The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



V. Commare

T. Kriner

Decision electronically authenticated