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**Datasheet for the decision
of 11 August 2014**

Case Number: T 2294/13 - 3.2.02
Application Number: 05002421.5
Publication Number: 1561420
IPC: A61B5/06, A61B1/06, A61B19/00
Language of the proceedings: EN

Title of invention:
Lesion identification system for surgical operation

Applicant:
Olympus Corporation

Headword:

Relevant legal provisions:
EPC Art. 109(1), 111(1), 123(2)

Keyword:
Claims amended on appeal overcoming the grounds for refusal by
the Examining Division

Interlocutory revision - department of first instance should
have rectified decision (yes)

Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:
T 0139/87, T 0047/90, T 0794/95, T 0726/10, T 1060/13

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 2294/13 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 11 August 2014

Appellant: Olympus Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 May 2013
refusing European patent application
No. 05002421.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The applicant has appealed the Examining Division's decision, dispatched on 29 May 2013, to refuse European patent application No. 05 002 421.5.
- II. The Examining Division based its decision on the ground that claims 1, 2 to 4 and 6 of the only request on file contained subject-matter which extended beyond the content of the application as filed, contrary to Article 123(2) EPC.

This request comprised claims 1 to 19, of which the only independent claim, i.e. claim 1, read as follows:

"A lesion identification system for surgical operation, comprising

- a light marker (12 (12a, 12b, 12c) / 212) adapted to be discharged from a medical instrument (66, 72) inserted in the vicinity of a lesion inside an organ of an organism to be targeted and to be indwelt in the vicinity of the lesion inside the organ, the light marker emitting light whose wavelengths belong, at least partly, to a range of wavelengths of near-infrared range, and
- a location-identifying device (14) adapted to detect the light, emitted from the light marker, at an outside of the organ to identify a location of the lesion,

characterized in that

- the location-identifying device is an endoscope (14) provided with an inserter section having an end and formed to emit visible light outside through the end, the end being adapted to be located at an outside of the organ within the organism;

an image pickup element (58) arranged at the end of the inserter section of the endoscope and adapted to receive both of light of the visible light reflected by the organ and light emitted from the light marker indwelt in the vicinity of the lesion inside the organ; and

an image processor adapted to process both the visible reflected light and the light coming from the light marker and adapted to display an image of the visible reflected light and an image of the light coming from the light marker on a monitor (80) in a superimposed manner."

III. The Examining Division argued that there was no basis in the application as filed for the introduction in claim 1 of the feature "an image pickup element (58) arranged at the end of the inserter section of the endoscope and adapted to receive both of light of the visible light reflected by the organ and light emitted from the light marker indwelt in the vicinity of the lesion inside the organ".

A disclosure of this feature could be found in claim 8 as filed, which however further defined "an image pickup device operative to generate an image". The omission of the image pickup device in claim 1 constituted an unallowable intermediate generalisation.

Claims 2 to 4 and 6 also introduced unallowable intermediate generalisations.

IV. The notice of appeal was received on 3 July 2013 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 19 September 2013.

V. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, in the alternative, of one of the first to fifth auxiliary requests, all filed with letter dated 19 September 2013.

The appellant also requested oral proceedings "as a last auxiliary measure".

Claim 1 of the main request reads as follows (additions to claim 1 of the request on which the impugned decision was based are underlined by the Board):

"A lesion identification system for surgical operation, comprising
a light marker (12 (12a, 12b, 12c) / 212) adapted to be discharged from a medical instrument (66, 72) inserted in the vicinity of a lesion inside an organ of an organism to be targeted and to be indwelt and to be fixed in the vicinity of the lesion inside the organ by means of a fixing means, the light marker emitting light whose wavelengths belong, at least partly, to a range of wavelengths of near-infrared range, and
a location-identifying device (14) adapted to detect the light, emitted from the light marker, at an outside of the organ to identify a location of the lesion,
characterized in that
the location-identifying device is an endoscope (14) provided with an inserter section having an end and formed to emit visible light outside through the end, the end being adapted to be located at an outside of the organ within the organism;
an image pickup element (58) arranged at the end of the inserter section of the endoscope and adapted to receive both of light of the visible light reflected by

the organ and light emitted from the light marker indwelt in the vicinity of the lesion inside the organ, and an image pickup device operative to generate an image from the light picked up by the image pickup element for display on a monitor,

an image processor adapted to process both the visible reflected light and the light coming from the light marker and adapted to display an image of the visible reflected light and an image of the light coming from the light marker on a monitor (80) in a superimposed manner."

The main request further comprises claims 2 to 15, all of which are dependent claims.

VI. The appellant's arguments, as far as they are relevant for the present decision, may be summarised as follows:

Independent claim 1 of the main request included the feature of claim 8 as originally filed that the image pickup device was operative to generate an image from the reflected light picked up by the pickup element for display on a monitor and was based on the original application documents.

Claims 2 to 4 and 6 of the request on which the impugned decision was based were no longer present.

Hence, the main request complied with Article 123(2) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. According to Article 109(1) EPC, "If 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, thereby allowing an applicant to have the case examined by two instances (for example T 139/87, T 47/90, T 794/95 and more recently T 726/10 and T 1060/13).
4. The invention as defined in claim 1 of the main request is directed to a lesion identification system useful during a surgical procedure on an organ of an organism to be targeted. In essence, the system comprises a light marker adapted to be introduced in the vicinity of a lesion inside the organ, an endoscope, an image pickup element, an image pickup device and an image processor for generating an image of the lesion on a monitor.
5. As the appellant has pointed out, the claimed lesion identification system comprises in particular the image pickup device as defined in claim 8 as filed. Its absence in claim 1 of the request on which the impugned decision was based was regarded by the Examining Division as giving rise to non-compliance with Article 123(2) EPC.

Hence, the objection under Article 123(2) EPC against the then pending claim 1, as formulated in the impugned decision, does not apply to claim 1 of the main request.

6. Claims 2 to 4 and 6 of the request on which the impugned decision was based are not present in the main request.

Hence, the objections to those claims as formulated in the impugned decision do not apply to the main request either.

7. It follows that all the objections on which the Examining Division based its refusal of the application have been overcome by amendment in the present main request.
8. For this reason, the Examining Division should have considered the appeal to be admissible and well founded and should have rectified its decision in accordance with Article 109(1) EPC.
9. Under Article 111(1) EPC, the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. When making its choice, the Board must bear in mind that a party should normally have the opportunity to have its case examined by two instances. The Board therefore decides to remit the case to the department of first instance for further prosecution.
10. The auxiliary requests need not be dealt with by the Board. Nor is it necessary to consider the appellant's

request for oral proceedings, since the present decision allows the appeal and the appellant may still have oral proceedings before the Examining Division, should the circumstances so require.

11. The case is hence remitted for the Examining Division to examine whether the main request and, if necessary, the auxiliary requests fulfill all the requirements of the EPC.

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

Decision electronically authenticated