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**Datasheet for the decision
of 30 June 2015**

Case Number: T 1546/14 - 3.2.08

Application Number: 04755739.2

Publication Number: 1633272

IPC: A61C19/06

Language of the proceedings: EN

Title of invention:
PERIODONTAL MEDICAMENT DELIVERY TRAY

Applicant:
Keller, Duane

Headword:

Relevant legal provisions:
EPC Art. 54

Keyword:
Novelty - after amendment

Decisions cited:

Catchword:



Beschwerdekammern
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Chambres de recours

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Case Number: T 1546/14 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 30 June 2015

Appellant: Keller, Duane
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Representative: DTS Patent- und Rechtsanwälte
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 29 January 2014 refusing European patent application No. 04755739.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman T. Kriner
Members: M. Alvazzi Delfrate
D. T. Keeling

Summary of Facts and Submissions

I. By its decision posted on 29 January 2014 the examining division refused European patent application No. 04755739.2. The refusal was based on Article 53(c) EPC, Article 123(2) EPC and on lack of novelty in view of

D1: WO -A- 02/38068.

II. The appellant (applicant) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.

III. Oral proceedings before the Board of Appeal were held on 30 June 2015.

IV. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the main request filed at the oral proceedings before the Board or, as an auxiliary measure, on the basis of one of the requests filed as main request and auxiliary requests 1-10 filed with letter of 28 May 2014 (now auxiliary requests 1 to 11).

Moreover, the refund of the appeal fee is requested.

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

"A method for manufacturing a tray for applying medication to at least certain of a patient's teeth and to gums proximate said teeth comprising the steps of:
(a) making a female impression of the patient's teeth and adjacent gums supporting said teeth from a suitable hardenable material;

(b) making a male model of the patient's teeth and surrounding gums from said female impression, said male model being formed of a suitable hardenable material;

(c) at the intersection of the gums and at least certain of the teeth of said male model, removing an amount of said hardenable material from said male model proximate the juncture of each of said teeth and the gum surrounding said teeth thereby to form at least one trough;

(d) forming a tray of moldable resilient material molded over said male model having at least one recess representative of said teeth with a bead of said resilient material formed in said trough forming a seal;

(e) applying a medication and a propulsion agent into said recess of said tray;

wherein the length of a lingual extension of the tray beyond the seal is adjusted according to the stage of periodontal disease suffered by the patient such that the propulsion agent applies less force to a patient with more advanced periodontal disease, wherein the periodontal disease is classified by the periodontal bleeding index, wherein for patients with class IV periodontal disease the lingual extension is 0-1 mm, for patients with class III periodontal disease the lingual extension is 1-2 mm, for patients with class II periodontal disease the lingual extension is 2-3 mm and for patients with class I periodontal disease the lingual extension is 3 mm or more."

VI. The arguments of the appellant can be summarised as follows:

Claim 1 satisfied the requirements of Article 123(2) EPC, since it was based on originally filed claim 11 and page 14 of the description.

Moreover, its subject-matter was novel, because D1 did not disclose the adjustment of the length of the lingual extension defined in the claim.

Finally, at the oral proceedings before the Examining Division the applicant was allowed to file only one auxiliary request, despite the fact that the subject of the proceedings had changed and that a new representative had been appointed shortly before the oral proceedings. This constituted a substantial procedural violation which justified the refund of the appeal fee.

Reasons for the Decision

1. Article 123(2) and Article 53(c) EPC

Claim 1 is essentially based on claim 11 as originally filed (with the deletion of the therapeutic step (f) carried out after the manufacture of the tray) and on the passage on page 14, lines 17 to 25 of the description. Moreover, the claim clarifies that the "lingual extension" is the lingual extension of the tray beyond the seal, as can be clearly seen in the drawings. As to the fact that the periodontal disease is classified by the bleeding index, a basis for this definition is provided on page 13, second paragraph. Therefore, claim 1 does not extend beyond the content of the application as originally filed.

Dependent claims 2 to 4 correspond to claims 12 to 14 as originally filed.

Accordingly, the requirements of Article 123(2) EPC are satisfied.

Moreover, since the therapeutic step (f) present in claim 11 as originally filed has been deleted from the claim the claimed method no longer falls under the exception to patentability according to Article 53(c) EPC.

2. Novelty

D1 discloses a method comprising the steps (a) to (e) defined in claim 1 (see claims 8 and 11). However, it does not disclose that the length of a lingual extension of the tray beyond the seal is adjusted according to the stage of periodontal disease suffered by the patient for whom the tray is produced such that the propulsion agent applies less force to a patient with more advanced periodontal disease, wherein the periodontal disease is classified by the periodontal bleeding index, wherein for patients with class IV periodontal disease the lingual extension is 0-1 mm, for patients with class III periodontal disease the lingual extension is 1-2 mm, for patients with class II periodontal disease the lingual extension is 2-3 mm and for patients with class I periodontal disease the lingual extension is 3 mm or more. Hence, the subject-matter of claim 1 is novel.

3. Request to refund the appeal fee

At the oral proceedings before the Examining Division the appellant submitted an auxiliary request which was admitted into the proceedings. Although the minutes comprise a statement that the examining division intended to admit only one auxiliary request (point 8)

there is no trace of a request to file a further auxiliary request. Rather, the appellant requested to continue the procedure in writing (point 13). The refusal to grant this request does not constitute a procedural violation, since oral proceedings are normally intended to decide a case.

Moreover, the auxiliary request was not only found to contravene the requirements of Article 123(2) EPC but also to lack novelty in view of D1, an objection which was already present in the communication annexed to the summons to oral proceedings. Hence, there was no change in the subject-matter of the proceedings which justified the submission of a further auxiliary request. The change of representative is in this respect immaterial, since the new representative is expected to take over the case where it was left by the previous representative. Accordingly, even a refusal to allow the submission of a further auxiliary request (of which no trace is present in the minutes) could not have amounted to a substantial procedural violation.

Summarising, the Board sees no reason for a refund of the appeal fee.

4. Claim 1 of the main request is substantially different from the claims of the requests underlying the appealed decision, which did not mention the dependency of the length of the lingual extension now defined in the claim. Moreover, the decision under appeal did not deal with the issue of inventive step. Under these circumstances the Board considers it appropriate to exercise its discretion under Article 111(1) EPC by remitting the case to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of the Main Request submitted at the oral proceedings before the Board of Appeal.
3. The request for the reimbursement of the appeal fee is dismissed.

The Registrar:

The Chairman:



V. Commare

T. Kriner

Decision electronically authenticated