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**Datasheet for the decision
of 30 June 2021**

Case Number: T 1229/15 - 3.4.01

Application Number: 06825064.6

Publication Number: 1937352

IPC: A61N1/36

Language of the proceedings: EN

Title of invention:

SUB-THRESHOLD STIMULATION TO PRECONDITION NEURONS FOR SUPRA-
THRESHOLD STIMULATION

Patent Proprietor:

Second Sight Medical Products, Inc.

Opponent:

Pixium Vision SA

Headword:

Second Sight Medical Products / Sub-threshold stimulation

Relevant legal provisions:

EPC Art. 123(2)
RPBA 2020 Art. 12(4)

Keyword:

Amendments - allowable (no)

Decisions cited:

T 0471/08



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Case Number: T 1229/15 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 30 June 2021

Appellant: Second Sight Medical Products, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 7 April 2015
revoking European patent No. 1937352 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chair P. Scriven
Members: T. Zinke
C. Almberg

Summary of Facts and Submissions

- I. An opposition was filed against European Patent 1937352, based on Article 100(a) EPC in combination with Articles 54 and 56 EPC, based on Article 100(b) EPC, and based on Article 100(c) EPC.
- II. The Opposition Division revoked the patent, since all then pending requests failed to comply with Article 123(2) EPC.
- III. The proprietor appealed the decision.
- IV. With the statement setting out the grounds of appeal, the proprietor requested that the decision be set aside and that the case be remitted to the Opposition Division for further prosecution based on claim sets filed at the same time for a main request or one of auxiliary requests 1 to 19.
- V. In response to the proprietor's appeal, the opponent requested rejection of the appeal.
- VI. Both parties conditionally requested oral proceedings.
- VII. The Board arranged to hold oral proceedings, and, together with the summons, issued a communication under

Article 15(1) RPBA 2020, providing its preliminary opinion.

VIII. In response, both parties withdrew their requests for oral proceedings. The Board cancelled the oral proceedings.

IX. Claim 1 of the proprietor's main request reads as follows:

*A neural stimulator comprising:
means for providing a first supra-threshold pulse (38) on a stimulating electrode suitable to contact neural tissue;
means for providing a first sub-threshold pulse (46) on an electrode near said stimulating electrode, wherein the first sub-threshold pulse is simultaneous with the first supra-threshold pulse and said electrode near said stimulating electrode being suitable to contact neural tissue;
means for providing a second supra-threshold pulse (36) on said stimulating electrode; and
means for providing a second sub-threshold pulse (48) on said electrode near said stimulating electrode, wherein the first sub-threshold pulse (46) and the first supra-threshold pulse (38) are charge balanced by following pulses and the first and second supra-threshold pulses are of opposite polarity.*

- X. With the statement of grounds of appeal, the appellant filed auxiliary requests 1 to 19, including various amendments in different combinations, in order to overcome objections that were raised during the opposition proceedings at first instance. With regard to this decision, only the amendment common to all of auxiliary requests 4 to 19 is relevant, i.e. the one which replaces "electrode near said stimulating electrode" with "electrodes near to and surrounding said stimulating electrode". The further amendments are not relevant.

Reasons for the Decision

The main request

1. Claim 1 of the main request combines the embodiment of a method depicted in Figure 3 of the original application (described on page 9, lines 12 to 24), with original device claim 17, i.e. with an "electrode near said stimulating electrode". A combination of these two parts of the original application, however, is not directly and unambiguously derivable, because these parts of the originally filed application disclose different and non-combinable embodiments.
2. The method of Figure 3 and page 9, lines 12 to 24 can not be performed by the device claimed in original claims 13 and 17. The device only uses two electrodes (a stimulating electrode and an electrode near said stimulating electrode). The method, however, needs at least three electrodes (a stimulating electrode and

surrounding electrodes (plural) (cf. page 9, lines 15, 18, 22, 24).

3. The appellant argued (cf. statement setting out the grounds of appeal, sections 4.5 to 4.8), that a device might be implicitly disclosed, when only a method is described (as in Figure 3 and on page 9, lines 12 to 24), referring to T 471/08.
4. This argument, however, is not relevant to the present case, because the device defined in claim 1 of main request is not a device adapted to performing the method of Figure 3 and page 9, lines 12 to 24, due to the different number of electrodes involved.
5. Moreover, the electrodes in both embodiments are characterized by different relative positions with respect to the stimulating electrode. Whereas the method uses "surrounding" electrodes, the device claimed uses a "near" electrode. "Surrounding" and "near", however, describe different geometrical relations to the stimulating electrode. Surrounding electrodes are not necessarily near the stimulating electrode, and a near electrode does not necessarily surround.
6. Consequently, the main request is not allowable, because the amendments to independent claim 1 of the main request extend beyond the content of the originally filed application (Article 123(2) EPC).

Auxiliary requests

7. The auxiliary requests were submitted for the first time on appeal. Their admission is at the discretion of the Board (Article 12(4) RPBA 2007).

Auxiliary requests 1 to 3

8. Independent claim 1, in each of auxiliary requests 1 to 3, includes the same feature as the main request with regard to "electrode near said stimulating electrode", combining the embodiment of original Figure 3 with the embodiment of original claim 17. Hence, the same objection as discussed above with regard to the main request applies. Thus, with these requests, no serious attempt was made to overcome this objection to the main request (see appealed decision, point 3.1; cf. Case Law of the Boards of Appeal, 9th ed., V.A.4.12.1). Consequently, auxiliary requests 1 to 3 were not admitted into the appeal proceedings (Article 12(4) RPBA).

Auxiliary requests 4 to 19

9. Independent claim 1, in each of auxiliary requests 4 to 19, was amended (as compared to claim 1 of the main request) by replacing "electrode near said stimulating electrode" by "electrodes near to and surrounding said stimulating electrode".
10. As discussed above, the terms "near to" and "surrounding" describe different geometrical relations to the stimulating electrode. There is no disclosure in the application as originally filed of electrodes that

are, at the same time, both near and surrounding said stimulating electrode. Hence, this amendment - while trying to overcome the objection against claim 1 of the main request - raises a further issue under Article 123(2) EPC. For that reason, auxiliary requests 4 to 19 are not admitted into the appeal proceedings (Article 12(4) RPBA).

Right to be heard (Article 113(1) EPC)

11. The reasons for the present decision are all mentioned in the Board's preliminary opinion in the communication under Article 15(1) RPBA 2020, to which the appellant made no substantive response. The Board sees no reason to change its opinion as set out in the communication.

Conclusion

12. With no allowable request on file, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



D. Meyfarth

P. Scriven

Decision electronically authenticated