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Datasheet for the decision of 23 July 2018

Case Number: T 2122/15 - 3.2.08

Application Number: 10817719.7

Publication Number: 2477586

IPC: A61F7/00

Language of the proceedings: EN

Title of invention:
ALTERING TEMPERATURE IN A MAMMALIAN BODY

Applicant:
Board of Regents, The University of Texas System

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 84

Keyword:
Novelty
Inventive step
Claims - clarity (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
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Beschwerdekammern

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Case Number: T 2122/15 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 23 July 2018

Appellant: (Applicant)	Board of Regents, The University of Texas System 201 West Seventh Street Austin, TX 78701 (US)
Representative:	Bingham, Ian Mark The IP Asset Partnership Limited Prama House 267 Banbury Road Oxford OX2 7HT (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 3 June 2015 refusing European patent application No. 10817719.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	C. Herberhold
Members:	M. Alvazzi Delfrate
	Y. Podbielski

Summary of Facts and Submissions

I. By its decision posted on 3 June 2015 the examining division refused European patent application No. 10817719.7.

The examining division denied novelty and/or inventive step for all the requests on file in view of document

D6: WO -A- 2008/094485.

Furthermore (under "additional remarks") the examining division raised an objection of lack of clarity.

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

III. In the statement of grounds of appeal 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 one of auxiliary requests 1-4, all filed with letter of 9 October 2015. Oral proceedings were requested as a precautionary measure in the event that the Board considered dismissing the appeal or otherwise refusing the application.

IV. With communication of 9 May 2018 the Board set out its preliminary opinion. The objections raised in the decision under appeal were not found persuasive.

However, the feature that the heating, cooling and warming devices are configured to "only" apply heat to the peripheral thermoregulatory control tissue or cooling or warming stimulus to the glabrous tissue was found to lack clarity and to contravene the

requirements of Article 123(2) EPC. The Board also communicated that, in case of the submission of a request meeting said objections, a remittal of the case to the examining division for further prosecution was contemplated, because D6 was not considered to represent the closest prior art.

V. With letter of 5 July 2018 the appellant filed a new main request, wherein the objected word "only" had been removed. The appellant maintained the auxiliary requests filed with the statement of grounds and the precautionary request for oral proceedings in the event that the Board considered dismissing the appeal or otherwise refusing the application.

VI. Claims 1 and 2 of the **main request** (as filed with letter dated 5 July 2018) read as follows:

"1. A system for cooling the core body temperature of a subject, comprising:
a. a heating device (202) configured to apply heat to peripheral thermoregulatory control tissue of the subject, wherein the applied heat increases or maintains perfusion of blood in glabrous tissue of the subject;
b. a cooling device (204, 301, 404, 406) configured to apply a cooling stimulus to the glabrous tissue; and
c. the heating device (202) and cooling device (204, 301, 404, 406) are discrete and configured for simultaneous operation,

wherein the peripheral thermoregulatory control tissue is the tissue of the cervical spinal region and/or lumbar spinal region, and

wherein the glabrous tissue is a palmar region, a plantar region and/or an area of glabrous skin on the face of the subject."

"2. A system for warming the core body temperature of a subject, comprising:
a. a heating device (202) configured to apply heat to peripheral thermoregulatory control tissue of the subject, wherein the applied heat increases or maintains perfusion of blood in glabrous tissue of the subject;
b. a warming device (204, 301, 404, 406) configured to apply a warming stimulus to the glabrous tissue; and
c. the heating device (202) and warming device (204, 301, 404, 406) are discrete and configured for simultaneous operation,
wherein the peripheral thermoregulatory control tissue is the tissue of the cervical spinal region and/or lumbar spinal region, and
wherein the glabrous tissue is a palmar region, a plantar region and/or an area of glabrous skin on the face of the subject."

The auxiliary requests have no bearing on the present decision.

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

D6 did not disclose the combination of devices of either of claims 1 and 2. Hence, the claimed subject-matter was novel.

An inventive step was also provided because the person skilled in the art seeking to manipulate the core temperature would not have considered D6, which was focused on muscle healing.

The use of the terms "heating" and "warming" in claim 2 made a distinction between two devices both providing thermal energy to the body and did not cause any lack of clarity.

Finally, a remittal was not considered to be appropriate, since the only other relevant document was D4 (GB -A- 1,095,988), which had been considered both by the examining division and by the Board (in its preliminary opinion).

Reasons for the Decision

1. Novelty and inventive step in view of D6

1.1 D6 relates to a device for providing vibration together with temperature modulation (paragraph [0007]). The temperature modulating component may take the form of a heat or cold pack (paragraph [0010]). Several examples of other heating devices are also disclosed (paragraphs [0010] and [0011]). Thus, D6 discloses a system suitable for warming the core body temperature of a subject.

D6 mainly describes the application of one device to a body part. Among the examples of devices disclosed in D6 there are
- a device adapted to surround the hip and waist area (Figures 8A and 8B), where hot or cold packs 830 can be applied;
- a full or partial glove (Figure 9), which may comprise a cold or heat pack not shown in the drawing (paragraph [0048], last sentence);

- and a device adapted to surround the ankle region (Figure 4), wherein hot or cold packs can be applied in pockets 420, not located directly on the plantar region.

None of the shown devices apply a warming stimulus to the glabrous tissue on the face of a subject. Whether the devices of Figure 9 and Figure 4 apply such a stimulus to the palmar or plantar region of the subject depends on whether (a) a hot pack is used and (b) the hot pack is located in contact with said region or in its proximity but with enough heating power to reach said region.

D6 mentions the possibility of using multiple devices located on different areas of a person only in paragraph [0053]. In the sole example mentioned the user wears a knee brace and an ankle brace.

In order to arrive at the subject-matter of claim 2 the reader of D6 should have:
(i) selected the sole embodiment with multiple devices;
(ii) chosen a combination of the device of Figure 8 and 8B with the device of Figure 9 or Figure 4 (a combination which is not explicitly disclosed in D6);
(iii) chosen for both devices an embodiment with one or more hot packs;
(iv) located the hot packs in a way as explained above so as to apply a warming stimulus to the palmar or plantar glabrous tissue according to the claim.

In view of the multiple selections required, a system according to claim 2 cannot be considered directly and clearly disclosed in D6. Therefore, D6 is not novelty-destroying for claim 2.

1.2 For analogous reasons this finding applies also to claim 1. In addition, to arrive at claim 1 one would further have to control the combination of cold pack on the hand or foot with the hot pack on the back in a way which results in cooling the core body temperature.

Thus, D6 is not novelty-destroying for claim 1 either.

1.3 It was non-obvious to modify the system of D6 in the sense of claim 1 or claim 2 to regulate the core body temperature, since D6 is not directed to heating or cooling the core body temperature but rather to the treatment of injury or discomfort, for instance in the case of pain, swelling and inflammation (paragraphs [0001] and [0002]).

2. Main request - Clarity

The appealed decision comprises also (under "Additional remarks") a clarity objection in respect of the use in claim 2 of the wordings "heating device" and "warming device". The Board is of the view that by these wordings it is clear that two different devices are meant, which are both adapted to provide heat to the body. Hence, no lack of clarity is seen in this respect.

3. Remittal to the opposition division

As explained above, D6, the sole document considered in the decision under appeal, is not directed to cooling or heating the core body temperature. Hence, it cannot represent the closest prior art starting from which inventive step of claims 1 and 2 has to be assessed.

The appellant was of the view that the only other relevant prior art was D4: GB -A- 1,095,988 which had been considered both by the examining division and by the Board in their respective communications. However, no decision on inventive step starting from D4 has been taken by the examining division. Moreover, D4 could at most be regarded as the closest prior art for claim 2 because it does not relate to a system for cooling the core body temperature but rather to the application of hyperthermia.

Therefore, in agreement with the review function of the appeal proceedings, the Board considers it appropriate to remit the case to the examining division for further prosecution, so that inventive step of claims 1 and 2 can be assessed starting from the closest prior art.

Since the appellant has requested oral proceedings only in the event that the Board considered dismissing the appeal or otherwise refusing the application, the present decision can be taken in writing.

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.

The Registrar: The Chairman:

C. Moser C. Herberhold

Decision electronically authenticated