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**Datasheet for the decision
of 1 March 2018**

Case Number: T 0903/16 - 3.2.04

Application Number: 06770668.9

Publication Number: 1885434

IPC: A01M1/20, A01K13/00, A61L2/00

Language of the proceedings: EN

Title of invention:
ECTOPARASITE ERADICATION METHOD AND DEVICE

Applicant:
University of Utah Research Foundation

Headword:

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

Keyword:
Amendments - added subject-matter (no)

Decisions cited:
G 0002/10

Catchword:



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Case Number: T 0903/16 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 1 March 2018

Appellant: University of Utah Research Foundation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 11 November
2015 refusing European patent application No.
06770668.9 pursuant to Article 97(2) EPC**

Composition of the Board:

Chairman G. Martin Gonzalez
Members: E. Frank
T. Bokor

Summary of Facts and Submissions

- I. The appellant (applicant) filed notice of appeal, received on 19 January 2016, against the decision of the Examining Division posted on 11 November 2015 refusing European patent application No. 06 770 668.9 pursuant to Article 97(2) EPC and at the same time paid the prescribed fee. The statement setting out the grounds of appeal was received on 21 March 2016.

In the appealed decision the Examining Division held that the Swiss-type claims of the application were excluded from patentability under Article 52(4) EPC 1973 (or Article 53(c) EPC 2000), while the device claims constituted an unallowable extension of subject-matter under Article 123(2) EPC.

- II. In a communication dated 4 December 2017 issued in preparation for the oral proceedings scheduled for 26 January 2018, the Board draw attention to objections concerning the Swiss-type claims and device claims then on file. With letter of 9 January 2018 in reply to the communication, the appellant filed a main request, an auxiliary request and arguments. After a telephone conversation with the Board's rapporteur the appellant with letter dated 23 January 2018 filed a new main request comprising only device-type claims and declared that the new main request replaced all requests previously on file.

On 24 January 2018 the Board cancelled the oral proceedings, and the proceedings were continued in writing.

- III. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis

of the claims according to the main request submitted with letter of 23 January 2018.

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

"A handheld blow dryer for use in eradicating ectoparasites by applying heated air directly to a target area of an animal's body to be treated such that the heated air can directly impinge on substantially all ectoparasites located within the target area, wherein the target area is located on the scalp of the animal to be treated, wherein the dryer comprises means for producing heated air with an air flow rate of about 0.56632m³/min (20cfm) to about 6.22952m³/min (220cfm) and at a temperature of from about 50°C to about 100°C".

V. The appellant argued that the outstanding extension of subject-matter objections in respect of the device claims had been overcome by the set of claims according to the main request.

Reasons for the Decision

1. The appeal is admissible.

2. *Background*

The application relates to the elimination of ectoparasites, primarily head lice, by applying a volume of heated air directly onto the infested area such that the heated air impinges directly on the ectoparasites. A proper air temperature and flow rate directly impinging on the ectoparasites can achieve an effective ectoparasite mortality rate (see description, page 6, lines 14-25).

The application as originally filed claimed methods for eliminating ectoparasites, but formally no device claims. However, the Board notes that originally filed claim 27 was directed to a "handheld method" and contained features which were formally directed to a method, but were quite obviously intended to be effected by a device, such as heating of air and producing a directed heated air flow. With the present main request the appellant-applicant seeks protection only in the form of device-type claims directed to a handheld blow dryer for use in eradicating ectoparasites.

3. *Added subject-matter - main request*

The Examining Division argues in the appealed decision that the original disclosure does not "indicate, define or imply" that the devices described therein could be new and inventive (see reasons 21.3): "To then claim such devices is considered an infringement of Article 123(2) EPC". On the face of it, the Examining Division apparently considered that the devices disclosed in the application were not declared to belong to the invention, and for this reason claiming them constituted an infringement of Article 123(2) EPC.

According to established case law, the requirements laid down in Article 123(2) EPC are understood to mean that an amendment may only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole content of the description, claims and drawings as filed (see see Case Law of the Boards of Appeal of the European Patent Office (CLBA), 8th

edition 2016, Chapter II.E.1.2.1, with further reference to the "gold standard" cited in decision G 2/10). The question of whether or not the amended subject-matter in the documents originally filed is declared to be new and inventive, or whether such an assessment of novelty and inventiveness can merely be implied from the wording used in the application, is not relevant to the requirement of Article 123(2) EPC. Accordingly, the crucial consideration is whether the subject-matter as such is clearly and unambiguously derivable from the application as filed, i.e. in the present case of a device claim - the subject-matter of the claim being a device - whether the device with the claimed combination of features is clearly and unambiguously described in or derivable from the application as filed. The fact that in the application the disclosed range of devices is stated to be within the means known to one skilled in the art may be considered when examining other EPC requirements, e.g. novelty and inventive step, but it has no bearing on the question of disclosure for the purposes of Article 123(2) EPC.

The Board holds that the subject-matter of the claims is clearly and unambiguously derivable from the disclosure of the handheld blow dryer on page 16, lines 4-30. In lines 19-20 of page 16 it is further explicitly mentioned that the blow dryer can have a comb device attached to it, such as the device with reference numeral 60. The comb device with reference numeral 60 is further described on page 14, line 15, to page 15, line 5. Thus the further details of the attached comb device included in the dependent claims find their basis in this part of the description as originally filed.

From the above the Board concludes that the amended set of claims has a clear basis in the application as filed and is compliant with Article 123(2) EPC.

4. *Remittal*

With respect to the device claims before the Board, the decision under appeal concerned only the issue of extended subject-matter according to Article 123(2) EPC. The question of the exception to patentability for therapeutic methods under Article 52(4) EPC 1973 (or Article 53(c) EPC 2000) is obviously not relevant for the present claims, and so the Board need not address this issue. The decision under appeal did not consider any of the further requirements of the EPC, in particular those of novelty and inventive step. So as not to deprive the appellant of first-instance consideration of these remaining substantive requirements, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC and remit the case for further prosecution on the basis of the set of claims of the main request filed with letter of 23 January 2018. The appellant has declared his agreement with this course of action.

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:



G. Magouliotis

G. Martin Gonzalez

Decision electronically authenticated