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**Datasheet for the decision  
of 27 November 2020**

**Case Number:** T 0992/16 - 3.2.02

**Application Number:** 06764480.7

**Publication Number:** 1903942

**IPC:** A61B5/00, A61B5/145, A61B5/15,  
A61B5/151, A61B5/157

**Language of the proceedings:** EN

**Title of invention:**  
HEALTH MONITORING DEVICE AND METHOD

**Patent Proprietor:**  
i-SENS inc.

**Opponent:**  
Roche Diagnostics GmbH

**Headword:**

**Relevant legal provisions:**  
EPC Art. 54, 56, 104(1)  
EPC R. 80

**Keyword:**

Novelty (yes)

Inventive step (yes)

Amendments to the description in accordance with Rule 80 EPC  
(yes)

Apportionment of costs - abuse of procedure (no)

**Decisions cited:**

G 0003/14

**Catchword:**



**Beschwerdekammern**

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**Case Number: T 0992/16 - 3.2.02**

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 27 November 2020**

**Appellant:** i-SENS inc.  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
11 February 2016 concerning maintenance of the  
European Patent No. 1903942 in amended form.**

**Composition of the Board:**

**Chairman** M. Alvazzi Delfrate  
**Members:** M. Stern  
N. Obrovski  
A. Martinez Möller  
C. Schmidt

## Summary of Facts and Submissions

- I. Appeals were lodged by the patent proprietor and the opponent against the interlocutory decision of the opposition division concerning the maintenance of European patent 1 903 942 in amended form.

In the appealed decision it was held that the main request then on file contravened the requirements of Article 123(2) EPC, that the subject-matter of claim 1 of auxiliary request 1 lacked novelty over E14 and that auxiliary request 2a met the requirements of the EPC. The opposition division rejected opponent's request for apportionment of costs.

- II. The following documents are relevant for the present decision:

E1': US-A-2003/0212345

E7: WO-A-2005/034740

E8: WO-A-03/083469

E13: US-A-2004/0267300

E14: Accu-Chek<sup>®</sup> Compact User Manual

E15: Photos of an open carry case Accu-Chek<sup>®</sup> Compact (undated)

- III. Oral proceedings before the Board were held on 27 November 2020. At the end of the oral proceedings, the parties' requests were the following:

The patent proprietor 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, 2a, 2b, 3a, 3b, 4a, 4b, 5a, 5b, all filed on 20 June 2016 with the statement of grounds of

appeal, or auxiliary requests 6, 7, 8a, 8b, 9a, 9b, 10a, 10b, 11a, 11b, all filed on 3 November 2016 with the patent proprietor's reply to the opponent's statement of grounds of appeal.

The opponent requested that the decision under appeal be set aside and that the patent be revoked. They further requested that the costs of the oral proceedings before the opposition division on 16 December 2015 be borne by the patent proprietor.

IV. The main request corresponds to the claims of auxiliary request 1 underlying the appealed decision and the description filed on 16 October 2014 during the first oral proceedings before the opposition division.

Independent claims 1 and 18 of the main request read as follows:

"1. A health monitoring device for measuring blood or tissue fluid indicators, the device comprising

- a body (6) having a first opening (5) and a second opening (4),
- a piercing means (7) attached to the body and having a piercing head arranged to extend out from the first opening (5) of the body, the piercing means (7) being cockable and further releasable for piercing the skin with its piercing head, and
- a space (17) arranged in connection with the body (6), into which space a number of sensor strips (12) can be arranged so that they can be brought out from the device one by one through the second opening (4) of the body into sampling position, characterised by
- a shutter (1) being arranged to tightly cover in its first position the first (5) and the second (4) opening

of the body (6), the shutter (1) being movable to a second position for exposing the first (5) and the second (4) opening of the body, whereby a sensor strip (12) can be pushed from the second opening (4) of the body (6), the sensor strip (12) thus being capable of being brought into sampling position when the shutter (1) is in its second position."

"18. A method for carrying out an at least two-step health monitoring measurement, in which a portable health monitoring device is used, the device comprising a first means for carrying out the first step of the method and a second means for carrying out the second step of the method, the health monitoring device comprises a shutter which in its first position covers the first and second means and

- the shutter is brought into the second position for exposing the first and second means and for bringing the first, second or both means into operation position,
- the first and second means are operated when the shutter is in its second position,
- the shutter is returned to the first position,

wherein  
the health monitoring device according to any of claims 1 - 17 is used"

Claims 2 to 17 are dependent claims.

V. The arguments of the opponent relevant for the present decision are summarised as follows:

*Novelty*

The subject-matter of claims 1 and 18 lacked novelty over the Accu-Chek<sup>®</sup> Compact manual E14. On page 95, a

carry case was shown which, according to the photos of E15, carried a measuring device of the type of the Accu-Chek<sup>®</sup> Compact measuring device and a lancing device of the type of Accu-Chek<sup>®</sup> Softclix. The measuring device comprised a plurality of test strips which could be dispensed through an opening as shown, for example, on page 56 of E14 and in the photos E15, which depicted the same device as E14 and was thus to be considered part of the disclosure of E14. The lancing device had an opening which could be seen in the figure of page 93 of E14. Both elements could be mechanically joined by a holder, as shown in the figure of page 93, forming a health monitoring device in the sense of claim 1. This joined configuration was similar to that of Figure 2 of the patent in which different housing elements were also joined together. The carry case shown on page 95 of E14 constituted a shutter which tightly covered the aforementioned openings protecting the device from dirt, dust moisture and microbes of the environment, as explained in paragraph [0025] of the patent.

The subject-matter of claims 1 and 18 also lacked novelty over E1'. This document disclosed a health monitoring device comprising a body (14) with an opening (in the pressure ring 20) which had the functions of the first and second openings of the claim. The skilled person would recognise that the "first opening", "second opening" and their respective functions defined in claim 1 could be consolidated into a single opening. This was also acknowledged by the patent proprietor in paragraphs [0035] and [0107] of the granted patent, which mentioned embodiments in which the two openings were consolidated into one opening and the strip and the lancet moved together. Moreover, within the body of the device of E1', a

magazine (52) with test strips was located (Figure 4B) which could be brought out of the device one by one through a second opening. The device comprised, furthermore, a cap (10 in Figure 1B) that tightly covered the first and second openings.

*Inventive step departing from E1'*

The device of E1' did not exhibit two separate openings. However, two openings allowed more contaminants to enter the device than only one combined opening. Hence, even if the claim were to be interpreted to require two separate openings, the claimed device presented a disadvantage with respect to a device comprising only one opening as in E1'. Thus, by providing the feature of "two openings" a technical disadvantage which had already been overcome in the state of the art was being deliberately accepted. This could not support an inventive step vis à vis E1'. Furthermore, the device of claim 1 was obvious in view of E1' read in conjunction with E8 or E13 since the latter documents disclosed the separation of the openings for the lancet and the test strips. The device of E1' could be provided with two openings without extensive modifications. Also the drive mechanism for the lancet and the test strips could be decoupled from each other without extensive modifications. There was no technical incompatibility between the device of E1' and the systems of E8 and E13 with two openings.

*Inventive step departing from E13*

The device of claim 1 was obvious when starting from E13, in combination with either E1' or E7. There was no technical incompatibility that would prevent the combination of E13 with E1'. Moreover, E13 provided



enough space to place the band winding mechanism of E7 inside the cover 17 shown in the figures of E13.

*Adapted description*

The amendments to the description of the patent as granted, i.e. the excision of paragraph [0107] and the last two sentences of paragraph [0035], were not occasioned by grounds for opposition as required by Rule 80 EPC as they served to clarify the terms of the claim. However, lack of clarity under Article 84 EPC was no ground of opposition listed in Article 100 EPC.

*Apportionment of costs*

It would have been perfectly feasible for the patent proprietor to already file auxiliary request 2a during an interruption of the first oral proceedings offered by the opposition division, as it comprised only minor clarifications of the wording of claim 1 of auxiliary request 2. This would have avoided the stay of the opposition proceedings until decision G 3/14 had been issued. Instead, the patent proprietor chose to have the proceedings stayed and filed auxiliary request 2a one month before the second oral proceedings, although, following G 3/14, auxiliary request 2 would not require any clarification. The patent proprietor therefore knowingly and wilfully delayed the opposition proceedings. This was an abuse of procedure which justified that the costs of the second oral proceedings held on 16 December 2015 had to be borne by the patent proprietor.

VI. The arguments of the patent proprietor relevant for the present decision are summarised as follows:

*Novelty*

The subject-matter claimed was novel over E14. This document disclosed two different devices, a blood glucose measuring device, Accu-Chek<sup>®</sup> Compact, and a lancing device, Accu-Chek<sup>®</sup> Softclix. E14 failed, however, to disclose any structure that may be equated with the body of a device having the two openings claimed, i.e. a first opening out of which a piercing head extends and a second opening through which the sensor strips can be brought out from the device. The holder of page 93 was conceived to merely hold the two devices together. It was however not discernible in the figure of page 93 whether the holder covered the opening of the lancing device or not. Hence, the holder was no body with the aforementioned two openings. Nor was the carry case shown from the outside on page 95 such a body. It was not disclosed that the lancing device and the measuring device were placed inside the case joined together by the holder of page 93. The photos of document E15 could not be taken to supplement the disclosure of E14.

The subject-matter claimed was novel over E1' too. This document disclosed a test device carrying test strips with an affixed lance portion. These unitary lancet/test strips were fired through a single opening in a pressure-ring of the test device. In contrast, the device of the invention had two openings, each opening having one of the functions specified in the claim. Moreover, in the amended description corresponding to the present main request, paragraphs [0035] and [0107] of the granted patent no longer described the consolidation of two openings into a single opening, as in the granted patent.

*Inventive step departing from E1'*

The unitary construction of the lancet/test strip elements of E1' made it impossible - and thus non-obvious - for the test strip and the piercing head to extend out of different device body openings. Although E8 and E13 disclosed devices with two separate openings, one for the lancing device and another for the test strip, the opponent did not present arguments based on the problem-solution-approach showing how the skilled person departing from E1' would have arrived at the claimed subject-matter. The drive mechanism of the unitary lancet/test strip element in E1' was just entirely different from and thus incompatible with the drive mechanisms of the lancet and the test strips, as two separate items, in the devices of E8 and E13. Thus, the skilled person departing from E1' would not have readily arrived at the claimed subject-matter.

*Inventive step departing from E13*

The combination of E13 with E1' failed to render obvious the claimed subject-matter for analogous reasons. Also the combination of E13 with E7 was not straight-forward since E13 and E7 disclosed alternative device constructions. In E13, the test strips were introduced one by one into an opening of the device, while in E7 the test strips were advanced by a test band winding mechanism.

*Amended description*

The description corresponding to the claims of the main request was the amended description filed on 16 October 2014 during the first oral proceedings before the opposition division. Paragraph [0107] and

the last two sentences of paragraph [0035] were excised. These amendments were performed in response to the objection of lack of novelty over E1' as raised by the opponent. Thus, the amendments were occasioned by a ground of opposition, in accordance with Rule 80 EPC.

*Apportionment of costs*

The proprietor did not knowingly and wilfully delay the proceedings as alleged by the opponent. The proceedings were stayed because of the notice regarding the staying of proceedings due to G 3/14 as published in OJ 2014, A87. Thus, the decision to stay the proceedings was not made by the proprietor, but by the EPO. It had not even been possible for the proprietor to plan and knowingly abuse the procedure because the question with regard to Article 84 EPC had not been discussed earlier and came by surprise when the objection was raised by the opponent. Moreover, it was hindsight to consider the amendments trivial. Thus, the request for apportionment of costs should be dismissed.

**Reasons for the Decision**

1. *The invention*

The invention relates to a monitoring device for measuring blood or tissue fluid indicators comprising a lancet for piercing the skin for bringing out blood and disposable sensor strips for analysing the blood sample.

The device of claim 1 comprises, in essence, a body with a first and a second opening, piercing means attached to the body and having a piercing head

extending out from the first opening, the body having a space into which a number of sensor strips can be arranged so that they can be brought out from the device through the second opening, and a shutter arranged to tightly cover in its first position the first and second openings, the shutter being movable to a second position for exposing the openings.

As explained in paragraph [0025] of the patent, the shutter insures the openings for the lancet and the sensor strip to be open to the environment only when the measurement is actually being carried out, and ensures that the lancet and the sensor strips are otherwise protected from dirt, dust, moisture and microbes which can affect the measurement result.

2. *Novelty over E14*

2.1 E14 is a user manual of the opponent's blood glucose measuring device Accu-Chek<sup>®</sup> Compact. The cover page of E14 depicts this measuring device together with the opponent's lancing device Accu-Chek<sup>®</sup> Softclix. Within the measuring device (Accu-Chek<sup>®</sup> Compact) there is a space for a drum containing a number of sensor strips which are brought out from the device one by one through an opening (as seen in the figures on pages 3 and 56; page 55, right column, first sentence). The lancing device (Accu-Chek<sup>®</sup> Softclix) is shown on the cover page of E14 to have an opening allowing a piercing head to extend outwardly (page 41, first sentence).

On page 93, the lancing device and the measuring device are shown to be joined together by a holder ("Halter für Accu-Chek Compact" (2)). On page 95, a carry case ("Etui" (8)) is depicted from the outside, which

presumably carries the lancing device and the measuring device. As E14 does not disclose anything concerning the interior of the carry case, it is not clear whether the lancing device and the measuring device are carried within the case separately, or joined together by the holder (2) as shown on page 93. The opponent relied on two photos, designated as E15, as evidence that the lancing device and the measuring device were carried separately from each other inside a carry case. However, contrary to the opponent's assertion, these photos are not part of the disclosure of E14 and also no evidence of what E14 discloses.

- 2.2 The Board does not recognise a structure in E14 that may be equated with the "body" of the device having the two openings claimed, i.e., a first opening out of which a piercing head extends and a second opening through which the sensor strips can be brought out from the device. The opponent, as well as the Opposition Division (point 5.3.3 of the decision), appear to (vaguely) consider the "body" in E14 as something resulting from the configuration shown on page 93 in which the lancing device and the measuring device are joined together by the holder (2). However, the quality of the figure of page 93 does not allow to discern whether the holder covers the openings of the lancing device and the measuring device or not. It is indeed possible that the holder extends over the opening for the piercing head and/or the opening for the sensor strips, so that the lancing device and/or the measuring device have to be removed from the holder before being used. The holder may well cover any of these openings if its sole function was to hold the two devices together when not in use. In this case, the "body" of the device would lack the two openings claimed.

2.3 Moreover, in the configuration shown on page 93 there is no *"shutter ... arranged to tightly cover in its first position the first and the second opening of the body"* as claimed.

The opponent saw such a shutter to be anticipated by the carry case shown in the figure of page 95.

Without entering into the merit of this assertion itself, the Board notes that the figure on page 95 merely depicts a carry case from the outside. Hence, there is no disclosure as to whether the lancing device and the measuring device are placed inside the case joined together by the holder as on page 93. It may well be that the case of E14 does not even allow to accommodate the lancing device and the measuring device in the joined configuration of page 93. For example, the photos of E15, which the opponent (incorrectly) sees as part of the disclosure of E14, show the lancing device and the measuring device placed in respective straps or pockets that keep them separate from each other rather than joined together by a holder as on page 93. Hence, there is no disclosure that the configuration of page 95 comprises a *"body"* with the two openings as claimed.

The two configurations shown, respectively, on pages 93 and 95 seem to relate to two alternative means of keeping the lancing device and the measuring device together, i.e., either clipped together by a holder or within a carry case. In neither of these alternative configurations are all the features claimed present.

2.4 The device of claim 1 of the main request is therefore novel over E14. Since independent method claim 18 of the main request defines the use of the device of

claim 1, also the claimed method is novel with regard to E14.

3. *Novelty over E1'*

3.1 Document E1' discloses a test device carrying test strips (4) to which a lance portion (18) is affixed (paragraphs [0044] and [0079]; Figures 11A and 11B). That is, in E1' the test strips are a unitary construction of a biosensor and a forward pointing lance member. These unitary lancet/test strips are fired through an opening in pressure-ring (20) of the test device (paragraphs [0047] and [0057]; Figure 5B). A cap (10) covering the opening (paragraph [0045]; Figure 2A) has been equated by the opponent with the "shutter" as claimed.

3.2 The opening (20) is, however, just one opening having both functions recited in the claim, of allowing the piercing head (lance portion 18) to extend out and the sensor strip (4) to be brought out from the device.

In contrast to E1', claim 1 defines a device having a body with two openings, each opening having one of the mentioned functions, i.e., a first opening from which the piercing head extends out and a second opening through which the sensor strips can be brought out from the device one by one.

3.3 The opponent argued that the "first opening" and "second opening" and their corresponding functions as defined in claim 1 could be consolidated into one opening. The Board rejects this argument, since for the assessment of novelty it is irrelevant what modifications could be done to the claimed subject-matter. Relevant is only whether E1' directly and



unambiguously discloses a device falling under the terms of the claim, which, for the reasons indicated above, it does not.

It is likewise not relevant that paragraphs [0035] and [0107] of the granted patent mention embodiments in which the openings are consolidated into one opening and the test strip and the lancet move together, as further argued by the opponent. In the description corresponding to the main request, the mentioned paragraphs of the granted patent have been amended to no longer describe the consolidation into one single opening (paragraph [0107] and the last two sentences of paragraph [0035] were excised). It is thus irrelevant whether the mentioned paragraphs of the granted patent could have supported the opponent's interpretation of the claim.

3.4 In a further line of argument, the opponent argued that the opening of magazine 52 holding the sensor strips 4 (Figure 4B) constituted the "second opening" according to the claim. The Board disagrees, since the opening in magazine 52 does not allow the sensor strips to "*be brought out of the device*" as claimed, but into an intermediate space *within* the device.

3.5 The subject-matter of claims 1 and 18 of the main request is therefore novel with regard to E1'.

4. *Inventive step departing from E1'*

4.1 As was indicated above, the device of E1' has just a single opening for firing the unitary lancet/test strip elements. The unitary construction of the lancet/test strip elements makes it impossible - and thus non-

obvious - for the test strip and the piercing head to extend out of different device body openings.

- 4.2 The opponent argued that the claimed subject-matter would present disadvantages with respect to E1' which could not support an inventive step. It argued that two openings allowed more contaminants to enter the device than only one combined opening. Consequently, the claimed device resulted from deliberately accepting technical disadvantages which had already been overcome in the state of the art.

The Board is not persuaded by this argument, particularly in the absence of any arguments using the problem-solution-approach showing how the skilled person departing from E1' would have arrived at the claimed device in an obvious way. The Board considers that E1' is a piece of prior art that is too remote from the claimed device to allow the skilled person to readily arrive at the latter.

- 4.3 The opponent argued, moreover, that the device of claim 1 was obvious in view of E1' read in conjunction with E8 or E13 since the latter documents disclose two separate openings for the lancet and the test strips, respectively. It was argued that the device of E1' could be provided with two openings without extensive modifications. Also the drive mechanism for the lancet and the test strips could be decoupled from each other without extensive modifications. There was no technical incompatibility between the device of E1' and the systems of E8 and E13 with two openings.

The opponent is right that E8 and E13 disclose devices with two separate openings, one for the lancing device and another for the test strip. This is disclosed in E8

on page 18, lines 14-23 and Figure 1. However, E8 lacks a shutter as claimed. In E13, the device comprises an opening 39 for firing a lancet (paragraph [0050]) and another opening, slot 41, for inserting a test strip (paragraph [0051]; Figure 1). It may be noted that the test strips are retained by a clip 49 within cover 17 (paragraph [0054]) (equated with the "shutter" as claimed) and then *inserted* into slot 41 (paragraph [0051]), rather than *brought out* of an opening of the device, as required by claim 1.

Here again the opponent did not present arguments based on the problem-solution-approach showing how the skilled person departing from E1' would have used the teaching of either E8 or E13 to arrive at the claimed subject-matter. The drive mechanism of the unitary lancet/test strip element in E1' is entirely different from and thus incompatible with the drive mechanisms of the lancet and the test strips, as two separate items, in the devices of E8 and E13. A combination of E1' with either E8 or E13 is therefore certainly not straightforward.

4.4 The subject-matter of claims 1 and 18 of the main request is therefore non-obvious when departing from E1'.

5. *Inventive step departing from E13*

5.1 As indicated above, in E13 the test strips are retained by a clip 49 within cover 17 (paragraph [0054]) (equated with the "shutter" as claimed) and then *inserted* into slot 41 (paragraph [0051]), rather than *brought out* of an opening of the device, as required by claim 1.

- 5.2 The opponent proposed a combination of E13 with E1', again without presenting arguments using the problem-solution-approach how these two entirely alternative constructions would be combined. As indicated above, the drive mechanism of the unitary lancet/test strip element in E1' is entirely different to and thus incompatible with the drive mechanisms of the lancet and the test strips, as two separate items, in the device of E13. A combination of these documents is therefore certainly not straight-forward.
- 5.3 The opponent also considered a combination of E13 with E7 since the latter disclosed a test band (14) within the device (page 5, lines 25 to 30; Figure 4). It was posited by the opponent that the device of E13 would have sufficient space to accommodate the test band winding mechanism of E7. However, the opponent did not indicate what problem the skilled person would be solving by doing so and omitted to indicate why its solution would result obvious, particularly in view of the fact that E13 and E7 disclose alternative device constructions: in E13, the test strips are introduced one by one into an opening of the device, while in E7 the test strips are advanced by a test band winding mechanism.
- 5.4 The subject-matter of claims 1 and 18 of the main request is therefore non-obvious when departing from E13.
6. As a consequence, the Board comes to the conclusion that the subject-matter of independent claims 1 and 18 of the main request satisfies the requirements of novelty and inventive step within the meaning of Articles 54 and 56 EPC. This applies, *a fortiori*, to

the preferred device embodiments of dependent claims 2 to 17.

7. *Adapted description*

7.1 According to the patent proprietor's request (point IV above), the description corresponding to the claims of the main request is the amended description filed on 16 October 2014 during the first oral proceedings before the opposition division, where paragraph [0107] and the last two sentences of paragraph [0035] were excised.

7.2 Contrary to the opponent's view, these amendments to the description were introduced as a response to the objection of lack of novelty with regard to E1'. The opponent based this novelty objection on a particular interpretation of the terms of claim 1 which was said to be derived from the teaching of paragraphs [0035] and [0107] of the granted patent. The patent proprietor consequently excised the mentioned passages of the description. It is thus clear that the amendments were in response to the novelty objection raised and thus occasioned by a ground of opposition, in accordance with Rule 80 EPC. Whether the amendments were effective in remedying the raised objection or not, is in this respect immaterial.

8. The Board concludes that the objections raised do not prejudice the maintenance of the patent in amended form on the basis of the main request.

9. *Apportionment of costs*

9.1 The opponent requested that the costs of the second oral proceedings before the opposition division on 16 December 2015 be borne by the patent proprietor.

9.2 During the first oral proceedings on 16 October 2014, the opposition division decided *ex officio*, in view of the matter which was then pending before the Enlarged Board of Appeal in case G 3/14, to not examine the clarity of the claims of a certain request (then auxiliary request 2) and to stay the proceedings.

After resumption of the proceedings, the parties were summoned to attend second oral proceedings on 16 December 2015. One month before the second oral proceedings, the patent proprietor filed a new amended auxiliary request, auxiliary request 2a, preceding in hierarchy auxiliary request 2 that gave rise to the stay of proceedings (point 1.1 of the minutes dated 11 February 2016). The opposition division held new auxiliary request 2a to be compliant with the EPC.

9.3 The opponent argued that it would have been perfectly feasible for the patent proprietor to already file auxiliary request 2a during an interruption of the first oral proceedings offered by the opposition division, as it comprised only minor clarifications of the wording of claim 1 of auxiliary request 2. This would have avoided the stay of the opposition proceedings. Instead, the patent proprietor chose to have the proceedings stayed and filed auxiliary request 2a one month before the second oral proceedings. Hence, the patent proprietor knowingly and wilfully delayed the opposition proceedings. This was an abuse of procedure which justified that the costs of the second oral proceedings held on 16 December 2015 had to be borne by the patent proprietor.

- 9.4 Under Article 104(1) EPC, each party to the opposition proceedings shall bear the costs it has incurred, unless the opposition division, for reasons of equity, orders, in accordance with the Implementing Regulations, a different apportionment of costs.
- 9.5 The Board does not agree with the opponent's contention that the patent proprietor knowingly and wilfully delayed the opposition proceedings.

Firstly, the patent proprietor bears no responsibility for the decision taken by the Opposition Division to stay the proceedings *ex officio* in view of the clarity objections under Article 84 EPC raised by the opponent (for the first time during the first oral proceedings) against auxiliary request 2 (points 7.1 and 7.3 of the minutes dated 7 November 2014). Given the then prevailing uncertain legal situation with respect to the examination of clarity requirements of granted patent claims, it was the patent proprietor's legitimate right to await the then pending decision G 3/14 before introducing any changes to his requests in response to the clarity objections raised during the first oral proceedings. The necessity for the second oral proceedings resulted from the opposition division's decision to stay the proceedings alone.

Secondly, since it was the patent proprietor's legitimate right to choose the appropriate time to file its requests (within the corresponding admissibility criteria), the Board sees no reason which speaks against the patent proprietor's right to file the new auxiliary request 2a before the second oral proceedings. The opponent actually did not contest its admissibility. It is moreover irrelevant whether

auxiliary request 2a only contained "minor" amendments over auxiliary request 2, as alleged by the opponent, or that, after the Enlarged Board had rendered its decision in case G 3/14, auxiliary request 2 could stand unamended since granted claims were not to be objected for lack of clarity. Furthermore, the patent proprietor was free to choose the hierarchy of its requests.

The Board finally points out that at the time of filing the request it was not foreseeable whether that request would be considered allowable. Therefore, even if the patent proprietor had filed auxiliary request 2a already during the first oral proceedings, it would not have been possible for them to anticipate whether this would have prevented the need to examine the lower ranking auxiliary request 2 and the consequent stay of the proceedings.

- 9.6 The Board, therefore, fails to recognise an abuse of procedure on the side of the patent proprietor which would justify an apportionment of costs different from the general rule under Article 104(1) EPC that each party to the opposition proceedings shall bear the costs it has incurred.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent as amended in the following version:



- claims 1-18 according to the main request filed with the statement of grounds of appeal
- description pages 2-4 and 6-11 of the patent specification and pages 5, 12 and 13 as filed during the oral proceedings before the opposition division on 16 October 2014
- drawings figures 1a-15b of the patent specification.

3. The request that the costs of the oral proceedings on 16 December 2015 be borne by the patent proprietor is rejected.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated