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**Datasheet for the decision  
of 5 July 2017**

**Case Number:** T 1674/16 - 3.2.02

**Application Number:** 10181969.6

**Publication Number:** 2301468

**IPC:** A61B18/14

**Language of the proceedings:** EN

**Title of invention:**

Switch assembly for electrosurgical instrument

**Applicant:**

Covidien LP

**Headword:**

**Relevant legal provisions:**

EPC Art. 113(1)  
EPC R. 103(1)(a)

**Keyword:**

Right to be heard - non-attendance at oral proceedings -  
opportunity to comment (no) - substantial procedural  
violation (yes)  
Reimbursement of appeal fee - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 1674/16 - 3.2.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 5 July 2017**

**Appellant:** Covidien LP  
(Applicant) 15 Hampshire Street  
Mansfield, MA 02048 (US)

**Representative:** Soames, Candida Jane  
Maschio & Soames IP Limited  
30 Carlton Crescent  
Southampton SO15 2EW (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 4 March 2016  
refusing European patent application  
No. 10181969.6 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** E. Dufrasne  
**Members:** D. Ceccarelli  
M. Stern

## **Summary of Facts and Submissions**

- I. The applicant has appealed the Examining Division's decision, dispatched on 4 March 2016, to refuse European patent application No. 10 181 969.6.
- II. The Examining Division did so on the ground that the subject-matter of claim 1 of the only request then on file lacked novelty (Article 54(2) EPC) over document D5 (US-A-2007/0078456) and, therefore, did not meet the requirements of Article 52(1) EPC. That request had been filed on 20 March 2015, in response to the Examining Division's summons, dated 23 February 2015, to attend oral proceedings on 10 February 2016.
- III. The notice of appeal was received on 20 April 2016. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 30 June 2016.
- IV. The appellant's main (procedural) request was that the decision under appeal be set aside, the case remitted to the Examining Division for further examination on the basis of the claims labelled "Main Request" filed with the statement of grounds and the appeal fee reimbursed.

Should the Board take the view that the main (procedural) request was not allowable, the appellant further requested that the decision under appeal be set aside based on amended claims labelled "First Auxiliary Request" to "Fifth Auxiliary Request" filed with the statement of grounds.

- V. Claim 1 of the claims labelled "Main Request", which corresponds to claim 1 of the request on which the

impugned decision was based, reads as follows:

"An electrosurgical forceps (10), comprising:  
a housing (20);  
a shaft (12) affixed to the housing having jaw members (110, 120) at a distal end (16) thereof, wherein the jaw members are configured to move relative to one another from a first position wherein the jaw members are disposed in spaced relation relative to one another to a second position wherein the jaw members are closer to one another for manipulating tissue;  
a switch assembly (180) included within the housing, characterised by:  
the switch assembly comprising:  
a switch carrier (181);  
a flex circuit assembly (200) disposed on an exterior surface of the switch carrier, comprising:  
at least one monopolar switch (465, 466) configured to selectively activate a source of monopolar electrosurgical energy;  
a monopolar safety switch (430) configured to enable the at least one monopolar switch upon actuation of the monopolar safety switch; and  
a bipolar switch (460) configured to selectively activate a source of bipolar electrosurgical energy, characterized by further comprising  
a movable handle (40) configured to cause the jaw members to move between the first and second positions and to actuate the monopolar safety switch when the jaw members are in the second position,  
wherein the movable handle (40) is selectively movable about a pivot pin (45) from a first position relative to a fixed handle (50) to a second position in

closer proximity to the fixed handle (50) which, by operative association with a drive assembly (130), imparts movement of the jaw members (110) and (120) relative to one another, wherein the pivot pin mounts to the switch carrier at a handle pivot mount (182), and wherein the pivot pin is dimensioned to mount within a transverse opening (183) defined in the handle pivot mount."

VI. Claims 1 and 8 of the request pending when the Examining Division issued the summons to oral proceedings read as follows:

"1. An electrosurgical forceps (10), comprising:  
a housing (20);  
a shaft (12) affixed to the housing having jaw members (110, 120) at a distal end (16) thereof, wherein the jaw members are configured to move relative to one another from a first position wherein the jaw members are disposed in spaced relation relative to one another to a second position wherein the jaw members are closer to one another for manipulating tissue;  
a switch assembly (180) included within the housing, characterised by:  
the switch assembly comprising:  
a switch carrier (181);  
a flex circuit assembly (200) disposed on an exterior surface of the switch carrier, comprising:  
at least one monopolar switch (465, 466) configured to selectively activate a source of monopolar electrosurgical energy;  
a monopolar safety switch (430) configured to enable the at least one monopolar switch upon actuation of the monopolar safety switch; and

a bipolar switch (460) configured to selectively activate a source of bipolar electrosurgical energy; characterized by further comprising

a movable handle (40) configured to cause the jaw members to move between the first and second positions and to actuate the monopolar safety switch when the jaw members are in the second position."

"8. The electrosurgical forceps of any one of claims 1 to 7, wherein the movable handle (40) is selectively movable about the pivot pin (45) from a first position relative to a fixed handle (50) to a second position in closer proximity to the fixed handle (50) which, by operative association with a drive assembly (130), imparts movement of the jaw members (110) and (120) relative to one another."

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

Its right to be heard, enshrined in Article 113(1) EPC, had been infringed, since the reason on which the decision was based had not been raised before during the proceedings. More specifically, claim 1 of the request forming the basis of the impugned decision included the subject-matter of a previously filed claim 8, on whose novelty the Examining Division had given a positive opinion in the summons to oral proceedings. However, in the impugned decision, for the first time, the Examining Division had held that the subject-matter of claim 1 was not novel over D5. As a result, the applicant had been caught unawares by the decision, which had given a reason on which it had not had the opportunity to comment.

Thus, a substantial procedural violation under Rule 103(1)(a) EPC had been committed, which justified the reimbursement of the appeal fee.

### **Reasons for the Decision**

1. The appeal is admissible.
2. As the appellant argued, the subject-matter of claim 1 of the claims labelled "Main Request", which corresponds to claim 1 of the request on which the impugned decision was based, comprises the features of claims 1 and 8 pending when the Examining Division issued the summons to oral proceedings.
3. Before issuing the impugned decision, the Examining Division had raised only an objection of lack of inventive step against that claim 8, under point 4 of the communication accompanying the summons, which reads:

*"4. As regards the additional features of claim 8, they are considered conventional in the context of surgical forceps, as exemplified by D1 (US2007/173814), fig.1A, § [0063] or D2 (US2007/213708), fig.1A and §[0053] thereof. A modification of the D5 apparatus so as to employ a single movable handle is obvious for the one skilled in the art and will be carried out according to requirements and preferences. Claim 8 thus lacks an inventive step in view of D5 and D1 or D5 and D2 and, therefore is not patentable under Art.52(1) EPC."*



4. Under Article 113(1) EPC, "the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments".

In the impugned decision the Examining Division refused the application on the sole ground that claim 1 of the appellant's request filed in response to the summons lacked novelty over D5. It was the first time that that objection had been raised and reasons for it given, and the appellant had not had the opportunity to comment on it.

The Board notes that the Examining Division explicitly informed the appellant that a decision would "be taken at oral proceedings" (point 5 of the communication accompanying the summons). It further notes that it was the appellant's own choice, communicated by letter dated 1 February 2016, not to attend them. However, it is also to be considered that, in response to the summons, the appellant filed amended claims well before the deadline for written submissions set by the Examining Division under Rule 116(1) EPC (point 5 of the communication accompanying the summons).

In the more than 10 months that elapsed between the timely receipt of the amended claims and the date planned for the oral proceedings, the Examining Division's only reaction to those claims was a brief communication informing the appellant that the date fixed for oral proceedings remained unchanged. No further objections were raised, even after the appellant had said it would not be attending the oral proceedings.

Under these circumstances the appellant could not have

reasonably expected that a new objection of lack of novelty against the then pending claim 1 would be raised, either during oral proceedings held in its absence or, for the first time, in the written decision. Rather, this new objection caught it completely by surprise and deprived it of any opportunity to comment on the ground for the refusal of the application, in contravention of Article 113(1) EPC. This constitutes a substantial procedural violation.

For this reason, in accordance with Article 111(1) EPC, the case is remitted to the Examining Division for further examination, in particular of the claims labelled "Main Request" filed with the statement of grounds.

5. The Board also notes that, although the Examining Division expressly confirmed the date fixed for oral proceedings by a communication sent just two days before them, there is nothing in the file to indicate whether these oral proceedings really took place. In particular, there are neither minutes according to Rule 124(1) EPC nor is there any reference to those oral proceedings in the impugned decision. This amounts to a further procedural violation, as it prejudices the necessary transparency of examination proceedings before the EPO.
6. Under Rule 103(1) (a) EPC "the appeal fee shall be reimbursed in full [...] where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation".

As explained above, the Board allows the appellant's

main (procedural) request in substance. Hence, the appeal is allowable.

Issuing the impugned decision in contravention of Article 113(1) EPC constituted a substantial procedural violation which has forced the appellant to appeal in order to have its rights respected (as is provided for in the EPC). It follows that reimbursement of the appeal fee is equitable and the appellant's request to this effect should be granted.

## 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.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated