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**Datasheet for the decision
of 8 November 2018**

Case Number: T 2303/16 - 3.2.02

Application Number: 05741659.6

Publication Number: 1755454

IPC: A61B5/15, A61M5/32

Language of the proceedings: EN

Title of invention:

SQUEEZE-ACTIVATED MEDICAL PUNCTURING DEVICE

Applicant:

Becton, Dickinson and Company

Headword:

Relevant legal provisions:

EPC Art. 84, 109(1), 111(1)

EPC R. 43(1), 43(7)

Keyword:

Interlocutory revision - department of first instance should
have rectified decision (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

T 0139/87, T 0047/90, T 0690/90

Catchword:



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Case Number: T 2303/16 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 8 November 2018

Appellant: Becton, Dickinson and Company
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 April 2016
refusing European patent application No.
05741659.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman E. Dufrasne
Members: P. L. P. Weber
D. Ceccarelli

Summary of Facts and Submissions

- I. The appeal of the applicant is against the decision of the Examining Division dated 14 April 2016 refusing European patent application 05741659.6, filed as an international patent application under the PCT (PCT/US2005/014968).
- II. During the international phase, an international preliminary report on patentability (IPR) was drawn up by the International Searching Authority. Under "Re Item V" in that report, point 2 substantiated why the subject-matter of claim 1 was not novel in view of each of documents D1 to D5, and point 4 stated the following:

"Although claims 1, 12 and 21 have been drafted as separate independent claims, they appear to relate effectively to the same subject-matter. The aforementioned claims therefore lack conciseness. Moreover, lack of clarity of the claims as a whole arises, since the plurality of independent claims makes it difficult to determine the matter for which protection is sought. Hence, claims do not meet the requirements of Article 6 PCT. If amendments are filed, the relevant subject-matter should be defined in terms of a single independent claim per category.

Independent claims should be in the two-part form in accordance with Rule 6.3(b) PCT.

The features of the claims should be provided with reference signs placed in parentheses to increase the intelligibility of the claims (Rule 6.2(b) PCT)."

III. In its first communication dated 3 June 2014, the Examining Division referred to the IPR drawn up for the application during the PCT phase and indicated that the outstanding deficiencies mentioned in that report gave rise to objections under the corresponding provisions of the EPC.

IV. In its reply dated 6 October 2014, the applicant filed a new set of claims with amended independent claims 1, 12 and 21 and explained why their subject-matter was novel over documents D1 and D2.

Novelty in view of documents D3 to D5 was not analysed. Moreover, this reply contained no explanation as to why the set of claims with three independent claims satisfied the requirements of conciseness. Furthermore, the three independent claims were not written in the two-part form and did not include any reference signs. The reply also did not provide any explanation as to why these requirements might not need to be met.

V. The Examining Division refused the application in its decision dated 14 April 2016.

The reasons for the decision read as follows:

"Claims 1, 12 and 21 have been drafted as separate independent claims. Therefore the present application does not comply with the requirements of conciseness (Article 84 EPC, which is the corresponding provision in the EPC regarding conciseness).

The Applicant has not dealt at all, and therefore not overcome, this objection of lack of conciseness, let alone provided arguments as to why these claims could

fall into one of the exceptional situations set out in paragraphs (a), (b) or (c) of Rule 43(2) EPC.

Independent claims 1, 12 and 21 are not in the two-part form in accordance with Rule 43(1) EPC, which in the present case would be appropriate, with those features known in combination from the prior art being placed in the preamble (Rule 43(1)(a) EPC) and the remaining features being included in the characterising part (Rule 43(1)(b) EPC).

The features of the claims should be provided with reference signs placed in parentheses to increase the intelligibility of the claims (Rule 43(7) EPC)."

VI. Notice of appeal was filed on 22 June 2016, and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 30 July 2016.

In its statement of grounds of appeal the appellant requested:

To remand the application to the Examination Division.

To forward an Office Action referring in detail to all relevant EPC regulations.

To set aside the decision to refuse the above-mentioned Patent Application dated 14 April 2016 and to grant a European Patent based on the enclosed set of claims.

To reimburse the Appeal Fee.

As an auxiliary matter to set a date for oral proceedings.

VII. With its statement of grounds of appeal, the appellant filed a main request, an auxiliary request and amended description pages.

The only independent claim of the main request reads as follows:

"A medical puncturing device (10) comprising

a deformable housing (12) and a skin puncturing element (52) disposed within the housing (12), wherein, upon deformation of the housing (12) at the at least one point of deformation, the skin puncturing element (52) is movable from a retracted first position to a second position causing a tip (54) of the skin puncturing element (52) to be exposed,

characterized in that

at least a portion of the deformable housing (12) includes a cross section being continuous in a circumferential direction and perpendicular to a longitudinal axis of the housing (12), a portion of the continuous cross-section includes the at least one point of deformation; and

the skin puncturing element (52) is maintained in the retracted first position within the deformable housing (12) wherein the tip (54) of the skin puncturing element (52) is disposed within the deformable housing (12), the skin puncturing element (52) being maintained in the first position against a biasing force prior to deformation of the deformable housing (12) through an interference engagement between the deformable housing (12) and the skin puncturing element (52)."

The main claim is followed by dependent claims 2 to 16, all provided with reference signs.

- VIII. By letter dated 9 October 2018, the Board summoned the appellant to oral proceedings. In the communication pursuant to Article 15(1) RPBA it stated that all the reasons for the refusal had been overcome, explained why reimbursement of the appeal fee could not be granted and expressed its intention to remit the case to the Examining Division for further prosecution pursuant to Article 111(1) EPC.
- IX. By letter dated 16 October 2018, the appellant withdrew its request for reimbursement of the appeal fee. It also requested that the oral proceedings be cancelled and that the case be remitted to the Examining Division.
- X. The arguments of the appellant relevant to the decision can be summarised as follows:

The refusal on formal grounds after only one communication dated 3 June 2014 was disproportionate as the appellant had filed a response addressing the objections of lack of novelty and lack of inventive step. The formal objections could have been dealt with in a second communication replying to the detailed response of 6 October 2014. Also, in the obiter dictum at the end of the decision, the Examining Division had not addressed the arguments put forward in the aforementioned letter. Thus, the case should be remitted to the Examining Division with the order to forward an Office action addressing all relevant objections to the applicant.

In the claims attached to the statement of grounds of appeal, the appellant had addressed all the objections relevant to the decision, and it had also explained why the subject-matter of claim 1 was novel and inventive; therefore the decision should be set aside and the case remitted to the Examining Division with the order to issue a communication under Rule 71(3) EPC.

Reasons for the Decision

1. The appeal is admissible.

Although in the statement of grounds of appeal the appellant does not specifically address the two-part form of claim 1 and the presence of reference signs, which were two of the three reasons for refusing the application, it is clear when reading claim 1 that these objections have been addressed.

2. The decision under appeal to refuse the application is based on three reasons: the application does not comply with the requirements of conciseness in accordance with Article 84 EPC because there are three independent claims; the independent claims are not in the two-part form in accordance with Rule 43(1) EPC; and the features of the claims are not provided with reference signs in accordance with Rule 43(7) EPC.

As can be seen from the wording of the set of claims of the main request filed with the statement of grounds of appeal, all three reasons have been addressed:

- i) claim 1 is the only independent claim of the set, which overcomes the lack of conciseness objection under Article 84 EPC,
- ii) claim 1 is written in the two-part form pursuant to Rule 43(1) EPC, and

iii) all the claims are provided with reference signs pursuant to Rule 43(7) EPC.

3. In the Board's opinion, since all the reasons for the refusal on which the decision relied have been overcome, the Examining Division should have allowed interlocutory revision pursuant to Article 109(1) EPC. Not doing so constitutes a fundamental deficiency in the proceedings before the first-instance department.

In this regard, according to established case law, the possible existence of irregularities other than those that gave rise to the contested decision does not preclude rectification of the decision (T 139/87, OJ 1990, 68; T 47/90, OJ 1991, 486; T 690/90, not published).

In particular, other objections mentioned in an obiter dictum that might not have been properly addressed in the new set of claims cannot preclude rectification. Also, in relation to the two-part form, the Board notes that neither in the first communication nor in the reasons for the decision does the Examining Division mention the prior art to be used for the first part of the claim. Neither in the first communication nor in the decision (including its obiter dictum) was there any objection of lack of inventive step that could have given an indirect indication as to which of the documents the Examining Division considered the most appropriate for the two-part form. Consequently, the Examining Division was not in a position to refuse the interlocutory revision, even if it may have considered that the wrong document was used for it or the delimitation was not adequate. A general objection is overcome by a general correction addressing it.

4. The appellant considered that a refusal on formal grounds after only one communication was disproportionate and that the Examining Division should have sent a second communication with all the objections.

The Board notes the following:

In the IPR, the three objections constituting the basis for the refusal were already mentioned together with the novelty objections based on five documents. In its first communication, the Examining Division referred to this report and indicated that the deficiencies mentioned there gave rise to objections under the corresponding provisions of the EPC. This means that the appellant had knowledge of the existence of these objections since it had received the IPR and they were repeated in the first communication of the Examining Division. Despite this, in its response of 6 October 2014, not only did the appellant not address any of the three formal points, but it only addressed two out of the five lack-of-novelty objections in substance. In such a case, even if the Examining Division could have sent a second communication to the appellant, the Board cannot find any obligation or abuse on its part.

5. The appellant further considered that since it had dealt with all the objections when filing its appeal, the Board should order the grant of a patent.

The primary purpose of an appeal is to challenge a first-instance decision. While pursuant to Article 111(1) EPC the Board may exercise any power within the competence of the department which was responsible for the decision appealed, the Board considers it appropriate for the Examining Division to examine the

fulfilment of all other requirements of the EPC when the refusal was based only on formal aspects as in the present case. Additionally, this makes it possible for the appellant to have two-instance proceedings.

Hence, as the new set of claims has not been examined with regard to the other possible objections under the EPC, the Board remits the case to the Examining Division for further prosecution pursuant to Article 111(1) EPC.

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:



D. Hampe

E. Dufrasne

Decision electronically authenticated