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**Datasheet for the decision
of 21 June 2022**

Case Number: T 0882/17 - 3.2.02

Application Number: 12161435.8

Publication Number: 2471483

IPC: A61B19/00

Language of the proceedings: EN

Title of invention:

Surgical planning

Patent Proprietor:

KINGS COLLEGE LONDON
DePuy International Limited

Opponent:

Calibre Search Ltd.

Headword:

Relevant legal provisions:

EPC R. 99(2)
EPC Art. 106(2), 54, 56
RPBA Art. 12(2), 12(4)
RPBA 2020 Art. 12(2), 13(2)

Keyword:

Admissibility of appeal - appeal sufficiently substantiated
(yes)
Admissibility of opposition
Appeal decision - extent of examination - reformatio in peius
Late-filed evidence - submitted shortly before oral
proceedings - admitted (no)
Novelty - (yes)
Inventive step - (yes)

Decisions cited:

G 0007/91, G 0008/91, G 0009/92, G 0004/93, G 0003/97,
G 0004/97, G 0001/99, G 0001/13, J 0014/19, T 1178/04,
T 1423/06, T 1544/07, T 0384/08, T 1843/09, T 0646/13,
T 1437/15, T 0577/16, T 0803/17, T 2117/18, T 2596/19

Catchword:

If the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, an objection related to the inadmissibility of the opposition is subject to the principle of the prohibition of reformatio in peius. In such a procedural situation, the Board is prohibited from ordering the maintenance of the patent as granted due to the inadmissibility of the opposition (Reasons 3.19).



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Case Number: T 0882/17 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 21 June 2022

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
26 January 2017 concerning maintenance of the
European Patent No. 2471483 in amended form.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: N. Obrovski
 A. Martinez Möller

Summary of Facts and Submissions

- I. An appeal was lodged by the opponent against the interlocutory decision of the Opposition Division finding that, account being taken of the amendments made by the patent proprietor in accordance with the then-auxiliary request 1, the patent and the invention to which it related met the requirements of the EPC.
- II. In their reply to the notice of opposition, the proprietors had submitted that there were doubts as to the identity of the opponent and that the opposition was thus inadmissible. The opponent had then filed a request for correction of the opponent's name under Rule 139 EPC. With a communication pursuant to Article 113(1) EPC dated 15 April 2016, the Opposition Division informed the parties that "the request for a correction of the name of the opponent under Rule 139 EPC dated 25.03.15 is hereby accepted and the notice of opposition is admissible", and gave reasons for this decision. The opponent's name was then corrected. In its final decision dated 26 January 2017 rejecting the opposition, the Opposition Division did not refer to the issue of the admissibility of the opposition.
- III. Oral proceedings before the Board took place on 21 June 2022.

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondents (proprietors) requested that the appeal be found inadmissible, that the opposition be found inadmissible, or that the appeal be dismissed.

IV. Claim 1 as maintained in the interlocutory decision reads as follows:

"A computer implemented method (300) for creating a statistical shape model incorporating surgical planning information for a body part, comprising:
generating anatomical data (306) representing the anatomical shape of the body part from images (302) of a plurality of training subjects;
generating planning data (306) which can be used to represent at least one planning property for a surgical procedure from the images of the plurality of training subjects, wherein the planning property includes the position or orientation of a surgical instrument or a prosthetic component to be implanted using the surgical procedure; and
creating (316) a statistical shape model (318) from the anatomical data and the planning data and which incorporates the planning data."

V. The following documents are relevant to this decision:

E1: US 2003/0185346

E2: US 2005/0004451

E3: WO 2004/008943

A1: T. J. Hutton et al., "Active shape models for customised prosthesis designs", AIMDM'99, LNAI 1620, pp. 448-452, 1999

A2: Office Action by the United States Patent and Trademark Office for application no. 11/847,652 dated 22 October 2020.

VI. The appellant's arguments which are relevant to the present decision can be summarised as follows:

Admissibility of the appeal

In several sections of the statement of grounds of appeal, arguments were presented against the reasoning provided in the appealed decision. Hence the appeal was admissible.

Admissibility of the opposition

The appellant/opponent stated that it had requested in its appeal that the Opposition Division's decision dated 20 January 2017 be overturned and that the patent be revoked. The Opposition Division's decision dated 15 April 2016 in which the opposition had been considered admissible had not been appealed by the appellant/opponent. This would not even have been possible, as the appellant/opponent had not been adversely affected by it.

The respondents could have filed an appeal but did not do so. The respondents were thus limited to responding to the grounds of appeal provided by the appellant, but could not raise new grounds of their own in the appeal proceedings. Therefore there was no basis for discussing the admissibility of the opposition within the scope of the appellant/opponent's appeal.

Extension of the scope of protection

Claim 1 of the main request extended the protection conferred by claim 1 as granted, thus infringing Article 123(3) EPC.

In claim 1 as granted, the prosthetic component had a definite position in relation to the body part. The amendment in claim 1 as maintained, indicating that the prosthetic component was "to be implanted", resulted in many new positions and was not limited to a complete prosthetic being implanted.

Claim 1 as granted defined the statistical shape model as being created from the anatomical data. Claim 1 of the main request resulted in an extension and/or a shift of protection for two reasons. Firstly, it now provided a list of possible data for creating the model, encompassing creating the model using only the planning data. Secondly, using both the planning data and the anatomical data would not fall within the scope of claim 1 as granted, which required the model to be created exclusively from the anatomical data.

Admittance of the objections of added subject-matter and of lack of clarity

The objections of added subject-matter and of lack of clarity reflected what had been submitted in the first-instance proceedings, but also showed why the appellant disagreed with the decision. Naturally, the objection of added subject-matter provided in the appeal proceedings could not differ materially from the same objection previously raised. An appellant should have the opportunity to receive a second opinion and overturn a decision which it considered inaccurate with regard to such an objection as well.

Admittance of A1 and A2

Document A1 served to explain how claim 1 must be interpreted and document A2 to show that document A1

was known to the respondent. There was thus no reason to disregard them.

Novelty over E1

The subject-matter of claim 1 lacked novelty over E1.

The term "statistical shape model" was vague, and neither claim 1 nor the description provided an explicit and full definition. Paragraph [0013] of E1 disclosed a shape model which was derived statistically, and hence was a "statistical shape model" within the meaning of claim 1. The person skilled in the art would not have understood that the statistical model of E1 excluded a well-known statistical shape model.

E1 in paragraph [0015] disclosed a generic model comprising both an anatomical model (the statistical model) and a geometric model. The anatomical model and the geometric model overlapped, so the planning data was provided within the same model.

Moreover, claim 1 did not exclude the possibility of the anatomical data and the planning data overlapping or even being the same. This was also clear from the patent specification, in particular from the dependent claims defining further specific aspects and from paragraph [0064] indicating that the planning data could be anatomical points. Therefore the anatomical model of E1 should be regarded as incorporating planning data.

Admittance of the objection of lack of novelty over E2

E2 disclosed essentially the same subject-matter as E1. Hence the subject-matter of claim 1 was not novel over E2.

Inventive step

The subject-matter of claim 1 was not inventive over E1 and common general knowledge, or over E1 combined with E3.

The last feature of claim 1 was the only distinguishing feature. There was no synergistic effect resulting from the model being a statistical shape model and from this model including the planning data.

A statistical shape model was well known to the person skilled in the art, as evidenced by the reference in the patent specification to an article from 1992. It would have been an obvious choice to use a statistical shape model, either to minimise the amount of data or merely as an alternative.

The incorporation of planning data in the statistical model did not lead to any technical effect and could thus not justify an inventive step. Hence the subject-matter of claim 1 was not inventive over E1 and common general knowledge.

E3 in paragraph [0085] taught the advantages of providing the anatomical data and the surgical planning data in a single model. The person skilled in the art starting from E1 would thus, following the teaching of E3, incorporate the planning data into the statistical

model of E1. Thus the combination of E1 with E3 also rendered the subject-matter of claim 1 obvious.

VII. The respondents arguments which are relevant to the present decision can be summarised as follows:

Admissibility of the appeal

The statement of grounds of appeal did not substantiate any new arguments, evidence or facts in response to the appealed decision. The appeal was thus inadmissible.

Admissibility of the opposition

The appellant had appealed the entire decision, including the part finding the opposition admissible in the communication dated 15 April 2016. Article 106(2) EPC applied because the Opposition Division had not given any opportunity to appeal that part of the decision separately at the time the communication had been issued.

The opposition was not admissible because there were reasonable doubts as to the identity of the opponent. Firstly, the notice of opposition did not indicate that the opponent was a limited company. Secondly, companies "Calibre Search Ltd" and "Calibre Search (Manchester) Ltd" were both registered at the address indicated in the notice of opposition. Hence it was equally likely that "Ltd" or "(Manchester) Ltd" had been omitted in the notice of opposition. Thirdly, it was not clear whether there were joint opponents or a single opponent. Fourthly, the opponent's letter of 22 October 2015 showed that it had not been clear to the opponent's representative who the opponent was either.

Finding the opposition inadmissible would lead to the patent being maintained as granted. This complied with the prohibition of *reformatio in peius* when applying G 1/99 by analogy and taking into account that exceptions were to be allowed as a matter of equity.

Extension of the scope of protection

The scope of protection had been neither extended nor shifted.

Claim 1 had been limited by excluding prosthetic components which were going to be implanted, without changing their possible positions.

The wording "and which incorporates the planning data" in the last feature of claim 1 meant that the creation of the model incorporated the data, without defining an additional method step. The wording "from the anatomical data" in claim 1 as granted did not exclude the possibility of other data being used. It was incorrect to construe the new wording "from the anatomical data and the planning data" as encompassing the option of using only the planning data.

Admittance of the objections of added subject-matter and of lack of clarity

The objections were not substantiated because the statement of grounds of appeal repeated the objections raised in the first-instance proceedings without addressing the reasons in the appealed decision.

Admittance of A1 and A2

Documents A1 and A2 represented an amendment to the appellant's appeal case. They had been filed shortly before the oral proceedings and should not be admitted.

Novelty over E1

The subject-matter of claim 1 was novel over E1.

It was well known to the person skilled in the art what a statistical shape model was and that it included variation information. A definition was also provided in paragraph [0010] of the patent specification. E1 only referred to a statistical model and did not disclose a statistical shape model. Moreover, E1 did not disclose that the geometric data of paragraph [0015] was part of the statistical model of paragraph [0013].

Admittance of the objection of lack of novelty over E2

The objection of lack of novelty over E2 had not been substantiated and should not be admitted.

Inventive step

Including the planning data in the created statistical shape model resulted in a model which enabled anatomical variations to be accounted for in the surgical plan as well. Even if the technical problem starting from E1 were regarded as only providing an alternative, this alternative was suggested neither by E1 nor by E3. Hence the subject-matter of claim 1 was inventive over E1 combined with common general knowledge or with E3.

Reasons for the Decision

1. Invention

- 1.1 The invention deals with a computer implemented method for creating a statistical shape model incorporating surgical planning information for a body part. The model can then be instantiated using data from a patient in order to plan a surgery for that patient (see paragraphs [0006]-[0010] and [0017]-[0021] of the patent specification).
- 1.2 According to the method of claim 1, the statistical shape model is created from anatomical data and planning data. The anatomical data represents the anatomical shape of the body part and is generated from images of a plurality of subjects. The planning data can be used to represent at least one planning property for a surgical procedure from the images, the planning property including the position or orientation of a surgical instrument or a prosthetic component.

2. Admissibility of the appeal

- 2.1 The statement of grounds of appeal indicates, for example in points 22-24 and 54, reasons for setting aside the appealed decision which explicitly address the reasoning provided in this decision. For this reason alone, the statement of grounds of appeal complies with the requirements of Rule 99(2) EPC.
- 2.2 There is no reason to doubt that the appeal likewise complies with the other requirements set out in Rule 101(1) EPC. Hence the appeal is admissible.

3. Admissibility of the opposition

- 3.1 The Opposition Division maintained the patent in amended form, and the opponent is the sole appellant.
- 3.2 The respondents requested that the opposition be found inadmissible and the patent be maintained as granted. They essentially argued that the identity of the opponent as indicated in the notice of opposition could not be established without any doubt. Decision G 1/99 should be applied by analogy to allow for an exception to the principle of the prohibition of *reformatio in peius*.
- 3.3 The appellant essentially argued that the respondents could have filed an appeal themselves and were not permitted to raise the inadmissibility of the opposition within the scope of the opponent's appeal. In substance, the identity of the opponent as indicated in the notice of opposition could be established without any doubt.
- 3.4 If one considers the admissibility of the opposition as an indispensable procedural requirement which must be taken into account at all stages of the appeal proceedings (see point 3.18.5 below), this issue falls already for this reason within the scope of the present appeal. In any case, as the Opposition Division did not allow a separate appeal under Article 106(2) EPC on the decision on the admissibility of the opposition contained in the communication dated 15 April 2016, that decision could only be appealed together with the Opposition Division's final decision. Hence, even if one does not consider the admissibility of the opposition as such an indispensable procedural

requirement, it follows from this link that the Opposition Division's decision on the admissibility of the opposition and the underlying reasoning is to be treated as an issue which is part of the Opposition Division's final decision.

- 3.5 Under the principle of the prohibition of *reformatio in peius* it is unlawful to worsen the position of the appellant because of its own appeal.
- 3.6 Accordingly, if - as in the present case - the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, the patent proprietor is primarily restricted during the appeal proceedings to defending the patent in the form in which it was maintained by the Opposition Division in its interlocutory decision (G 9/92 and G 4/93, point 2 of the order).
- 3.7 The yardstick for determining whether the position of an appellant is, because of its own appeal, worsened in a way which is incompatible with the principle of the prohibition of *reformatio in peius* is the order of the decision under appeal, in particular the legal effect of that order on the appellant (T 1437/15, Reasons 3.2.2, with reference to G 9/92, Reasons 14 and 16; see also parallel case T 803/17, Reasons 3.5).
- 3.8 Pursuant to the order of the decision under appeal, the patent was maintained in amended form on the basis of auxiliary request 1, i.e. the patent was not maintained as granted. Hence if the Board considered the opposition inadmissible, set aside the decision under appeal and maintained the patent as granted, the solely-appealing opponent would be in a worse position than if it had not appealed. Thus the question arises

whether the principle of the prohibition of *reformatio in peius* prohibits such a result.

- 3.9 The Board considers it appropriate to first assess whether and, if so, to which extent the principle of the prohibition of *reformatio in peius* prohibits it from taking account of the admissibility of the opposition in the present case before dealing with this question in substance.
- 3.10 The Enlarged Board in G 1/99 under certain conditions recognised a narrow exception to the principle of the prohibition of *reformatio in peius* to the benefit of the patent proprietor. The Enlarged Board's reasoning in G 1/99 is largely built on the statement in G 9/92 and G 4/93, Reasons 16, that amendments by the non-appealing patent proprietor which go beyond defending the patent in the version maintained by the Opposition Division "may be rejected if they are neither appropriate nor necessary".
- 3.11 The exception recognised in G 1/99 is limited to claim amendments made during the appeal proceedings which extend the scope of the patent in comparison to the version maintained by the Opposition Division. Such broadening claim amendments are only permitted under very strict conditions. Firstly, an objection necessitating such a claim amendment must have been submitted by the opponent or the Board during the appeal proceedings (see the order in G 1/99 and Reasons 10; see also G 9/92 and G 4/93, Reasons 16). Secondly, such a claim amendment must be the only possible option to avoid revocation of the patent (*ultima ratio*), meaning that amendments narrowing the claims would not overcome the objection raised in the appeal proceedings (see the order in G 1/99 and

Reasons 14 and 15). The Enlarged Board also stressed that this exception to the principle of the prohibition of *reformatio in peius* must be construed narrowly (G 1/99, Reasons 15).

3.12 The Enlarged Board further stated that it would be inequitable for the patent proprietor not to have the opportunity to mitigate the consequences of an error of judgement by the Opposition Division which caused a contravention of Article 123(2) EPC (G 1/99, Reasons 14). The Board in T 1843/09, Reasons 2.4, held that the overall framework established by G 1/99 could also be applied to cases other than those which concerned an error of judgement by the Opposition Division as to added subject-matter, but nevertheless stayed within this overall framework.

3.13 Clearly, invoking the inadmissibility of the opposition has nothing to do with a claim amendment made in reaction to an objection which has been submitted by the opponent or the Board during the appeal proceedings within the meaning of G 1/99. Generally speaking, invoking the inadmissibility of the opposition is not the only possible way for a patent proprietor to avoid revocation of a patent due to an opponent's appeal either. G 1/99 thus concerns an entirely different situation from the present case and can therefore, contrary to the respondents' view, not be applied by analogy.

3.14 In view of the principle of the prohibition of *reformatio in peius* as laid down by the Enlarged Board of Appeal in G 9/92 and G 4/93, and in view of the only - and narrowly construed - exception to that principle recognised by the Enlarged Board in G 1/99, it thus seems that a patent proprietor who did not appeal an

interlocutory decision by the Opposition Division is barred from raising the inadmissibility of the opposition as a mere respondent in order to achieve the maintenance of the patent as granted. If the opponent is the sole appellant, G 9/92, G 4/92 and G 1/99 do not seem to allow account to be taken of the inadmissibility of the opposition in a way which leads to this result.

3.15 This matter has, however, been assessed differently in several decisions by technical boards of appeal. The leading decision in this regard is T 1178/04 (OJ 2/2008, 80). It is stated therein that the admissibility of the opposition is an indispensable procedural requirement which must be examined *ex officio* in the appeal proceedings and which is not subject to the principle of the prohibition of *reformatio in peius* (Reasons 18-36). This view has been adopted in other decisions as well, although usually only with regard to the inadmissibility of the opposition being an indispensable procedural requirement to be examined *ex officio* (e.g. T 577/16, Reasons 1.1; T 2596/19, Reasons 3.2), and only in some cases also with regard to it not being subject to the principle of the prohibition of *reformatio in peius* (e.g. T 1423/06, Reasons 2.3). It is to be noted, however, that in none of these decisions has a board ordered maintenance of the patent as granted due to the inadmissibility of the opposition even though the opponent had been the sole appellant against an interlocutory decision maintaining the patent in amended form.

3.16 The present Board disagrees with the approach in T 1178/04 for the following reasons:

- 3.17 Inadmissibility of the opposition supposedly not subject to the principle of the prohibition of *reformatio in peius* - derivation from German law
- 3.17.1 It is stated in T 1178/04 that the principle of the prohibition of *reformatio in peius* as recognised by the Enlarged Board of Appeal was mainly taken from German law (Reasons 24). The principle is then explained in the context of the German legal system, citing sources of German legal literature (Schulte, Patentgesetz mit Europäischem Patentübereinkommen, 7th edition 2005, § 73 PatG, mn 76 and 77; Benkhard, Patentgesetz, 10th edition 2006, § 79 PatG, mn 10), the authors of which are in favour of the view that the inadmissibility of an opposition is an indispensable procedural requirement and not subject to the principle of the prohibition of *reformatio in peius* (Reasons 25). Subsequently, the reason why indispensable procedural requirements are supposedly not subject to the principle of the prohibition of *reformatio in peius* in German law is considered in more detail. The Board in T 1178/04 assumes that this is so because there are conditions for parties to be able to make a substantive request which must be met before a court is allowed to decide on such a substantive request (Reasons 26).
- 3.17.2 As the Board in T 1178/04 put much emphasis on the origin of the principle of the prohibition of *reformatio in peius* as applied in the German legal system, the present Board considers it appropriate to address this line of argument in detail.
- 3.17.3 The sources of German legal literature cited in T 1178/04 refer to an older decision of the German Federal Court of Justice (BGH) according to which the principle of the prohibition of *reformatio in peius*

does not apply to procedural requirements which have to be taken into account *ex officio* (BGH, decision of 23 February 1972, X ZB 6/71 "Sortiergerät", Reasons III.2.b), last sentence). In the underlying case, the German Patent Office had considered the opposition admissible but not allowable. Upon appeal by the opponent, the Federal Patent Court ("Bundespatentgericht") had then considered the opposition inadmissible (without considering its allowability) and had dismissed the opponent's appeal.

3.17.4 It seems that the Federal Court of Justice in X ZB 6/71 "Sortiergerät" was of the opinion that the Federal Patent Court's ruling that the opposition was inadmissible put the opponent in a worse position than it had been in in the decision under appeal, which had found the opposition unallowable. This understanding of the scope of the principle of the prohibition of *reformatio in peius* then apparently led the Federal Court of Justice to state at the time that this principle was generally not applicable to indispensable procedural requirements.

3.17.5 The Board's understanding of the scope of the principle of the prohibition of *reformatio in peius* under the EPC differs from the one indicated by the Federal Court of Justice in the decision X ZB 6/71 "Sortiergerät". In particular, an appellant whose opposition is rejected in the decision under appeal and whose appeal is then dismissed by a board (because of the inadmissibility of the opposition or for any other reason) would not be put in a worse position than if it had not appealed as, in both cases, the patent would be maintained as granted. The reasons leading to this result - the result being the maintenance of the patent as granted - do not fall within the scope of the principle of the

prohibition of *reformatio in peius* (see point 3.7 above and parallel case T 803/17, Reasons 3.5). It seems that, in its more recent case law, the German Federal Court of Justice has adopted a similar understanding of the scope of the principle of the prohibition of *reformatio in peius* (see point 3.17.14 below).

3.17.6 Moreover, it seems that the more recent case law of the Federal Court of Justice in areas of law other than patent law is not compatible with the statement in the last sentence of its older decision X ZB 6/71 "Sortiergerät" that the principle of the prohibition of *reformatio in peius* generally does not apply to indispensable procedural requirements.

3.17.7 Already in its decision of 18 December 1985, IVb ZB 677/81, Reasons 3.b)bb), the Federal Court of Justice explicitly deviated from the predominant view in the legal literature at the time and stated that indispensable procedural requirements which must, at least under German law, indeed always be examined *ex officio*, are not generally exempt from the principle of the prohibition of *reformatio in peius*.

3.17.8 According to the Federal Court of Justice, such a general exception would be at odds with the fact that decisions which lacked indispensable procedural requirements also became final when they were not appealed. If such procedural defects were acceptable in a decision which was not appealed, it was not justified to require that such defects had to be taken into account under all circumstances, even to the disadvantage of the sole appellant, in a decision which was appealed.

- 3.17.9 The Federal Court of Justice further stated that the rationale underlying the principle of the prohibition of *reformatio in peius* concerned not only the principle of party disposition but also the right to a fair trial. With regard to the latter, the principle of the prohibition of *reformatio in peius* protected an appellant from becoming further impaired in its rights due to their own appeal, i.e. from ending up more adversely affected than it had been by the decision against which it had appealed.
- 3.17.10 According to the Federal Court of Justice, a deviation from the principle of the prohibition of *reformatio in peius* is therefore not justifiable for any indispensable procedural requirement. Rather, the different principles involved have to be weighed against each other, and in particular indispensable procedural requirements, the lack of which is so severe that it enables the person affected to file an action for the retrial of the case under German civil procedural law ("Wiederaufnahmeklage"), can justify an exception to the principle of the prohibition of *reformatio in peius*.
- 3.17.11 Under German civil procedural law, such an action can be filed against a decision which has become final, and is only possible for a limited number of very severe reasons (see §§ 579 and 580 ZPO [German Code of Civil Procedure]), for example if a judge is found guilty of a criminal act, or if a judgment was based on a forged document. Such an action for retrial must, in most cases, be filed within 1 month after the party concerned became aware of the reason justifying the action for retrial, and at the latest within 5 years after the decision concerned has become final (see § 586 ZPO).

3.17.12 The EPC does not provide for such an action for retrial and, even if one considered the possibility to file a petition for review under Article 112a EPC in this context, the inadmissibility of the opposition would not qualify as a possible ground for a petition for review under Article 112a(2) and Rule 104 EPC.

3.17.13 In its decision of 25 April 2018, XII ZB 414/16, Reasons II.2.b) (containing further references to decisions confirming the applicability of the principle of the prohibition of *reformatio in peius*), the Federal Court of Justice considered the principle of the prohibition of *reformatio in peius* in a case in which the appellate court had issued a substantive decision which had been predominantly in favour of the appellant. The appellant filed an appeal ("Rechtsbeschwerde") against that part of the decision of the appellate court adversely affecting him with the Federal Court of Justice as court of third instance. Although the Federal Court of Justice found that the appellant had not had a right to appeal to the appellate court and that the appellate court should therefore have rejected the appeal ("Beschwerde") as inadmissible, it ruled that the principle of the prohibition of *reformatio in peius* prevented it from setting aside the decision of the appellate court. The Federal Court of Justice then dismissed the appeal ("Rechtsbeschwerde") before it in view of the inadmissibility of the appeal ("Beschwerde") that had been filed with the appellate court.

3.17.14 Taking the inadmissibility of the appeal lodged with the appellate court ("Beschwerde") for the first time into account when deciding on the allowability of the appeal before the Federal Court of Justice

("Rechtsbeschwerde") was in decision XII ZB 414/16 not considered to constitute a violation of the principle of the prohibition of *reformatio in peius*. This appears to deviate from the Federal Court of Justice's previous consideration in its older decision X ZB 6/71 "Sortiergerät", where the opponent had appealed against the decision of the German Patent Office to reject the opposition, and in which the Federal Court of Justice had considered the dismissal of the opponent's appeal by the Patent Court ("Bundepatentgericht") due to the inadmissibility of the opposition as a (justified) violation of the principle of the prohibition of *reformatio in peius*.

3.17.15 In the decision X ZB 6/71 "Sortiergerät" the Federal Court of Justice had also referred to the specifics of opposition proceedings in patent law and the limited applicability of the principle of party disposition. However, while it must be said that the more recent decisions of the Federal Court of Justice on the relationship between indispensable procedural requirements and the principle of the prohibition of *reformatio in peius* were taken in an area of law other than patent law, the Federal Court of Justice's main considerations therein seem to be of a general nature. In particular, according to these more recent decisions of the Federal Court of Justice the principle of the prohibition of *reformatio in peius* is not only linked to the principle of party disposition but also to the right to a fair trial, which is applicable in patent law as well.

3.17.16 The Board also notes that the German Patent Court ("Bundepatentgericht") stated in its decision of 2 February 1988, 12 W (pat) 91/86, Reasons III., that the specifics of opposition appeal proceedings in

patent law rather support the inadmissibility of the opposition being subject to the principle of the prohibition of *reformatio in peius*. The Patent Court referred in this context *inter alia* to the possibility that a non-appealing patent proprietor may itself have an interest in the patent being maintained in amended form (i.e. as upheld in opposition proceedings) rather than as granted. The Patent Court considered in its decision also the aforementioned decision IVb ZB 677/81 of the German Federal Court of Justice, although this decision was not taken in the area of patent law.

3.17.17 As to the weighing of the various legal principles involved, the Board considers the inadmissibility of an opposition not to be on the same footing as a procedural defect which allows an action for retrial ("Wiederaufnahmeklage"; see IVb ZB 677/81, Reasons 3.b)bb) and point 3.17.10 above) or represents an absolute ground for revision ("absoluter Revisionsgrund"; see XII ZB 414/16, Reasons II.2.b)aa) (1)) under German law or, for that matter, a ground for a petition for review under the EPC.

3.17.18 As an interim conclusion, the line of argument in T 1178/04 relating to German law is in the Board's opinion not persuasive, and cannot justify a deviation from the principle of the prohibition of *reformatio in peius* as established by the decisions of the Enlarged Board of Appeal in G 9/92, G 4/93 and G 1/99.

3.17.19 If anything, the opposite can be deduced from German case law, namely that what have been termed indispensable procedural requirements are not generally exempt from this principle. The Board considers the more recent case law of the Federal Court of Justice on

this matter both more authoritative (see J 14/19, Reasons 6.10) and more convincing than the legal literature referred to in T 1178/04.

- 3.18 Inadmissibility of the opposition supposedly not subject to the principle of the prohibition of *reformatio in peius* - derivation from G 3/97 and G 4/97
 - 3.18.1 Another line of argument in T 1178/04 employed in support of the view that the admissibility of the opposition is an indispensable procedural requirement and not subject to the principle of the prohibition of *reformatio in peius* relates to the decisions of the Enlarged Board of Appeal G 3/97 and G 4/97.
 - 3.18.2 In these decisions, the Enlarged Board of Appeal held that the admissibility of an opposition on grounds relating to the identity of an opponent may be challenged during the course of the appeal even if no such challenge had been raised before the Opposition Division. The Enlarged Board stated in this context that a decision of the EPO on the validity of a patent requires the existence of an admissible opposition (G 3/97 and G 4/97, Reasons 6). It is in particular the latter sentence which the Board in T 1178/04 considered as a sufficient reason to consider that the admissibility of the opposition is an indispensable procedural requirement and that it is not subject to the principle of the prohibition of *reformatio in peius*.
 - 3.18.3 The Board is not convinced by this line of argument either. In particular, the Enlarged Board in G 3/97 and G 4/97 did not address the principle of the prohibition of *reformatio in peius*. Nor was there any reason to do so, because in the first case T 301/95 underlying the

referral both the patent proprietor and the opponent had appealed, and in the second case T 649/92 the opposition had been rejected in the decision under appeal. Hence the principle of the prohibition of *reformatio in peius* did not play any role in either of the two underlying cases.

- 3.18.4 Accordingly, point 6 of the reasons in G 3/97 and G 4/97 is not concerned with the principle of the prohibition of *reformatio in peius*, but rather with the point in time at which an objection related to the admissibility of the opposition may be raised, in particular with the question of whether such an objection may be raised for the first time in the appeal proceedings. With regard to the latter, the Rules of Procedure of the Boards of Appeal which were in force at the time the decisions G 3/97 and G 4/97 were taken did not contain any provisions on late-filed submissions. Such provisions were only introduced with the Rules of Procedure 2003 (OJ EPO 2003, 61). The provisions of the Rules of Procedure of the Boards of Appeal, i.e. currently the RPBA 2020, implement Article 114(2) EPC in a way which is in principle binding on the Boards of Appeal (see Article 23 RPBA 2020). Therefore the statements of the Enlarged Board of Appeal in G 3/97 and G 4/97, Reasons 6, may have to be interpreted differently in view of the current legal framework. For example, it does not necessarily follow from G 3/97 and G 4/97 that any objection related to the admissibility of the opposition raised at the end of the oral proceedings before the Board must always be taken into account under Article 13(2) RPBA 2020, regardless of whether exceptional circumstances present themselves, regardless of whether the objection should have already been submitted in the opposition proceedings under Article 12(6) RPBA 2020, and

regardless of whether this objection will *prima facie* be successful. In any case, G 3/97 and G 4/97 did not address the principle of the prohibition of *reformatio in peius*.

- 3.18.5 Numerous decisions of the Boards of Appeal have stated that the admissibility of the opposition is an indispensable procedural requirement (T 646/13, Reasons 1.2: "established case law"). However, even if it is assumed that the admissibility of the opposition qualifies as an indispensable procedural requirement which can and must be examined at all stages of the appeal proceedings *ex officio* (i.e. even if none of the parties raises an objection in this regard), it does not follow from this qualification that the principle of the prohibition of *reformatio in peius* would not be applicable.
- 3.18.6 In the Board's view, the latter does in particular not follow from G 3/97 and G 4/97, Reasons 6. Even if the statements therein are understood as an indirect confirmation that the admissibility of an opposition is an indispensable procedural requirement, there is no indication that the prohibition of *reformatio in peius* would then not be applicable. As explained before, the Enlarged Board in G 3/97 and G 4/97 did not need to address the matter, and even the German legal system does not consider that the principle of the prohibition of *reformatio in peius* is automatically inapplicable to all indispensable procedural requirements.
- 3.18.7 Moreover, if G 3/97 and G 4/97 were to be understood as limiting the principle of the prohibition of *reformatio in peius* in regard to the admissibility of the opposition, these decisions would be in contradiction to the previous decisions of the Enlarged Board in

G 9/92 and G 4/93. In these decisions, the Enlarged Board of Appeal held that the idea that, regardless of whether the opposing party appeals, an appellant might have to take the risk of its appeal endangering the result which it had achieved before the department of first instance is not found in the EPC (G 9/92 and G 4/93, Reasons 12). It was also stated that an appellant's initial statement as to the extent to which amendment or cancellation of the decision is requested - contained, under Rule 99(2) EPC 2000, in the statement of grounds of appeal and, under Rule 64 (b) EPC 1973, in the notice of appeal - has a binding and restrictive effect on any subsequent requests by appellants or respondents, as well as on *ex officio* examination (G 9/92 and G 4/93, Reasons 6, 7, 10, 14 and 16; see also G 1/99, Reasons 6.6, last sentence). A non-appealing party as a respondent has (only) the opportunity to make appropriate and necessary submissions in the appeal proceedings to defend the result obtained before the department of first instance (G 9/92 and G 4/93, Reasons 11).

3.18.8 Had it really been the Enlarged Board's intention in G 3/97 and G 4/97 to limit its previous rulings and the above-mentioned statements in G 9/92 and G 4/93, it can be expected that the Enlarged Board would have explicitly addressed these decisions in its reasoning for G 3/97 and G 4/97. This was, however, not done. In G 1/99, on the other hand, which does concern such a limitation, G 9/92 and G 4/93 are explicitly addressed in detail.

3.18.9 Furthermore, if G 3/97 and G 4/97 were to be understood as limiting the principle of the prohibition of *reformatio in peius* in regard to the admissibility of the opposition, this limitation would be to the benefit

of the patent proprietor. The decision of the Enlarged Board of Appeal in G 1/99 was taken after decisions G 3/97 and G 4/97 and concerns exactly this question, namely whether an asymmetrical application of the principle of the prohibition of *reformatio in peius* to the benefit of the patent proprietor can be justified (Reasons 11). Again, it is hardly conceivable that the Enlarged Board of Appeal in G 1/99 would not have referred to its previous statements in G 3/97 and G 4/97 if these statements had indeed had any relevance to the principle of the prohibition of *reformatio in peius* and, more specifically, to any possible exceptions to that principle to the benefit of the patent proprietor.

3.18.10 Moreover, in G 7/91 and G 8/91 the Enlarged Board held that the appeal proceedings are regarded as terminated by virtue of the withdrawal of the sole appellant's appeal in so far as the substantive issues settled by the contested decision at first instance are concerned (Reasons 12). In other decisions, the Enlarged Board stressed in this context that an appellant's request restricts the extent to which boards of appeal may act *ex officio* (G 1/99, Reasons 6.6, last sentence; see also G 9/92 and G 4/93, Reasons 6). The Enlarged Board rejected the claim that Article 114(1) EPC constituted a legal basis for a continuation of appeal proceedings after the appeal has been withdrawn (G 7/91 and G 8/91, Reasons 8). It also considered the argument that a board may sometimes have to "stand by and watch" while a "flawed" decision of the department of first instance becomes final, and did not deem this decisive (G 7/91 and G 8/91, Reasons 10.2).

3.18.11 Hence, if the admissibility of the opposition were not subject to the principle of the prohibition of

reformatio in peius, an opponent as the sole appellant against an interlocutory decision could still withdraw its appeal whenever this objection is considered successful by a board, for example during the oral proceedings before a board. This would, firstly, be at odds with the statement in G 9/92 and G 4/93, Reasons 12, that "*the concept that it should be possible for a sole appellant to be compelled as a result of opposing requests to withdraw its appeal*" is absent from the EPC. Secondly, the appeal proceedings would then be terminated and the Board could anyway no longer order maintenance of the patent as granted due to the inadmissibility of the opposition. In other words, the Board could then no longer do anything about the inadmissibility of the opposition, and the interlocutory decision under appeal, lacking this procedural requirement, would become final. Both of these considerations speak against the inadmissibility of the opposition not being subject to the principle of the prohibition of *reformatio in peius*.

3.19 In conclusion, if the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, an objection related to the inadmissibility of the opposition is subject to the principle of the prohibition of *reformatio in peius*. In such a procedural situation, the Board is prohibited from ordering maintenance of the patent as granted due to the inadmissibility of the opposition.

3.20 As stated before, according to the Enlarged Board an appellant's initial statement as to the extent to which amendment or cancellation of the decision is requested has a binding and restrictive effect on any subsequent requests by appellants or respondents, as well as on *ex officio* examination (G 9/92 and G 4/93, Reasons 6, 7,

10, 14 and 16; see also G 1/99, Reasons 6.6, last sentence). Moreover, the Enlarged Board stated in the order in G 1/99 that "*[i]n principle, an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, must be rejected*" (highlighting by the Board). It follows from these statements that the principle of the prohibition of *reformatio in peius* involves not only the right of a party not to be put in a worse position because of their own appeal, but also the limitation of a board's power to order anything which goes beyond the extent of the appeal as defined in an appellant's initial statement. Accordingly, the principle of the prohibition of *reformatio in peius* must be taken into account *ex officio* at all stages of the appeal proceedings. Consequently, it would not be possible for a party to waive the application of this principle, contrary to what was concluded in T 1544/07, Reasons 2.5. However, in the present case the appellant did not submit any waiver, and the Board therefore does not need to provide a definitive answer to this question.

- 3.21 As stated before, if the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, the Board is prohibited from ordering maintenance of the patent as granted due to the inadmissibility of the opposition. This does, however, not answer the question of whether the Board then may not assess the admissibility of the opposition at all, whether it may only assess it in the context of the admissibility of the opponent's appeal, or whether that assessment may only be carried out in the context of the allowability of the appeal. None of these options would contravene the principle of the prohibition of *reformatio in peius*.

3.22 First option - no consideration at all

3.22.1 The first option would be not to consider a patent proprietor's objection related to the admissibility of an opposition at all whenever the principle of the prohibition of *reformatio in peius* applies because the opponent is the sole appellant against an interlocutory decision of the Opposition Division maintaining the patent in amended form.

3.22.2 A possible argument in favour of such an approach could be that there is only one possible consequence of the inadmissibility of the opposition, namely that the Opposition Division's decision must be set aside and the patent be maintained as granted. It could then be argued that, if a board is prevented from bringing about this result because of the principle of the prohibition of *reformatio in peius*, a board could do nothing else either when it, or the patent proprietor, considers the opposition inadmissible (see, with regard to the transfer of opponent status, T 1178/04, Reasons 20).

3.22.3 The Board is not convinced by such an approach. Firstly, as will be explained below, it is possible to consider the admissibility of an opposition in appeal proceedings in a way which is compatible with the principle of the prohibition of *reformatio in peius*, in particular in the context of the allowability of an opponent's appeal. Secondly, if the admissibility of an opposition could not be considered at all in appeal proceedings where the opponent is the sole appellant against an interlocutory decision maintaining the patent in amended form, an opponent whose opposition was recognised as inadmissible by a board could

nevertheless have the patent revoked, which seems inappropriate. Thirdly, such an approach would obviously not be compatible with the case law that the inadmissibility of the opposition is an indispensable procedural requirement which can and must be taken into account by a board in the appeal proceedings as well.

3.23 Second option - consideration in the context of the admissibility of the appeal

3.23.1 The requirements for an admissible appeal are listed in Rule 101 EPC, and the admissibility of the opposition is not one of them. While there is a certain overlap between the requirements for an admissible appeal and the requirements for an admissible opposition, these requirements are conceptually distinct, and it therefore does not seem justified to generally assess the admissibility of the opposition in the context of the admissibility of the appeal. The sufficient substantiation of an opposition is, for example, an admissibility requirement for an opposition which has nothing to do with the admissibility of an appeal.

3.23.2 As to the overlap, there are situations conceivable in which a single reason which causes an opposition to be inadmissible also causes an appeal to be inadmissible. For example, a legal entity which does not exist cannot be a party to proceedings, and if an opposition or an appeal is filed by a non-existent company the opposition or appeal will in principle be inadmissible (G 1/13, Reasons 16.1). Therefore, if a party ceases to exist before the opposition was filed and then files an appeal as a non-existing party, the same reason which causes the opposition to be inadmissible, namely the party's non-existence, also causes the appeal to be inadmissible.

- 3.23.3 If, in such a situation, the party's non-existence only comes to the fore in appeal proceedings in which the opponent is the sole appellant against an interlocutory decision maintaining the patent in amended form, the Board will terminate the appeal proceedings due to the inadmissibility of the appeal. Hence, in such a specific situation, it could be said that the (reason for the) inadmissibility of the opposition is considered, at least indirectly, in the context of the admissibility of the appeal.
- 3.23.4 It would, however, not be possible to set aside the decision under appeal due to the inadmissibility of the opposition in such a situation, as this would contravene the principle of the prohibition of *reformatio in peius* . Setting aside the decision under appeal in such a situation is also precluded if one considers the admissibility of the appeal under Article 110, first sentence, EPC as a precondition for a board to rule on the allowability of the appeal.
- 3.24 Third option - consideration in the context of the allowability of the appeal
- 3.24.1 Under Article 110 EPC, if the appeal is admissible, the Board of Appeal must examine whether the appeal is allowable. Hence if the first option (no consideration at all) is rejected for the reasons given in point 3.22.3 above, and if the reason for the inadmissibility of an opposition does not exceptionally also cause the appeal to be inadmissible, the admissibility of an opposition is to be assessed in the context of the allowability of the appeal.

- 3.24.2 Under this approach, an opponent's (admissible) appeal against the interlocutory decision of an Opposition Division maintaining the patent in amended form is dismissed as unallowable if the Board finds the opposition inadmissible.
- 3.24.3 The dismissal of the opponent's appeal if the Board considers the opposition inadmissible reflects the fact that the boards in the order of their decisions decide on the appeal rather than on the opponent's opposition. This corresponds to the - by now settled - practice of the boards in the order of their decisions to state that the patent is maintained as granted, instead of stating that the opposition is rejected.
- 3.24.4 Considering the admissibility of an opposition in the context of the allowability of an opponent's appeal is also compatible with the view that the admissibility of an opposition is an indispensable procedural requirement. The Board points out that the qualification of the admissibility of the opposition as an indispensable procedural requirement only requires that it can and must be taken into account in the appeal proceedings as well. Additionally stipulating an exception from the principle of the prohibition of *reformatio in peius* is, as explained in point 3.18 above, neither necessary for this qualification nor justified.
- 3.24.5 The Board notes that the German Federal Court of Justice follows a comparable approach when acting as a court of third instance. In particular, it assesses the admissibility of an appeal before an appellate court - which can conceptually roughly be compared to the admissibility of an opposition before an opposition division - (only) in the context of the allowability of

the appeal filed with the Federal Court of Justice (see point 3.17.13 above).

3.25 The principle of the prohibition of *reformatio in peius* and remittal

3.25.1 Considering the admissibility of an opposition in the context of the allowability of the appeal usually does not lead to a remittal of the case. More generally speaking, however, the Board notes that the principle of the prohibition of *reformatio in peius* also applies in the event of a remittal. It prevails until the final settlement of the opposition case and, therefore, also in any proceedings, including further appeal proceedings, subsequent to a remittal (see T 1843/09, Reasons 2.3.1).

3.25.2 In T 1178/04, the leading decision considering the admissibility of the opposition as not being subject to the principle of the prohibition of *reformatio in peius*, the Board considered the invalid transfer of the opposition to be a remediable procedural defect insofar as the opposition proceedings could be continued with the correct opponent after remittal. If there is a procedural defect which can be remedied (which, in view of Rule 77(1) EPC, is usually not the case for the inadmissibility of an opposition), the decision under appeal can be set aside and remitted to the department of first instance in order to remedy the defect. This, in the Board's view, is also possible in a situation where the opponent is the sole appellant against an interlocutory decision of the Opposition Division maintaining the patent in amended form. However, in such a situation, the Opposition Division's second decision after remittal of the case may not put the opponent in a worse situation than if it had not

appealed (subject to the exception to the principle of the prohibition of *reformatio in peius* as set out in G 1/99).

3.25.3 The Board in T 1178/04, Reasons 19, considered this differently and stated that, after remittal and rehearing of the case, the opponent "may find itself in a worse position than if it had not appealed". Had the Board in T 1178/04 come to a similar conclusion on this matter as the Board in T 1843/09, Reasons 2.3.1, it would seem that there might not even have been any need to stipulate an exception to the principle of the prohibition of *reformatio in peius*.

3.26 Application to the present case - admissibility of the opposition

3.26.1 In the present case, the alleged inadmissibility of the opposition concerns the allegation that the identity of the opponent could not be established before the expiry of the opposition period. In view of all the above considerations, and as this issue does not affect the admissibility of the appeal, the Board considers this issue in the context of the allowability of the opponent's appeal.

3.26.2 In substance, the respondents argued that the opposition was inadmissible because there had been multiple options and therefore reasonable doubt as to the identity of the opponent, which had excluded a correction of the opponent's name under Rule 139 EPC. The Board does not agree.

3.26.3 Firstly, the allegation that "Calibre Search", at the given address, could also refer to a natural person or

other legal forms such as a partnership is merely speculative and not supported by any evidence.

- 3.26.4 Secondly, as stated by the Opposition Division, it is apparent from the opponent's name in the notice of opposition as filed ("Calibre Search") that only the legal form was omitted. Once the name is considered together with the missing legal form, it can only refer to "Calibre Search Ltd." and not, as alleged by the respondents, also to "Calibre Search (Manchester) Ltd.". In the latter case, the name without the legal form would have been "Calibre Search (Manchester)", rather than "Calibre Search".
- 3.26.5 Thirdly, it is clear that the name "Calibre Search" refers to a single company. There is no indication that this term could refer to a multitude of companies acting as joint opponents, as alleged by the respondents.
- 3.26.6 Fourthly, the opponent's representative's submission of 22 October 2015 only reflects that the representative, upon being confronted with the proprietor's observations on the opposition and being unaware that a second company was registered at the same address, verified the facts with his client prior to submitting a request for correction. Hence the statement according to which matters were clarified bears no relevance for assessing whether the identity of the opponent could be established or not.
- 3.26.7 The correction of the opponent's name thus introduced what was originally intended. The correction was also filed without delay, which was not disputed by the respondents.

3.26.8 In conclusion, the Opposition Division's decision to correct the opponent's name under Rule 139 EPC was correct, as well as its decision to consider the opposition admissible. The identity of the opponent could be established on the basis of the information in the notice of opposition.

4. Extension of the scope of protection

4.1 It is disputed whether the amendments in claim 1 of the main request resulted in an extension of the scope of protection as compared with claim 1 as granted.

4.2 The amendment "*the position or orientation of a surgical instrument or a prosthetic component to be implanted using the surgical procedure*" restricts the prosthetic component defined in claim 1 as granted by excluding prosthetic components which are not to be implanted using the surgical procedure. The amendment results neither in claim 1 covering new positions for the prosthetic component nor in any change as to whether the position referred to is from a complete prosthetic or only from a part/component. Hence the amendment does not cause an extension of the scope of protection.

4.3 The amendment "creating (316) a statistical shape model (318) from the anatomical data and the planning data and which incorporates the planning data" defines that the statistical shape model must be created from the planning data as well ("and"), thus requiring both data elements. Hence claim 1 of the main request does not encompass creating the model using only the planning data.

4.4 The appellant submitted that claim 1 as granted required that the statistical shape model be created exclusively from the anatomical data.

4.5 The Board disagrees. The last feature of claim 1 as granted does not include any word such as "only" or "exclusively" which might support this interpretation. Moreover, this interpretation is not technically sensible in view of the wording "and which incorporates the planning data" in the last feature of claim 1, which requires the created model to incorporate the planning data. Hence the addition of "and the planning data" does not infringe Article 123(3) EPC.

5. Admittance of the objections of added subject-matter and of lack of clarity

5.1 The statement of grounds of appeal was filed before 1 January 2020 and is thus subject to Article 12(4) RPBA 2007 (Article 25(2) RPBA 2020). As Article 12(4) RPBA 2007 explicitly refers to Article 12(2) RPBA 2007, the latter is applicable by way of reference as well (T 460/19, Reasons 2; T 2117/18, Reasons 2.2.1).

5.2 It is uncontested that the objections of added subject-matter and of lack of clarity in the statement of grounds of appeal are essentially a repetition of the respective objections raised in the first-instance opposition proceedings.

5.3 The objections of added subject-matter were addressed in point 3.2 of the appealed decision (see also points 2.5.4-2.5.5). The objections of lack of clarity were addressed in point 5.2 of the appealed decision. The statement of grounds of appeal does not address the reasons provided in these points of the appealed

decision, either explicitly or implicitly. It follows that these objections are not substantiated within the meaning of Article 12(2) RPBA 2007. Therefore the Board decided to disregard these objections under Article 12(4) RPBA 2007.

5.4 The Board also points out in this context that the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020), and not to provide a second opinion as asserted by the appellant.

6. **Admittance of A1 and A2**

6.1 Documents A1 and A2 were filed after notification of the summons to oral proceedings. A1 and A2 concern new evidence and facts, and their filing is an amendment to the appellant's appeal case. Hence their admittance is subject to Article 13(2) RPBA 2020.

6.2 The appellant submitted that the evidence served to explain why certain features of claim 1 should be interpreted broadly. However, the breadth of said features had not previously been disputed. Moreover, the appellant did not explain why these documents, which are from 1999 and October 2020, had only been filed in May 2022, i.e. one month prior to the oral proceedings before the Board.

6.3 There are thus no exceptional circumstances within the meaning of Article 13(2) RPBA 2020 justifying taking documents A1 and A2 into account. Hence the Board did not admit them into the appeal proceedings.

7. Novelty over E1

- 7.1 E1 relates to a method for computer-aided navigation and/or treatment planning. It teaches providing a generic model of a body structure and adapting the model to a specific patient (see paragraphs [0007], [0009] and [0022]-[0028]). It further discloses in paragraph [0013] that the generic model may also include "a statistical model of the body structure".
- 7.2 It is disputed whether E1 discloses the last feature of claim 1 reading "*creating (316) a statistical shape model (318) from the anatomical data and the planning data and which incorporates the planning data.*"
- 7.3 The term "statistical shape model" is understood by a person skilled in the art of medical image processing as relating to a shape model which also includes variation information. This meaning is not only the common meaning in the art but also the one indicated in paragraph [0010] of the patent specification.
- 7.4 A statistical shape model is thus a specific type of statistical model. Hence the statistical model disclosed in paragraph [0013] of E1, which does not include variation information, does not anticipate the statistical shape model of claim 1.
- 7.5 The last feature of claim 1 further requires the created statistical shape model to incorporate the planning data.
- 7.6 E1 discloses that the generic model may include a statistical model (paragraph [0013]) and a model in the form of geometric data which can be "*angles and/or*

trajectory information which can be displayed for the physician and for example indicate to him the ideal position of an implant" (paragraph [0015]). The geometric data can be regarded as anticipating the planning data of claim 1. However, E1 does not disclose that the statistical model incorporates the geometric data. Also, if the statistical model and the geometric data of E1 were spatially aligned and thus overlapped, as argued by the appellant, this would not mean that the statistical model incorporated the geometric data.

7.7 The appellant argued that claim 1 did not require the planning data and the shape/anatomical data to be separate items. Hence the anatomical data provided within the statistical model in E1 also anticipated the planning data.

7.8 The location of specific anatomical points may indeed play an important role when planning a surgery. Specific anatomical points can even reflect the position or orientation of a prosthetic component to be implanted, as also acknowledged in the patent specification (see for example paragraphs [0039]-[0041] and [0061]). The Board thus agrees that claim 1 does not exclude the possibility of the planning data corresponding to anatomical points.

7.9 However, E1 does not disclose that the statistical model of paragraph [0013] includes any anatomical points identified as being relevant for surgery, let alone as representing the position or orientation of a surgical instrument or a prosthetic component to be implanted. The fact that specific anatomical points are potentially relevant for planning a surgery does not imply that an anatomical model having anatomical points inherently comprises planning data within the meaning

of claim 1. Hence the statistical model of E1 cannot be regarded as incorporating planning data.

7.10 In summary, E1 discloses creating neither a statistical shape model nor a statistical model which incorporates planning data. Hence E1 does not disclose the feature "*creating (316) a statistical shape model (318) from the anatomical data and the planning data and which incorporates the planning data.*". It follows that the subject-matter of claim 1 is novel over E1 (Article 54 EPC).

8. Admittance of the novelty objection over E2

8.1 The objection of lack of novelty over E2 has not been substantiated and was therefore not validly submitted (T 2117/18, Reasons 2.2.17). In particular, the appellant did not refer to any specific part or passage of E2 which might disclose the subject-matter of claim 1. Therefore the Board decided to disregard this objection (Article 12(2) and (4) RPBA 2007).

9. Inventive step

9.1 E1 and common general knowledge

9.1.1 The creation of a statistical shape model (first distinguishing feature) which incorporates planning data (second distinguishing feature) allows anatomical variations in both shape and surgical planning to be accounted for (see paragraph [0032] of the patent specification).

9.1.2 The appellant argued that there was no evidence that this would lead to an improvement in the created model.

The absence of any improvement meant that there was no technical effect and no inventive step.

9.1.3 Also, if the appellant's submission that the subject-matter of claim 1 did not lead to an improvement over the method taught by E1 were to be accepted, the problem to be solved by the two distinguishing features would then be to provide an alternative model to the model created in E1.

9.1.4 E1 does not mention a statistical shape model, let alone suggest its use as an alternative model. Moreover, even if, using common general knowledge, the person skilled in the art were to consider using a statistical shape model as the statistical model of E1 and accordingly adapt the model creation, E1 does not suggest incorporating the planning data into this model. This incorporation would additionally require variation information for the planning data, information which is not mentioned in E1.

9.1.5 Hence the person skilled in the art starting from the method of E1 and wanting to provide an alternative model would not arrive at a method as defined by claim 1 using common general knowledge.

9.2 E1 combined with E3

9.2.1 E3 deals with selecting a bone sample for use as an implant and determining a plan for cutting the bone sample (see abstract as well as paragraphs [002] and [0010]-[0016]).

9.2.2 E3 in an example in paragraph [0085] teaches providing an archive with image-derived data for a plurality of bone scans, in particular with morphometric

measurements from each scan, together with information about the quantity and type of implants cut from each bone.

9.2.3 Also, if the teaching of paragraph [0085] of E3 were considered when faced with the problem of providing an alternative model to the model of E1, the person skilled in the art following this teaching would provide the model as an archive comprising a plurality of training images or image-derived data for each training image together with corresponding planning/implant data for each training image. This data representation, i.e. archiving the data available for each training image, is different from the solution defined by claim 1, which provides the data in a compact form as a statistical shape model incorporating the planning data. Hence the combination of E1 and E3 does not lead to a method as defined by claim 1 either.

9.3 It follows that the subject-matter of claim 1 is inventive (Article 56 EPC).

10. Conclusion

10.1 Since none of the appellant's objections prejudices maintenance of the patent on the basis of the main request, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated