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**Datasheet for the decision  
of 29 June 2022**

**Case Number:** T 0634/18 - 3.4.01

**Application Number:** 13166842.8

**Publication Number:** 2713177

**IPC:** G01R33/54, A61B5/055

**Language of the proceedings:** EN

**Title of invention:**

Medical imaging apparatus and control method thereof with  
classification and recommendation of protocols

**Patent Proprietor:**

Samsung Electronics Co., Ltd.

**Opponent:**

Siemens Healthcare GmbH

**Headword:**

Recommendation of medical imaging protocols / Samsung

**Relevant legal provisions:**

EPC Art. 100(a), 56, 54(1), 111(1), 113(1)

RPBA Art. 12(4)

RPBA 2020 Art. 12(2), 13(1), 13(2)

**Keyword:**

Late-filed evidence - admitted (yes)  
Novelty - Main Request (no) - Auxiliary Requests I, II (no)  
Inventive step - Auxiliary Request III (no)  
Late-filed request - Auxiliary Requests II bis, III bis -  
admitted (no)  
Amendment after summons - Auxiliary Requests III ter, III  
quater - taken into account (no)  
Amendment to appeal case - Auxiliary Requests IV, V, VI, VII -  
admitted (no)  
Right to be heard - appeal procedure - respected (yes)  
Appeal decision - remittal to the department of first instance  
(no)

**Decisions cited:**

T 0724/08, T 0062/15, T 1903/13, T 0731/17, T 1089/17



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Case Number: T 0634/18 - 3.4.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.01**  
**of 29 June 2022**

**Appellant:** Siemens Healthcare GmbH  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 11 January 2018  
rejecting the opposition filed against European  
patent No. 2713177 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** B. Noll  
**Members:** T. Petelski  
C. Almberg

## Summary of Facts and Submissions

- I. The opposition against European patent 2 713 177 was based on Articles 100(a) and (b) EPC.
- II. The Opposition Division rejected the opposition, thereby maintaining the patent as granted.
- III. The opponent (appellant) appealed, requesting that the decision be set aside, and the patent revoked. With the statement of grounds of appeal, the opponent submitted documents

E10: Excerpt from Merriam Webster and Oxford Dictionary on the definition of "to classify",

O14: English translation of Japanese patent document O14a: JP 2010/082025 A, and

O15: English translation of Japanese patent document O15a: JP 2007/143719 A.

Documents O14a and O15a themselves were also submitted.

The opponent also offered witness evidence not relevant for this decision.

- IV. The proprietor (respondent) requested that the appeal be dismissed and that the patent be maintained as granted (Main Request). Alternatively, the patent was to be maintained on the basis of one of auxiliary

requests I (filed during opposition and re-filed with a first reply to the appeal), II, III, IV, V, VI and VII (filed with a first and second reply to the appeal), II bis and III bis (filed after the expiry of the time limit for the reply to the appeal).

Further, the proprietor requested that documents O14/O14a and O15/O15a not be admitted into the proceedings. If the Board were to admit them nevertheless, and in view of any inventive step arguments based on O15, the case should be remitted to the first instance.

- V. The opponent, in turn, introduced a document not relevant for this decision, and requested that Auxiliary Requests II - VII not be admitted. Further, there was no reason to remit the case to the first instance.
- VI. In a communication sent with a summons to oral proceedings, the parties were informed about the Board's preliminary opinion on their cases, according to which, amongst others:
- (a) O15 was likely to be admitted for *prima facie* relevance.
  - (b) A remittal to the first instance was unlikely.
  - (c) Auxiliary Requests II and III were likely to be admitted into the proceedings, whereas Auxiliary Requests II bis, III bis, and IV - VII were not.
  - (d) O15 took away novelty of claims 1 of the Main Request and of Auxiliary Requests I and II. The

extent to which O15 was relevant for inventive step of Auxiliary Request III remained to be discussed.

- VII. In reply to the Board's preliminary opinion, the proprietor filed Auxiliary Requests III ter and III quater. They reiterated their request for remittal, should O15 be admitted.
- VIII. During oral proceedings before the Board, which were held by video link, both parties confirmed their requests from the written procedure. In addition, the opponent requested that Auxiliary Requests II bis, III bis, III ter and III quater not be admitted.
- IX. Further during oral proceedings, the proprietor made an oral complaint that their right to be heard had not been respected, then specified it in writing and filed it. The complaint was filed in reaction to the Board
- not remitting the case to the first instance following the admission of O15 into the proceedings, and
  - not admitting Auxiliary Requests III ter, III quater, IV, V, VI and VII into the proceedings.

The complaint is annexed to the decision.

- X. Thus, the proprietor's final claim requests are, in hierarchical order:

- Main Request, as granted;

- Auxiliary Request I, filed during opposition proceedings (then labelled "Auxiliary Request"), and re-filed with the first reply to the appeal;
- Auxiliary Request II, filed with the first reply to the appeal;
- Auxiliary Request II bis, filed after the expiry of the time limit for the reply to the appeal;
- Auxiliary Request III, filed with the first reply to the appeal;
- Auxiliary Request III bis, filed after the expiry of the time limit for the reply to the appeal;
- Auxiliary Request III ter, filed with the reply to the Board's preliminary opinion;
- Auxiliary Request III quater, filed with the reply to the Board's preliminary opinion;
- Auxiliary Request IV, filed with the first reply to the appeal;
- Auxiliary Request V, filed with the first reply to the appeal;
- Auxiliary Request VI, filed with the second reply to the appeal;
- Auxiliary Request VII, filed with the first reply to the appeal (then labelled "Auxiliary Request VI").

XI. Claim 1 of the Main Request reads (without reference signs):

*A medical imaging apparatus comprising:*

*a display unit;*

*a controller configured to receive and analyze information related to a subject and to determine one or more protocols to*

*scan the subject based on the received and analyzed information related to the subject;*

*characterized in that the controller is further configured*

*to classify the determined one or more protocols based on a selected criterion of plural predefined criteria, wherein the plural predefined criteria include: image capture time, image resolution, image capture noise, power consumption, image quality, the amount of data, or a combination thereof;*

*to recommend one or more protocols classified according to the selected criterion; and that*

*the display unit is configured to display an array of the one or more protocols recommended by the controller as classified according to the selected criterion.*

XII. Claim 1 of Auxiliary Request I differs from claim 1 of the Main Request in that the medical imaging apparatus is defined as:

*..., wherein said apparatus is a magnetic resonance imaging apparatus... .*

XIII. Claim 1 of Auxiliary Request II differs from claim 1 of Auxiliary Request I in that the feature



*... and wherein the determined one or more protocols include a group of control signals representing pulse sequences...*

is added directly before the characterizing part of the claim.

XIV. Claim 1 of Auxiliary Request II bis differs from claim 1 of each of the higher-ranking requests in that the preamble reads (without reference signs):

*A medical imaging apparatus, wherein said apparatus is a magnetic resonance imaging apparatus comprising:*

*coil units for generating a static magnetic field and a gradient magnetic field in the static field and for exciting atomic nuclei and receiving echo signals therefrom;*

*a display unit;*

*a controller configured to receive and analyze information related to a subject and to determine one or more protocols to scan the subject based on the received and analyzed information related to the subject;*

*a database storing said one or more protocols, each protocol thereof including a group of control signals representing pulse signals for controlling said coil units... .*

XV. Claim 1 of Auxiliary Request III differs from claim 1 of the Main Request in that the definition of the controller in the preamble reads (without reference signs; differences underlined):

*... a controller configured to receive and analyze information related to a subject, wherein the information related to the subject comprises patient diagnosis information, and wherein the controller is configured to determine an image capture area based on the patient diagnosis information, and to determine one or more protocols to scan the subject based on the received and analyzed information related to the subject, wherein the controller is configured to determine the one or more protocols to scan the subject based on the determined image capture area...*

XVI. Claim 1 of Auxiliary Request III bis differs from claim 1 of Auxiliary Request III in that the definition of the controller in the preamble reads (without reference signs; differences underlined):

*... a controller configured to receive and analyze information related to a subject, wherein the information related to the subject comprises patient diagnosis information given by a medical team, and wherein the controller is configured to determine an image capture area based on*

*the patient diagnosis information, and to determine one or more protocols to scan the subject based on the received and analyzed information related to the subject, wherein the controller is configured to select the one or more protocols to scan the subject from a database based on the determined image capture area... .*

- XVII. Claim 1 of Auxiliary Request III ter differs from claim 1 of Auxiliary Request III in that the definition of the controller in the preamble reads (without reference signs; differences underlined):

*... a controller configured to receive and analyze information related to a subject, wherein the information related to the subject comprises patient diagnosis information and personal information of the patient, and wherein the controller is configured to determine an image capture area based on the patient diagnosis information, and to determine one or more protocols to scan the subject based on the received and analyzed information related to the subject, wherein the controller is configured to determine the one or more protocols to scan the subject based on the determined image capture area and to determine protocols more suitable for the patient based on the personal information of the patient... .*

XVIII. Claim 1 of Auxiliary Request III quater differs from claim 1 of Auxiliary Request III ter in that, in the definition of the controller, the personal information of the patient is defined as

*... including the sex, age, and medical record of the subject...*

XIX. Claim 1 of Auxiliary Request IV differs from claim 1 of Auxiliary Request I in that the following feature is added at the end of the claim (without reference signs):

*... and that the display unit is configured to provide a user interface allowing a selection of a desired protocol from among the array of the recommended one or more protocols.*

XX. Claim 1 of Auxiliary Request V differs from claim 1 of Auxiliary Request IV in that the preamble further defines the medical imaging apparatus to comprise

*... an operating console with an input device;*

and in that the following additional definition of the display unit is added at the end of the claim (without reference signs):

*... wherein the user interface is an indicator, such that if an operator moves the indicator via the input device of the operating console, a protocol corresponding*

*to the moved position is displayed on the display unit.*

XXI. Claim 1 of Auxiliary Request VI differs from claim 1 of Auxiliary Request V in that the above definition of the indicator reads (without reference signs, differences underlined):

*... wherein the user interface is in the form of a slide bar with an indicator, such that if an operator moves the indicator of the slide bar which is movable in two directions via the input device of the operating console, a protocol corresponding to the moved position is displayed on the display unit.*

XXII. Claim 1 of Auxiliary Request VII differs from claim 1 of Auxiliary Request V in that the definition of the indicator reads

*... wherein the user interface is in the form of a slide bar with an indicator, such that if an operator moves the indicator of the slide bar leftward or rightward via the input device of the operating console, a protocol corresponding to the moved position is displayed on the display unit.*

## **Reasons for the Decision**

### *The content of the patent*

1. The patent lies in the field of medical imaging, in particular magnetic resonance imaging (MRI). The imaging apparatus needs to follow a certain measurement protocol in order to acquire the desired image for a particular patient. The manual selection of a suitable protocol is complex and time consuming. The patent proposes to overcome this disadvantage by automatically recommending, to the user of the apparatus, suitable protocols based on a user's input of information related to the patient (see the patent publication, paragraphs [0015] - [0017]). To assist the user in selecting the final protocol, the automatically determined protocols are classified, for example according to image capture time or resolution, and presented to the user in this classified form (paragraphs [0080] - [0085]).

### *Admission of O15/O15a*

2. Japanese patent document O15a and its English translation O15 were submitted for the first time with the statement of grounds of appeal. According to Article 12(4) RPBA 2007, the Board has the power not to admit these documents into the proceedings.
3. The proprietor argued, in support of their request that O15 not be admitted, that Article 12(2) RPBA 2020 restricted the appeal proceedings primarily to a review of the decision under appeal. O15, however, was not

part of the appealed decision and should, therefore, not be considered.

4. Further, Article 12(4) RPBA 2007 gave the Board the power to hold inadmissible facts and evidence that could have been presented in the first instance proceedings. O15 clearly could and should have been filed during the opposition proceedings, because the complete reasoning of the decision by the Opposition Division had been excessively discussed previously. Hence, O15 could not have been a reaction to a surprising development of proceedings. Article 12(4) RPBA 2007 did not allow the Board to admit documents based on other criteria, like *prima facie* relevance. This was confirmed by the decision T 724/08, points 3.3 and 3.4, and by T 62/15, points 1.2 and 1.3.
5. Therefore, O15 constituted an amendment to the appeal case, the admission of which would be contrary to the provisions of Articles 12(2) RPBA 2020 and Article 12(4) RPBA 2007.
6. Even if the Board were inclined to consider *prima facie* relevance, O15 should not be admitted for the reason that it was not more relevant than the other documents on file. In this context, the proprietor argued in favour of novelty (see the respective arguments mentioned further below).
7. In contrast to the proprietor's arguments, it is established case law that *prima facie* relevance is one criterion, amongst others, that may be relied on when considering admission (Case Law of the Boards of Appeal, 9th edition, in the following called "Case Law", V.A.4.13.2). The decisions cited by the proprietor are in line with the established case law.

Point 1.3 of T 62/15 merely says that *prima facie* relevance is "not necessarily a criterion", referring to T 724/08. The latter decision emphasizes, under point 3.4, that the Board may use the criterion of *prima facie* relevance when exercising its discretion of admission but is not obliged to do so. The concrete result of the Board's exercise of discretion in these cases has no consequence for the present case.

8. Hence, in view of the high *prima facie* relevance of O15, this document is admitted into the proceedings for this reason alone. It is apparent on first glance that O15 differs from the other cited documents in that protocols, which are determined based on user input, are displayed in three different "goodness" regions on a screen (Figure 5 of O15). Thereby, it is closer to the claimed subject-matter than the other cited document.
9. As a consequence, O15 is admitted into the proceedings.

*Main request - novelty over O15*

10. O15 discloses a medical imaging apparatus like an MRI apparatus (paragraph [0012] and Figure 1), which has a functionality of selecting imaging protocols from a database according to information input by the user ([0020]). Part of the input to the user interface are an "examination target" and a "part of body examined", which are "pituitary examination" and "head" in the example shown in Figure 3. The computing means of the medical imaging apparatus analyses, which protocols in the database have entries that match the user input. The matching protocols are retrieved from the database and displayed in a graph on a screen along axes that



represent criteria selected by the user (paragraphs [0020] - [0022]; Figure 6 showing the protocol specific entries in the database). The possible selectable criteria include image quality and examination time (paragraph [0025] and Figure 5).

11. According to Figure 5 of O15, the protocols are displayed as icons in the graph, which, in one embodiment, is subdivided into regions A, B and C "defined between respective adjacent auxiliary lines" (paragraph [0031]). The areas correspond to different classes of the "goodness of the image" (see transition between pages 20 and 21 of O15). Displaying the protocols and the areas A, B and C in one graph is a classification of the protocols into goodness classes. The protocols are arranged in the graph with respect to their x- and y-axis values. This arrangement is in the form of an array, an array not necessarily meaning an arrangement in the form of columns and rows. Of the protocols displayed in Figure 5 of O15, rank A will normally comprise the most recommended protocols.
12. It follows that O15 discloses all features of claim 1.
13. According to the proprietor, however, the feature according to which the controller was "configured to receive and analyse information related to a subject and to determine one or more protocols ... based on the received and analysed information related to the subject" differed from O15 in three aspects.
14. Firstly, the verb "to analyse" in claim 1 of the patent implied more than a mere one-to-one matching of the user input with a parameter of the protocol. An analysis required a processing and converting of the received information such that the output format was

different from the input format. This did not happen in O15, where the input information was transmitted and compared in the format in which it was entered by the user, without any intermediate step of analysing.

15. Secondly, the "examination target" and the "part of body examined" in O15 were purely protocol-related parameters that were not specific to a patient and contained no information on the latter. Hence, they were not "information related to a subject" in the sense of claim 1.
16. Thirdly, according to paragraphs [0019] and [0021], the protocols in O15 were determined not only based on the examination target and part of body examined, but also based on information related to the equipment, which was entered into the field "Type of equipment" shown in Figure 3.
17. Still according to the proprietor, these three differences illustrated the fundamentally different concepts of O15 and the patent in suit. O15 disclosed the input of protocol parameters, like the equipment used or a body part to be imaged, to search for protocols in a purely "protocol-centred" lookup process. In contrast, the patent was directed at inputting and analysing information specific to the patient, including name and age, in order to search for suitable protocols in a "patient-centred" process.
18. In the Board's view, however, the proprietor interprets the claim more narrowly than justified by its wording. The expression "to analyse" in the context of claim 1 does not imply more than a simple processing of the subject-related information in a way to allow a selection of protocols. A change of format is not

implied. Hence, the action of comparing the input information to protocol-related entries in a database, as it is performed in O15 (implicit from paragraphs [0020] - [0022] and Figures 3 and 6), constitutes an "analysis" of whether the information matches a database-entry of a protocol or not. The protocols corresponding to the matching database-entries are those that are selected (or "determined") as suitable protocols to scan the subject.

19. Secondly, the proprietor's understanding of "information related to a subject" is not convincing and stands in contrast to the description of the patent in suit. According to paragraphs [0067] and [0069] of the patent publication, patient diagnosis information, like a possible illness or a diseased area or even image capture protocols for confirmation of the diseases, are regarded as "information related to a subject". The reader understands that the latter expression comprises any information that is suitable to tailor the selected protocols to the subject under examination. This is in line with the proprietor's statement in their first reply to the appeal, last sentence on page 4, according to which "the skilled person understands that the information related to the subject in the context of the present application includes information relevant to determine a scanning protocol for a medical imaging apparatus". In O15, the user input of the "examination target" is patient specific and may be "pituitary examination" for a patient in the example of Figure 3. Hence, the content (a diseased area) and the goal (select protocols suitable for a specific patient) of the input in O15 are similar to the patent and the input information in O15 falls within the scope of claim 1. The alleged difference between protocol parameters and patient

information is artificial, because at least one protocol parameter in O15 is patient information.

20. Thirdly, claim 1 does not exclude that the determination of protocols is also based on other criteria than information related to a subject, like the type of equipment used.
21. The proprietor further argues that not all protocols in Figure 5 were located on the lines A, B and C. Therefore, these lines could not be regarded as a classification.
22. However, it is the regions between the lines and not the lines themselves that define the classes in Figure 5 of O15. The different positions of the protocol icons within the classes only provide additional information but do not compromise the classification itself. The position of a protocol icon on a line may be regarded, for example, as a classification into two classes.
23. It follows that the subject-matter of claim 1 is not novel (Articles 52(1) and 54 EPC), which means that the ground for opposition under Article 100(a) EPC prejudices the maintenance of the patent in the form of the Main Request.

*Auxiliary Request I - novelty over O15*

24. Claim 1 differs from claim 1 of the Main Request in that the medical imaging apparatus is defined as an MRI apparatus.

25. In one embodiment, the imaging apparatus in O15 is also an MRI apparatus (see paragraphs [0012] and [0019] of O15).
26. The proprietor relies on their arguments provided in the context of the Main Request.
27. It follows that the subject-matter of claim 1 is not novel (Articles 52(1) and 54 EPC) for the same reasons as those given with regard to the Main Request. This means that the ground for opposition under Article 100(a) EPC prejudices the maintenance of the patent in the form of Auxiliary Request I.

*Auxiliary Request II - admission*

28. Auxiliary Request II was filed with the proprietor's first reply to the opponent's statement of grounds of appeal. The Board considers this request to be a genuine attempt to overcome the objections raised by the opponent. Further, the subject-matter claimed in this request does not create a fresh case, because it further develops the main application of the invention (MRI) that is already defined in the claims of Auxiliary Request I. Hence, the Board admitted Auxiliary Request II into the proceedings (Article 12(4) RPBA 2007).

*Auxiliary Request II - novelty over O15*

29. Claim 1 differs from claim 1 of Auxiliary Request I in that the protocols are defined as including a group of control signals representing pulse sequences.

30. Protocols for MRI imaging implicitly include such control signals.
31. The proprietor does not contest that, and relies on their arguments provided in the context of the Main Request.
32. It follows that the subject-matter of claim 1 is not novel (Articles 52(1) and 54 EPC) for the same reasons as those given with regard to Auxiliary Request I. This means that the ground for opposition under Article 100(a) EPC also prejudices the maintenance of the patent in the form of Auxiliary Request II.

*Auxiliary Request II bis - admission*

33. Auxiliary Request II bis was filed after expiry of the time limit for a reply to the appeal. Its admission is subject to Article 13(1) RPBA 2020.
34. Claim 1 differs from claim 1 of Auxiliary Request II in that the MRI apparatus is further defined to comprise coil units for generating magnetic resonances and receiving echo signals, and to comprise a database for storing the protocols.
35. These features are not suited to resolve the novelty objection raised against the higher-ranking requests, because such coil units are inherent in every MRI apparatus (see also paragraph [0012] of O15), and because a database that stores the protocols is disclosed by O15 (see database 17a disclosed in paragraphs [0018] and [0019]).

36. Independent method claim 7 defines the protocols to include a group of control signals representing pulse sequences but does not define an MRI apparatus. This gives rise to further problems like added matter, because protocols including pulse sequences were not disclosed in the application as filed for a medical imaging apparatus other than MRI.
37. The proprietor does not contest these findings and merely refers to their arguments put forward with regard to the higher-ranking requests, thereby providing an insufficient justification for this particular amendment.
38. Considering the above, the Board did not admit Auxiliary Request II bis into the proceedings (Article 13(1) RPBA 2020).

*Auxiliary Request III - admission*

39. Auxiliary Request III was filed with the proprietor's first reply to the opponent's statement of grounds of appeal. Just like with Auxiliary Request II, the Board considers this request to be a genuine attempt to overcome the objections raised by the opponent. Further, the subject-matter claimed in this request does not create a fresh case, because it remains within the framework of the invention of automatically recommending imaging protocols in order to assist the operator in the preparation of a medical imaging apparatus. Hence, the Board admitted Auxiliary Request III into the proceedings (Article 12(4) RPBA 2007).

*Auxiliary Request III - novelty, inventive step in view of O15*

40. In addition to claim 1 of the Main Request, claim 1 defines the information related to a subject to comprise patient diagnosis information. Also, it defines the controller as being further configured to determine an image capture area based on patient diagnosis information, and to determine the protocols based on the determined image capture area.
41. In the example of Figure 3 of O15, the "examination target" that is input by the user is "pituitary examination". This information defines the area of the disease (the pituitary gland in the brain) and is, therefore, patient diagnosis information in the sense of the patent in suit. This is evident from paragraph [0069] of the patent publication, which defines the patient diagnosis information to include "diseased areas that are expected to cause diseases".
42. Still according to the example of Figure 3 of O15, the "part of body examined" that is input by the user is the "head". The matching protocols are necessarily configured for measuring this body part, which is why this information is an image capture area in the sense of the patent in suit. According to the latter, the image capture area is equivalent to an organ such as "brain" or "liver" (paragraph [0079] of the patent publication), which are also body parts.
43. In O15, the image capture area ("part of body examined") is analysed in that it is matched to a parameter of the protocols stored in the database (implicit from paragraphs [0020] and [0021], and Figures 3 and 6). The protocols with matching



parameters are determined and displayed on a screen ([0022], [0024] and [0028]).

44. The subject-matter of claim 1 differs from O15 in that the controller is configured to determine the image capture area based on the patient diagnosis information. In O15, the image capture area ("head") and the patient diagnosis information ("pituitary information") are typed in manually by the user to fill the fields F and G shown in Figure 3. Hence, the subject-matter of claim 1 is novel over O15.
45. The technical effect of that difference, and also the objective technical problem, lies in the provision of an easier (and faster) selection of protocols. This is a problem the skilled person would have considered, because it is in line with the purpose of O15 as disclosed in paragraph [0006]: "An object of the present invention is therefore to provide technology for enabling easy acquisition of a desired examination protocol by a user ...".
46. It would have been apparent to the skilled person that an image capture area, or, in the words of O15, the "part of body examined", can often be determined from an examination target, since there can be a direct and simple relation between both. In the example of Figure 3, that would be a determination of the body part "head" from the information "pituitary information". When trying to solve the problem of further simplifying the protocol determination, the skilled person not only could, but also would have programmed the controller to perform this "auto-fill" step of field G in Figure 3 whenever possible. This amounts to an automation of the otherwise manual task of entering an image capture area that could have well been determined automatically in

most cases. Such reprogramming would have been a routine operation for the skilled person.

47. The proprietor is of a different opinion. In addition to the arguments provided with the Main Request (see above points 13. to 17.), they argued that O15 required the entry of several parameters, like the "examination target", the "part of body examined" and the "type of equipment". The controller then merely returned a list of protocols with matching parameters. Therefore, there was neither a need to automatically determine an image capture area, nor to determine protocols based on such an image capture area. Hence, the skilled person would not have changed anything in O15 without hindsight. The single entry of information defined in claim 1 of the patent in suit was faster and more reliable than O15, because a single entry involved only half the risk of entering wrong information.
48. This is not convincing. The proprietor's argument ignores the suitability of correlated information against the random error that may occur with a single entry. In O15, an error made by inputting two incompatible entries can be more reliably detected than an error in a single entry. Hence, reliability is not part of the problem, whereas velocity and simplicity of the protocol selection is. There is no hindsight involved when conceding that the skilled person, who aimed at following the goal of O15 in making the selection of protocols easier, would have considered providing the input of the "part of body examined" by an auto-fill option based on the "examination target", whenever there was an unambiguous correlation. By doing so, the skilled person would have arrived at an apparatus configured to determine an image capture area based on patient diagnosis information, and also

configured to determine protocols based on the determined image capture area by matching the image capture area to the respective parameter in the list of protocols.

49. It follows that claim 1 of Auxiliary Request III does not involve an inventive step over the disclosure of O15. This means that the ground for opposition under Article 100(a) EPC also prejudices the maintenance of the patent in the form of Auxiliary Request III.

*Auxiliary Request III bis - admission*

50. Auxiliary Request III bis was filed after expiry of the time limit for a reply to the appeal. Its admission is subject to Article 13(1) RPBA 2020.
51. Claim 1 differs from claim 1 of Auxiliary Request III in that the patient diagnosis information is defined to be "given by a medical team", and in that the controller is configured to select the protocols from a database.
52. The amendments give rise to a new objection in that it is not clear, how far the medical imaging apparatus is restricted by the source (medical team) of the received information.
53. If the feature relating to the medical team were to be considered as clear, then this feature would not further restrict the controller. This is so, because the feature covers the understanding that the source of the information has no influence on the configuration of the controller. Hence, the amendments are not suitable to resolve the objection regarding lack of

inventive step that was raised against Auxiliary Request III. Notwithstanding this, in O15 the information may be entered by a "physician or technician", both of which are considered as members of a medical team. On the other hand, the selection of protocols from a database is disclosed by O15 (see the selection from database 17a in paragraphs [0018] and [0019], together with Figure 6).

54. The proprietor did not present any arguments on this claim request beyond those brought forward with regard to Auxiliary Request III, which is why the justification of this amendment is insufficient.
55. Considering the above, the Board did not admit Auxiliary Request III bis into the proceedings under Article 13(1) RPBA 2020.

*Auxiliary Requests III ter and III quater - admission*

56. Auxiliary Requests III ter and III quater were filed in the week before oral proceedings, more than 9 months after notification of the summons to oral proceedings (and the Board's accompanying provisional opinion). Their admission is governed by Article 13(2) RPBA 2020, under which such amendments to a party's case are in principle disregarded unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
57. The proprietor argues that Auxiliary Requests III ter and III quater were filed as a legitimate reaction to the Board's preliminary opinion on O15. O15 had been firstly filed in appeal proceedings, together with new objections, which created completely new factual

circumstances. Since the Opposition Division could not provide an opinion on O15, it was the Board that provided the proprietor with the first (preliminary) opinion on that document. Hence, exceptional circumstances were present. Auxiliary Requests III ter and III quater were attempts to overcome the inventive step objection raised against Auxiliary Request III based on O15. It would only be fair to allow the proprietor a reaction to that objection, considering that the reasoning behind the objection was not even known to the proprietor. Further, Auxiliary Requests III ter and III quater were, *prima facie*, allowable, and should be admitted for this reason, too.

58. The Board does not recognize the circumstances as exceptional in the sense of Article 13(2) RPBA 2020.
59. In the present case, O15, and a respective argumentation, were filed for the first time by the opponent with the statement of grounds of appeal. The focus was on novelty, but inventive step starting from O15 was also addressed (page 16, paragraph preceding point 2; page 23, second paragraph). The Board acknowledges the proprietor's right to react to those submissions, which they did in the form of two replies including counter-arguments and the filing of Auxiliary Requests II, III, IV, V, VI and VII. The opponent, in turn, adapted their objections based on O15 to the newly filed auxiliary requests. In particular, the opponent attacked, albeit briefly, the inventiveness of Auxiliary Request III starting from O15 (letter dated 18 December 2018, page 13, first to third paragraphs). Moreover, in the further written procedure the proprietor filed yet another batch of auxiliary requests; II bis and III bis.

60. The Board's preliminary opinion was based on the facts, evidence and arguments put before it. In particular, the Board picked up the same distinguishing feature over claim 1 of auxiliary request III (determination of the imaging area from the diagnosis information) as had the opponent in its foregoing, fallback inventive step attack based on O15 (preliminary opinion, point 70; letter dated 18 December 2018, page 13, first to third paragraphs). The fact that the Board did not consider it necessary to resort to E1, E2 or E3 in assessing what the skilled person would have done, does not constitute a fresh case or surprising twist of proceedings in itself that would amount to exceptional circumstances in the sense of Article 13(2) RPBA 2020. The proprietor was in a position to decide by which versions they intended to defend the patent without waiting for the Board's assessment of their arguments. The purpose of the strict admission criteria of Article 13 RPBA 2020 is precisely the opposite of that of awaiting the Board's preliminary opinion, namely, to prevent the submission of amendments to the appeal case at a later stage than necessary, thus avoiding unnecessary complication and prolongation of the proceedings to the detriment of procedural economy.
61. It follows from the above that there are no exceptional circumstances, let alone any justifying cogent reasons. As a result, the Board is not taking account of Auxiliary Requests III ter and III quater (Article 13(2) RPBA 2020).

*Auxiliary Requests IV, V, VI and VII - admission*

62. Each of Auxiliary Requests IV, V, VI and VII was filed with one of the two replies to the appeal. Their

respective admission is governed by Article 12(4) RPBA 2007.

63. The subject-matter of claim 1 of Auxiliary Request IV differs from the Main Request in that the medical imaging apparatus is an MRI apparatus and in that the display unit of the apparatus comprises a user interface allowing a selection of a desired protocol from the recommended ones. In Auxiliary Requests V to VII, the user interface and its operation is defined in increasingly more detail.
64. By defining a user interface without even including the features added by the higher-ranking requests, Auxiliary Requests IV - VII go into a completely different direction than the higher-ranking requests. Auxiliary Requests II and II bis differ from the Main Request in that they define, in increasing detail, particular configurations of the apparatus for MRI. In turn, Auxiliary Requests III and III bis differ from the Main Request in details of the received subject information and its use for determining the protocols that are to be classified. The details of MRI and of the automated protocol determination are different from a user interface for selecting items on a display.
65. The opponent submits that the respective subject-matter of all auxiliary requests was correlated. They all related to the problem of improving the manner of how to select a protocol to scan the subject. Displaying and selecting a protocol using the user interface was part of the overall recommendation and selection procedure that was at the core of the invention. This followed from paragraphs [0085], [0101] and [0102] of the patent publication. In addition, the opponent referred to the arguments that were brought forward in

favour of admission of Auxiliary Requests II bis, III bis, III ter and III quater. These arguments mainly related to the auxiliary requests being a legitimate reaction, at the earliest possible time, to the fresh case caused by the filing of O15.

66. The Board neither questions that O15 introduces a fresh case nor the proprietor's right to file new requests in reaction. What is objected to here is the filing of requests that go into different directions.
67. The object of the invention as described in the patent publication is to "automatically recommend protocols suitable for image capture of a subject based on information related to the subject" (see paragraph [0017]). The Board agrees with the proprietor in that automatically selecting protocols from a database using the received subject information, as well as classifying and displaying the selected protocols, are part of the recommendation. Hence, the subject of all requests that are higher ranking than Auxiliary Request IV stay within the idea of recommending protocols. The particular user interface, however, that allows the operator to select one of the protocols displayed as a result of the recommendation, is something else entirely, because it does not contribute to the definition of the preceding automatic recommendation in any way.
68. It is settled case law that the admission of requests during appeal proceedings depends on whether they converge or diverge with the subject-matter of higher-ranking requests (Case Law, V.A.4.12.4; see also decision T 1903/13, point 3.3.4 and 3.3.5).



69. In view of the above, Auxiliary Requests IV, V, VI and VII are not admitted into the proceedings, because they each define a line of development diverging from the lines of the higher-ranking requests (Article 12(4) RPBA 2007).

*Remittal to the first instance*

70. As mentioned, the proprietor requests remittal of the case to the first instance, in the event that O15 is admitted into the proceedings. This condition is met.
71. The opponent argued against a remittal.
72. Article 111(1) EPC leaves it to the Board's discretion to remit the case to the first instance. According to Article 11 RPBA 2020, however, a board shall not remit a case, unless there are special reasons for doing so. The aim of the latter provision is to reduce the likelihood of a "ping-pong" effect between the Boards and the departments of first instance, and a consequent undue prolongation of the entire proceedings before the EPO (OJ, Supplementary publication 2/2020; explanatory remarks relating to Article 11).
73. Although O15 was newly filed with the statement of grounds of appeal, the respectively submitted objections of lack of novelty and lack of inventive step stay within the patentability issues that had been examined and discussed during opposition proceedings in relation with other documents. Both parties' arguments relating to O15 correspond closely to arguments already put forward with respect to the other documents without requiring the assessment of new questions or a different interpretation of claim features. To the

contrary, O15 even simplifies the discussion on certain points of claim interpretation such as on the interpretation of "to classify". Hence, all issues relating to O15 could be dealt with without undue burden, the factor which was also decisive in T 1089/17 (see points 4 and 5 therein, and point 75., below). In view of these circumstances, there are no special reasons for remittal (see also OJ Supplementary publication 2/2020, *ibidem*). The case will thus be decided on the merits by the Board. This will also prevent an undue prolongation of the overall proceedings to the detriment of procedural economy.

74. The proprietor holds that the principles of decision T 1089/17 were not applicable to the present case. In the case T 1089/17, the document that was admitted into the appeal proceedings was similar to a document cited in the patent application, and therefore already known to the proprietor. It was also clearly more relevant than the other documents cited, unlike in the present case. In addition, the requests filed by the proprietor in reply to the new document were admitted into the proceedings.
  
75. In the Board's view, however, the case T 1089/17 (see points 4 and 5), although different from the present case in its details, corresponds to the case at hand in the relevant points. Namely, in that a new, highly relevant document was introduced during appeal proceedings, the respective grounds of opposition raised in this regard were already discussed during opposition proceedings in relation to other documents, and the issues relating to the new document could be dealt with without undue burden, even in a more simplified way. The parallels are such that this Board reaches a similar conclusion to that of the Board in T

1089/17, to the effect that there are no special reasons for remitting the case to the first instance.

*Complaint by the proprietor*

76. During oral proceedings, the proprietor also filed the following written complaint, which is attached to the decision:

*Herewith I submit that the Proprietor's right to be heard is violated because the decision not to remit the case to first instance and not to admit auxiliary requests ARIIIter, ARIIIquater, IV, V, VI and VII into the proceedings leads to a situation where the requirements of article 113 EPC are not fulfilled. The reasons are as follows:*

- The request for remitting the case to first instance was refused, so that the Proprietor did not have a chance to defend the case before two instances;*
- The previous auxiliary request (ARIII) was not allowed based on lack of inventive step in view of late filed document O15 (only submitted with the grounds of appeal and not discussed before the opposition division);*
- The opinion of the Board in connection with ARIII does not discuss lack of inventive step in view of O15, and the*

*grounds for deciding on lack of inventive step are not known to the Proprietor;*

*- ARIIIter, ARIIIquater, IV, V, VI and VII are requests which attempt to overcome the (unknown) inventive step objection;*

*- By not admitting auxiliary requests ARIIIter, ARIIIquater, IV, V, VI, VII the Proprietor has not been able to adequately defend her rights.*

*Referring to Article 112a(2)(c) EPC and Rule 106 EPC, I raise this objection during the oral proceedings, and request to make a note in the minutes and the decision.*

77. Further to these points, the proprietor argues that the introduction of O15 had altered the factual framework of the case by bringing into play new facts and evidence that had not been discussed during opposition proceedings. For the proprietor to adequately defend their case, the Board should have either remitted the case or admitted all auxiliary requests. The Board's task was to review the decision but not to replace the Opposition Division, as was confirmed under points 7.2 to 7.4 of the decision T 731/17.
78. The first part of the proprietor's complaint lies in that their right to be heard was violated by the Board considering O15 without remitting the case to the first instance.

79. The Board notes that a right to have every matter decided by two instances does not exist (Case Law, V.A. 7 and 7.2.1).

Furthermore, the Board is not aware of any fundamental procedural deficiency in the first instance proceedings. Hence, a possible remittal according to Article 11 RPBA 2020 depends upon whether, at the Board's discretion, the introduction of O15 otherwise provides a special reason for such remittal. However, as explained under point 73., above, O15 could be dealt with without undue burden in the appeal proceedings. Accordingly, the Board's decision not to remit does not entail a fundamental violation of the proprietor's right to be heard.

80. In the case T 731/17, which was cited by the proprietor in support of their argument, the only inventive step analysis that was covered in detail by the decision under appeal used a general-purpose computer as a starting point. The responsible board concluded that it could not perform an inventive step discussion based on particular documents (D1 - D4) without undue burden and remitted the case. Due to the very different circumstances, this outcome has no implication for the present case.

81. The second part of the proprietor's complaint lies in that their right to be heard was violated by the Board not admitting Auxiliary Requests III ter, III quater, IV, V, VI and VII in reaction to the admission of O15 into the appeal proceedings.

82. In reply to the opponent's patentability objections based on O15, the proprietor submitted counter-arguments, re-filed Auxiliary Request I, and filed

Auxiliary Requests II, III, IV, V, VI and VII. Further, in reaction to the opponent's reply to these filings, the proprietor filed additional Auxiliary Requests II bis and III bis (see points 59. and 60.). Of those, Auxiliary Requests I, II and III have been considered by the Board. Hence, the proprietor was given ample opportunity to present their comments and to submit requests.

83. When drafting the Auxiliary Requests, the proprietor must have expected that the opponent adapted their original argumentation based on O15 to the new requests. They must have also expected that the Board might not follow the opponent's complete argumentation, such that inventive step over O15 alone would also be examined. The Board's provisional opinion merely presented an assessment of the situation, which assessment was not a fresh case on its own (see point 60.). Hence, the proprietor could have filed all auxiliary requests already in reply to the opponent's statement of grounds of appeal, before receiving the Board's provisional opinion.
84. The right to be heard and to react to O15 does not exempt the proprietor from the duty to file their requests as early as possible. Nor does it exempt the requests from being examined with regard to their admission according to established criteria. Correspondingly, the non-admission of some of the proprietor's claim requests is not a disrespect of the right to be heard, but a result of the Board using its discretionary powers on admission as laid out in the relevant provisions (see points 61. and 69.).
85. The proprietor further complained, during oral proceedings, that they did not know the exact reason

why the Board found Auxiliary Request III not to be inventive. It is not clear, to the Board, how this complaint relates to the alleged violation of the right to be heard. Nonetheless, it is noted that the proprietor has no right to expect the Board to explain the reasons for its decisions in detail during oral proceedings, or, previously, in the provisional opinion for that matter. Rather, they may assume that the reasons address the essential arguments put forward by the parties. In the present case, the opponent presented several inventive step attacks against Auxiliary Request III starting from O15 during the oral proceedings, the first of which relied on O15 alone. After a discussion of these attacks with the proprietor, the Board announced its conclusion and explicitly stated that it followed the lines of the opponent's first inventive step attack based on O15 alone. Hence, the allegation of the proprietor that they did not know the reasons why Auxiliary Request III lacked an inventive step are unsustainable.

86. In view of the above, the Board considers that the proprietor's right to be heard has been respected both with regard to remittal and admission, which decisions were at the Board's discretion (Articles 111(1) and 113(1) EPC, Articles 11 and 13(2) RPBA 2020, and Article 12(4) RPBA 2007). Hence, the proprietor's complaint is unfounded and must be dismissed.

### *Conclusion*

87. With no allowable claim request on file, the appealed decision must be set aside and the patent revoked.

**Order**

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

1. The appealed decision is set aside.
2. The patent is revoked.

The Registrar:

The Chair:



H. Jenney

B. Noll

Decision electronically authenticated