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**Datasheet for the decision
of 29 October 2019**

Case Number: T 0816/19 - 3.4.03

Application Number: 11773305.5

Publication Number: 2617109

IPC: H01S5/14, H01S5/183, G02B21/00,
G02B21/16, H01S3/081, H01S3/11

Language of the proceedings: EN

Title of invention:

NON-LINEAR MICROSCOPE COMPRISING MODE LOCKED SEMICONDUCTOR DISK
LASER

Applicant:

The University of Dundee

Headword:

Relevant legal provisions:

EPC Art. 84, 94(3), 97(2), 111(1), 113(1)
EPC R. 43(1), 43(3), 71(3), 71(6), 115(2)
PCT Art. 6
RPBA Art. 11, 12(2), 15

Keyword:

Remittal to the department of first instance - fundamental
deficiency in first instance proceedings (no)
Right to be heard - examination procedure - violation (no)
Statement of grounds of appeal - party's complete case

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0816/19 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 29 October 2019

Appellant: The University of Dundee
(Applicant) Nethergate
Dundee DD1 4HN (GB)

Representative: Gordon, Naoise Padhraic Edward
Black & Associates Limited
Office 2/1
211 Dumbarton Road
Glasgow G11 6AA (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 2 November 2018
refusing European patent application No.
11773305.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: S. Ward
G. Decker

Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division refusing European patent application No. 11 773 305 on the grounds that the subject-matter of claim 1 was not clear, and therefore did not meet the requirements of Article 84 EPC, and that the application did "not meet the requirement following from Article 84 EPC, taken in combination with Rule 43(1) and (3) EPC, that the independent claim must contain all the technical features essential to the definition of the invention".
- II. In the statement of grounds of appeal the appellant requested "that the Decision of the Examining Division to refuse the application be overturned and that the ... patent application be remitted to the Examining Division for examination."
- III. Claim 1 of the currently valid request (claims 1-12 filed with letter of 27 September 2018 and rejected in the contested decision) reads as follows:

"A non-linear microscope (2) which comprises a mode locked semiconductor disk laser (3) which provides an incident beam of the microscope, wherein the mode locked semiconductor disk laser produces pulses having an ultra-short pulse length, wherein the laser wavelength of the laser beam is at or near the action cross section maximum wavelength for creating two photon excited fluorescence of a fluorescing biological marker in a sample wherein the semiconductor disk laser is mode locked with a quantum dot semiconductor saturable absorber mirror (SESAM) and has a cavity with end mirrors formed by the SESAM and a curved output

coupling mirror and wherein the mode locked semiconductor laser produces pulses of less than 2 picoseconds at a repetition rate of less than 1 GHz such that the mode locked semiconductor disk laser is suitable for providing an incident beam for the second harmonic generation (SHG) imaging and for two photon excitation fluorescence (TPEF) imaging, wherein preferably a TPEF and a SHG image are viewable in combination."

IV. The procedural history of the case, insofar as it is relevant, may be summarised as follows:

(i) The application was filed as international patent application PCT/GB2011/001361 and published as WO 2012/035307 A1. A Written Opinion of the International Searching Authority (WOISA) was drawn up, in which the claims then on file were found to lack clarity (Article 6 PCT), and to lack novelty and/or inventive step.

(ii) The application entered the European phase as application No. 11 773 305 on the basis of a set of amended claims 1-14. In the subsequent communication pursuant to Article 94(3) EPC dated 26 November 2014 the Examining Division noted that a WOISA had already been drawn up, and concluded that the "deficiencies mentioned in that report give rise to objections under the corresponding provisions of the EPC." New objections under Articles 84 and 123(2) EPC were also raised in the light of the amendments.

(iii) A response was filed by the applicant-appellant dated 2 June 2015 together with amended claims 1-12; arguments were given in support of the new claims.

(iv) The second action of the Examining Division was a communication under Rule 71(3) EPC dated 6 June 2018 informing the applicant of the intention to grant a patent based on claims comprising amendments proposed by the Examining Division, and explaining why such amendments were considered necessary in relation to the requirements of Article 84 EPC.

(v) The applicant-appellant filed a response dated 27 September 2018 with "a reasoned statement and amendments to the claims under Rule 71(6) EPC". The applicant-appellant did not, therefore, approve the amended claims proposed by the Examining Division.

(vi) The Examining Division directly issued a decision refusing the application on the grounds that the latest filed claims failed to meet the requirements of the EPC.

V. The appellant's arguments in the statement of grounds of appeal, insofar as they are relevant to the present decision, may be summarised as follows:

The examination procedure comprised a single examination report, whereas Article 94(3) EPC and Guidelines C-IV, 3 provided for communication with the applicant as often as necessary. The applicant had cooperated fully with the examination process.

The Guidelines stated that "where there is a reasonable prospect that an additional invitation to overcome the objection(s) could lead to the grant of the application, the examiner will send a further written communication or contact the applicant by telephone." In this case, it was self-evident that such a reasonable prospect existed, because the Examining

Division issued the communication under Rule 71(3) EPC dated 6 June 2018. The correct course of action at that stage would therefore have been to issue a second communication pursuant to Article 94(3) EPC which set out the scope of claims which were acceptable to the Examining Division. The applicant's right to be heard under Article 113 EPC had not, therefore, been respected, because the Examining Division had contravened its own Guidelines.

Moreover, the Guidelines allowed the Examining Division to include amendments made on its own initiative in the text for approval, but only where the applicant could reasonably be expected to accept them. In case of doubt, the applicant should be contacted by telephone or an official communication should be written.

Guidelines C-V, 1.1 gave examples of the type of amendments which might not be proposed without consulting the applicant. The first example given was, "amendments which significantly change the meaning or scope of the claims, if there are different ways of amending the claim, so that the examiner cannot assume to which possibility the applicant will agree".

In this case, the Examining Division proposed a substantial claim amendment which limited the scope of the claim to a single wavelength and peak power value. It was reasonable to conclude that the applicant would not accept such an amendment, but the applicant was not contacted by telephone, nor was an official communication issued. The Examining Division therefore failed to follow its own Guidelines for a second time.

The applicant's right to be heard under Article 113 EPC was therefore not respected because the Examining

Division contravened its own Guidelines on two separate occasions during examination.

- VI. With the summons to oral proceedings, the Board sent the appellant a communication under Article 15(1) RPBA setting out its provisional views. The Board noted that the statement of grounds of appeal did not comprise any arguments attempting to rebut the substantive findings of the Examining Division, and that the appellant's case was entirely focused on establishing that the procedure followed by the Examining Division was flawed. The Board presumed that the basis for the requested remittal to the Examining Division was Article 111(1) EPC, in conjunction with Article 11 RPBA. The provisional view of the Board was that this was not warranted.
- VII. In a subsequent letter dated 23 October 2019 the appellant confirmed that it would not attend oral proceedings and submitted further arguments in support of its case.

Reasons for the Decision

1. The appeal is admissible.
2. As announced in advance, the duly summoned appellant did not attend the oral proceedings. According to Rule 115(2) EPC, if a party duly summoned to oral proceedings does not appear as summoned, the proceedings may nevertheless continue, the party then being treated as relying only on its written case. As the present case was ready for decision at the

conclusion of the oral proceedings (Article 15(5) and (6) RPBA), the voluntary absence of the appellant was not a reason for delaying the decision (Article 15(3) RPBA).

3. *The framework of the appeal*

3.1 Rule 12(2) RPBA states the following:

"The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on ..."

3.2 The present appeal is against the decision of the Examining Division to refuse the application on the grounds that the claimed subject-matter did not meet the requirements of Article 84 EPC, due to a lack of clarity, and did not meet the requirements of Article 84 EPC in combination with Rules 43(1) and (3) EPC, as claim 1 did not contain all the technical features essential to the definition of the invention.

The statement of grounds of appeal does not comprise any arguments attempting to rebut the substantive findings of the Examining Division, nor have any amendments been filed aimed at overcoming the Examining Division's objections. Instead, the arguments of the appellant are entirely focused on establishing that the procedure followed by the Examining Division was flawed. In particular, according to the appellant, "the applicant's right to be heard under Article 113 EPC has not been respected because the Examining Division has contravened its own guidelines ..." (page 3, point iii,

3; page 4, point 4). Consequently, the decision should be overturned, and the application "remitted to the Examining Division for examination."

- 3.3 In the communication pursuant to Article 15(1) RPBA, the Board stated that, although no specific legal basis had been cited for the requested remittal, it was presumed that the appellant requested that the case be remitted to the Examining Division pursuant to Article 111(1) EPC in conjunction with Article 11 RPBA. This view was not contested in the appellant's subsequent letter.

Article 11 RPBA states the following:

"A Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise."

The Board accepts that a failure to respect the requirements of Article 113(1) EPC is generally considered to constitute a fundamental deficiency within the meaning of Article 11 RPBA.

- 3.4 In summary, the Board understands the position of the appellant to be as follows: the Examining Division violated its right to be heard under Article 113(1) EPC; this constitutes a fundamental deficiency within the meaning of Article 11 RPBA, and consequently the case should be remitted to the Examining Division pursuant to Article 111(1) EPC in conjunction with Article 11 RPBA.

- 3.5 These contentions, together with the corresponding supporting arguments in the statement of grounds of

appeal therefore constitute the appellant's "complete case" within the meaning of Article 12(2) RPBA, and form the subject of the present appeal.

3.6 The substantive findings of the Examining Division have not been challenged in the statement of grounds of appeal, and therefore will not be considered in the present appeal.

4. *Alleged violation of the requirements of Article 113(1) EPC*

4.1 The first action of the Examining Division was a communication under Article 94(3) EPC raising objections under Articles 84 and 123(2) EPC and making reference to the WOISA (see above, point IV(ii)). The response of the applicant-appellant dated 2 June 2015 included amended claims 1-12 and arguments in support thereof (see above, point IV(iii)).

The second action of the Examining Division was a communication under Rule 71(3) EPC (see above, point IV(iv)) informing the applicant of the intention to grant a patent based on claims comprising amendments proposed by the Examining Division, and explaining why such amendments were considered necessary in relation to the requirements of Article 84 EPC.

4.2 The appellant essentially argues that the Examining Division was wrong in:

(a) failing to send a second communication under Article 94(3) EPC; and

(b) proposing the grant of a patent based on inappropriate amendments without prior consultation with the applicant.

These two alleged errors are considered to be contrary to the Guidelines and to result in a violation of the right to be heard under Article 113(1) EPC.

4.3 Article 113(1) EPC states the following:

"The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments."

In the light of the wording of the article itself, establishing that a party's right to be heard pursuant to Article 113(1) EPC has not been respected would require a clear demonstration that a *decision of the European Patent Office* was based on grounds or evidence on which the party did not have an opportunity to present its comments.

4.4 The choice by the Examining Division not to proceed by means of a second communication under Article 94(3) EPC is not a "decision of the European Patent Office". Moreover, neither the choice to issue a communication under Rule 71(3) EPC nor the contents thereof (including any proposed amendments annexed thereto) is a decision of the European Patent Office. The only action in the proceedings before the department of first instance which constitutes a decision of the European Patent Office within the meaning of Article 113(1) EPC is the decision of the Examining Division to refuse the European patent application pursuant to Article 97(2) EPC.

Consequently, to establish that the requirements of Article 113(1) EPC were not met, the appellant would need to provide a convincing argument why the decision to refuse the application was based on grounds or evidence on which it had no opportunity to present its comments.

- 4.5 In the statement of grounds of appeal, however, there is not even an attempt to construct an argument relating to the content of the decision to refuse the application. Instead, the appellant's arguments focus exclusively on the two alleged procedural deficiencies in the written procedure leading up to the issuing of the decision. Even if the Board were to accept that the written procedure was not conducted according to the Guidelines, no explanation is given in the statement of grounds of appeal why this would imply that the decision to refuse the application was inconsistent with Article 113(1) EPC.

The appellant's contentions that the Examining Division was wrong not to send a second communication under Article 94(3) EPC and to propose allegedly inappropriate amendments do not, therefore, constitute arguments that the requirements of Article 113(1) EPC have not been met (whether the decision of the Examining Division actually meets the requirements of Article 113(1) EPC is dealt with below under point 7).

- 4.6 The Board is nevertheless prepared to look at the question whether the procedure adopted by the Examining Division was inconsistent with normal office practice, as reflected in the Guidelines, and if so, whether this would in itself constitute a fundamental deficiency

warranting remittal of the case pursuant to Article 11 RPBA.

5. *No second communication under Article 94(3) EPC*

5.1 The appellant argues that the Examining Division was wrong to issue a communication under Rule 71(3) EPC when it did, and should instead have issued a further communication under Article 94(3) EPC.

5.2 Article 94(3) EPC states the following:

"If the examination reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the Examining Division shall invite the applicant, as often as necessary, to file his observations and, subject to Article 123, paragraph 1, to amend the application."

It is for the Examining Division to determine, in the light of the circumstances of the case, whether to send a second or further communication under Article 94(3) EPC (see *Case Law of the Boards of Appeal, 9th edition 2019, IV.B.2.4.1*, last two paragraphs).

5.3 In issuing the communication under Rule 71(3) EPC, the Examining Division evidently judged that the case was ready for grant, subject to the proposed amendments which, as explained in the communication under Rule 71(3) EPC, were, in its view, necessary to overcome the objections under Article 84 EPC. The question whether the proposed amendments were reasonable or appropriate is a separate issue which will be dealt with below under point 6.

Given its position that the case was ready for grant, issuing a further communication under Article 94(3) EPC would have served no purpose, and it is perfectly consistent with normal office practice and the Guidelines that the Examining Division chose, at this point, to send a communication under Rule 71(3) EPC.

6. *The amendments proposed in the communication under Rule 71(3) EPC*

6.1 The appellant argues that the amendments made by the Examining Division were substantial, and, having regard to Guidelines C-V, 1.1 (the edition of November 2017 would have been in force), they should not have been proposed in a communication under Rule 71(3) EPC.

6.2 The Board accepts that, in the light of Guidelines C-V, 1.1, and the nature of the proposed amendments, it is debatable whether it was wise to propose these amendments in a communication under Rule 71(3) EPC, without first consulting the applicant. However, even if the Examining Division contravened the Guidelines in this respect, this would not, in the view of the Board, warrant remittal under Article 11 RPBA.

6.3 Firstly, proposing amendments which are overly limiting might well be considered an error of judgement in relation to the substance of the case, but it does not constitute a fundamental *procedural* deficiency as required for remittal under Article 11 RPBA (see *Case Law of the Boards of Appeal, 9th edition, 2019, V.A. 7.7.1*).

6.4 Secondly, as set out in Guidelines C-V, 1.1, the reason why the Examining Division should not propose far-reaching or very limiting amendments is "to avoid

changes which the applicant is more likely to reject, thus helping to avoid delays in the conclusion of examination proceedings". It is therefore a matter of efficiency.

Pursuant to Article 113(2) EPC, the applicant can refuse to approve the text of an amendment which it finds unduly limiting (as happened in the present case). Instead, the applicant may request reasoned amendments or corrections to the communicated text or may keep to the latest text submitted. In such a case, "the Examining Division shall issue a new communication under paragraph 3 if it gives its consent; otherwise it shall resume the examination proceedings" (Rule 71(6) EPC).

6.5 Hence, even if an amendment proposed in a communication under Rule 71(3) EPC is inappropriate, no fundamental loss of rights is at stake, since the applicant always retains the right to disapprove such an amendment, thereby triggering either a new communication under Rule 71(3) EPC or a resumption of examination proceedings, pursuant to Rule 71(6) EPC.

6.6 In summary, a proposal for amendment made in a communication under Rule 71(3) EPC, even if the amendments may be judged inappropriate, does not, by itself, constitute a fundamental deficiency in the proceedings within the meaning of Article 11 RPBA.

7. *Issuing the decision to refuse the application*

7.1 Following the response to the communication under Article 71(3) EPC, in which the applicant-appellant declined to approve the amended claims proposed by the Examining Division and submitted instead new claims and

supporting arguments, the Examining Division directly issued a decision to refuse the application on the grounds that these new claims failed to meet the requirements of the EPC.

Although the appellant has not explicitly challenged this aspect of the procedure, it is, in the Board's view, also necessary to look at whether such an immediate refusal complies with the requirement of Rule 71(6) EPC to "resume the examination proceedings" and with the requirement of the right to be heard under Article 113(1) EPC.

- 7.2 According to the Guidelines C-V, 4.7.1 (edition of November 2017; "Communications/oral proceedings after resumption") a direct refusal of the application is possible in these circumstances, under certain conditions:

"If the following criteria are satisfied, the application may be refused directly:

"(a) the grounds and evidence behind the non-allowance or non admittance of the request filed in response to the Rule 71(3) communication have already been dealt with in examination proceedings (Art. 113(1));

"(b) the applicant has received at least one communication according to Art. 94(3) and Rule 71(1) and (2) (see C-III, 4); and

"(c) the applicant's right to oral proceedings on request has been respected (Art. 116(1))."

The Board sees no reason to deviate from the conclusions drawn in this section of the Guidelines.

7.3 In the present case, a communication according to Article 94(3) and Rule 71(1) and (2) EPC had been sent and there was no request on file for oral proceedings. Hence, only criterion (a) is relevant, which aims at safeguarding the appellant's right to be heard. The question is therefore whether the reasons given for refusing the application had already been communicated to the applicant during the examination proceedings.

7.4 In the contested decision, the Examining Division found (Reasons, point 1.1) that the following feature was unclear:

"the laser wavelength of the laser beam is at or near the action cross section maximum wavelength for creating two photon excited fluorescence of a fluorescing biological marker in a sample".

7.5 The finding that this feature lacked clarity, and the reasons for this conclusion, were first mentioned in section 1.1(ii) of the Written Opinion of the International Searching Authority (WOISA). In the communication under Article 94(3) EPC dated 26 November 2014 the following was stated:

"A Written Opinion of the International Searching Authority (WOISA) has already been drawn up for the present application in accordance with the PCT. The deficiencies mentioned in that report give rise to objections under the corresponding provisions of the EPC.

"The amendments made upon entry into the European phase do not overcome these objections and give rise to new objections as follows ...".

This objection was also set out on sheet 2 of the communication under Rule 71(3) EPC.

7.6 The Examining Division also found in the contested decision (Reasons, point 1.2) that the wavelength and the corresponding peak power of the laser were essential features of the invention (Article 84 in combination with Rules 43(1) and (3) EPC). This objection also had previously been stated on sheet 2 of the communication under Rule 71(3) EPC.

7.7 Both of these objections would apply equally to the claims on which the contested decision was based. In particular, claim 1 proposed by the applicant with the letter dated 27 September 2018 comprises the feature mentioned above under point 7.4 word for word, and does not define the wavelength and the corresponding peak power of the laser, which the Examining Division had previously explained were, in its opinion, essential features of the invention.

The Board makes no comment on whether the reasons for refusing the application were well-founded or not; that is not the subject of the present appeal (see point 3.6, above). It is simply noted that these objections had been communicated by the Examining Division to the applicant during examination and prior to the decision to refuse.

7.8 The Board sees no reason to suppose that the Examining Division did not take into account the counter-arguments in the applicant's response dated 27 September 2018, these arguments being explicitly mentioned in the decision (see point 7 of the Summary of Facts and Submissions). Rather it appears that the

Examining Division was simply unpersuaded and held to its previously stated position.

7.9 The Board therefore judges that, in issuing the decision to refuse the application at the point at which it did, the Examining Division did not contravene the requirements of Article 113(1) or Rule 71(6) EPC, nor did it fail to follow the Guidelines.

8. *Further arguments of the appellant made in the letter of 23 October 2019*

8.1 In the letter of 23 October 2019 the appellant argues that a skilled person "would readily understand that the SDL wavelength had to be selected to match the Action Cross Section of the biomarker being used ... [and] would also have available to them, the relevant data which allowed the Specific Action Cross Section wavelength for the biomarker to be selected."

This argument can only be understood as an attempt to demonstrate that the claim is clear and/or comprises the essential features of the invention. In other words, it seeks to challenge the substantive decision of the Examining Division in relation to the requirements of Article 84 and/or Rule 43 EPC. These matters were not raised in the statement of grounds of appeal, and hence are not part of the present appeal (see above, point 3.6). The further argument that the claim amendments proposed by the Examining Division themselves rendered the claims unclear is irrelevant, as the decision to refuse the application was not based on these claims.

8.2 The appellant argues: "Whether the applicant could have chosen a different approach is irrelevant". The Board has never suggested otherwise.

8.3 The appellant also states the following:

"The Applicant's argument that 'The invention produces a very bright TPEF signal despite the fact that a very low peak power is used because the wavelength that provides the peak power is dependent upon the biological marker's two-photon action cross section' is not properly addressed by the Examining Division, nor are the previously submitted arguments on novelty and inventiveness."

In pointing out a technical advantage of the claimed non-linear microscope, the applicant-appellant is presumably advancing an argument in support of inventive step. Since the application was refused for lack of clarity and a failure to include the essential features of the invention in the independent claims, there was no obligation on the Examining Division to comment on this, or the other "arguments on novelty and inventiveness".

8.4 The appellant further argues as follows:

"The Grounds for Refusal document contains an Obiter Dictum statement which relates to possible inventive step arguments to which the applicant has been denied the right of reply."

By explicitly using the title "Obiter dictum" (i.e. "that which is said in passing") the Examining Division made it clear that the statements made under this heading merely reflected its opinions on certain

matters and did not represent the reasons for the decision (i.e. the *ratio decidendi*). Article 113(1) EPC only gives a right to be heard on grounds or evidence on which a decision of the European Patent Office is based, and since statements made *obiter dictum* do not form part of the basis for the decision, Article 113(1) EPC does not confer any "right of reply" (see *Case law of the Boards of Appeal of the European Patent Office*, 9th edition 2019, III.B.2.3.2, last paragraph, and the cases cited therein).

9. *Conclusion*

9.1 In the present appeal the question is not whether the Examining Division was correct in its substantive judgements on clarity or the essential features of the invention, as these were not challenged in the statement of grounds of appeal.

Equally irrelevant is whether the Board, if it were put in the position of the Examining Division, and had reached the same substantive conclusions, would have followed the same procedure or not.

9.2 The only question at issue in the present case is whether "fundamental deficiencies" within the meaning of Article 11 RPBA are apparent in the first instance proceedings, which would warrant overturning the decision and remitting the case to the Examining Division. For the reasons given above, this is not the case.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated