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Boards of Appeal

Chambres de recours

Case Number: T 1642/10 - 3.2.02

DECISION
of the Technical Board of Appeal 3.2.02
of 23 October 2013

Appellant: NATIONAL RESEARCH COUNCIL OF CANADA
(Patent Proprietor) 1200 Montreal Road
Ottawa, ON K1A 0R6 (CA)

Representative: Jansen, Cornelis Marinus
V.O.
Johan de Wittlaan 7
2517 JR Dan Haag (NL)

Respondent: HAMAMATSU PHOTONICS K.K.
(Opponent 1) 1126-1, Ichino-cho
Higashi-ku
Hamamatsu-shi
Shizuoka 435-8558 (JP)

Representative: HOFFMANN EITLE
Patent- und Rechtsanwälte
Arabellastrasse 4
D-81925 München (DE)

Respondent: Pulsion Medical Systems AG
(Opponent 2) Joseph-Wild-Strasse 20
D-81829 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 10 June 2010
revoking European patent No. 1143852 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: E. Dufrasne
Members: M. Stern
P. L. P. Weber

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Summary of Facts and Submissions

- I. The proprietor lodged an appeal against the decision of the Opposition Division dispatched on 10 June 2010 revoking European patent No. 1 143 852.
- II. The Opposition Division revoked the patent on the basis that the subject-matter of claim 1 of the granted patent lacked novelty over document D32, and that the subject-matter of the then pending auxiliary requests did not comply with the requirements of Articles 123(2), 84, 54 and/or 56 EPC. The ground of lack of inventive step was based on D32 as closest prior art.
- III. Notice of appeal was filed by the proprietor on 30 July 2010 and the fee for appeal was paid on 2 August 2010. A statement setting out the grounds of appeal was received on 11 October 2010.
- IV. In a communication under Article 15(1) and 17(2) RPBA dated 24 May 2013 annexed to a summons to oral proceedings, the Board gave its provisional opinion regarding novelty over document D32 and indicated that all further objections raised and substantiated by respondent-opponent 1 would also be discussed if considered necessary.

Respondent-opponent 2 remained silent throughout the appeal proceedings.

Hence, in what follows, references to "the respondent" are to be understood as referring to "respondent-opponent 1".

- V. With its letter dated 9 September 2013, the appellant filed auxiliary requests 1 to 6.
- VI. In its response dated 23 September 2013, the respondent objected to the admissibility of auxiliary requests 1 to 6 since they had been filed only about six weeks before the oral proceedings and contained features taken from the description which related to unsearched subject-matter.
- VII. Oral proceedings took place on 23 October 2013.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or, in the alternative, on the basis of one of auxiliary requests 1 and 2 filed with letter dated 9 September 2013, auxiliary request 3 filed during oral proceedings, and auxiliary requests 4 to 6 filed with letter dated 9 September 2013.

At the beginning of the oral proceedings the appellant requested that only novelty over document D32 be discussed and decided upon, particularly since novelty over document D1 and inventive step starting from D1 had not been substantiated by the respondents in reply to the statement of grounds of appeal. Moreover, for the discussion of any grounds other than novelty over D32, the appellant requested remittal of the case to the Opposition Division.

The respondent requested that the appeal be dismissed. It also requested that the Board make a final decision on all outstanding matters instead of remitting the

case to the Opposition Division, and that auxiliary requests 1 to 6 should not be admitted.

VIII. The following documents are of importance for the present decision:

- D1: JP-A-9 309 845 (with English translation)
- D9: Brochure "ARGUS-20 with C2400-75i"; printed May 1997
- D32: M. Sato et al.: "Development of Deep Organ Microcirculation Visualization Techniques Using an Infrared Biomicroscope System; Research Report 1990 from the Suzuken Memorial Foundation; Vol. 9, pages 63-73 and 228; 20 December, 1991
- D32a: English translation of D32.

IX. Claim 1 of the different requests reads as follows (amendments with respect to claim 1 of the main request, i.e. claim 1 of the patent as granted, are highlighted by the Board):

Main request:

"A device for visualizing movement of a fluorescent dye carried in the bloodstream of a cardiovascular bypass graft during a surgical procedure, the device comprising
a means capable of providing radiation suitable to excite the fluorescent dye;
a camera capable of capturing the radiation emitted from the fluorescent dye within the blood vessel as an angiographic image; and
wherein the camera captures images at the rate of at least 15 images per second;

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wherein the fluorescent dye is ICG and/or has a peak absorption and emission in the range 800 to 850 nm; wherein the camera is capable of obtaining multiple images of the cardiovascular bypass graft while the heart is beating; and wherein the device is suitable to convert the images into a viewable image."

Auxiliary request 1:

"A device for visualizing movement of a fluorescent dye carried in the bloodstream of a cardiovascular bypass graft during a surgical procedure, the device comprising:

a means capable of providing radiation suitable to excite the fluorescent dye;

a camera capable of capturing the radiation emitted from the fluorescent dye within the blood vessel as an angiographic image; and

wherein the camera captures images at the rate of at least 15 images per second;

wherein the fluorescent dye is ICG and/or has a peak absorption and emission in the range 800 to 850 nm;

wherein the camera is capable of obtaining multiple images of the cardiovascular bypass graft while the heart is beating; and

wherein the device is suitable to convert the images into a viewable image to assess graft patency."

Auxiliary request 2:

"A device for visualizing ~~movement of~~ a fluorescent dye carried in the bloodstream ~~of a cardiovascular bypass graft~~ during a surgical procedure, the device comprising:

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