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**D E C I S I O N**  
**of 4 August 2005**

**Case Number:** T 0736/01 - 3.3.9

**Application Number:** 92117731.7

**Publication Number:** 0537769

**IPC:** A61L 31

**Language of the proceedings:** EN

**Title of invention:**

Polypropylene multifilament warp knitted mesh and its use in surgery

**Patentee:**

United States Surgical Corporation

**Opponent:**

Ethicon GmbH & Co. KG

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 106(1), 107, 111(1)

**Keyword:**

"Admissibility of the appeal (yes)"

"Remittal to the first instance (yes)"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 0736/01 - 3.3.9

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.9**  
**of 4 August 2005**

**Appellant:**  
(Opponent)

Ethicon GmbH & Co. KG  
Robert-Koch-Straße 1  
D-22851 Norderstedt (DE)

**Representative:**

Both, Georg, et al.  
Uexküll & Stolberg Patentanwälte  
Beselerstraße 4  
D-22607 Hamburg (DE)

**Respondent:**  
(Proprietor of the patent)

United States Surgical Corporation  
150 Glover Avenue  
Norwalk, Connecticut 06856 (US)

**Representative:**

Hoffmann Eitle  
Patent- und Rechtsanwälte  
Arabellastraße 4  
D-81925 München (DE)

**Decision under appeal:**

Interlocutory decision of the Opposition  
Division of the European Patent Office orally  
announced on 8 March 2001 and posted 3 May 2001  
concerning maintenance of European patent  
No. 0537769 in amended form.

**Composition of the Board:**

**Chairman:** P. Kitzmantel  
**Members:** W. Ehrenreich  
B. Günzel

## Summary of Facts and Submissions

- I. Appeal was lodged by the Opponent *Ethicon GmbH*, (formerly *Ethicon GmbH & Co. KG*) on 2 June 2001 against the interlocutory decision of the Opposition Division to maintain the European patent No. 0 537 769 in amended form.

The patent entitled "Polypropylene multifilament warp knitted mesh and its use in surgery" had been granted in respect of European patent application No. 92 117 731.7 filed on 16 October 1992 in the name of *United States Surgical Corporation*.

- II. The decision under appeal was based on Claims 1 to 15 of a main request submitted in the oral proceedings before the Opposition Division on 8 March 2001. Claim 1 of the main request, which is a combination of Claims 1 and 2 of the patent as granted, reads as follows:

"1. A warp knitted surgical mesh fabricated from polypropylene multifilament yarn, wherein the polypropylene is an isotactic polypropylene resin having a melt flow index, g/10 min, of from 2 to 6."

Claims 2 to 13 were directly or indirectly dependent on Claim 1 and Claims 14 and 15 were directed to a method of making a surgical mesh.

- III. With respect to the prior art D1 to D8 cited in the opposition proceedings, the Opposition Division held that the subject-matter of the main request was novel and inventive. It was further held in the decision that

the amended Claim 1 complied with the Articles 84 and 123(2) and (3) EPC.

IV. With the Statement of the Grounds of Appeal filed on 31 August 2001, the Appellant submitted for the first time the documents:

D10 DE-A 20 29 437

D11 US-A 4 557 264 and

D12 C. C. Chu and L. Welch: "Characterization of morphologic and mechanical properties of surgical mesh fabrics"; J. Biomedical Materials Research, vol. 19, 903-916 (1985)

and argued that the claimed subject-matter lacked an inventive step over this new prior art.

V. With the letter of response dated 15 April 2002 the Respondent (Patent Proprietor) submitted that the appeal was inadmissible. In this respect, the following arguments were put forward:

- the decision under appeal referred only to the documents D1 to D8. No objections to the reasoning of the decision were provided by the Appellant in the Statement of the Grounds of Appeal;
- it followed from the Appellant's Statement that the Appellant was adversely affected by the continued maintenance of the patent only, but not by the decision as such. However, under Article 107 EPC, only a party adversely affected by a decision could lodge an appeal;

- the Appellant provided entirely new attacks against the patent on the basis of completely different prior art. Such objections could not be recognised as an appeal against the correctness of the first instance decision.

Furthermore, arguments as to the presence of an inventive step of the claimed subject-matter over the prior art - D10 to D12 inclusive - were provided.

- VI. The Appellant requested that the decision under appeal be set aside and the patent be revoked. Alternatively, oral proceedings were requested.
- VII. The Respondent requested that the appeal be rejected as inadmissible and that the patent be maintained in the form as allowed by the decision of the Opposition Division.

Furthermore, the Respondent expressed the view that D10 to D12 should not be admitted and asked for remittance of the case to the first instance if the Board decided to admit these new documents.

As an auxiliary measure, the Respondent also requested oral proceedings.

- VIII. In a communication dated 17 May 2005 the Board expressed its preliminary position that the appeal was admissible and that it was appropriate to admit D10 to D12 into the proceedings. The Board further informed the Parties that it intended to remit the case to the Opposition Division and asked them if, under these

circumstances, they maintained their respective requests for oral proceedings.

IX. In response to the above communication the Respondent (Patent Proprietor) informed the Board with the letter dated 1 June 2005 as follows:

"The Patent Owner does not require oral proceedings before the Board of Appeal on the specific question whether the case should be remitted to the first instance. However, if the Opponent wants oral proceedings on this specific issue, then the Patent Owner wishes to be present and to present his point of view to the Board of Appeal.

The Patent Owner maintains its request for oral proceedings on the substantive grounds of appeal. That means, the Patent Owner wants oral proceedings before the Opposition Division, after the case has been remitted to the first instance."

With the letter dated 18 July 2005 the Appellant informed the Board as follows:

"Under the circumstances explained in this communication, the Opponent does not maintain its request for oral proceedings. However, the Opponent maintains its request for oral proceedings on the substantive grounds of appeal, i.e., before the Opposition Division, after the case has been remitted to the Opposition Division."

## Reasons for the Decision

### 1. *Admissibility of the Appeal*

The Board does not accept the Respondent's analysis, with reference to Article 107 EPC, that the Appellant, by not taking issue with the reasons of the attacked decision, was not entitled to appeal because acting in this manner was tantamount to an admission that he was not adversely affected by the decision (see point V).

According to Article 106(1) EPC, an appeal lies from a decision - in the present case from the decision of the Opposition Division - rather than from the grounds of such a decision.

Concerning the requirements for the admissibility of the appeal, the Board refers to the case law of the boards of appeal, in particular to T 611/90 (OJ EPO 1993), Reasons 1 and 2, and to T 847/93 (not published in the OJ EPO), Reasons 1. It follows from this jurisprudence that admissibility of an appeal is not to be denied because the Appellant has not taken issue with the reasons upon which the decision of the Opposition Division is based but has presented a fresh case to the Board by submitting arguments based on new documents - provided the new arguments and evidence concern a ground of opposition which corresponds to one of the grounds on which the opposition had been filed.

This proviso has been met by the Appellant in the present case. The arguments presented in the Statement of the Grounds of Appeal on the basis of new evidence represented by D10 to D12 are related to the same

opposition ground under Article 100(a) EPC, namely that the claimed subject-matter lacked an inventive step. For these reasons, the requirements of admissibility of the appeal according to Article 107 EPC are fulfilled.

2. *Admission of the documents D10 to D12*

In the Board's judgment, the new documents introduced by the Appellant - in particular D12 in which the mechanical properties (inter alia flexural rigidity) of the three warp-knitted surgical meshes Mersilene<sup>R</sup> (made of polyester multifilament yarn), Teflon<sup>R</sup> (made of PTFE multifilament yarn) and Marlex<sup>R</sup> (made of PP monofilament yarn) are compared in relation to their fabric and yarn structure - are relevant and represent prior art which should be taken into account when assessing inventive step of the subject-matter of the current main request. D10 to D12 are therefore admitted into the proceedings.

3. *Remittal of the case to the previous instance*

Since it is not the function of an appeal to examine and decide upon a fresh case resulting from the newly submitted and admitted prior art (see T 26/88; OJ EPO 1991, 30, Reasons 12 and T 611/90 Reasons 3 and 4) the Board exercises its discretion according to Article 111(1) EPC and remits the case to the Opposition Division.



**Order**

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

1. The Appeal is admissible.
2. The decision under appeal is set aside.
3. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:

G. Röhn

P. Kitzmantel