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D E C I S I O N
of 23 March 2006

Case Number: T 0380/04 - 3.2.02

Application Number: 00114654.7

Publication Number: 1175917

IPC: A61M 1/34

Language of the proceedings: EN

Title of invention:
Hemodialysis apparatus

Applicant:
Fresenius Medical Care Deutschland GmbH

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 84, 123(2), 54

EPC R. 51(4)

Keyword:

"Novelty: yes, after amendments"

"Grant and printing fees: refunded"

Decisions cited:

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Catchword:

-



Case Number: T 0380/04 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 23 March 2006

Appellant: Fresenius Medical Care Deutschland GmbH
(Applicant) Else-Kröner-Strasse 1
D-61352 Bad Homburg v.d.H. (DE)

Representative: Laufhütte, Dieter
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 October 2003
refusing European application No. 00114654.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: M. Noel
A. Pignatelli

Summary of Facts and Submissions

- I. European patent application No. 00 114 654.7 (publication no. EP-A1-1175917) was refused by decision of the examining division dated 22 October 2003 on the grounds of lack of clarity (Art. 84 EPC) and lack of novelty (Art. 54 EPC) of the claimed subject-matter vis-à-vis the prior art document D1: WO-A1-98/50091.
- II. The appellant (applicant) lodged an appeal against this decision by notice received on 16 December 2003 and paid the appeal fee on the same day. A statement setting out the grounds of appeal was filed on 25 February 2004, along with new sets of claims.
- III. In response to a communication of the Board, the appellant submitted by letter dated 23 February 2006 new sets of amended claims.
- IV. Oral proceedings were held on 23 March 2006, during which the different requests were discussed.

At the end of the oral proceedings, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claim 1 filed as third auxiliary request on 23 February 2006 (now the main request).

Furthermore, he requested that the grant and printing fees paid on 1 August 2003 be reimbursed.

V. Claim 1 reads as follows:

"A hemodialysis and/or hemofiltration apparatus with an extracorporeal circuit (10) for receiving blood to be purified as well as with a hemodialyzer and/or hemofilter (20) communicating with the blood circuit (10), wherein upstream and downstream of the hemodialyzer and/or hemofilter (20) the blood circuit (10) has at least one supply line (12,14), respectively, for supplying a substitution fluid,

characterized in that

the apparatus further comprises measuring devices for recording the transmembrane pressure and/or hematocrit (HKT) and/or blood density, the measuring devices being connected to a control unit (100) for controlling one or several of the transmembrane pressure and/or hematocrit (HKT) and/or blood density, wherein the control unit (100) is designed such that the control is carried out by means (13,15) of at least one of the infusion rates (Q_{spre} , Q_{spost}) of the substitution fluid."

VI. At the oral proceedings, the appellant argued that the subject-matter of claim 1 differed from the teaching of D1 by its characterising features. It was, therefore, novel. The basic idea of the invention was to apply the infusion rates of the substitution fluid as actuating variables in order to control an operational and/or blood parameter. This concept was not disclosed by D1.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

Claim 1 is formed essentially by a combination of apparatus claims 7 and 8 of the application as filed. In particular:

The preamble of claim 1 corresponds to the preamble of original claim 7.

In the characterising portion of claim 1, the feature "the apparatus further comprises measuring devices...connected to a control unit (100)" is drawn up from original claim 8. The last feature "wherein the control unit (100) is designed such that the control is carried out by means (13,15) of at least one of the infusion rates (Q_{spre} , Q_{spost}) of the substitution fluid" is drawn up from the characterising portion of original claim 7.

According to the characterising portion of claim 7 as filed it is stated that the control unit (100) is used "for controlling one or several operational and/or blood parameters", whereas in claim 8 as filed it is stated that the measuring devices are used "for recording the operational and/or blood parameters". It is additionally specified in claim 2 as filed that "the operational and/or blood parameters are the trans-membrane pressure (TMP) and/or the blood density and/or the hematocrit value (HKT) of the blood". Therefore, the remaining features of claim 1 at issue, which refer

to the specific parameters to be successively recorded and controlled, are supported by the original claim 2 and the application as filed (see paragraph 38 of the version as published).

It results therefrom that the amendments made to claim 1 do not extend beyond the content of the application as filed, in accordance with the requirements of Art. 123(2) EPC. Furthermore, since the new claim 1 defines the parameters which are intended to be controlled by the control unit, the clarity objection raised by the examining division has been removed.

3. *Novelty*

Document D1 discloses (see figure) all the features contained in the preamble of claim 1, namely a hemodialysis and/or hemofiltration apparatus with an extracorporeal circuit 20,21 for receiving blood to be purified as well as with a hemodialyzer and/or hemofilter 8 communicating with the blood circuit, wherein upstream and downstream of the hemodialyzer and/or hemofilter the blood circuit has at least one supply line 25,26, respectively, for supplying a substitution fluid (see page 11, lines 1-15).

Moreover, D1 discloses measuring means (pressure sensor 30, flow rates sensors 2', 3', 4', scales 5, 6, 7) some of them being connected to a control unit 9-14. The control unit is designed such that the control is carried out by means (pumps 2,3) of at least one of the infusion rates of the substitution fluid (see page 11, line 28 to page 12, line 2). The electronic means of

the control unit serve not only to monitor but also to control and regulate the infusion rates of the substitution fluids as a function of the measured variables (see page 1, lines 5-9; from page 2, line 30 to page 3, line 3; page 5, lines 24-32).

The subject-matter of claim 1 differs from the disclosure of D1 by the specification of the same parameters which are first to be recorded (measured) and then to be controlled, successively, i.e. by the following features:

"for recording the transmembrane pressure and/or hematocrit (HKT) and/or blood density", and

"for controlling one or several of the transmembrane pressure and/or hematocrit (HKT) and/or blood density".

In document D1, instead, the treatment parameters are adjusted by the control means on the basis of the measured variables and other data (see D1, page 6, lines 1-12 and lines 22-32). These variables and parameters, however, are different from the claimed parameters.

Consequently, the subject-matter of claim 1 is novel over D1 within the meaning of Art. 54(1) EPC.

4. *Remittal*

Since the decision of refusal was exclusively based on the grounds of lack of clarity and lack of novelty, now removed, the Board finds it appropriate to remit the case to the first instance for further prosecution.

5. *Reimbursement of fees*

The appellant requested that the grant and printing fees he paid on 1 August 2003 after issue of the communication under Rule 51(4) EPC by the examining division be refunded.

As the decision under appeal correctly stated, the applicant was obliged to pay the grant and printing fees for the auxiliary request after the examining division sent the communication under Rule 51(4) EPC - even if it did disagree with the grant of the patent on the basis of this request - in order to avoid a loss of his rights due to a lack of clarity in the application of Rule 51(4) EPC at that time.

Legal advice No. 15/05 (OJ EPO 2005, 357) clarified that the applicants have the possibility to disagree with the version held to be allowable by the examining division and can maintain preceding requests and that in this case the payment of the grant and printing fees is not necessary (see Legal advice No. 15/05 point 1.5b).

The payment of the grant and printing fees of 1 August 2003 was therefore not justified.

Article 10c Rules relating to fees foresees that where too large a sum is paid to cover a fee, the excess shall not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund.

From this provision follows e contrario the general principle that an amount shall be refunded when it was paid without a legal basis.

In the present case, the full amount of the fees, which per definition is not an insignificant amount, has been paid and the party has requested the refund.

Therefore, the general principle referred to above has to be applied and the fees be reimbursed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claim 1 filed as third auxiliary request on 23 February 2006.
3. The request for reimbursement of the grant and printing fees paid on 1 August 2003 is allowed.

The Registrar:

The Chairman:

V. Commare

T. Kriner