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Datasheet for the decision of 19 June 2007

Case Number: T 1083/05 - 3.2.02

Application Number: 94201693.2

Publication Number: 0620017

IPC: A61M 1/36

Language of the proceedings: EN

Title of invention:
Device and method for depletion of the leukocyte content of blood products

Patentee:
PALL CORPORATION

Opponent:
Fresenius AG

Headword:
-

Relevant legal provisions:
EPC Art. 76, 100(c)

Keyword:
"Divisional application - extended subject-matter"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1083/05 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 19 June 2007

Appellant: (Patent Proprietor)
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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 30 June 2005 concerning maintenance of the European Patent No. 0620017 in amended form.

Composition of the Board:

Chairman: T. Kriner
Members: M. Noel
E. Dufrasne

Summary of Facts and Submissions

I. By interlocutory decision dated 8 June 2005 and posted 30 June 2005, the opposition division decided to maintain the European patent No. 0620017 in amended form according to the second auxiliary request then on file. The version as granted had been refused on the basis of Article 76(1) EPC.

II. The appellant (patentee) lodged on appeal against this decision by notice received on 22 August 2005 and paid the appeal fee on the same day. A statement setting out the grounds of appeal was filed on 10 November 2005.

III. Oral proceedings were held on 19 June 2007. 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 the auxiliary request filed with the statement of grounds.

The respondent (opponent) requested that the appeal be dismissed.

IV. Claim 1 according to the appellant's requests reads as follows:

Main request:

"A device for the depletion of the leukocyte content of a blood product comprising a filter element formed from synthetic fibres **characterized in that** the element includes an integral preformed multilayer element (12) of synthetic fibres, the surfaces of said fibres having

a modified CWST of from greater than 53 dynes/cm to up to 90 dynes/cm."

Auxiliary request:

The content of claim 1 of the main request and the following additional feature at the end of the claim:

"each of the layers being preformed to controlled density and pore size, either as a single layer, or in combination with one or more other layers, and said layers being bonded to each other."

V. At the oral proceedings the appellant presented the following arguments:

The characterizing feature of claim 1 of both requests according to which the surfaces of the fibres had "a modified CWST (Critical Wetting Surface Tension) of from greater than 53 dynes/cm to up to 90 dynes/cm" was validly supported as well by the divisional application as filed (see page 10, lines 46-51 of the version as published, EP-A-0 620 017) as by the earlier application as filed (see page 10, lines 50-55 of the version as published, EP-A-0 313 348). In the above-cited paragraphs the value of 90 dynes/cm was described as an upper limit above which the priming time of the filter element was not satisfying. The general instruction resulting therefrom was, therefore, to stay below and within a range up to 90 dynes/cm, the inclusion of the upper limit of 90 resulting from the understanding of the expression "CWST in excess of about 90 dynes/cm have been observed to have longer priming times". Further, since at the end of the quoted

paragraphs, filters with CWST in the range up to 90 dynes/cm were expressly mentioned there was a clear hint that the value of 90 dynes/cm had to be considered as an upper limit.

The range "up to 90 dynes/cm" in claim 1 as granted was not inconsistent with the slightly narrower range of "less than 90 dynes/cm" presented in claim 3 and on page 8, lines 11-12 of the divisional application as filed (published version), because the general information reported in the above cited paragraphs of the description of both the earlier and the divisional applications prevailed over any amendments made after the filing of the divisional application. The characterizing feature "up to 90 dynes/cm", therefore, did not extend the subject-matter of claim 1 beyond the content of the earlier application as filed, in accordance with the requirements of Article 76(1) EPC.

VI. The respondent submitted that an upper limit of 90 dynes/cm was meaningless and found no justification in the earlier application as filed, since filters with a CWST less than 90 dynes/cm functioned as well as filters with a CWST greater than 90 dynes/cm, as recited in the quoted paragraphs on page 10 of the earlier or the divisional application or in the examples presented in the description. Moreover, the expression "in excess of about 90 dynes/cm" excluded explicitly to consider 90 dynes/cm as an upper limit of the range. Because of excessively long priming time, the above paragraphs recommended that the CWST of the filter should be held within a range below about 75 dynes/cm, as was further mentioned in claim 33 or on page 18, lines 14-16 of the earlier application.

Moreover, the claimed feature "up to 90 dynes/cm" resulted in an unacceptable generalisation to all filters whereas the quoted passage was intentionally restricted to "some filters with CWST in excess of about 90 dynes/cm". Therefore, the disputed feature was not supported by the earlier application as filed, in contravention of the requirements of Article 76(1) EPC.

Reasons for the decision

1. The appeal is admissible.

2. *Article 100(c) EPC*

2.1 According to Article 100(c) EPC, a patent granted on a divisional application may be opposed on the ground that its subject-matter extends beyond the content of the earlier application as filed. Similar wording is used in Article 76(1) and Article 123(2) EPC which exclude the addition of new subject-matter during examination. Article 76(1) EPC states that a European divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed, and Article 123(2) EPC states that a European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

In the present case the patent in suit results from a divisional application (application number 94201693.2; published as EP-A-0 620 017) of the earlier application

(application number 88309851.9; published as EP-A2-0313348). In the following, the published versions of the earlier and the divisional applications will be referred to.

It is established by the European Patent Convention and its corresponding case-law that a divisional application has to meet the requirements of both Article 76(1) EPC and Article 123(2) EPC. With respect to the present case it has therefore to be assessed whether or not the feature according to which the surface of the fibres has a modified CWST of from greater than 53 dynes/cm to up to 90 dynes/cm is disclosed in the divisional application as filed (Article 123(2) EPC), and whether technical information has been introduced into the divisional application which a skilled person would not have objectively and unambiguously derived from the earlier application as filed (Article 76(1) EPC).

2.2 *Article 76(1) EPC*

Claim 1 according to the main and auxiliary requests states that the surfaces of the synthetic fibres of the filter should have "a modified CWST of from greater than 53 dynes/cm to up to 90 dynes/cm".

However, a range having such specific lower and upper CWST limits is not supported by the earlier application as filed, be it in the description or in the claims. While the lower limit of 53 dynes/cm can be deduced separately, for example from claims 11, 19, or 26 of the earlier application, the upper limit is generally described as remaining below about 75 dynes/cm (see

claims 14, 31, 33, 44) and pertains to ranges different from the range stated in claim 1 under dispute.

The upper limit of 90 dynes/cm is referred to in the earlier application exclusively on page 10, lines 50-55, in the following terms:

"For reasons which are not well understood, some filters which have CWST in excess of about 90 dynes/cm have been observed to have longer priming times. Since there appears to be no theoretical reason for the CWST of the filter media to greatly exceed the surface tension of water (73 dynes/cm) it appears advisable that the CWST be held within a range somewhat above the CWST of untreated polyester fibre (52 dynes/cm), and below about 75 dynes/cm. Nevertheless, filters with CWST in the range up to and over 90 dynes/cm and above have functioned well."

The expression "in excess of about 90 dynes/cm" is vague and ambiguous. An upper CWST limit of 90 dynes/cm cannot be derived therefrom with certainty, the more since the information given there with respect to the priming time only refers to "some filters" and, therefore, cannot be generalised to any filter element. Moreover, while the quoted paragraph advises to select a CWST in the range from above 52 dynes/cm to below 75 dynes/cm so as to avoid longer priming times, the next sentence, contradictorily, prompts the reader to use filters having modified CWST up to 90 dynes/cm and over and above apparently without any working difficulty. It results, again, that 90 dynes/cm cannot be considered as an upper limit value since all values situated on both sides are equally suitable and even

recommended. Therefore, the specific range as claimed of from greater than 53 dynes/cm to up to 90 dynes/cm is not justified and not derivable from said paragraph.

Other paragraphs in the earlier application refer to examples of filters having been modified to CWST largely greater than 90 dynes/cm, e.g. on page 21, lines 26-31 ("greater than 94 dynes/cm") or on page 24, lines 30-33 and table 16 (109 dynes/cm). However, none of these examples makes reference to the specific range as claimed or presents a CWST of 90 dynes/cm as an upper limit or as a value of particular significance or essential for the invention. Contrary to that, a CWST ranging from 59 to 65 dynes/cm is presented as optimal (page 21, line 29) and values in excess of 75 dynes/cm are still more preferred (page 24, lines 39-40), which is not surprising considering that the CWST of a porous medium must be greater than the surface tension of the liquid product to be filtered and that the surface tension of PRC (packed red cells) amounts to 73 dynes/cm for the blood plasma and to 64,5 dynes/cm for the red cells (see earlier application, page 6, lines 43-50 and page 24, lines 36-38).

Thus, by formulating a new range from greater than 53 dynes/cm to up to 90 dynes/cm on the basis of individual values taken from passages and examples of the description, which were not at all related to each other, the reader was confronted with new information not directly and non-ambiguously derivable from the text of the earlier application as filed. Consequently, the claimed range is the result of an arbitrary selection without having sufficient basis in the earlier application as filed and extends beyond the

content of said earlier application, contrary to the requirements of Article 76(1) EPC.

Since the same range is present in claim 1 of both the main and the auxiliary requests, none of them is acceptable.

2.3 *Article 123(2) EPC*

Having regard to the finding that the present requests do not meet the requirements of Article 76(1) EPC there was no reason for an additional examination whether or not these requests meet the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

V. Commare T. Kriner