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**Datasheet for the decision
of 18 September 2007**

Case Number: T 1166/05 - 3.2.02

Application Number: 97939980.5

Publication Number: 0927058

IPC: A61M 5/24

Language of the proceedings: EN

Title of invention:
Syringe

Patentee:
NOVO NORDISK A/S

Opponent:
Aventis Pharma Deutschland GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 54

Keyword:
"Novelty - (yes, after amendments)"

Decisions cited:
-

Catchword:
-



Case Number: T 1166/05 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 18 September 2007

Appellant: NOVO NORDISK A/S
(Patent Proprietor) Novo Allé
DK-2880 Bagsvaerd (DK)

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

Respondent: Aventis Pharma Deutschland GmbH
(Opponent) Industriepark Höchst, Gebäude K 801
D-65926 Frankfurt am Main (DE)

Representative: Wess, Wolfgang
Schwabe Sandmair Marx
Patentanwälte
P.O. Box 86 02 45
D-81629 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 July 2005
revoking European patent No. 0927058 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: D. Valle
M. J. Vogel

Summary of Facts and Submissions

I. The appellant (patentee) lodged an appeal on 8 September 2005 against the decision of the opposition division posted on 20 July 2005 to revoke the European patent 0927058. The fee for the appeal was paid simultaneously and the statement setting out the grounds for appeal was received on 21 November 2005.

II. The opposition division held that the patent as granted and the auxiliary requests 1 and 2 then on file did not meet the requirements of Article 54 EPC (lack of novelty) having regard to

D1 = EP-A-0 037 696.

In addition the following documents submitted by the opponent have been considered for the present decision:

D2 = WO-A-93/07922

D6 = US-A-4 082 121.

III. Oral proceedings took place on 18 September 2007.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or in the alternative on the basis of one of the auxiliary requests 1 to 4, all filed during the oral proceedings.

IV. Claim 1 of the main request reads as follows:

"A syringe by which medicine may be apportioned in preset doses from an ampoule, which syringe has

- a dose setting (2, 23) and injection mechanism comprising a dose setting member which comprises an injection button (11) on a carrier rod (13) and may be moved in one direction to preset a dose in the opposite direction to inject the preset dose, and
- a piston advancing mechanism comprising a piston rod and a piston rod drive,
- the dose setting (2, 23) and injection mechanism being coupled to the piston advancing mechanism through a unidirectional coupling transmitting only movement of the dose setting member in the dose injection direction to the piston rod drive (17)

in which syringe

- an air shot button (26, 30) is provided,
- the operation of which acts only on the piston advancing mechanism side of the unidirectional coupling to enable influence on the piston advancing mechanism to advance the piston rod a distance corresponding to expulsion of a fixed volume of medicine."

V. The appellant argued that the subject-matter of new claim 1 of the main request complied with Article 123(2) EPC and was novel, since none of the present documents disclosed all features of this claim. D1 which could be regarded as representing the most relevant state of the art did not disclose that the dose setting member comprised an injection button on a carrier rod nor that the operation of the air shot button acted only on the piston advancing mechanism side of the unidirectional coupling.

The respondent disagreed with the arguments of the appellant and stated that claim 1 did not comply with Article 123(2) EPC, since the wording of this claim

covered also embodiments where the button was detachably connected with the carrier rod. Furthermore he argued that the subject-matter of claim 1 of the main request was not novel having regard to D1 and D6. With respect to D1 he was of the opinion that the operation of the air shot button represented by the front portion (4) acted on the piston advancing mechanism side (14) of the unidirectional coupling (12, 13), since this operation caused a relative movement between the drive member (14) and the syringe (2).

Reasons for the Decision

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

Claim 1 of the main request is based on the granted claim 1 and on the disclosure on page 2, lines 20 to 25; page 4, lines 19, 20 and on Figure 2 of the published application (WO-A-98/10814).

The argument of the respondent that the wording "an injection button (11) on a carrier rod (13)" implied that also embodiments having an injection button detachably connected with the carrier rod were now covered by the claim, which constituted an extension of subject-matter beyond that originally disclosed, can not be accepted.

Figures 2 and 4 as published in WO-A-98/10814 which both are schematic drawings clearly show an injection button (11) on a carrier rod (13). The connection

between the button and the rod is not disclosed in the published application, neither in the drawings nor in the description. Therefore it is clear for the skilled person that the kind of this connection is without importance and may be selected according to the circumstances.

Consequently the amended claim 1 meets the requirements of Article 123(2) EPC.

3. *Novelty*

3.1 D1 discloses a syringe by which medicine may be apportioned in preset doses from an ampoule (2), which syringe has a dose setting and injection mechanism (10, 12, 13, 14) comprising a dose setting member (10) which comprises an injection button (7) on a carrier rod (10), and may be moved in one direction to preset a dose (see in particular page 5, line 20 to page 6, line 22) and in the opposite direction to inject the preset dose, and a piston advancing mechanism comprising a piston rod (14) and a piston rod drive (12), the dose setting and injection mechanism being coupled to the piston advancing mechanism through a unidirectional coupling (12, 13) transmitting only movement of the dose setting member (10) in the dose injecting direction to the piston rod drive, and in which syringe an air shot button (4) is provided to enable an expulsion of a fixed volume of medicine (see page 7, lines 9 to 18).

However, D1 does not disclose that the operation of the air shot button acts only on the piston advancing mechanism side of the unidirectional coupling to enable influence on the piston advancing mechanism to advance

the piston (17) rod a distance corresponding to said expulsion of a fixed volume of medicine.

The respondent's argument that the air shot button (4) acts on the piston advancing mechanism side of the unidirectional coupling is not convincing. The air shot button which is represented in D1 by the front barrel portion (4) may be removed in order to insert a fully loaded syringe (2) into the barrel (3) and then be repositioned. As it is brought into its fully secured position it pushes back the body of the syringe thereby allowing the expulsion of air that can be present in the syringe (see D1, page 7, lines 9 to 18). Therefore the air shot button of D1 acts directly on the syringe and at best indirectly - by transmission of pressure - on the whole dose setting and injection mechanism (10, 12, 13 and 14). However it does not act only on the piston advancing mechanism side of the unidirectional coupling.

3.2 D2 and D6 disclose less features of claim 1 of the main request than D1.

The syringe disclosed in D2 does not comprise an air shot button. The press button (30) has exclusively the function of easing the mechanism of the dose setting knob (14) (see page 5, line 30, page 7, line 8).

D6 does not refer to a syringe by which medicine may be apportioned in set doses from an ampoule. The syringe according to D6 has a closed piston chamber (19) into which liquid medicine may be drawn and subsequently be injected by a piston (17). Furthermore this syringe does not comprise an air shot button but a system that

automatically eliminates any air from the piston chamber when this chamber is filled.

3.3 Accordingly the subject-matter of claim 1 of the main request is novel.

4. Since the decision under appeal dealt only with the novelty issue, the board considers it appropriate to remit the case to the first instance for further prosecution.

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 the main request filed during the oral proceedings.

The Registrar:

The Chairman:

V. Commare

T. Kriner