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**Datasheet for the decision
of 24 June 2009**

Case Number: T 1048/07 - 3.3.10

Application Number: 00907226.5

Publication Number: 1176996

IPC: A61L 29/14

Language of the proceedings: EN

Title of invention:

Lubricious coating for medical devices comprising an antiblock agent

Applicant:

Boston Scientific Limited

Headword:

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Relevant legal provisions:

EPC Art. 123 (2)

Keyword:

"Amendments: extend beyond content of application as filed"

Decisions cited:

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Catchword:

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Case Number: T 1048/07 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 24 June 2009

Appellant: Boston Scientific Limited
The Corporate Centre,
Bush Hill,
Bay Street
St. Michael,
Barbados, West Indies (BB)

Representative: Hauck Patent- und Rechtsanwälte
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 06 December 2006
refusing European patent application
No. 00907226.5 pursuant to
Article 97(1) EPC 1973.

Composition of the Board:

Chairman: R. Freimuth
Members: P. Gryczka
J.-P. Seitz

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Examining Division posted on 6 December 2006 refusing the European patent application No. 00907226.5 with the International publication No. WO 00/67816.
- II. The Examining Division held that amended claims 1, 5 and 6 of the then pending main request extended beyond the application as filed, *inter alia*, since there was no basis for the anti-blocking agent being defined as a salt of an alpha-olefin sulfonate, in particular not on page 10, lines 6 to 9 referred to by the Applicant (Appellant) where only two specific surfactants were disclosed. In addition claim 1 of the main request and of the then pending auxiliary request lacked clarity and the invention was not sufficiently disclosed.
- III. With a letter dated 13 April 2007, the Appellant filed an amended set of claims as sole request.

Claim 1 of said request reads as follows:

"1. A method for coating a medical device for insertion into the body, comprising:

- dissolving a mixture of a hydrophilic coating with an antiblock agent in a solvent or a mixture of solvents,
- with the hydrophilic coating comprising at least one polymeric material selected from the group consisting of polyethylene oxides, polyacrylic acid and polyvinylpyrrolidone and
- with an antiblock agent being selected which does not phase separate in solution and which migrates to the

surface of the coating once the coating has lost most or all of the solvent and
- coating of the medical device with the mixture of the hydrophilic coating with the antiblock agent by using any conventional coating techniques."

Claim 4 of said request reads as follows:

"4. The method of claim 1 wherein said antiblock agent is selected from the group consisting of long chain alkyl derivatives of fatty esters, fatty amides, fatty acid amides, fatty acids, fatty amines, alcohols, fatty acid alcohols, polyalkylene waxes, oxidized polyalkylene waxes, silicone waxes, silicone oils, alphaolefin, sulfonates, phosphate ester of fatty alcohols, and mixtures thereof."

- IV. With a communication dated 15 April 2009, the Board informed the Appellant (Applicant) that at the oral proceedings scheduled in front of the Board on 24 June 2009 the conformity of the amended claims with the requirements of Articles 123 (2) had to be examined. In addition, since the antiblock agent was still defined by functional features it was questionable whether the claimed subject-matter was clear (Article 84 EPC) and whether the patent application disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 83 EPC).
- V. Oral proceedings took place on 24 June 2009 before the Board in the absence of the duly summoned Appellant who informed the Board on the 22 June 2009 that he will not attend them (Rule 115 (2) EPC).

- VI. The Appellant argued in writing, *inter alia*, that the new claim 4 corresponded to original claim 14 and thus fulfilled the requirements of Article 123(2) EPC.
- VII. The Appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 8 submitted with the letter dated 13 April 2007 as sole request.
- VIII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Amendments

2. Whereas the original application claimed a medical device as such (claims 1 to 12) and a method for producing it (claims 13 to 20), the amended set of claims presented as sole request in the appeal proceedings is directed to a method for coating a medical device. In this new set of claims, claim 4 requires that in the claimed method the antiblock agent which is dissolved with a hydrophilic coating in a solvent or mixture of solvents is selected from the group consisting of, *inter alia*, "alphaolefin, sulfonates" (*sic*).

- 2.1 According to the Appellant this amendment was based on claim 14 as originally filed. However, claim 14 as filed neither discloses alphaolefin nor alphaolefin sulfonates and therefore cannot be a basis for the antiblock agent being defined in amended claim 4 as an "alphaolefin" (if the comma has been introduced in the claim intentionally between "alphaolefin" and "sulfonates"), nor for the antiblock agent being defined as "alphaolefin sulfonates" (if the comma has been introduced erroneously into the claim between "alphaolefin" and "sulfonates").
- 2.2 In the decision under appeal it was concluded that there was no basis in the application as filed for a similar amendment, namely the antiblock agent being defined *inter alia* as a sodium salt of alpha-olefin sulfonates (point 3.1 of the reasons, second paragraph). The Appellant referred there as support for the amendment to page 10, line 6 to 9. However, the Board concurs with the conclusions of the Examining Division that this passage only describes specific antiblock agents and only one particular alpha-olefin sulfonate, namely "Bio-Terge AS-40". Thus, also this part of the application as filed cannot form a proper basis for present claim 4 generalising that in the claimed method for coating a medical device an "alphaolefin" or "alphaolefin sulfonates" is or are dissolved with a hydrophilic coating in a solvent or a mixture of solvents.

2.3 The Board concludes that the subject-matter of claim 4 as amended extends beyond the content of the application as filed, thus, contravening the provisions of Article 123(2) EPC. In these circumstances, the Appellant's sole request is not allowable and must be rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth