

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**Datasheet for the decision  
of 9 June 2009**

**Case Number:** T 1949/08 - 3.3.10

**Application Number:** 97931489.5

**Publication Number:** 0858292

**IPC:** A61L 17/00

**Language of the proceedings:** EN

**Title of invention:**

Absorbable mixture and coatings for surgical articles  
fabricated therefrom

**Applicant:**

United States Surgical Corporation

**Opponent:**

-

**Headword:**

Surgical suture coating/UNITED STATES SURGICAL CORPORATION

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

"Extension of subject-matter (yes)"

**Decisions cited:**

T 0680/93

**Catchword:**

-



Case Number: T 1949/08 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 9 June 2009

**Appellant:** United States Surgical Corporation  
150 Glover Avenue  
Norwalk  
Connecticut 06856 (US)

**Representative:** Marsh, Roy David  
Hoffmann Eitle  
Patent- und Rechtsanwälte  
Arabellastrasse 4  
D-81925 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 9 April 2008  
refusing European application No. 97931489.5  
pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** J.-C. Schmid  
F. Blumer

## Summary of Facts and Submissions

- I. The appeal lodged on 19 June 2008 lies from the decision of the Examining Division dated 9 April 2008 refusing European patent application No. 97 931 489.5.
- II. The decision of the Examining Division was based on the sets of claims according to the then pending main and first auxiliary requests. The Examining Division considered that the application as filed failed to provide a basis in the sense of Article 123(2) EPC for any salt of the esters, as recited in claim 1 of these requests. Hence, the Examining Division arrived at the conclusion that the claims contained subject-matter not disclosed in the application as filed, thus infringing the provision of Article 123(2) EPC.
- III. At the oral proceedings before the Board held on 9 June 2009 the Appellant (Applicant) no longer maintained the former auxiliary requests 1 to 4 and defended the grant of a patent solely on the basis of the main request filed with the letter dated 18 August 2008, claim 1 of that request reading as follows:
- "1. A surgical suture coating comprising:
- a) a copolymer comprising a predominant amount of epsilon-caprolactone and a minor amount of at least one other copolymerizable monomer; and
- b) a salt of a lactylate ester of a C<sub>10</sub> or greater fatty acid."
- IV. The Appellant no longer requested that the term "lactylate ester" to be corrected into "salt of a lactylate ester" under Rule 139 EPC (correction of

errors) and submitted that the amendment in question was supported by the application as filed where salts of lactylate were disclosed, in particular in claim 9 and in the paragraph bridging pages 4 and 5.

V. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request filed on 18 August 2008.

VI. At the end of the oral proceedings the decision of the Board was announced.

### **Reasons for the Decision**

1. The appeal is admissible.

2. *Amendments (Article 123(2) EPC)*

The amendment carried out on claim 1 concerns the definition of the lactylate ester of a C<sub>10</sub> or greater fatty acid which has been restricted to a salt thereof.

2.1 In order to determine whether an amendment offends against Article 123(2) EPC it has to be examined whether or not a technical information has been introduced which a skilled person would not have objectively, i.e. directly and unambiguously, derived from the application as filed (see decision T 680/93 of 29 November 1994, point 2 of the reasons; not published in OJ EPO).

2.2 According to the Appellant, this amendment is based on claim 9 and on the passage of bridging page 4 and 5 of the application as filed.

The first part of the passage referred to by the Appellant (page 4, lines 26 to 32 of the application as filed) discloses a general formula of alkaline-earth metal salts of esters covering *inter alia* lactylate ester of C<sub>10</sub> or greater fatty acids while the second part of this passage (page 4, line 33 to page 5, line 3), and also claim 9, exemplify specific calcium, magnesium, aluminium, barium and zinc salts, i.e. magnesium stearoyl lactylate, aluminium stearoyl lactylate, barium stearoyl lactylate, zinc stearoyl lactylate, calcium palmityl lactylate, magnesium palmityl lactylate, aluminium palmityl lactylate, barium palmityl lactylate, or zinc palmityl lactylate, calcium olelyl lactylate, magnesium olelyl lactylate, aluminium olelyl lactylate, barium olelyl lactylate, zinc olelyl lactylate, and calcium stearoyl lactylate.

2.3 A generalisation of the specific disclosure referred to above or of individual lactylate salts of particular metals has thus been made since claim 1 of the main request covers any salt of lactylate ester of C<sub>10</sub> or greater fatty acids, irrespective of the counter ion used. However, the salts disclosed in the application as filed relate only to specific metals, which are no longer required in present claim 1.

2.4 Thus, the disclosure of those particular metal salts in the application as filed does not form a proper basis to the claimed generalisation to any salts.

Hence, to generalise those specific metal salts to any salt provides the skilled person with technical information which is not directly and unambiguously derivable from the application as filed.

As a consequence the amendment in claim 1 covering any salt of a lactylate ester of C<sub>10</sub> or greater fatty acid cannot be based on the disclosure of the original application, but is an undue generalisation thereof which extends beyond the content thereof.

3. Therefore, the Board concludes that the subject matter of claim 1 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:

A. Counillon

R. Freimuth