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**Datasheet for the decision
of 3 February 2011**

Case Number: T 0004/09 - 3.2.02

Application Number: 00962566.6

Publication Number: 1225930

IPC: A61M 1/00

Language of the proceedings: EN

Title of invention:
Suction Bag Assembly

Patentee:
Serres Oy

Opponent:
Medela Holding AG

Headword:
-

Relevant legal provisions:
EPC Art. 123

Relevant legal provisions (EPC 1973):
-

Keyword:
"Extension of subject-matter (no, after amendments)"

Decisions cited:
-

Catchword:
-



Case Number: T 0004/09 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 3 February 2011

Appellant: Serres Oy
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 3 November 2008
revoking European patent No. 1225930 pursuant
to Article 101(2) and 101(3)(b) EPC.

Composition of the Board:

Chairman: D. Valle
Members: C. Körber
A. Pignatelli

Summary of Facts and Submissions

- I. The appellant (proprietor) lodged an appeal on 18 December 2008 against the decision of the opposition division posted on 3 November 2008 to revoke the patent for lack of support by the original disclosure. The fee for the appeal was paid on the same day and the statement setting out the grounds for appeal was received on 11 March 2009.

- II. Oral proceedings have been held the 3 February 2011.

- III. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of a main request consisting of claims 1 to 9 as filed with letter of 11 March 2009, description and drawings as granted or on the basis of a first auxiliary request consisting of claims 1 to 9 and page 3 of the description as filed with letter of 11 March 2009, pages 2 and 4 of the description and drawings as granted, or of a second auxiliary request consisting of claims 1 to 9 and pages 3 and 4 of the description as filed with letter of 30 December 2010, description, page 2 and drawings as granted, or of a third or a fourth auxiliary request consisting of claims 1 to 9 as filed with letter of 11 March 2009, description and drawings as granted, or of a fifth auxiliary request consisting of claims 1 to 9 as filed with letter of 30 December 2009, description and drawings as granted.

- IV. The respondent (opponent) requested that the appeal be dismissed, that the new documents A24 to A26 filed with letter of 9 July 2009 be introduced into the

proceedings and that the sentence at column 4, line 57 to column 5, line 1 of the patent specification be deleted.

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

"Suction bag assembly for collection of liquid fluid, the assembly comprising:

- a collection container (1) open at its one end,
 - a cover (4) for closing said one open end of said collection container (1) and adapted to be inserted into said collection container (1), a flexible suction bag (3) attached to said cover (4),
 - a vacuum connector (2) provided at said collection container (1) and communicating via a flow channel with a vacuum source so as to provide a vacuum between the interior surface of said collection container (1) and the exterior surface of said suction bag (3),
 - a patient tubing connector (5) provided at said cover (4) and serving to provide fluid communications from the source of fluids to the interior of said suction bag (3),
 - a conduit (7) provided at said cover (4) for transmitting the applied vacuum from the space (11) remaining between the interior surface of said collection container (1) and the cover (4) to the interior of said suction bag (3), and
 - a filter (6) serving to prevent contaminants from entering the vacuum system,
- characterized in that
- said filter (6) is adapted to a surface of the cover (4) facing the interior of the suction bag (3),
 - said filter is adapted to the end of said conduit exiting into the interior of said suction bag,

- said cover (4) is a unitary part."

VI. The appellant argued essentially as follows.

Claim 1 of the main request complied with Article 123(2) EPC.

a) The sentence in claim 1 of the main request: "said filter (6) is adapted to a surface of the cover (4) facing the interior of the suction bag (3)" was supported by the feature of original claim 1: "said filter is adapted to the end of said conduit exiting into the interior of said suction bag" and by the sentences at page 7; lines 5 to 7, page 8, lines 24 to 31 of the description.

b) The feature of claim 1 of the main request that the cover was a unitary part was supported by Figure 1 and page 9, lines 23 to 27 of the description. Unitary meant simply that a group of elements was seen as a unit.

c) The sentence of the description of the patent specification, column 4, line 57 to column 5, line 1: "the seal in this joint may be implemented, e.g. using O-rings mountable about the rim of the cover 4", even if not correctly translated did not result in a broadening of the original disclosure.

VII. The respondent argued essentially as follows.

Claim 1 of the main request did not meet the requirements of Article 123(2) EPC.

a) The sentence in claim 1 of the main request: "said filter (6) is adapted to a surface of the cover (4) facing the interior of the suction bag (3)" did not comply with Article 123(2) EPC. The original description, page 7, lines 5 to 7, stated that "the filter ... is adapted to the underside interior surface of the cover". That meant that originally the filter was provided only in the part of the interior surface which was underside, that is facing downward, and not, for example, to the interior part which was facing laterally.

b) Also the sentence in claim 1 of the main request: "said cover (4) is a unitary part" did not comply with Article 123 (2) EPC. The word "unitary" was not contained in the original disclosure. Unitary meant made of one piece. However, page 8, lines 13 and 14 of the original disclosure stated that "the cover 4 is shaped to have a rim 12". That meant that the rim 12 was part of the cover. According to the only embodiment of the invention disclosed in the application (see Figure 1) the cover was therefore not unitary because it was made of two pieces, namely the element 4 and the element 12. Furthermore, the claim recited that the cover was provided for closing the open end of the collection container. That meant that the cover (4) should comprise also the rim (12), since otherwise it would not be able to close the container.

c) Finally, the sentence of the description of the patent specification, column 4, line 57 to column 5, line 1: "the seal in this joint may be implemented, e.g. using O-rings mountable about the rim of the cover 4" did not comply with Article 123(2) EPC. According to the proprietor-appellant, the translation of the sentence from the original Finnish application was not correct. The right translation was "The seal in this joint may also be implemented, e.g. using O-rings mountable about ~~the rim of~~ the cover 4". The sentence in the patent in suit comprised technical information beyond the original disclosure. This affected also the interpretation of the claims which, in consequence of that, covered a broader scope than that originally disclosed against Article 123(2) EPC.

The objection raised in writing based on Article 100(b) EPC was not further pursued at the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. Article 123(2) EPC

a) The sentence in claim 1 of the main request: "said filter (6) is adapted to a surface of the cover (4) facing the interior of the suction bag (3)" is supported by the sentence of the original description at page 8, lines 24 to 31, where it is said that the cover 4 has a conduit 7 whose second end exits into the *interior* of the suction bag 3 and that a filter 6 is adapted to this second end. Differing from the position

of the respondent, the Board understands the sentence at page 7, lines 5 to 7 of the description, where it is said that the filter is adapted to the "underside" interior surface of the cover portion, as meaning that the filter is adapted to the surface of the cover facing the interior of the suction bag.

b) The sentence in claim 1 of the main request: "said cover (4) is a unitary part" is supported by page 8, lines 13 and 14 of the original description and by Figure 1.

The Board agrees with the view of the respondent regarding the meaning of the term "unitary" as: made of one piece, so that it cannot be set apart without destroying its integrity. Contrary to the view of the appellant "unitary" can not simply mean: a group of elements seen as a unit, since in that case the meaning would be completely subjective and its insertion in the claim would become void of any significance.

The original description and drawings consistently disclose a unitary cover in the sense defined above. The description, page 8, line 13, individuates the cover with the reference number 4, and Figure 1 clearly shows that the cover (4) is integral, since its section shows a uniform hatching. The view of the respondent that the cover 4 comprises also the rim 12 (shown with a different hatching in the figure) cannot be shared. In the view of the Board, the sentence at page 8, lines 13 to 15 of the description: "the cover 4 is shaped to have a rim 12" has to be construed as "the cover is shaped to hold a rim". The first meaning of the verb "to have" in the Merriam Webster dictionary is

"to hold or maintain as a possession" and not to comprise. Furthermore, this view is supported by the Figure 1.

The contested sentence cannot be supported by the passage of the description cited by the appellant (page 9, lines 27 to 27): "a new suction bag with its integral cover", since in the view of the Board this passage refers to the fact that the cover is integral with the suction bag and does not say anything about the characteristics of the cover itself.

The Board does not share the view of the respondent that the sentence "cover for closing" in claim 1 means that the cover alone closes the container. The sentence tells namely that the cover is merely instrumental for closing the container (possibly in combination with further elements such as the sealing rim (12)).

c) The sentence in the description of the patent in suit, column 4, line 57 to column 5 line 1: "the seal in this joint may be implemented, e.g. using O-rings mountable about the rim of the cover 4" does not go beyond the original disclosure. The Board construes the meaning of the sentence as: "the seal in this joint may be implemented, e.g. using O-rings mountable about the *outer border* of the cover 4". This view is supported by the use of the term "rim" in the same sense at column 4, line 52, where it is said that the rim 12 is adapted to be tightly compressible against the rim (that is: the outer border) of the collection container. It follows that the meaning of the sentence above is practically the same as that of the correct translation of the original disclosure as submitted by

the appellant: "the seal in this joint may also be implemented, e.g. using O-rings mountable about ~~the rim~~ of the cover 4". As a further consequence, it is not necessary to delete this sentence from the description of the patent in suit as requested by the respondent.

3. The decision under appeal did not deal with the questions of novelty and inventive step. Therefore the Board is of the advice to remit the case to the first instance for further prosecution in order to give the patentee two levels of jurisdiction. The question whether the lately submitted documents A24 to A26 should be admitted into the proceedings will become relevant only in connection with the second and third auxiliary requests and therefore has not been considered in this decision.

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 claims 1 to 9 filed as main request with letter of 11 March 2009, description and drawings as granted.

The Registrar:

The Chairman:

D. Sauter

D. Valle