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**Datasheet for the decision
of 10 January 2012**

Case Number: T 1331/09 - 3.2.06

Application Number: 98952149.7

Publication Number: 1021149

IPC: A61F13/00, A61F13/12

Language of the proceedings: EN

Title of invention:

BANDAGE INCLUDING DATA ACQUISITION COMPONENTS

Applicant:

Sternberg, Edward A.

Opponents:

Techn.Uni.DELFT/Acad.Med.Centrum
AMSTERDAM/Uni.Med.Centrum ROTTERDAM, Erasmus Uni.

Relevant legal provisions:

EPC 1973 Art. 54(1), 54(2)
EPC Art. 123(2)
RPBA Art. 13

Keyword:

Public prior use - yes
Novelty (main request) - no
Admittance into the proceedings (first to sixth auxiliary
requests) - no

Decisions cited:

T 472/92



Case Number: T1331/09 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 10 January 2012

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 15 April 2009
revoking European patent No. 1021149 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: M. Harrison
Members: G. Kadner
W. Sekretaruk

Summary of Facts and Submissions

- I. The mention of grant of European patent No. 1 021 149, with 27 claims, on the basis of European patent application No. 98952149.7 filed on 8 October 1998 and claiming a US-priority from 9 October 1997, was published on 9 July 2003.

Claim 1 of the patent as granted reads as follows:

"A bandage comprising:

- a pad (18) positionable in contact with a patient (14);
- a microcontroller (46) contained within the pad (18) [*AR1]; and
- a sensor (42) coupled to the microcontroller (46) to provide a signal to the microcontroller (46), the signal being related to the status of the pad (18), [*AR6] wherein the microcontroller (46) records [**AR1] information related to the signal from the sensor (42)."

- II. Notice of opposition, in which revocation of the patent on the grounds of Article 100(a) EPC 1973 was requested, was filed against the granted patent. Documents were presented in support of the opponent's allegation of certain non-confidential prior disclosures, *inter alia* minutes of the Rotterdam Amblyopia Screening Effectiveness Study (RAMSES) meetings.

By way of its interlocutory decision posted on 15 April 2009, the opposition division revoked the European patent. The opposition division held that the persons within the RAMSES group had an implicit obligation of confidentiality, but that the subject-matter of claim 1 however did not involve an inventive step when compared to the further cited prior art in combination with the

knowledge of the person skilled in the art. The requirement of Article 56 EPC 1973 was thus not met.

III. Notice of appeal was filed against this decision by the appellant (patentee) on 24 June 2009, and the appeal fee was paid on 25 June 2009. Two auxiliary requests were filed together with the grounds of appeal on 25 August 2009.

IV. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary view that it was *inter alia* questionable whether participants of the RAMSES meetings had an obligation of confidentiality in view of the presence of at least some members who were acting on behalf of public bodies. It would further have to be discussed whether - if proven - the alleged prior disclosure was enabling in such a way that the invention could be carried out. The auxiliary requests did not seem to be admissible with respect to Article 123(2) EPC.

V. With letter dated 9 December 2001, the appellant filed six auxiliary requests replacing all previous auxiliary requests.

VI. Oral proceedings were held on 10 January 2012. During the discussion of the matter the following documents were emphasised as relevant by the parties:

- A0: Translation of several passages in the documents A1 to A7
- A2: Minutes of a first preparatory meeting of project group RAMSES, dated 25 November 1996 and partial translation into English
- A4: Agenda for RAMSES meeting of 27 June 1997 and attached minutes of meeting 21 February 1997

- A5: Agenda for RAMSES meeting of 12 September 1997 and its translation into English, and attached minutes of meeting 27 June 1997
- A6: Memo of 8 September 1997 from Rikard Juttmann to Dr Simonsz and Prof. Dr Van der Maas and attached a draft concept proposal
- A7: Minutes of RAMSES meeting of 12 September 1997
- A8: Declaration dated 6 February 2009 by Prof Dr P.J. van der Maas
- A9: Declaration dated 6 February 2009 by Dr Juttmann
- A10: Declaration dated 9 September 2010 by Dr Jan-Tjeerd h.N. de Faber MD
- A12: Declaration dated 30 November 2011 by Dr. H. Schepping MCM
- A13: Declaration received at the EPO on 7 December 2011 by A.J.M. Hermans, MD, PhD
- E2: Internal note by C. Romijn dated 24 December 1996
- L1: Amblyopia, Jan-Tjeerd H.N. de Faber, MD, and Christine Kingma-Wilschut, CO, 1996 Rapid Science Publishers, ISBN 1-85992-836-4, ISSN 1040-8738
- L2: Compliance in amblyopia therapy: objective monitoring of occlusion, Alistair R Fielder, Mary Irwin, Rosemary Auld, Kenneth D Cocker, Helen S Jones, Merrick J Moseley; British Journal of Ophthalmology 1995; 79: 585-589

The appellant (patentee) requested that the decision under appeal be set aside and that the European patent be maintained as granted or on the basis of one of the auxiliary requests 1 to 6, filed 9 December 2011.

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

- i. Claim 1 of the first auxiliary request was amended by insertion of "and including a

memory" at [*AR1] and "in the memory" at [**AR1].

ii. Claim 1 of the second auxiliary request reads:

"A bandage capable of monitoring a patient wearing the bandage comprising:

- a microcontroller (46) having a memory positioned within the bandage;
- means for securing the bandage (10) to the patient (14) at a desired location;
- a sensor (42) attached to the microcontroller (46), the sensor (42) being positionable such that the sensor (42) is capable of generating a signal based on the status of the patient (14) and the bandage;

wherein the arrangement is such that the signal generated by the sensor (42) is monitored;

and information desired from the signal generated by the sensor (42) is recorded in the memory in the microcontroller (46)."

iii. Claim 1 of the third auxiliary request includes the wording of claim 1 according to the first auxiliary request with the insertion of:

"... a data transfer port (32) formed in the pad (18),"

before "wherein", and at the end:

"... the data transfer port (32) allows for an external connection to the microcontroller (46) contained within the pad (18)."

- iv. Claim 1 of the fourth auxiliary request includes the wording of claim 1 according to the second auxiliary request with the insertion of:

"... and a data transfer port (32) formed in the pad (18),"

before "wherein", and at the end:

"... and the data transfer port (32) allows for an external connection to the microcontroller (46) contained within the pad (18)",

and the word "and" before "information desired" being deleted.

- v. Claim 1 of the fifth auxiliary request includes the wording of claim 1 according to the main request (claim 1 as granted) to which the features of granted claim 11 are added:

... wherein the bandage is shaped as an eye patch for use in occlusion therapy, the eye patch (12) further comprising means (16) for attaching the eye patch (12) to the eye area of a patient (14);

wherein the microcontroller (46) contained within the pad (18) has a memory capable of storing information; and wherein the sensor (42) coupled to the microcontroller (46) provides a signal to the microcontroller (46), the signal from the sensor (42) indicating

whether the eye patch (12) is attached to the patient (14)."

- vi. Claim 1 of the sixth auxiliary request includes the wording of claim 1 according to the fifth auxiliary request in which the features of granted claim 8 are inserted at [*AR6] marked in claim 1 as granted:

"... and a data transfer port (32) formed in the pad (18), the data transfer port (32) allowing for an external connection to the microcontroller (46) contained within the pad (18)".

- VII. The arguments of the appellant can be summarized as follows:

The burden of proof of a public prior enabling disclosure lay with the Respondent. The RAMSES group had to be considered as a limited circle of persons belonging to a formal group in which each member was bound to confidentiality. Even if the representatives of public bodies would have an interest in gaining information for their respective organisations, those public bodies were very often subject to confidentiality; these persons respect the well known code of academics that a person responsible for a publishable development should be the first person to make that publication. The circumstances of the discussions within the RAMSES group indicated an implicit obligation of confidentiality because the group had a formal nature due to issuance of an agenda and distribution of minutes. The members of the group were all people of high standing and shared a common interest. They were all selected and formally invited,

and the interest of the group was to encourage everyone to discuss their ideas freely so that the members could be confident that their input into the meetings would not be used against their interests, for example, in such a way that might deprive them of the right to first publication of the results of their research. With respect to all these circumstances it was not proven that the knowledge within the RAMSES group had been made available to the public. A member of the RAMSES group, Dr De Faber, had confirmed in A10 that he understood the meetings were of a confidential nature.

Even if it were assumed that the discussions within the RAMSES group had a public nature, no enabling disclosure of a device had occurred. The term "wireless" used in A4 only indicated that the data transmission from the occlusion patch to the storing device was carried out by any means avoiding wires, such as a transponder, as mentioned in E2, but did not necessarily mean that a memory was integrated into the patch. Therefore the disclosure in A4 did not relate to an apparatus falling within the scope of the claims of the patent in suit.

VIII. The respondent argued that the RAMSES meetings were not of a confidential nature. As can be seen with regard to the minutes of the meetings, they contain many details, but are totally silent on confidentiality. Therefore the discussions and disclosures in attendance of people invited from public organisations have to be considered as having been non-confidential and thus public. The disclosure was such that a skilled person would clearly understand the meaning of a micro-electronic measuring instrument, applied as part of the occlusion patch which was able to record the time during which the patch was applied correctly, and from which the measurement result could be read out. By distribution of A6 together with

A5 and its discussion during the meeting on 12 September 1997 according to A7, the disclosure of an eye-patch having the features of claim 1 had been made available to the public.

Reasons for the Decision

1. The appeal is admissible.
2. *Public prior use (Article 54(2) EPC 1973)*
 - 2.1 As regards the RAMSES meetings and the minutes of various meetings of same, the Board concludes that e.g. Dr De Faber (the declarant in A10) is a member of this group, such that the evidence concerning disclosures made within those meetings does not lie exclusively in the hands of the opponents. A standard of evidence which is "up to the hilt" (in the sense of T 472/92) is thus not applicable to the disclosures made in the RAMSES meetings. Instead, while still accepting that the burden of proof indeed lies with opponent, the substantive weight of any evidence supplied by the opponent and any counter evidence supplied by the proprietor must be assessed based on the balance of probabilities.
 - 2.2 In this regard, the evidence filed by the respondent identifies certain attendees of the RAMSES meetings as being persons who are evidently under no obligation to maintain confidential any information disclosed. In particular, Dr Hermans (see e.g. A13), Mrs Lantau and Mr Scheppink (see e.g. A12), are representatives of public bodies or foundations with a clear interest in gaining information for their respective organisations, and who do not - absent any evidence to the contrary -

have any common interest restricted only to the members of the RAMSES meetings (see also A8/A9 (items 3 and 5)).

2.3 In A10, Dr De Faber (e.g. items 3 and 8) states why he presumed that certain information was strictly confidential by implication. Novelty is an objective-only assessment (see G 1/92, point 2.1. of the Reasons) and in view of the presence of representatives of public bodies and foundations, this presumption, whilst credible from Dr Faber's subjective viewpoint, is objectively not convincing. Moreover, in view of the statement in A4, according to which "Dr. De Faber has not been authorised to provide any further information on the progress of the group in Wisconsin", during the discussion of the RAMSES group, the Board concludes that any restriction to the dissemination of information was something that needed to be specified within the group. Indeed, this concerns a specific restriction in confidentiality which is the only documented indication that the general information made available to the members of the RAMSES group would be subject to any restriction at all.

2.4 Based on the presence of members of members of the public in these meetings, and absent any specific details (such as invitations or framework details or the like concerning the RAMSES meetings) expressing e.g. special conditions of confidentiality for the members of the group, the presumption of implied confidentiality is concluded to be unfounded.

2.5 Therefore the Board concludes that the information disclosed in the RAMSES meetings was indeed available to the public.

2.6 The question then arises as to "what" the public had access. In A4, item 4, reference is made to "the chip" (rather than merely "a chip") which would be mounted in the occlusion patch itself so that that the system would be "wireless". In view of the quotation marks it needs to be assessed what is the meaning of the term "wireless" in this context, e.g. whether it only tries to avoid a wire connection between the occlusion patch and an external memory as was contended by the appellant, or whether it unambiguously refers to a patch having a chip and is thus self-contained, rather than referring to a transponder-type device.

2.7 In A7 (item 4) reference is made to the "memory capacity of the patches" which indicates that the memory is contained in the occlusion patch. The title of item 4 of the minutes (A7) is "Sub-study on treatment compliance", which relates to the study mentioned in the internal MEMO between Mr. Juttmann and Mr. Simonsz (A6). According to the Agenda for the meeting on 12 September 1997 (A5, item 4) the study would be handed out during the meeting as Addendum 3 and is therefore made available to the members of RAMSES from public bodies. In the introduction (item 1 of the sub-study itself included as part of A6), the following statement is made: "the occlusion dose monitor" (ODS) ... is a microelectronic measuring instrument, applied as part of the occlusion patch, which is able to monitor the difference in temperature between the outside air and the space between the eye and the patch, thus making possible the measurement of the time during which the patch was applied correctly." Item 2 relates to the method to be followed, in which (after sub-item 3) it reads: "After collecting the ODS-patch "reading out" of the measurement results takes place."

2.8 A skilled person presented with this information would unambiguously conclude that this disclosure is enabling to provide a chip in the occlusion patch itself which has the purpose of monitoring and recording the occlusion dose. In this regard it should be noted that at the date of priority, a skilled person had available to him based on his common general knowledge, memories and chips of the appropriate size and capacity for inclusion in an eye patch. Further, the skilled person was already aware of a functioning system for occlusion dose monitoring based on a (larger) portable monitor carried remotely and connected to an eye patch by wires (see e.g. L1).

3. *Main request, novelty (Article 54 EPC 1973)*

In the light of the knowledge of A4 and A6, the content of which was publicly available, as shown by A7 and A5, the prior disclosure is enabling for a skilled person in a way sufficient to provide all the necessary elements at least in as far as those corresponding to a device as defined in claim 1.

Based on the Board's conclusion that the RAMSES meetings were to be considered non-confidential in nature, and that the written minutes were also non-confidential and available to members of the public, and further that the disclosure in the minutes amounted to an enabling disclosure, the appellant did not contest that any feature of the subject-matter of claim 1 could then be regarded as novel.

4. *Auxiliary requests*

In relation to the auxiliary requests and in light of the finding of non-confidentiality and enablement regarding the disclosures made during the RAMSES meetings (see item 3 above), the appellant did not present arguments in support of novelty of any specific further feature(s) introduced into claim 1 of any of the auxiliary requests.

4.1 First to fourth auxiliary requests

Claim 1 of each of these requests relates to "a microcontroller", whereby the feature "and including a memory" had been introduced into each of these. In relation to the disclosure of this subject-matter, the appellant referred to independent claim 19 (claim 21 as filed) where a *memory in the microcontroller* is disclosed. However, claim 19 is an independent claim which relates to a method including a series of particular steps. Taking one feature out of the context in which it is originally disclosed and combining it with features of a different embodiment to thereby form a new combination of features leads in the present case to subject-matter being claimed which is not originally disclosed. Therefore, since the claims of auxiliary requests 1 to 4 have been amended in a manner which is contrary to Article 123(2) EPC), the Board exercised its discretion under Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) not to admit these requests into the proceedings, noting that such requests were - even when considering the requirement of Article 123(2) EPC alone - not clearly allowable. Such introduction would thus not have lead to an allowable set of claims and further consideration of the requests would thus have been contrary at least to the need for procedural economy.

4.2 Fifth auxiliary request

Claim 1 of the fifth auxiliary request was restricted by the features "... wherein the bandage is shaped as an eye patch for use in occlusion therapy, the eye patch further comprising means for attaching the eye patch (12) to the eye area of a patient, wherein the microcontroller contained within the pad has a memory capable of storing information and wherein the sensor coupled to the microcontroller provides a signal to the microcontroller, the signal from the sensor indicating whether the eye patch is attached to the patient".

When compared with the teaching made public during the RAMSES meetings (see point 2.7 above) these added features were unambiguously disclosed in combination with the eye patch discussed in the study, such that the subject-matter of claim 1 does not meet the requirement of novelty (Article 54 EPC 1973). Since, at least for this reason, this request is not clearly allowable, the Board exercised its discretion not to admit the request into the proceedings (Article 13(1) RPBA).

4.3 Sixth auxiliary request

Claim 1 of the sixth auxiliary request was further restricted by the features "... and a data transfer port formed in the pad, the data transfer port allowing for an external connection to the microcontroller contained within the pad". These features were also made public during the RAMSES meetings in combination with the eye patch discussed during the study (see point 2.7 above). It is self-evident that there must be some kind of data transfer port in order to be able to read out the measurement results for them to be of any

use. Since this request also does not overcome the objection of lack of novelty (Article 54 EPC 1973) the Board exercised its discretion not to admit the request into the proceedings (Article 13(1) RPBA).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Patin

M. Harrison

Decision electronically authenticated