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**Datasheet for the decision
of 7 June 2013**

Case Number: T 2259/09 - 3.2.02

Application Number: 98904865.7

Publication Number: 1011785

IPC: A61M 37/00

Language of the proceedings: EN

Title of invention:

Injector for a subcutaneous infusion set

Patent Proprietor:

Medtronic MiniMed, Inc.

Opponent:

Unomedical A/S

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 123(3), 69(1)

EPC R. 46(2)(i)

Keyword:

"Added subject-matter (no)"

"Extension of protection due to the deletion of drawings from
the granted patent (no)"

Decisions cited:

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Catchword:

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Case Number: T 2259/09 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 7 June 2013

Appellant: Medtronic MiniMed, Inc.
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Respondent: Unomedical A/S
(Opponent) Birkerød Kongevej 2
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 October 2009
revoking European patent No. 1011785 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: E. Dufrasne
Members: M. Stern
C. Körber

Summary of Facts and Submissions

- I. The proprietor lodged an appeal against the decision of the Opposition Division dispatched on 23 October 2009 revoking European patent No. 1 011 785.
- II. The Opposition Division revoked the patent on the basis that the ground for opposition under Article 100(c) EPC prejudiced its maintenance as granted, and that the patent as amended according to the auxiliary requests did not meet the requirement of Article 123(3) EPC. In particular, the Opposition Division held that in the auxiliary requests, due to the deletion of the complete set of drawings from the granted patent, the protection conferred by the patent had been extended.
- III. Notice of appeal was filed by the proprietor on 23 November 2009 and the fee for appeal was paid on the same day. A statement setting out the grounds of appeal was received on 26 February 2010.
- IV. In a communication under Article 15(1) RPBA dated 1 March 2013, the Board expressed its provisional opinion that auxiliary request 2 considered in the impugned decision seemed to satisfy the requirements of Article 123(2) and (3) EPC. It also pointed out that on this basis, and once deficiencies pursuant to Rule 46(2)(i) EPC were resolved, the Board would be inclined to remit the case to the Opposition Division for further prosecution.
- V. In a letter dated 7 May 2013, the appellant requested, as a main request, that the case be remitted to the Opposition Division for further prosecution on the

basis of a request set A, consisting of description columns 1 to 12 and claims 1 to 15 as filed with the letter dated 7 May 2013. If request set A could not be allowed, a request set B, itself comprising several requests, should be considered.

VI. The respondent/opponent remained silent throughout the appeal proceedings.

VII. Claim 1 of the main request (request set A) reads as follows (differences to claim 1 of the granted patent shown as strike-through by the Board):

"1. An injector ~~(10; 110)~~ for transcutaneously placing an insertion needle ~~(12)~~ of a subcutaneous insertion set ~~(14)~~ through the skin of a patient, comprising: barrel means ~~(28; 128)~~ defining an elongated bore; plunger means ~~(30; 130)~~ slidably received within said bore for movement between an advanced position and a retracted position, said plunger means including means for receiving and supporting the insertion set in a position with the insertion needle oriented for transcutaneous placement upon movement of said plunger means from said retracted position to said advanced position; and drive means ~~(36; 136)~~ for urging said plunger means with a controlled force and speed from said retracted position toward said advanced position to transcutaneously place the insertion needle, wherein the insertion needle is provided as part of an insertion set, said plunger means comprises a plunger head ~~(32; 132)~~ having a recess ~~(44; 144)~~ formed therein for mated slide-fit reception of at least a portion of the insertion set, characterized in that said plunger

head further includes safety retainer means ~~(94, 96, 98, 100, 202)~~ for retaining the insertion set on said plunger head during movement from said retracted position to said advanced position, said retainer means permitting separation of the insertion set from said plunger head when said plunger head is in the advanced position."

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) EPC*

The main request (request set A) corresponds to auxiliary request 2 considered in the impugned decision, from which however two further reference signs (in column 6, line 1 and column 10, line 24) have been deleted.

In the impugned decision, the Opposition Division held that this request satisfied the requirements of Article 123(2) EPC. The respondent/opponent did not challenge this finding and the Board does not see valid reasons to question it either.

3. *Article 123(3) EPC*
 - 3.1 Whilst the patent as granted comprises a set of Figures 1 to 29, in the amended patent according to the main request (request set A) all drawings have been deleted to comply with the requirements of Article 123(2) EPC, the description has been

correspondingly adapted by deleting all reference to the drawings, and all reference signs have been deleted from the description and the claims, pursuant to Rule 46(2)(i) EPC.

- 3.2 With the deletion of the drawings from the patent specification, technical information is undoubtedly lost. Whilst this loss of information may also introduce some uncertainties about certain details of the preferred embodiments depicted in the drawings, it cannot be concluded, as in the impugned decision, that it automatically broadens the protection conferred by the patent.

The Opposition Division had argued that according to Article 69(1) EPC, although the extent of the protection conferred by the European patent was determined by the claims, the description and drawings were to be used to interpret the claims, in particular to resolve ambiguities in the claims. Hence, amendments to the description and drawings generally had an impact on the extent of protection conferred by the European patent.

- 3.3 In the present case, the claims are not limited to any of the details, dimensions or features specifically depicted in the (deleted) drawings (such as those mentioned under point 3.2.6 of the impugned decision). Moreover, under Article 69(1) EPC, reference to the drawings of a patent specification may be helpful or even necessary if an ambiguity exists in the granted claim. However, in the present case, as the appellant points out, the impugned decision has not identified any such ambiguity; nor can the Board see any. None of

the specific features of claim 1 of the granted patent has a different or broader meaning without the drawings than with the drawings. Nor does deleting the drawings create any potential additional ambiguity beyond that which may have been present in claim 1 of the patent as granted.

3.4 Consequently, the Board comes to the conclusion that the deletion of the drawings does not extend the scope of the protection conferred by the main request, which request therefore fulfils the provisions of Article 123(3) EPC.

4. The decision under appeal dealt only with the presence and the removal of the drawings under, respectively, Article 123(2) and Article 123(3) EPC. Since the Board finds that the main request (request set A) satisfies the requirements of Article 123(2) and (3) EPC, there is no need for the Board to consider if this also applies to the subsidiary request set (request set B).

Further objections raised in the notice of opposition, in particular those regarding novelty and inventive step, have not been addressed in the impugned decision. Consequently, following the appellant's request and in order to allow the case to be examined at two levels of jurisdiction, the Board finds it appropriate to remit the case to the Opposition Division for continuation of the proceedings on the basis of the pending main request (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

D. Hampe

E. Dufrasne