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**Datasheet for the decision
of 4 June 2013**

Case Number: T 1980/10 - 3.3.03

Application Number: 01927369.7

Publication Number: 1263991

IPC: C12Q 1/68, C08L 63/00,
C08L 33/06

Language of the proceedings: EN

Title of invention:
Epoxide polymer surfaces

Applicants:
Surmodics IVD, Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Amendments (not allowable)"

Decisions cited:
-

Catchword:
-



Case Number: T 1980/10 - 3.3.03

DECISION
of the Technical Board of Appeal 3.3.03
of 4 June 2013

Appellants: Surmodics IVD, Inc.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 1 March 2010
refusing European patent application No.
01927369.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: B. ter Laan
Members: F. Rousseau
C.-P. Brandt

Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division refusing European patent application No. 01 927 369.7, originating from international application No. PCT/US01/40199 and published as WO-A-01/67129. Claim 1 of the application as filed read as follows:

"1. A reagent composition for attaching a target molecule to the surface of a substrate, the reagent composition comprising a polymeric backbone adapted to be covalently attached to the surface and comprising one or more pendent epoxide groups adapted to form covalent bonds with corresponding functional groups on the target molecule.

II. The impugned decision, posted on 1 March 2010, was based on the ground that claim 1 of the sole request, filed on 8 September 2009, failed to comply with the requirements of Article 123(2) EPC 1973. That claim 1 read as follows:

"1. A reagent composition for attaching a target molecule to the surface of a substrate, the reagent composition comprising a copolymer having one or more pendant epoxy groups and one or more pendant photoreactive groups, the copolymer formed by reacting a mixture comprising:

(a) one or more monomers having pendant epoxy groups wherein the one or more monomers having a pendant epoxide group is selected from the group consisting of glycidyl acrylate, glycidyl

- methacrylate, allyglycidyl ether, and glycidyl vinyl ether in an amount of 5 to 35 mole percent based on the weight of the copolymer;
- (b) one or more diluent monomers, wherein the diluent monomers are selected from the group consisting of acrylics, vinyls, nylons, polyurethanes, and polyethers; and
 - (c) one or more monomers having a photoreactive group in an amount of 0.1 to 5 mole percent based on the weight of the copolymer, wherein the photoreactive group is suitable to attach the copolymer to the surface of the substrate by formation of a covalent bond and the epoxy group is suitable to form a covalent bond with the target molecule."

According to the reasons of the decision, the application as filed did not provide a direct and unambiguous disclosure for a copolymer formed by reacting the monomers defined under (a), (b) and (c).

- III. An appeal against that decision was filed on 17 March 2010 and the prescribed fee was paid the same day. The statement setting out the grounds of the appeal was submitted on 24 June 2010, to which were annexed four sets of claims forming the Appellants' Auxiliary Requests I to IV.

Claim 1 of the Fourth Auxiliary Request read as follows:

- "1. A reagent composition for attaching a target molecule to the surface of a substrate, the reagent composition comprising a copolymer having one or more pendant epoxy groups and one or more pendant

photoreactive groups, the copolymer formed by reacting a mixture comprising:

- (a) 5 mole % to 35 mole % of one or more glycidyl methacrylate monomers having pendant epoxy groups;
- (b) one or more acrylamide diluent monomers; and
- (c) 0.1 mole % and 5 mole % one or more N-[3-(4-Benzoylbenzamido)propyl]methacrylamide (BBA-APMA) monomers having a photoreactive group."

IV. A communication by the Board dated 03 April 2013, sent in advance by fax on 27 March 2013, was issued in preparation of the oral proceedings. It was in particular pointed out that Tables 1 and 2, referred to by the Appellants in their statement setting out the grounds of appeal, which were stated to indicate the basis in the application as filed of the claims of Auxiliary Requests I to IV, had not been submitted. Comments concerning clarity and conciseness of claim 1 of Auxiliary Request IV were nevertheless provided. It was also indicated in point 13, that the application as filed would not appear to define a copolymer formed by reacting glycidyl methacrylate, acrylamide and BBA-APMA, in combination with the amount of repeating units then defined in said claim (Article 123(2) EPC). Reference was made to copolymers consisting of those repeating units - disclosed in Example 6 and on page 28 of the application as filed as compound (VI) -, which, however, contained amounts of repeating units different from those defined in claim 1 of Auxiliary Request IV.

V. With a letter of 29 April 2013, the Appellants submitted a new main request and an auxiliary request replacing the previous requests then on file. The new

requests both contained the same claim 1 which read as follows:

- "1. A reagent composition for attaching a target molecule to the surface of a substrate, the reagent composition comprising a copolymer having one or more pendant epoxy groups and one or more pendant photoreactive groups, the copolymer formed by reacting a mixture comprising:
- (a) 2 mole % to 30 mole % of glycidyl methacrylate having pendant epoxy groups;
 - (b) 65 mole % to 97.9 mole % acrylamide; and
 - (c) 0.1 mole % and 5 mole % N-[3-(4-Benzoylbenzamido)-propyl] methacrylamide (BBA-APMA) having a photoreactive group."

VI. The Appellants' arguments can be summarized as follows:

- (a) As regards the compliance of the amended claims with the requirements of Article 123(2) EPC, claim 1 of both requests was based on claim 1 of earlier Auxiliary Request IV, the latter having been amended to define the amounts of the repeating units as shown for compound (VI) on page 28 of the application as filed.
- (b) Claim 1 had been amended in order to overcome the objection under Article 123(2) EPC against claim 1 of Auxiliary Request IV raised by the Board in point 13 of their communication, and where the Board had acknowledged "*that if claim 1 is meant to define the copolymer formed by reacting glycidyl methacrylate, acrylamide and BBA-APMA, basis appears to be found in Example 6 of the*

application as filed and on page 28 defining compound (VI), which consists of those repeating units" (letter of 29 April 2013, page 2, third paragraph).

(c) The modifications presented followed "*the suggestions for amendments that in the view of the Board of Appeal could find basis in the description as filed and could thus comply with Art. 123(2) EPC as stated under item 13 of the Communication" (letter of 29 April 2013, page 1, fourth paragraph).*

VII. In the letter of 29 April 2013, the Appellants indicated that they did not intend to attend the oral proceedings and requested that a decision be made on the basis of the new main and first auxiliary requests and their written submissions. It was also requested that the Board communicate whether the sets of claims of the main request, or alternatively of the auxiliary request were deemed allowable in view of Article 123(2) EPC. They also asked the Board to issue a further communication or to phone the Representative if minor amendments were still necessary to overcome remaining objections under Article 123(2) EPC to one of the sets of claims.

VIII. The Appellants have requested that the decision under appeal be set aside and that the case be processed further on the basis of the main and auxiliary requests filed with letter of 29 April 2013.

IX. Oral proceedings were held on 4 June 2013 in the absence of the Appellants.

Reasons for the Decision

1. The appeal is admissible.

Procedural matters

Absence of the Appellants at the oral proceedings

2. A Board of Appeal has the power and the duty to conduct the proceedings before them, in particular to decide in which manner the appeal proceedings have to come to an end. Whether scheduled oral proceedings in ex parte proceedings should be maintained or a further communication issued, which factually would constitute a continuation of the procedure in writing, is at the Board's discretion. In the present case, the Board did not consider it useful to communicate any preliminary opinion about the newly formulated requests in advance to the already scheduled oral proceedings. It was deemed more appropriate to hear the Appellants on the issues at stake at the scheduled oral proceedings, providing them with the opportunity to react to the Board's comments and to amend the claims if necessary.
3. The Appellants who were duly summoned to oral proceedings, however did not appear and the proceedings were continued in their absence in accordance with Rule 115(2) EPC, the Appellants being treated as relying only on their written case (Article 15(3) RPBA), in accordance with their request of 29 April 2013.

4. In view of the only ground for the refusal and the comments by the Board in the communication sent in preparation for the oral proceedings, the Appellants could expect that the issue of whether the claimed subject-matter extended beyond the content of the application as filed would form an essential part of the discussion at the oral proceedings. The Appellants nevertheless chose not to attend the oral proceedings, and did not seize thereby an opportunity to argue their case and submit, if necessary, suitable amendments.
5. As the end of the oral proceedings, a decision was taken on the basis of the main and auxiliary requests filed with letter of 29 April 2013. Whether or not the objections mentioned against those requests could have been met by suitable amendments is irrelevant as the Board examines and decides upon the patent application only in the text submitted to it, or agreed, by the applicant (Article 113(2) EPC).

Admissibility of the new requests

6. The filing of the new Main and First Auxiliary Requests can be considered to be in direct response to the issues concerning the requirements set out in Articles 123(2) and 84 EPC, which were addressed in points 12 and 13 of the Board's communication. They are therefore admitted to the proceedings.

Main Request

Article 123(2) EPC

7. On appeal from the examining division, the applicant is required by Article 108 EPC in combination with Rule 99(2) EPC, as is also reflected in Article 12 RPBA, to indicate in his statement of grounds of appeal the reasons for setting aside the impugned decision, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based. Therefore, when the application has been refused for added subject-matter and amended application documents are submitted, the applicant is expected to indicate the passages in the original application which are the basis for the modified documents. The burden of proof in demonstrating that the amended application finds a direct and unambiguous basis in the documents of the application as filed lies therefore with the Appellants.

8. In the present case, the Appellants did not indicate which passages of the original documents constituted a basis for the claimed subject-matter. As regards claim 1 of the Main Request, the Appellants argued that it was based on claim 1 of a previous request, namely Auxiliary Request IV submitted with the statement setting out the grounds of the appeal, the claim now defining the amount of repeating units disclosed for compound (VI) on page 28 of the application as filed. Furthermore, in comparison to claim 1 of that Auxiliary Request IV, the expressions "one or more", as well as "monomers" and "diluent monomers" had been deleted.

9. A statement that an amended claim results from the insertion of additional features taken in isolation from specific passages of the original application into the claim of a previous request, for which previous request a basis in the application as filed has already been provided, is in principle not sufficient in order to demonstrate that the requirements of Article 123(2) EPC are satisfied. Evidence is also required that the connection between the inserted features and the combination of features provided in the previous request does not constitute technical information that was not directly and unambiguously derivable from the application as filed. Therefore, it is necessary to demonstrate that the inserted features are disclosed in the application as filed in the context of the subject-matter already defined in the previous claim, i.e. that the new combination of features resulting from the insertion of the additional features is directly and unambiguously disclosed in the original application.

10. Turning to the particulars of the present case, the expression "0.1 mole % **and** 5 mole %", which has been inserted in claim 1 for defining the amount of co-monomer BBA-APMA, is, in view of the formula representing compound (VI) on page 28, cited by the Appellants as basis in the application as filed for this amendment, understood, to the Appellants' benefit, to read "0.1 mole % **to** 5 mole %". Otherwise, the amount of co-monomer BBA-APMA so defined would not have been shown to be disclosed in the application as filed, and claim 1 would already contravene Article 123(2) EPC for this reason.

11. Apart from the reference to Example 6 and Formula (VI) on page 28, no basis in the application as filed has been indicated for the subject-matter of present claim 1. In fact, not even an explanation of the basis in the application as filed for claim 1 of previous Auxiliary Request IV to which the Appellants referred as the basis of claim 1 of the present request, has been provided, despite the indication by the Board in the communication dated 03 April 2013, that such an explanation was missing.

12. The passages concerning Example 6 and formula (VI) on page 28 do not constitute themselves a proper support for the subject-matter now being claimed. According to formula (VI) and Example 6 the copolymer to be used in the reagent composition is formed by reacting glycidyl methacrylate, acrylamide and BBA-APMA, i.e. it consists only of those repeating units. However, according to present claim 1, the copolymer is formed by reacting a mixture comprising glycidyl methacrylate, acrylamide and BBA-APMA, allowing thereby a broader class of copolymers than those disclosed in Example 6 and Formula (VI) of the application as filed. This definition of the copolymer in present claim 1 does not only allow the presence of large amounts of undefined copolymerized monomeric units in addition to those provided by glycidyl methacrylate, acrylamide and BBA-APMA, but it also results in the possibility of using proportions of the repeating units provided by glycidyl methacrylate, acrylamide and BBA-APMA that differ from those allowed by Formula (VI) as filed. This constitutes technical information not directly and unambiguously derivable from the application as filed. The Board is not aware of any passage of the

application as filed that would provide such technical information, nor have the Appellants indicated such a passage.

13. The Appellants suggested that according to the Board's communication the introduction into claim 1 of the amounts of repeating units defined on page 28 for formula (VI) would result in a claim complying with the requirements of Article 123(2) EPC. However, that is not the case, as the Board's comments in point 13 of the communication were given conditional on the claim being directed to a reagent composition comprising a copolymer formed by reacting glycidyl methacrylate, acrylamide and BBA-APMA, i.e. comprising a copolymer consisting only of those repeating units. This condition, however, appears to have been ignored in the present formulation of claim 1.

14. Consequently, the Appellants have failed to establish that the subject-matter of claim 1 of the main request meets the requirements of Article 123(2) EPC. The main requests is thus not allowable and has to be rejected.

Auxiliary request

15. Claim 1 of the auxiliary request is identical to claim 1 of the main request. It is therefore rejected for the same reasons.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

E. Goergmaier

B. ter Laan