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Datasheet for the decision of 21 October 2014

Case Number: T 1749/11 - 3.3.10

Application Number: 04732560.0

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Language of the proceedings: EN

Title of invention:
RESORBABLE POLYMERIC MEDICAL GOODS WITH IMPROVED MECHANICAL PROPERTIES AND METHOD FOR PRODUCING SAME

Applicant:
Synthes GmbH

Headword:

Relevant legal provisions:
EPC Art. 123(2), 111(1)

Keyword:
Amendments - added subject-matter (no)
Remittal to the examining division

Decisions cited:

Catchword:

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Case Number: T 1749/11 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 21 October 2014

Appellant: (Applicant)	Synthes GmbH Eimattstrasse 3 4436 Oberdorf (CH)
Representative:	Lusuardi, Werther Dr. Lusuardi AG Kreuzbühlstrasse 8 8008 Zürich (CH)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 27 December 2010 refusing European patent application No. 04732560.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	P. Gryczka
Members:	R. Pérez Carlón
	C. Schmidt

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal against the decision of the examining division to refuse the European patent application Nr. 04 732 560.0.

II. The examining division considered that the method for producing medical devices according to claim 1 of the then pending main request did not involve an inventive step. In the decision under appeal it also indicated, for the sake of completeness, that claim 17 of the then pending main request, which was directed to a medical device, contained added subject-matter and was not admissible in the sense of Rule 137(5) EPC since it related to subject-matter that had not been searched.

III. During the oral proceedings before the board on 21 October 2014, the appellant filed a main request containing only one claim, which reads as follows:

"*Resorbable or degradable polymeric medical device in the form of pins, pegs, plates, screws, medullary nails, ribbons or monofilaments, having a tensile strength in the range of 100 to 5,000 MPa and a tensile Young's modulus in the range of 4,000 to 30,000 MPa, said medical device being obtained by applying compressive forces on solid polymeric objects containing liquid or solid additives being chosen from the group comprising:*
aliphatic mono--, di- or trialcohols, chlorinated solvents, aliphatic acetates, aliphatic aldehydes and ketones, aliphatic carboxylic acids and lactones, carboxylic esters, alkenic acetates, alkenic methyl esters, acetylenic alcohols, acetylenic acids and esters, monocarbocyclic carboxylic acids and lactones, monocarbocyclic esters, esters of hydroxy acids, and

dibasic aliphatic acids; whereby

A) the additives are able to promote the slippage of the polymeric objects through the forming device, facilitate transient chain mobility and promote chain orientation;

B) said additives are present in an amount of 0.005 to 20% of the dry weight of said polymeric objects;

C) the solubility parameters of said additives being selected in such a way that after absorbing by said polymeric objects the additives do not dissolve more than 0.01 to 1% of the total mass of said polymeric objects;

D) said applying of compressive forces is performed minimally at a temperature of $T_{mim} = T_g - 50°C$, *T_g being the glass transition temperature of the polymer the said object is made of polymer; and*

E) said applying of compressive forces is performed maximally at a temperature $T_{max} = T_m - 5°C$, *Tm being the melting peak temperature of the polymer the said object is made of said polymer objects."*

IV. The arguments from the appellant relevant for the present decision were the following:

Claim 1 found a basis in the combination of claims 1, 3, 20 and page 4, lines 13-14 of the application as originally filed.

The objection of the examining division that the then pending process claims lacked an inventive step did no longer apply to the present request, which was solely

directed to a medical device.

The objections raised by the examining division that the then pending claim 17 directed to a medical device contained added subject-matter and had not been searched were also overcome by the main request in appeal proceedings.

V. The final requests of the appellant were that the decision under appeal be set aside and that a patent be granted in the following version:

- main request as filed during the oral proceedings;
- as first auxiliary request: main request as filed with letter dated 20 December 2013;
- as second auxiliary request: first auxiliary request filed with letter dated 19 September 2014;
- as third auxiliary request: second auxiliary request as filed during oral proceedings;
- as fourth auxiliary request: third auxiliary request as filed with letter dated 19 September 2014;
- as fifth auxiliary request: fourth auxiliary request as filed during the oral proceedings.

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

Reasons for the Decision

1. The appeal is admissible.

Main request:

Amendments:

2. Claim 1 of the main request finds a basis in the combination of claims 1, 2 and 30 with the passage on page 4, lines 13-14 of the application as originally filed.

The requirements of Article 123(2) EPC are thus fulfilled.

Remittal:

3. By filing the main request, the appellant overcomes the objections raised by the examining division in the decision under appeal:

3.1 All the claims directed to a process have been deleted. Thus, the appellant overcomes the sole reason of the examining division for refusing the application, namely that the process subject-matter of the then pending claims 1-16 was not inventive.

3.2 By combining original claims 1, 3, 20 and page 4, lines 13-14 of the application as originally filed, the appellant also overcomes the objection raised by the examining division for completeness that the then pending claim 17, directed to a medical device, contained added subject-matter.

3.3 There is no indication on file which could lead to the conclusion that the subject-matter of the claims as originally filed had not been searched completely. In

fact the search report cites prior art in relation with the medical device subject-matter of claim 20 as originally filed.

Since the medical device according to claim 1 of the main request requires all the technical features of the medical device of claim 20 as originally filed and said subject-matter has been searched, the board concludes that the objection raised under Rule 137(5) EPC in relation to the then pending device claim has also been overcome.

3.4 According to Article 111(1) EPC, a board may either exercise any power within the competence of the department which was responsible for the appealed decision, i.e. decide on all issues, or remit the case to the first instance for further prosecution.

The board notes that the examining division considered that the medical device according to claim 20 as originally filed was not novel. However, the medical device according to claim 1 requires additional technical features such as the chemical nature of the liquid or solid additives and the form of the medical device. Since the examining division has not examined this subject-matter, it is appropriate to remit the case for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the examining division for further prosecution on the basis of the main request as filed at the oral proceedings before the board.

The Registrar: The Chairman:

C. Rodríguez Rodríguez P. Gryczka

Decision electronically authenticated