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**Datasheet for the decision
of 13 January 2015**

Case Number: T 2159/11 - 3.3.10

Application Number: 01973601.6

Publication Number: 1335761

IPC: A61L31/10, A61L27/34

Language of the proceedings: EN

Title of invention:
COATINGS FOR MEDICAL DEVICES

Patent Proprietor:
ETHICON, INC.

Opponent:
Boston Scientific Corporation

Headword:

Relevant legal provisions:
EPC Art. 100(c), 123(2), 112(1)(a), 113(1)
EPC R. 84(1), 100(1)
RPBA Art. 15(1), 17

Keyword:
Grounds for opposition - added subject-matter (yes)
Amendments - allowable (no) - first auxiliary request
Referral to the Enlarged Board of Appeal - (no)
Right to be heard - opportunity to comment (yes)

Decisions cited:

T 0823/96, T 1389/08, T 1170/02, T 0727/00, T 0612/09,
T 0956/07, T 0925/98, T 0002/81, T 0201/83, T 1107/06,
T 0958/06

Catchword:



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Case Number: T 2159/11 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 13 January 2015

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 15 July 2011
revoking European patent No. 1335761 pursuant to
Articles 101(2) and 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: R. Pérez Carlón
F. Blumer

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division to revoke European patent No. 1 335 761.
- II. An opposition had been filed on the grounds of added subject-matter (Article 100(c) EPC), insufficiency of disclosure (Article 100(b) EPC), and lack of novelty and inventive step (Article 100(a) EPC).

The opposition was withdrawn during these appeal proceedings.

- III. The opposition division considered *inter alia* that the main request, which was the patent as granted, and the then pending first auxiliary request did not contain subject-matter extending beyond the content of the application as originally filed. It further concluded that the subject-matter of claim 1 of both requests was not novel over document D1 (EP 1 192 957 A2), which constituted prior art under Article 54(3) EPC.
- IV. Claim 1 of the main request in these appeal proceedings, which is the patent as granted, reads as follows:

"An implantable medical device comprising:

a biocompatible film effective to provide an inert surface to be in contact with body tissue of a mammal upon implantation of said device in said mammal,

said film comprising a polyfluoro copolymer comprising:

from greater than 85 to 92 weight percent of polymerized residue of a vinylidene fluoride; and

from less than 15 to 8 weight percent of polymerized residue of hexafluoropropylene."

V. Claim 1 of the first auxiliary request, filed with the statement setting out the grounds of appeal, contains all the features of claim 1 of the main request and two disclaimers.

VI. The arguments of the appellant relevant for the present decision are as follows:

According to the case law of the boards of appeal, the disclosure of a broader range and of a sub-range within that broader range inherently disclosed the sub-ranges on either side of the explicitly disclosed sub-range (T 1170/02, T 925/98, T 2/81, T 201/83, T 1107/06). The ranges on page 7, lines 19-26 of the application as originally filed were defined using the terms "from" and "to", which meant that the explicitly disclosed sub-range included these end points. In order to avoid any overlap, it was thus necessary to define any inherently-disclosed sub-range in wording which excluded the end point of the explicitly-disclosed sub-range. Thus, the "greater than" language in claim 1 met the requirement that the claimed sub-range was one on the side of the explicitly disclosed sub-range and did not overlap with it.

A negative decision on added subject-matter would be surprising, since the opposition division had already decided in the appellant's favour, and the sole opposition had been withdrawn. Under these circumstances, the board should be bound by the

decision of the opposition division, in particular as it had not issued any preliminary opinion.

Lastly, should the board be minded to dismiss the appeal on the grounds that the ranges defined in claim 1 of the main and auxiliary requests represented added subject-matter, the appellant requested that the following question be referred to the Enlarged Board of Appeal:

"In light of T 1170/02, in a situation where an application discloses a broad range of, for example, 50 to 92 and a narrower range of from 60 to 85, does a claim which recites a range of from 50 to less than 60 or from greater than 85 to 92 meet the requirement of Article 123(2) EPC?"

The proper application of the requirements of Article 123(2) EPC to numerical ranges was a general question of law. Further, if this board reached a conclusion which differed from that of T 1170/02, two potentially conflicting decisions would exist. Thus, a referral would be fully justified and fulfil the conditions set out in Article 112(1) (a) EPC.

- VII. Oral proceedings before the board took place on 13 January 2015.

- VIII. The final requests of the appellant were that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, subsidiarily, that the patent be maintained on the basis of the first auxiliary request as filed with the statement setting out the grounds of appeal of 24 November 2011.

If the board decided that none of the requests complied with Article 123(2) EPC, the appellant further requested that the following question be referred to the Enlarged Board of Appeal:

"In light of T 1170/02, in a situation where an application discloses a broad range of, for example, 50 to 92 and a narrower range of from 60 to 85, does a claim which recites a range of from 50 to less than 60 or from greater than 85 to 92 meet the requirements of Article 123(2) EPC?"

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

Reasons for the Decision

1. The appeal is admissible.

Amendments:

2. Claim 1 of of the patent as granted contains the feature:

"said film comprising a polyfluorocopolymer comprising:

from greater than 85 to 92 weight percent of polymerized residue of a vinylidene fluoride; and

from less than 15 to 8 weight percent of polymerized residue of hexafluoropropylene"

This amendment was challenged by the former opponent in opposition proceedings and again before withdrawal of the opposition in these appeal proceedings.

3. The appellant acknowledged that the application as originally filed did not explicitly disclose that wording of claim 1. However, it relied as an implicit basis for it on disclosure on page 7, lines 19-26, which reads:

"Polyfluoro copolymers used in the present invention typically comprise vinylidene fluoride [sic] copolymerized with HFP, in the weight ratio of from about 50 to about 92 weight percent vinylidene fluoride [sic] to about 50 to about 8 weight percent HFP.

Preferably, polyfluoro copolymers used in the present invention comprise from about 50 to about 85 weight percent VDF copolymerized with from about 50 to about 15 weight percent HFP"

According to the description, HFP stands for hexafluoropropylene (page 7, line 13) and VDF for vinylidene fluoride (page 3, lines 14-15).

4. The ground of opposition under Article 100(c) EPC would preclude the maintenance of the patent as granted if its content went beyond that of the patent application as originally filed.

In order to determine whether or not the patent in suit contains added subject-matter, it has to be examined whether it discloses technical information which a skilled person would not have objectively and unambiguously derived, either explicitly or implicitly, from the application as filed.

Implicit disclosure means no more than the clear and unambiguous consequence of what is explicitly disclosed (see T 823/96, point 4.5 of the reasons, not published

in OJ EPO), and should not be construed to mean matter that is not part of the content of the technical information provided by a document but may be rendered obvious on the basis of that content.

5. Following decisions T 1389/08 Reasons 5, T 1170/02 Reasons 4, T 727/00 Reasons 1.1.3, 1.1.4 and 2.1.2, T 612/09 Reasons 13 and T 956/07, Reasons 5.1, the passages on page 7 of the application as originally filed "*from about 50 to about 92 weight percent vinylidene fluoride*" and "*from about 50 to about 85 weight percent VDF*" inherently disclose a sub-range on the upper side of the explicitly disclosed sub-range "*from about 50 to about 85 weight percent VDF*" which extends to the upper limit "*about 92 weight percent*" of the broadest range.

In favour of the appellant, it will be further considered that the features of the application as originally filed "about 85" and "about 92" can be read as "85" and "92", although the appellant's arguments were based on an alleged very precise meaning of these values (see point 6.).

The question, however, arises whether the inherently disclosed sub-range is clearly and unambiguously "**from greater than 85 to 92**".

6. The appellant argued that the ranges on page 7, lines 19-26 were defined using the terms "from" and "to", so that the end point of the sub-range was already included in the explicitly disclosed sub-range. It was thus necessary to define the implicitly disclosed sub-range in wording which excluded the end point of the explicitly disclosed sub-range in order to avoid any overlapping. The "greater than" language in claim 1 met

the requirement of defining a sub-range just outside of the explicitly disclosed sub-range, avoiding any overlap. The appellant relied in support of these arguments on decisions T 925/98, T 2/81, T 201/83, T 1107/06 and T 1170/02.

The board considers, however, that the broader range and the narrower sub-range in the application as originally filed may inherently disclose a further range resulting from the explicitly disclosed end values of said ranges, namely "85" and "92", but fails to see why, as alleged by the appellant, any overlap must be excluded in this context. In fact, considering that the value "85" only belonged to the explicitly disclosed sub-range, but not to the implicitly disclosed sub-range on its side, is a new technical information which cannot be derived from the application as originally filed.

For this reason, the board concludes that the sub-range "from greater than 85 to 92" is not implicitly disclosed by the broader range "from about 50 to about 92" and the sub-range "from about 50 to about 85" in the application as originally filed.

7. It remains to be examined whether the implicitly disclosed interval "from 85 to 92" could still provide a basis for the range "from greater than 85 to 95". This could be the case if the term "greater than 85" did not add any technical information going beyond that of the term "85".

According to the appellant (see point 6. above), the feature "greater than 85" was required in claim 1 in order to exclude the otherwise overlapping point "85". Thus, the feature "greater than 85", which excludes the

overlapping point "85", must necessarily be different from "85", which includes it. It must therefore be concluded that the feature "greater than 85" represents additional technical information (T 985/06, Reasons 2.1), and cannot be considered implicitly disclosed by the value "85".

8. The lower amount of polymerised VDF of "greater than 85" required by claim 1 thus does not find a basis in the application as originally filed, with the consequence that the ground under Article 100(c) EPC precludes the maintenance of the patent as granted.

9. The appellant did not contest that the feature "greater than 85" is also present, in the same context, in claim 1 of the first auxiliary request, and the board thus concludes that claim 1 of the first auxiliary request contains subject-matter extending beyond the disclosure of the application as originally filed, for the same reasons as the main request, with the consequence that the first auxiliary request is not allowable.

Decisions T 952/98, T 2/81, T 201/83 and T 1107/06:

10. None of decisions T 952/98, T 2/81, T 201/83 and T 1107/06 relates to an amendment consisting of restricting the subject-matter claimed to an implicitly disclosed sub-range to one side of an explicitly disclosed, preferred sub-range, let alone to whether any overlap between the explicitly disclosed sub-range and the inherently disclosed sub-range to one side must be avoided:
 - 10.1 In the case at issue in T 925/98 and T 2/81, the amendment resulted in a range which still included the preferred, explicitly disclosed, narrower sub-range in

addition to the inherently disclosed sub-range to one side, and hence differs from the situation in this appeal proceedings. Further, none of these decisions dealt with the key issue of an end point "greater than" a given value.

- 10.2 Decision T 201/83 relates to the issue of added subject-matter in connection with a range arising from the combination of an explicitly disclosed range and an end value disclosed only in one of the examples. Like the preceding decisions, it does not further address the issues arising from an amendment to a value "greater than" a explicitly disclosed value.
- 10.3 Decision T 1107/06 refers to an amended claim including a disclaimer which arose from an embodiment of the invention, and is not related to features including numerical ranges.
- 10.4 The appellant also relied on "the other cases referred to in the paragraph bridging pages 349 and 350 of the Case Law Book". Since the corresponding passage in the latest (7th) edition of 2013 deals with the omission of features, it appears that the appellant intended to refer to the 6th (2010) edition, or to its corresponding passage on pages 407-408 of the 7th edition. Said passage refers, however, like T 2/81 and T 925/98 (see point 10.1 above), to amendments resulting in a range containing a narrower, explicitly disclosed, preferred sub-range and one of the implicitly disclosed sub-ranges lying within the broadest range to one side of the narrower, explicitly disclosed, preferred sub-range. Further, no reference is made to a range excluding one of its end-points by the wording "greater than".

It is thus concluded that none of these decisions relates to the issue of an end point defined as "greater than" a given value.

Decision T 1170/02:

11. The sole decision cited by the appellant whose conclusions could be relevant to the present appeal is T 1170/02, which relates to whether a claim including the feature "at least 0.1 times **but below** 0.5 times" finds a basis in the parent application, which discloses "**0.1**-10 times, preferably **0.5**-5 times".

It was considered in that decision that the feature "0.1 to 0.5 times" (i.e. without the term "but below") was directly and unambiguously derivable from the parent application, in accordance with the case law cited in point 5. above.

The board then addressed the question of whether the feature "0.1 times but below 0.5 times" was directly and unambiguously derivable from the disclosure of the parent application, taken as a whole, and was consistent with it. The board considered that the reasoning was the same as for the range "0.1 to 0.5 times" and the conclusion "applied mutatis mutandis to the range '0.1 times to below 0.5 times'". The conclusion of the board relied, thus, on the assumption that "0.5" was *the same* as "below 0.5".

In contrast, the appellant argued in its letter of 19 August 2013, point 4.2.4.4 and during the oral proceedings before the board that the wording in claim 1 "from greater than 85" excluded the overlapping point "85". This argument of the appellant, which the board has accepted in its favour, implies that these terms

are not identical.

Therefore, the appellant cannot rely on the conclusions of T 1170/02 since this decision arose from a premise ("0.1 to 0.5 times" is the same as "0.1 times but below 0.5 times") which is at odds with its argument that "from greater than 85" excludes "85", which implies that both terms are different.

Request for a referral to the Enlarged Board of Appeal:

12. The appellant requested, should the board be minded to dismiss the appeal on the grounds that the ranges in claim 1 of the main and auxiliary requests represented added subject-matter, that the following question be referred to the Enlarged Board of Appeal:

"In light of T 1170/02, in a situation where an application discloses a broad range of, for example, 50 to 92 and a narrower range of from 60 to 85, does a claim which recites a range of from 50 to less than 60 or from greater than 85 to 92 meet the requirement of Article 123(2) EPC?"

If this board reached a conclusion which differed from that of T 1170/02, two potentially conflicting decisions would exist. The application of the requirements of Article 123(2) EPC to numerical ranges was, furthermore, a general question of law. Such a referral thus fulfilled the conditions set out in Article 112(1)(a) EPC.

13. Although this request for a referral was submitted at the end of the oral proceedings before the board, when the debate had already been closed and the board intended to announce its decision, the board will

nevertheless address its substance.

14. Article 112(1)(a) EPC stipulates that such a referral is made if the board considers that a decision is required for the purposes defined in Article 112(1) EPC, namely to ensure uniform application of the law, or if a point of law of fundamental importance arises.

The different conclusions with respect to the issue of added subject-matter in T 1170/02 and in the present decision derive from a different *technical* interpretation of the features "greater than" and "below" in the specific cases under appeal. As explained above (point 11.), decision T 1170/02 saw no difference between "0.1 to 0.5 times" and "0.1 times but below 0.5 times" and for that reason it concluded that, if the former was inherently disclosed, the latter was disclosed for the very same reasons.

In the present case, however, it was the appellant's position that the wording "from greater than 85" excluded the overlapping point "85". It was under this assumption, which, in favour of the appellant, has not been examined as to its merits, that the board has drawn the conclusion that no basis for the feature "greater than 85" could be found in the application as originally filed. The different conclusions in the present appeal and in T 1170/02 do not arise from a divergent application by the boards of the relevant law on amendments, but from a different interpretation of the wording of the claims, which depends on the technical and factual situation of the case. The present decision is thus not in conflict with previous case law.

In addition, the question suggested by the appellant is

not a question of law but related to a technical issue which can only be answered taking into account the interpretation of the subject-matter claimed within the relevant technical field and in view of the technical details of the claimed invention, with the consequence that any conclusion drawn on the basis of the specific facts of a case does not necessarily have to be generally applicable.

Since the question proposed by the appellant is not a point of law of fundamental importance no discrepancy is apparent in the application of the law which could justify a remittal to the Enlarged Board of Appeal under Article 112(1) (a) EPC, the appellant's conditional request for a referral is refused.

Procedural issues:

15. During the oral proceedings before the board, the appellant argued that any negative decision on added subject-matter would be surprising, since the opposition division had already decided in its favour and the sole opposition had been withdrawn. Under these circumstances, the board should be bound by the decision of the opposition division, in particular since it had not issued any preliminary opinion on the case.

According to Rule 84(1) EPC, opposition proceedings may be continued after the opposition has been withdrawn. Rule 100(1) EPC stipulates that the provisions relating to proceedings before the department which has taken the impugned decision, in this case the opposition division, apply to appeal proceedings unless otherwise provided.

The board is thus not bound by the decision of the opposition division and may examine an opposition even after the sole opposition has been withdrawn.

The opposition was based on the ground under Article 100(c) EPC (point 1.2 of the notice of opposition) for the same reason examined in this decision. The opposition division dealt with this issue (point 2.3.b of the decision), the former respondent maintained its objection in its response to the notice of appeal (point 3.2 of the response) and the appellant presented its arguments on this issue both in writing (point 4.2.4 of its submission from 19 August 2013) and during the oral proceedings before the board. The board considers for these reasons that the appellant cannot be surprised by a decision on this issue, and that it had sufficient opportunity to provide its arguments thereon.

The appellant further argued that the board should have provided a preliminary opinion on the case if it did not intend to share the conclusion of the opposition division.

According to Article 15(1) RPBA, a board may send a communication to the parties, but it is not obliged to. In the present case, since the issue of added subject-matter was clearly in dispute by the parties in the written proceedings, the board did not feel it necessary to indicate in a communication that it would be dealing with that point during the oral proceedings.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is rejected.
2. The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated