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Datasheet for the decision of 11 June 2014

Case Number: T 1904/12 - 3.2.02

Application Number: 05104948.4

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Language of the proceedings: EN

Title of invention:
Needle tip guard for hypodermic needles

Patent Proprietor:
B. Braun Melsungen AG

Opponent:
Poly Medicure Limited

Headword:

Relevant legal provisions:
EPC Art. 76(1), 100(c), 123(2)

Keyword:
Added subject-matter (yes)
Late-filed request - admitted (no)

Decisions cited:

Catchword:

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European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1904/12 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 11 June 2014

Appellant: (Patent Proprietor)	B. Braun Melsungen AG Carl-Braun-Strasse 1 34212 Melsungen (DE)
Representative:	Kinkeldey, Daniela Bird & Bird LLP Maximiliansplatz 22 80333 München (DE)
Respondent: (Opponent)	Poly Medicure Limited 105, Sector 59 HSIDC Industrial Area Faridabad Haryana 121 004 (IN)
Representative:	Thum, Bernhard Wuesthoff & Wuesthoff Patent- und Rechtsanwälte Schweigerstrasse 2 81541 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 4 July 2012 revoking European patent No. 1604700 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	E. Dufrasne
Members:	P. L. P. Weber
	M. Stern

Summary of Facts and Submissions

I. The appeal by the patent proprietor is against the decision of the Opposition Division posted on 4 July 2012 to revoke the patent because its subject-matter extended beyond the application as filed and beyond the earlier application as filed.

The notice of appeal was filed on 28 August 2012 and the appeal fee paid on the same day. The statement setting out the grounds of appeal was filed on 12 November 2012.

II. In a communication annexed to the summons to oral proceedings, the Board drew the attention of the parties to the fact that in particular it would have to be examined whether there was a basis for a radially confining biasing force acting on the needle trap which was independent from the axial extending force of a coil spring.

III. Oral proceedings were held on 11 June 2014.

The appellant requested that the impugned decision be set aside and that the patent be maintained as granted or, in the alternative, on the basis of one of the auxiliary requests I and III filed with letter dated 12 November 2012, IIIB and IIIC filed with letter dated 9 May 2014 and IIID filed during the oral proceedings. The other auxiliary requests on file were withdrawn during the oral proceedings.

The respondent requested that the appeal be dismissed.

IV. In the written proceedings the appellant filed several non-patent documents (court decisions, expert opinions) to support its arguments.

V. The different versions of claim 1 read as follows:

Claim 1 of the patent as granted reads as follows (with the feature numbering proposed by the respondent):

"1. A needle protective device comprising:

1.1 a needle (10) having a sharpened distal end (11);

1.2 a needle guard (22, 22a) slidably mounted on said needle (10),
1.2.1 said needle guard (22, 22a) having a proximal end and a distal end,
1.2.2 said needle guard (22, 22a) containing a movable needle trap (41) that is biased toward said needle (10),
1.2.3 said needle trap (41) entrapping said sharpened distal end (11) of said needle (10) when said distal end of said needle guard (22, 22a) moves distal of said sharpened distal end (11) of said needle (10); and

1.3 limiting means for limiting the forward movement of said needle guard (22, 22a) along said needle (10);

1.4 wherein the needle guard (22, 22a) further comprises a resilient member (19) located in an annular fashion
1.4.1 surrounding a portion of the needle guard (22, 22a) and
1.4.2 applying a radially confining biasing force on the needle trap (41),

1.5 the needle trap (41) being hingedly attached to the needle guard (22, 22a).”

Claim 1 according to auxiliary request I reads as follows (changes to claim 1 of the main request highlighted by the Board):

“A needle protective device comprising:

a needle (10) having a sharpened distal end (11);

a needle guard (22, 22a) slidably mounted on said needle (10),

said needle guard (22, 22a) being adapted to be manually urged forward along the shaft of the needle (10),

said needle guard (22, 22a) having a proximal end and a distal end,

said needle guard (22, 22a) containing a movable needle trap (41) that is biased toward said needle (10),

said needle trap (41) entrapping said sharpened distal end (11) of said needle (10) when said distal end of said needle guard (22, 22a) moves distal of said sharpened distal end (11) of said needle (10); and

limiting means for limiting the forward movement of said needle guard (22, 22a) along said needle (10);

wherein the needle guard (22, 22a) further comprises a resilient member (19) located in an annular fashion surrounding a portion of the needle guard (22, 22a) and applying a radially confining biasing force on the

needle trap (41), the needle trap (41) being hingedly attached to the needle guard (22, 22a).”

Claim 1 according to auxiliary request III reads as follows (changes to claim 1 of the main request highlighted by the Board):

“A needle protective device comprising:

a removable indwelling intravenous catheter,

a needle (10) having a sharpened distal end (11);

a needle guard (22, 22a) slidably mounted on said needle (10),

said needle guard (22, 22a) being adapted to be manually urged forward along the shaft of the needle (10),

said needle guard (22, 22a) having a proximal end and a distal end,

said needle guard (22, 22a) containing a movable needle trap (41) that is biased toward said needle (10),

said needle trap (41) entrapping said sharpened distal end (11) of said needle (10) when said distal end of said needle guard (22, 22a) moves distal of said sharpened distal end (11) of said needle (10); and said needle trap (41) having a lead-in area (33) for locating a resilient member (19) on said needle guard (22, 22a) into notch or indentation (60 and/or 61);

limiting means for limiting the forward movement of said needle guard (22, 22a) along said needle (10);

wherein the needle guard (22, 22a) further comprises the resilient member (19) located in an annular fashion surrounding a portion of the needle guard (22, 22a) and applying a radially confining biasing force on the needle trap (41), the needle trap (41) being hingedly attached to the needle guard (22, 22a).”

Claim 1 according to auxiliary request IIIB reads as follows (changes to claim 1 of the main request highlighted by the Board):

“A needle protective device comprising:

a removable indwelling intravenous catheter,

a needle (10) having a sharpened distal end (11);

a needle guard (22, 22a) slidably mounted on said needle (10),

said needle guard (22, 22a) being adapted to be manually urged forward along the shaft of the needle (10),

said needle guard (22, 22a) having a proximal end and a distal end,

said needle guard (22, 22a) containing a movable needle trap (41) that is biased toward said needle (10),

said needle trap (41) entrapping said sharpened distal end (11) of said needle (10) when said distal end of said needle guard (22, 22a) moves distal of said sharpened distal end (11) of said needle (10); and said needle trap (41) having a lead-in area (33) for

locating a resilient member (19) on said needle guard (22, 22a) into notch or indentation (60 and/or 61);

limiting means for limiting the forward movement of said needle guard (22, 22a) along said needle (10);

wherein the needle guard (22, 22a) further comprises the resilient member (19) located in an annular fashion surrounding a portion of the needle guard (22, 22a), ~~and~~ the resilient member (19) applying a radially confining biasing force on the needle trap (41) to assist inherently molded bias of the needle trap (41) by urging the needle trap (41) inwardly and in front of the sharpened needle tip (11), and the resilient member (19) extending, the needle trap (41) being hingedly attached to the needle guard (22, 22a).”

Claim 1 according to auxiliary request IIIC reads as follows (changes to claim 1 of the main request highlighted by the Board):

“A needle protective device comprising:

a removable indwelling intravenous catheter,

a needle (10) having a sharpened distal end (11);

a needle guard (22, 22a) slidably mounted on said needle (10),

said needle guard (22, 22a) being adapted to be manually urged forward along the shaft of the needle (10),

said needle guard (22, 22a) having a proximal end and a distal end,

said needle guard (22, 22a) containing a movable needle trap (41) that is biased toward said needle (10),

said needle trap (41) entrapping said sharpened distal end (11) of said needle (10) when said distal end of said needle guard (22, 22a) moves distal of said sharpened distal end (11) of said needle (10); and said needle trap (41) having a lead-in area (33) for locating a resilient member (19) on said needle guard (22, 22a) into notch or indentation (60 and/or 61);

limiting means for limiting the forward movement of said needle guard (22, 22a) along said needle (10);

wherein the needle guard (22, 22a) further comprises the resilient member (19) located in an annular fashion surrounding a portion of the needle guard (22, 22a), ~~and~~ the resilient member (19) applying a radially confining biasing force on the needle trap (41) to assist inherently molded bias of the needle trap (41) by urging the needle trap (41) inwardly and in front of the sharpened needle tip (11), and the resilient member (19) axially extending, the needle trap (41) being hingedly attached to the needle guard (22, 22a).”

Claim 1 according to auxiliary request IIID reads as follows (changes to claim 1 of the main request highlighted by the Board):

“A needle protective device comprising:

a removable indwelling intravenous catheter,

a needle (10) having a sharpened distal end (11);

a needle guard (22, 22a) slidably mounted on said needle (10),

said needle guard (22, 22a) being adapted to be manually urged forward along the shaft of the needle (10),

said needle guard (22, 22a) having a proximal end and a distal end,

said needle guard (22, 22a) containing a movable needle trap (41) that is biased toward said needle (10),

said needle trap (41) entrapping said sharpened distal end (11) of said needle (10) when said distal end of said needle guard (22, 22a) moves distal of said sharpened distal end (11) of said needle (10); and said needle trap (41) having a lead-in area (33) for locating a resilient member (19) on said needle guard (22, 22a) into notch or indentation (60 and/or 61);

limiting means for limiting the forward movement of said needle guard (22, 22a) along said needle (10);

wherein the needle guard (22, 22a) further comprises the resilient member (19) located in an annular fashion surrounding a portion of the needle guard (22, 22a), ~~and~~ the resilient member (19) applying a radially confining biasing force on the needle trap (41) to assist inherently molded bias of the needle trap (41) by urging the needle trap (41) inwardly and in front of the sharpened needle tip (11), and the resilient member (19) applying an axially extending force, the needle trap (41) being hingedly attached to the needle guard (22, 22a).”

VI. The arguments of the appellant necessary for the present decision and relative to features 1.4, 1.4.1, 1.4.2 and the linked amendments made in the auxiliary requests can be summarised as follows:

Main request - Added subject-matter

An object of the invention was to avoid problems of fatigue due to plastic material losing its properties over time. This was the reason why the resilient member surrounded part of the needle guard. This was apparent e.g. in relation to Figures 43A and 44A for which it was explicitly specified in the description that the resilient member assisted the inherently moulded bias of the needle guard trap. Therefore it was self-evident for the person skilled in the art that the assistance was optional, and hence that the two functions of the resilient member, namely of exerting a radial force on the trap to urge it towards the needle shaft and of urging the needle guard axially towards the needle tip, could be separated.

Further, it was mentioned on page 77, line 12 that the notch on the needle trap on which the compressed coil or resilient member pressed could be dispensed with, and it was self-evident that in such a case the axial extension force could then no longer affect the radial force applied to the needle trap, because the coil would slide over the needle trap.

In any case, in the embodiments according to Figures 61 to 63 there was a resilient member on the needle guard, but no axial force was necessary to urge the needle guard towards the needle tip.

Only claiming a radial force applied to the needle trap was therefore supported by the application as filed.

Auxiliary request I - Added subject-matter

The additional feature in claim 1 made it clear that the resilient means were not for the axial movement of the needle guard along the needle shaft since this movement was made by hand and an axial extension force would make no sense in these embodiments.

Auxiliary request III - Added subject-matter

The additional feature had to be read in the light of the description in which the function of the notch was said to be for retaining the coils of the compressed resilient member, so that the use of this wording in the claim implied that the resilient member meant in the claim also applied an axial extension force.

Auxiliary requests IIIB and IIIC

Admissibility

These requests had been filed in due time before the oral proceedings, in reaction to points raised in the Board's communication. They should therefore be admitted into the proceedings.

Added subject-matter

When read in the light of the description, the wording that the resilient member was "extending", and a fortiori "axially extending" as now present in the claim, had to be understood as meaning that the resilient member applied an axial extension force.

Auxiliary request IIID

Admissibility

This request solved all the issues since it was now explicit in the claim that the resilient member applied an axially extending force.

VII. The arguments of the respondent necessary for the decision and relative to features 1.4, 1.4.1, 1.4.2 and the linked amendments made in the auxiliary requests can be summarised as follows:

Main request – Added subject-matter

What was relevant for the assessment of what was disclosed in the application as filed was not whether the person skilled in the art could have thought of something else but whether the features at stake were directly and unambiguously disclosed. This meant that if there was any doubt, they had to be considered as not disclosed.

A resilient member surrounding the needle guard in the form of a rubber ring would fall under the present wording of claim 1. Already this showed that the subject-matter had been extended because no such embodiment was disclosed in the application as filed. In all embodiments with a resilient member partly surrounding the needle guard, an axial force was applied to the needle guard. The possible absence of a notch was also not relevant either, since the application as filed said nothing about the way an embodiment without a notch would function and what it would look like.

Further, it was not relevant whether an embodiment made sense or not, what was relevant was what was disclosed.

Auxiliary request I – Added subject-matter

The same objection applied to claim 1 of this request since the feature of the application of an axial extension force to the needle guard by the resilient member was still not present in the claim.

Auxiliary request III – Added subject-matter

The same objection applied to claim 1 of this request as well.

Auxiliary requests IIIB and IIIC

Admissibility

These requests should not be admitted into the proceedings because they had been filed late and the appellant had had ample opportunities to file auxiliary requests earlier, this objection being already present in the opposition proceedings.

Added subject-matter

The same objection applied as for the other requests.

Auxiliary request IIID – Admissibility

This request should not be admitted into the proceedings because it was late-filed and prima facie not allowable, the application of an axial extension force to the needle trap still not being mentioned in

the wording of the claim. This problem with the axial force was already mentioned in the impugned decision stating that the main function of the resilient member was to apply an axial force.

Reasons for the Decision

1. The appeal is admissible.

2. The patent in suit was granted on the basis of a divisional application of EP-A-0891198. In the following the Board will refer to the published version of the description and drawings of the parent application (WO-A-97/31666) since both parties agreed that the description and drawings of the originally filed divisional application were identical to those published for the parent application.

3. The invention is about a needle guard for protecting medical staff from needle sticking. A needle guard, in a proximal waiting position on the needle shaft, includes a needle trap which is urged against the needle shaft. After use of the needle, the needle guard including the needle trap is pushed (manually or through a resilient means) towards the needle tip until the needle trap is moved into its protecting position in front of the needle tip. The needle guard is prevented from falling off the needle shaft by movement limiting means.

4. Main request

4.1 Although objections of added subject-matter were raised by the respondent and/or opposition division in relation to other features, the Board wishes to first

deal with features 1.4, 1.4.1 and 1.4.2 that "*the needle guard (22, 22a) further comprises a resilient member (19) located in an annular fashion surrounding a portion of the needle guard (22, 22a) and applying a radially confining biasing force on the needle trap (41)*".

These features require the presence of an "annular" resilient member surrounding a portion of the needle guard and that this resilient member applies a radial force on the needle trap. It follows that the embodiments not using an annular resilient member surrounding a portion of the needle guard (e.g. those shown in Figures 42A to 42C) do not fall under the wording of claim 1.

The embodiments in which an annular resilient member surrounding a portion of the needle guard is used can be subdivided into two categories: i) those in which the resilient member is also used for pushing the needle guard towards the needle tip, and ii) those in which the needle guard is brought manually towards the needle tip. In the figures relating to all these embodiments the resilient member is always depicted as a coil spring.

4.2 For the first series of embodiments i), e.g. in relation to the embodiment shown in Figure 17, it is mentioned on page 21, lines 7 to 13 that the "*...said needle tip guard 41 is biasly contacting said hypodermic needle 10 by the inherent memory of the molded configuration of said needle tip guard 41 and/or the extending force of the surrounding resilient member 19.*".

The same is stated in connection with Figure 30 on page 25, lines 7 to 22: "*...with resilient member 19 urging the needle guard assembly 22 toward the distal end of the hypodermic needle 10. The needle guard assembly 22 having a moveable needle tip guard 41 with a hinge section 40, said needle tip guard 41 is molded in a manner whereby the needle tip guard 41 comprises an inherent biasing force toward the hypodermic needle 10, another biasing force is exerted on the needle tip guard 41 by the extending force of the resilient member 19,...*".

In relation to Figure 31, it is stated that on page 26, lines 2 to 8 "*Additionally, the extending force of the resilient member 19 urges the needle tip guard 41 inwardly to a covering position, said resilient member 19 surrounds both the needle guard assembly 22 and the outer wall of the needle tip guard 41 holding the needle tip guard 41 in a closed, protective position by a radially confining force.*"

The same kind of statement is found on page 29, lines 26 to page 30, line 6 in relation to Figure 43A: "*...said resilient member 119 assists inherently molded bias of needle guard trap 41 by urging said needle guard trap 41 inwardly and in front of the sharpened needle tip 11 (see Figure 33),...*".

Again, in relation to Figure 44A on page 30, lines 27 to page 31, line 1: "*...said resilient member 119 assists inherently molded bias of needle guard trap 41 by urging said needle guard trap 41 inwardly and in front of the sharpened needle tip 11,...*".

And again it is stated in relation to Figure 65 on page 44, lines 24 to 34 that "*...needle guard assembly*

22 being urged toward the distal end of the hypodermic needle 10 by the extending force of the resilient member 19, having a needle trap 41 biasly contacting said hypodermic needle 10 by the inherent memory of the molded configuration of said needle tip guard 41 and/or the extending force of the surrounding resilient member 19,...".

In relation to Figure 84, it can be read on page 56 line 16 to page 57, line 12 that "*...a metal needle trap 41 biasly contacting said hypodermic needle 10 by the inherent memory of the metal configuration of said needle trap 41 and/or the extending force of the surrounding resilient member 19,...*".

(The above passages show that the terminology used in the application as filed is inconsistent regarding the needle trap (41) and the needle guard (22, 22a) in claim 1. In the following, the Board will stick to the terminology used in the claim.)

From these passages it follows that for the embodiments according to the first category mentioned above, namely those in which the resilient member is also used for pushing the needle guard towards the needle tip, throughout the description the resilient member is described as having three functions: it urges the needle guard towards the distal end of the needle shaft, it urges the needle trap against the needle shaft respectively into its protecting position (these two functions being fulfilled by the extension force of the resilient member), and finally it maintains the needle trap in the protecting position. The drawings do not show anything else or anything contradictory.

It follows that when the feature of claim 1 in question requires that "*the needle guard (22, 22a) further comprises a resilient member (19) located in an annular fashion surrounding a portion of the needle guard (22, 22a) and applying a radially confining biasing force on the needle trap (41)*", this extends the subject-matter of claim 1 to any kind of annular resilient member surrounding a portion of the needle guard and able to apply a radial biasing force to the needle trap, even to such resilient members which do not or are not able to apply an axial extension force on the needle guard and the needle trap. Such embodiments have however not been described in the application as filed.

Hence, already for this reason, subject-matter of claim 1 extends beyond the content of the application as filed.

4.3 The appellant submitted that since it was explicitly specified e.g. in relation to Figures 43A and 44A that the resilient member assisted the inherently moulded bias of the needle trap it was self-evident for the person skilled in the art that the assistance was optional and hence that the two functions of the resilient member of exerting a radial force on the trap to urge it towards the needle shaft and of urging the needle guard axially towards the needle tip could be separated. This would also be implicit from the desire to avoid the fatigue problem linked with the plastic material used.

The Board does not share this opinion. In all embodiments shown in the figures and described in the description, in which the resilient member has the function of urging the needle guard towards the needle tip, this same resilient member is also presented as

having the function of urging the needle trap towards the needle shaft. This is for instance clear from the passage on page 21: "*said needle tip guard 41 is biasly contacting said hypodermic needle 10 by the inherent memory of the molded configuration of said needle tip guard 41 and/or the extending force of the surrounding resilient member 19.*". This passage means nothing else than that the needle trap is urged towards the needle shaft either only by the inherent memory of the moulded configuration of the needle trap, or only by the extending force of the surrounding resilient member, or, possibly by both. For the present case, it is not relevant whether or not the needle guard could be urged towards the needle shaft only by the inherent memory of its material; what is relevant is that when a resilient member is present which surrounds a portion of the needle guard and which applies a radial force on the needle trap (as required by the claim), then this resilient member also applies an axial extending force. Whether or not this is done to solve a fatigue problem is not decisive. Only the solution which is disclosed is relevant.

4.4 The appellant further submitted that since it was mentioned on page 77, line 12 that the notch on the needle trap on which the compressed coil or resilient member pressed could be dispensed with, it was self-evident that in such a case the axial extension force could no longer affect the radial force applied to the needle trap, because the coil would slide over the needle trap.

The Board cannot share this opinion. The part of the description including page 77, line 12 mentioning that the notch is optional does not include any more detailed information. In particular, it is not

described how the needle guard or the needle trap would be constructed or function, if no notch were present any longer on the needle trap. The Board sees no reason to believe that the coil spring would simply slide over the needle trap. There is no indication in the description that if no notch were used, the extension force of the resilient member would no longer play any role for the application of a radial force to the needle trap. On the contrary, for instance in relation to the embodiment shown in Figures 30, 31, no notch is referred to in the description, but it is nevertheless mentioned on page 25 that "*another biasing force is exerted on the needle tip guard 41 by the extending force of the resilient member 19*", which suggests that a notch is not indispensable for exerting a radial biasing force on the needle trap.

4.5 The appellant further submitted that in the embodiments according to Figures 61 to 63 there was a resilient member on the needle guard, but no axial force was necessary to urge the needle guard towards the needle tip, since it was moved by hand.

Of course, in these embodiments according to the second category ii), the coil spring is not for the axial movement of the needle guard. But also in the embodiment of Figures 61 and 62 the coil spring shown is compressed behind the notches 60 and 61, which was not disputed by the appellant. From a mechanical point of view it is self-evident that because the needle trap is hingedly attached to the needle guard at its proximal end, the axial force applied to the notch of the needle trap by the compressed coil spring will result in a pushing of the needle trap towards the needle shaft, i.e. a radial force applied to the needle trap. This mechanical effect is no different from that

in the embodiments in which the coil spring is used to urge the needle guard towards the needle tip, even if in this latter case the axial force applied is probably greater.

4.6 Therefore, the ground for opposition pursuant to Article 100(c) EPC prejudices the maintenance of the patent in the version according to the main request.

5. Auxiliary request I – Added subject-matter

The subject-matter of claim 1 according to this request has been limited by the indication that the needle guard is adapted to be manually urged forward along the shaft of the needle. This corresponds to a limitation of the embodiments of the second category ii) mentioned above. Such embodiments are shown for instance in Figures 61, 103, 120 and described in the corresponding parts of the description.

According to the appellant, this additional feature in claim 1 makes it clear that the resilient member is not for the axial movement of the needle guard along the needle shaft since this movement is made by hand, and an axial extension force would make no sense in these embodiments.

The Board does not share the opinion of the appellant. Of course, in these embodiments the coil spring is not for the axial movement of the needle guard but, as explained above, also in these embodiments the radial force applied to the needle trap is at least partly the result of the axial force applied to it by the resilient member.

The argument of the appellant that an axial extension force made no sense in relation to these embodiments or, in other words, that the axial component of the force was not relevant here, but only the radial component was, is likewise not convincing. What is relevant is what the application as filed discloses for the person skilled in the art. In the present case, throughout the application, each time a resilient member located in an annular fashion surrounding a portion of the needle guard is used and this resilient member applies a radial force to the needle trap, this radial force is partly due to the axial extension force of this resilient member. Hence, for the reader of the application, even if theoretically other technical solutions were possible, the solution disclosed throughout the application is constantly the same. In this context it is interesting to note, as explained above, that also in the embodiments in which the needle guard is pushed by hand (e.g. Figure 61) the radial force applied to the needle trap is related to the axial extending force of a resilient member. Hence, the application as filed does not disclose any alternative technical means for applying a radial force to the needle trap when a surrounding resilient member is used. So the person skilled in the art reading the description and drawings of the application as filed would not directly and unambiguously derive therefrom that the radial force could be applied in another manner when a resilient member surrounding a portion of the needle guard is used.

Thus, pursuant to Article 123(2) EPC, the same objection of added subject-matter as against claim 1 of the main request prejudices the maintenance of the patent on the basis of claim 1 according to auxiliary request I.

6. Auxiliary request III – Added subject-matter

Claim 1 according to auxiliary request III corresponds to claim 1 of auxiliary request I, with the additional feature of "*the needle trap (41) having a lead-in area (33) for locating a resilient member (19) on said needle guard (22, 22a) into notch or indentation (60 and/or 61)*".

According to the appellant, this additional feature had to be read in the light of the description in which the function of the notch was said to be for retaining the coils of the compressed resilient member, so the use of this wording in the claim would imply that the resilient member meant in the claim also applied an axial extension force.

The Board does not share the opinion of the appellant. In the corresponding passage of the description, page 76, lines 2 to 9, it is explicitly specified that "*...notch 61 (is) for maintaining an extended force of said resilient member on said trap 41...*". In contrast, the wording of present claim 1 still does not exclude the use of a resilient member partly surrounding the needle guard and applying a radial force to the needle trap without such radial force at least partly resulting from the axial extension force of the resilient member.

7. Auxiliary requests IIIB and IIIC

Admissibility

In the annex to the summons to oral proceedings, the Board pointed out that in the oral proceedings it would

in particular have to be examined whether there was a basis for a radially confining biasing force acting on the needle trap which was independent of the axial extending force of a coil spring. Therefore the Board considers that the filing of auxiliary requests IIIB and IIIC by the appellant one month before the oral proceedings represents a bona fide attempt to have fallback positions in response to the views expressed by the Board in its annex. Furthermore, the requests are in line with the other requests already in the proceedings and their consideration does not place an undue burden on either the respondent or the Board.

For these reasons, the requests are admitted into the proceedings.

Added subject-matter

In both these requests the function of the resilient member has been defined more precisely: "*the resilient member (19) applying a radially confining biasing force on the needle trap (41) to assist inherently molded bias of the needle trap (41) inwardly and in front of the sharpened needle tip (11), and the resilient member (19) axially extending,*" ("axially" being absent from auxiliary request IIIB).

According to the appellant it was self-evident from the description that when the claim mentioned that the resilient member was extending, and a fortiori axially extending, this meant that it applied an axial extension force.

The Board cannot agree with the appellant for two reasons. Firstly, the word "extending" or "axially extending" taken alone can have different meanings,

including the simple meaning of having a dimension in the axial direction, which by no means implies that the resilient member applies any axial extension force to anything. Secondly, as already mentioned above, in all the paragraphs of the description in which it is mentioned that the resilient member assists the inherently moulded bias of the needle trap, this is said to be the result of the extension force of the resilient member. This relationship is still not in the claim.

Hence, claim 1 according to either of auxiliary requests IIIB and IIIC still contains added subject-matter, which, pursuant to Article 123(2) EPC, prejudices the maintenance of the patent on that basis.

8. Auxiliary request IIID - Admissibility

Claim 1 of auxiliary request IIID corresponds to claim 1 of auxiliary request IIIC but specifies that the resilient member applies an axially extending force: "*the resilient member (19) applying a radially confining biasing force on the needle trap (41) to assist inherently molded bias of the needle trap (41) inwardly and in front of the sharpened needle tip (11), and the resilient member (19) applying an axially extending force, the needle trap (41) being hingedly attached to the needle guard (22, 22a).*"

According to the appellant, this solved all the issues since it was now emphasised in the claim that the resilient member applied an axially extending force.

In the Board's opinion, this request is prima facie still not allowable, in particular because it is still not made clear that the radial force on the needle trap

is (partly) due to the axial extension force of the resilient member. In other words, the relationship between the radial force applied to the needle trap and the axial extension force of the resilient member is still not apparent from the wording of the claim. Considering further that this issue was already raised in the Board's annex to the summons, the appellant had ample time to formulate an adequate request for dealing with this aspect.

For the above reasons, the Board decides not to admit auxiliary request IIID into the proceedings, pursuant to Article 13(1) RPBA.

9. The various non-patent documents cited by the appellant in the written proceedings in support of its arguments do not change the above appraisal.

While it is undisputed that a party to proceedings before the boards of appeal of the EPO is free to choose its line of argumentation and the evidence it submits in support, this does not mean that the boards are always obliged to justify in detail why a given piece of evidence is disregarded or not convincing. In particular, decisions taken by other courts in national or other court proceedings have no legally binding effect on the boards of appeal as independently set up by the EPC. Consequently, the boards of appeal are also under no obligation to specifically justify why they follow or depart from particular points in these decisions. What is important is that the arguments raised by the parties, possibly incorporating part of the reasoning of such other decisions, have been dealt with, as is the case here.

The same applies to the expert opinions filed. While such expert opinions may be of decisive importance before a court not comprising any technically qualified judges, they are less so before the technical boards of appeal of the EPO, which are composed of at least two technically qualified members experienced in the technical fields their board deals with, and at least one legally qualified member. In the present case the technical analysis made by the Board and apparent from the above reasons for the decision is self-explanatory as to why the technical expert's opinion filed has or has not been endorsed for the particular point at stake.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Hampe E. Dufrasne

Decision electronically authenticated