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**Datasheet for the decision  
of 19 March 2018**

**Case Number:** T 0682/13 - 3.3.10

**Application Number:** 02713675.3

**Publication Number:** 1379288

**IPC:** A61L27/16, A61L27/50

**Language of the proceedings:** EN

**Title of invention:**

CROSS-LINKED ULTRA-HIGH MOLECULAR WEIGHT POLYETHYLENE FOR USE  
AS MEDICAL IMPLANT

**Applicant:**

SMITH & NEPHEW, INC.

**Headword:**

POLYETHYLENE FOR USE AS MEDICAL IMPLANT/SMITH & NEPHEW

**Relevant legal provisions:**

EPC Art. 111(1), 123(2)

**Keyword:**

Amendments - extension beyond the content of the application  
as filed (no)  
Appeal decision - remittal to the department of first instance  
(yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0682/13 - 3.3.10

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 19 March 2018**

**Appellant:** SMITH & NEPHEW, INC.  
(Applicant) 1450 Brooks Road  
Memphis, TN 38116 (US)

**Representative:** Smith & Nephew  
Group Legal Department  
PO Box 81  
101 Hessle Road  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 13 September  
2012 refusing European patent application No.  
02713675.3 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** P. Gryczka  
**Members:** J.-C. Schmid  
T. Bokor

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the Examining Division refusing European patent application No. 02 713 675.3.
- II. With the statement of grounds of appeal dated 23 January 2013, the Appellant withdrew its former requests and filed a new main request which was based on former auxiliary request 2 and having in addition a new independent claim 23. It furthermore filed three auxiliary requests.
- III. With a communication dated 15 May 2017, the Board informed the Appellant that it intended to remit the case to the Examining Division for further prosecution.
- IV. With a letter dated 11 July 2017, the Appellant withdrew its request for oral proceedings if the case were remitted to the Examining Division for further prosecution.
- V. The Appellant requested that a patent be granted on the basis of the main request, or subsidiarily on the basis of one of the first to third auxiliary request, all requests being filed with statement of grounds of appeal dated 23 January 2013.

## **Reasons for the Decision**

1. The appeal is admissible.
2. The sole ground for the refusal of the application by the Examining Division was that the subject-matter of claims according to the then pending main and first to fourth auxiliary requests extended beyond the content

of the application as filed, and thus contravened the requirement of Article 123(2) EPC.

In particular, with respect to auxiliary request 2 the Examining Division held that dependent claims 21 and 22 contravened Article 123(2) EPC due to their dependency upon claim 2 relating to an embodiment involving an implant having a less than about 1.17 m<sup>2</sup>/Mega cycle total particle surface area.

3. Claims 1 to 20 of the main request are identical to claims 1 to 20 of the then pending second auxiliary request. In the decision under appeal the Examining Division acknowledged that claims 1 to 20 of the then pending second auxiliary request meet the requirement of Article 123(2) EPC.

With regard to dependent claims 21 and 22 of the then pending second auxiliary request the Examining Division stated that the requirement of Article 123(2) EPC was not met for the reasons given for dependent claims 22 and 23 of the then pending main request having the same wording. In this respect the Examining Division held that that the features of these dependent claims were not disclosed in combination with the embodiment of independent claim 2 of the then pending main request which was directed to an embodiment wherein the implant has a less than about 1.17 m<sup>2</sup>/Mega cycle total particle surface area.

However, none of the claims 1 to 20 of the main request comprises the characteristic relating to "less than about 1.17 m<sup>2</sup>/Mega cycle total particle surface area". Accordingly, claims 21 and 22 do not comprise the combination of features objected to by the Examining Division.

New independent claim 23 is identical to independent claim 2 of the then pending main request, which was held to be in compliance with Article 123(2) EPC by the Examining Division.

In conclusion, the objections under Article 123(2) EPC raised in the decision under appeal are overcome by the new main request.

4. *Remittal*

The Appellant requested that the application is allowed to proceed to grant. Granting this request presumes that the Board is satisfied that all relevant patentability requirements of the EPC have been examined and found to be fulfilled. In the present case it is apparent from the file that while some of the requirements have been examined by the Examining Division in the first instance proceedings, a positive decision that they have been fulfilled has not been made. The statement of the grounds of appeal was also restricted to the issue of added subject-matter (beyond merely stating the "the application is now in order for allowance").

However, the essential function of an appeal is to consider whether the decision issued by the first-instance department is correct, and therefore the Board deems it appropriate for this further outstanding examination to be performed by the department of first instance. Hence, the case is referred back to the Examining Division 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.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated