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**Datasheet for the decision
of 21 September 2018**

Case Number: T 1360/13 - 3.2.02

Application Number: 04716557.6

Publication Number: 1601395

IPC: A61M5/315, A61M5/24, A61M5/32

Language of the proceedings: EN

Title of invention:
IMPROVEMENTS IN AND RELATING TO A PEN-TYPE INJECTOR

Patent Proprietor:
DCA Design International Limited

Opponent:
Ypsomed AG

Headword:
-

Relevant legal provisions:

EPC Art. 64, 69, 100(c), 123(3)
RPBA Art. 13(1)
EPC Prot. Interpretation Article 69

Keyword:

Main request - added subject-matter (yes)
Auxiliary requests filed in the written phase - admitted (yes)
Auxiliary requests - extension of protection (yes)
Auxiliary requests filed at the oral proceedings - admitted
(no)

Decisions cited:

G 0002/88, G 0009/91, G 0001/93, T 0142/05, T 2259/09,
T 0236/12

Catchword:

In view of Article 69(1) EPC which states that the description and the drawings shall be used to interpret the claims when determining the extent of the protection conferred by a European patent, after grant, any information in the description and/or drawings of a patent directly related to a feature of a claim and potentially restricting its interpretation cannot be removed from the patent without infringing Article 123(3) EPC.



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Case Number: T 1360/13 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 21 September 2018

Appellant: DCA Design International Limited
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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
17 April 2013 concerning maintenance of European
Patent No. 1601395 in amended form

Composition of the Board:

Chairman E. Dufrasne
Members: P. L. P. Weber
D. Ceccarelli

Summary of Facts and Submissions

- I. The appeals by the patent proprietor and the opponent are directed against the interlocutory decision of the opposition division posted on 17 April 2013 that account being taken of the amendments according to the first auxiliary request made by the proprietor during the opposition proceedings, the patent and the invention to which it related met the requirements of the EPC. Oral proceedings before the Opposition Division took place on 8 October 2012.

- II. The patent in suit originates from a PCT application filed on 3 March 2004. In the international phase, drawing sheets 1/6 to 6/6 were exchanged under Rule 26 PCT after the date of filing. The patent was granted with the exchanged drawing sheets.

- III. Notice of appeal was filed by the appellant/opponent ("opponent") on 14 June 2013. The appeal fee was paid on the same day. The opponent filed a statement setting out the grounds of appeal on 26 August 2013.

- IV. Notice of appeal was filed by the appellant/patent proprietor ("patent proprietor") on 13 June 2013. The appeal fee was paid on the same day.

The penultimate sentence of the notice of appeal reads:

"It is respectfully requested to reverse the decision and to maintain the European Patent 1 601 395 as granted."

The patent proprietor filed the statement setting out the grounds of appeal on 21 August 2013.

The first paragraph under point "1. Requests" of the statement setting out the grounds of appeal reads as follows:

"It is respectfully requested to reverse the interlocutory decision of the Opposition Division dated April 17, 2013 and to maintain European Patent 1 601 395 on the basis of attached Main Request, which is the Main Request as filed [sic] on October 8, 2012 during oral proceedings."

- V. By letter dated 23 December 2014, the patent proprietor filed an amended main request.
- VI. The parties were summoned to oral proceedings by communication of 6 July 2018. In the communication, in accordance with Article 15(1) RPBA, the Board expressed, among other matters, its preliminary opinion that Article 100(c) EPC prejudiced the maintenance of the patent as granted because the amended drawings introduced subject-matter extending beyond the application as filed. The Board also mentioned that should the patent proprietor wish to amend the drawings, compliance with Articles 123(2) and (3) EPC would have to be examined.
- VII. By letter dated 27 July 2018, the proprietor filed auxiliary requests 9 to 17, all without drawings and without reference to the drawings in the description.
- VIII. Oral proceedings were held on 21 September 2018.

The opponent requested that the decision under appeal be set aside and that the patent be revoked.

The patent proprietor requested that the decision under appeal be set aside and that the patent be maintained on the basis of one of the main request, filed with letter dated 23 December 2014, auxiliary requests 9 to 17, filed with letter dated 27 July 2018 and auxiliary requests 18 to 26 filed during the oral proceedings.

Auxiliary requests 1 to 8 filed by letter dated 21 August 2013 were withdrawn.

IX. Claim 1 of the main request as filed with the statement setting out the grounds of appeal reads as follows (difference over granted version underlined):

"A pen-type injector comprising a piston rod (32, 32', 32'') having a screw thread (34), a dose dial sleeve (50, 50', 50'', 50''') rotatable with respect to the housing (2, 2', 2''), a drive sleeve (60, 60', 60'') which is axially displaceable but not rotatable with respect to the piston rod (32, 32', 32''); the injector being characterized by

an insert (14, 14', 14''') located in a housing (2, 2', 2'') and through which the piston rod (32, 32', 32'') may rotate;

ratchet means (40) associated with the insert (14, 14', 14''') to ensure the piston rod (32, 32', 32'') only rotates in a single direction through the insert (14, 14', 14''');

athe dose dial sleeve (50, 50', 50'', 50''') rotatable with respect to the insert (14, 14', 14''');

a button (70, 70', 70'') located on the drive sleeve (60, 60', 60'') and rotatable with respect to the drive sleeve (60, 60', 60''); and

clutch means which upon depression of the button (70, 70', 70'') prevents rotation between the dose dial sleeve (50, 50', 50'', 50''') and the drive sleeve (60, 60', 60'')."

- X. Claim 1 of the main request filed by letter dated 23 December 2014 reads as follows (difference over version filed with statement of grounds highlighted):

"A pen-type injector comprising a piston rod (32, 32', 32'') having a screw thread (34), a dose dial sleeve (50, 50', 50'', 50''') rotatable with respect to the a housing (2, 2', 2''), a drive sleeve (60, 60', 60'') which is axially displaceable but not rotatable with respect to the piston rod (32, 32', 32''); the injector being characterized by

an insert (14, 14', 14''') located in athe housing (2, 2', 2'') and through which the piston rod (32, 32', 32'') may rotate;

ratchet means (40) associated with the insert (14, 14', 14''') to ensure the piston rod (32, 32', 32'') only rotates in a single direction through the insert (14, 14', 14''');

the dose dial sleeve (50, 50', 50'', 50''') rotatable with respect to the insert (14, 14', 14''');

a button (70, 70', 70'') located on the drive sleeve (60, 60', 60'') and rotatable with respect to the drive sleeve (60, 60', 60''); and

clutch means which upon depression of the button (70, 70', 70'') prevents rotation between the dose dial sleeve (50, 50', 50'', 50''') and the drive sleeve (60, 60', 60'')."

XI. Claim 1 of auxiliary request 9 reads as follows (differences over version under point X highlighted):

"A pen-type injector comprising a piston rod (~~32, 32', 32''~~) having a screw thread (34), a dose dial sleeve (~~50, 50', 50'', 50'''~~) rotatable with respect to the a housing (~~2, 2', 2''~~), a drive sleeve (~~60, 60', 60''~~) which is axially displaceable but not rotatable with respect to the piston rod (~~32, 32', 32''~~); the injector being characterized by

an insert (~~14, 14', 14''~~) located in athe housing (~~2, 2', 2''~~) and through which the piston rod (~~32, 32', 32''~~) may rotate;

ratchet means (~~40~~) associated with the insert (~~14, 14', 14''~~) to ensure the piston rod (~~32, 32', 32''~~) only rotates in a single direction through the insert (~~14, 14', 14''~~);

the dose dial sleeve (~~50, 50', 50'', 50'''~~) rotatable with respect to the insert (~~14, 14', 14''~~);

a button (~~70, 70', 70''~~) located on the drive sleeve (~~60, 60', 60''~~) and rotatable with respect to the drive sleeve (~~60, 60', 60''~~); and

clutch means which upon depression of the button (~~70, 70', 70''~~) prevents rotation between the dose dial

sleeve (~~50, 50', 50'', 50'''~~) and the drive sleeve (~~60, 60', 60''~~)."

XII. The arguments of the opponent relevant for the decision can be summarised as follows:

Admissibility of the appeal of the patent proprietor

The appeal of the patent proprietor was not admissible. The requests proposed for reinstatement in the appeal proceedings had been withdrawn in the opposition proceedings. Therefore, the decision under appeal did not adversely affect the appellant by not allowing these requests.

Added subject-matter

For instance, the thread in Figure 9 of the patent as granted was visibly a double, right hand thread. This could not be seen in Figure 9 of the application as filed. Generally, the drawings of the patent as granted showed many more details - sometimes not even uniformly - than the drawings of the application as filed, which were basically black and grey. Thus, the drawings of the patent as granted added subject-matter beyond the content of the application as filed.

Admissibility of auxiliary requests 9 to 17.

The problem with the black drawings had already been discussed in the first-instance proceedings. Thus, requests related to this problem could have been filed earlier. The corrected requests raised numerous questions such as extent of protection, clarity and sufficiency. The late filing of the requests complicated the work of the opponent.

The requests should therefore not be admitted into the appeal proceedings.

Extension of the protection conferred

Since all the references to the drawings including the reference signs were deleted from the description, the teaching of the patent was much broader than that of the granted version. The deletion of the reference signs led to an absence of a link between the information given and the specific embodiments originally meant. Moreover, several features of the claim had to be interpreted more broadly without the information present in the drawings. For example, claim 1 required the button to be located on the drive sleeve. The meaning of "located on" could only be inferred from the figures. So this feature had a broader meaning without the drawings. The same applied to many other features of the claim - the deletion of the drawings had a broadening effect. It had to be recalled that Article 69 EPC and the Protocol on its interpretation required that the description and drawings had to be used to interpret the claims, i.e. also by the national courts in any infringement or nullity case. Especially for determining equivalency the drawings were often important. In mechanical inventions such as the one in question the teaching for the person skilled in the art often came from the combination of the description and drawings.

Therefore, the deletion of the drawings and the references to the drawings contravenes Article 123(3) EPC.

Admissibility of auxiliary requests 18 to 26

The difficulty with the drawings of the patent as granted was already known in the proceedings at first instance. Therefore the patent proprietor could have filed these requests much earlier. Moreover, these requests did not solve, *prima facie*, the problem with Article 123(3) EPC since the details on the drawings were not reinstated. Therefore, these requests should not be admitted into the proceedings.

XIII. The arguments of the patent proprietor relevant for the decision can be summarised as follows:

Admissibility of the appeal of the patent proprietor

The statement setting out the grounds of appeal was where the form in which the patent was meant to be maintained had to be presented. There it was clear that the main request had to be that filed at the oral proceedings on the 8 October 2012. Clerical mistakes could still be corrected. Therefore, the appeal was admissible.

Added subject-matter

Any mistakes in the drawings would be identified and corrected by the person skilled in the art. More importantly, the drawings of the patent as granted did not add subject-matter; they only reflected the information present in the description.

Admissibility of the auxiliary requests 9 to 17

The objection of added subject-matter was not substantiated in the statement of the grounds of appeal of the opponent, and the patent proprietor reacted as

soon as the provisional opinion of the Board was known. A decision according to which the deletion of the drawings was allowed was also cited.

These requests should therefore be admitted into the proceedings.

Extension of the protection conferred

The present case was comparable to T 2259/09, in which it was decided that the drawings could be deleted. This decision demonstrated that it was, in principle, possible to delete the drawings from a granted patent. Moreover, there were many patents without drawings; drawings were not necessary per se. In the present case, the description was precise enough so that the person skilled in the art would not need any drawings. For instance, the function of the button mentioned in claim 1 was described in the description of the patent as well.

Therefore, the absence of drawings did not change the interpretation of the claims and consequently did not change the extent of protection.

Admissibility of auxiliary requests 18 to 26

These requests should be admitted into the proceedings and the case remitted to the department of first instance to examine the new situation because they overcame the problems with added subject-matter and changed the situation in relation to Article 123(3) EPC. Moreover, in case T 236/12, such a reinstatement of the originally filed drawings was considered allowable under Article 123(3) EPC.

Reasons for the Decision

1. Admissibility of the appeals
 - 1.1 The appeal of the opponent is admissible. This was not disputed by the patent proprietor.
 - 1.2 The opponent considered that the appeal of the patent proprietor was not admissible because in its notice of appeal and its statement setting out the grounds of appeal, the patent proprietor requested the maintenance of the patent on the basis of a request in relation to which it was not adversely affected. Indeed, neither claim 1 according to the patent as granted nor the version of claim 1 of the main request filed with the statement setting out the grounds of appeal was maintained by the patent proprietor in the opposition proceedings.

Rule 99(1)(c) EPC requires that the notice of appeal defines "the subject of the appeal". Under Rule 99(2) EPC, it is the statement setting out the grounds of appeal which has to indicate the "extent" to which the impugned decision is sought to be amended since in the vast majority of cases it is with the statement of grounds of appeal that new requests are filed (e.g. T 689/09, 1.1 to 1.12 of the Reasons; T 226/09, 1. to 1.10 of the Reasons). This applies in the present case.

The notice of appeal requested the reversal of the (impugned) decision and the maintenance of the patent as granted. Concerning the version of claim 1 of the main request filed with the statement setting out the grounds of appeal, the statement clearly indicates that the version to be taken as the main request is that filed during the oral proceedings of 8 October 2012.

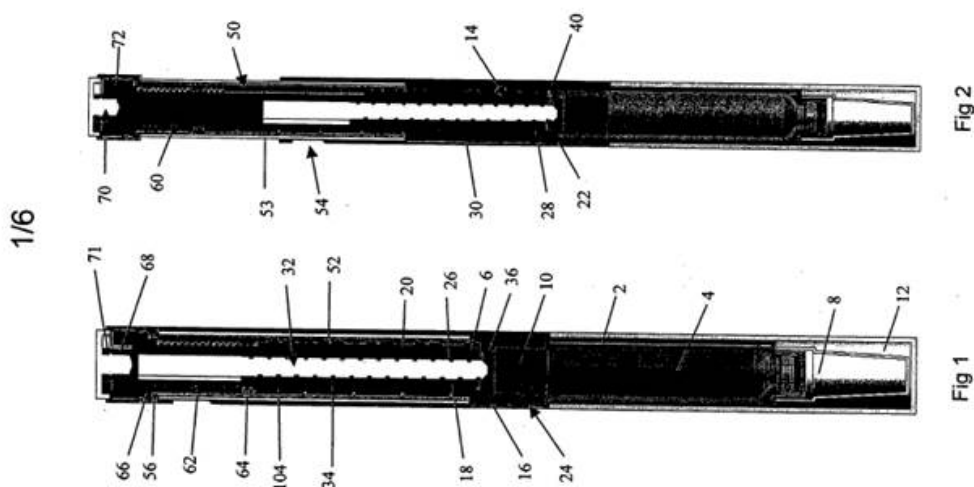
Thus, it is obvious which version is meant and that the patent proprietor can later correct any obvious mistake in the version attached to the statement setting out the grounds of appeal so it conforms to the meant version. This was done with the filing of 23 December 2014.

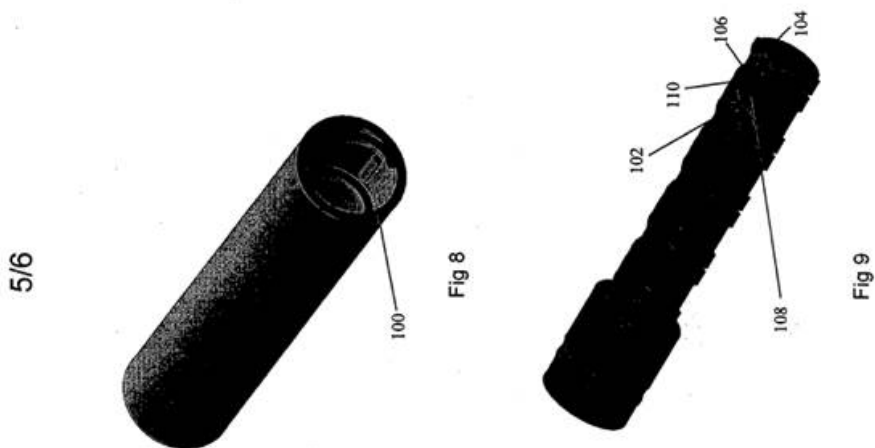
Thus, the appeal of the patent proprietor is admissible.

- 2. Main request - Added subject-matter - Article 100(c) EPC.

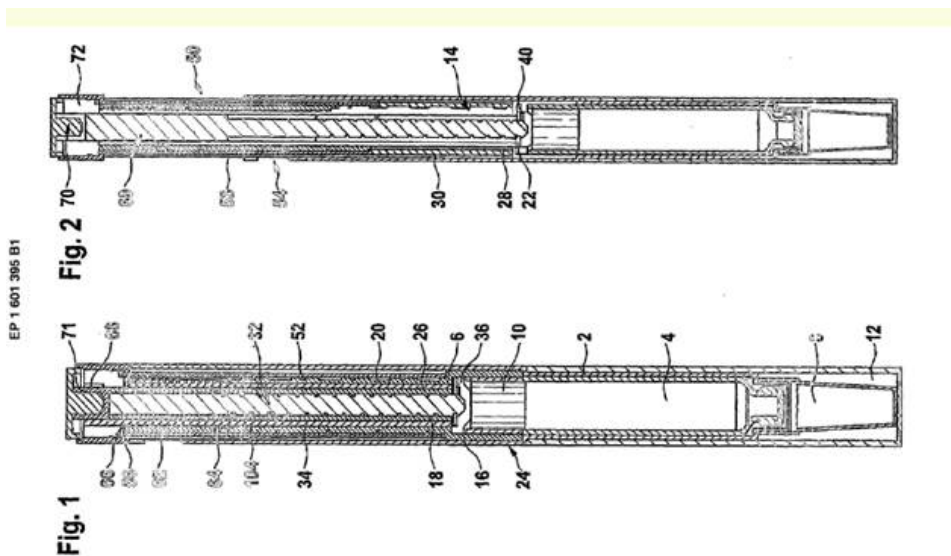
The patent was granted with drawing sheets exchanged according to Rule 26 PCT during the international phase, the originally filed drawing sheets being of poor quality, essentially showing black or grey elements (see the drawings below). The same exchanged drawing sheets which were part of the patent as granted are part of the main request documents.

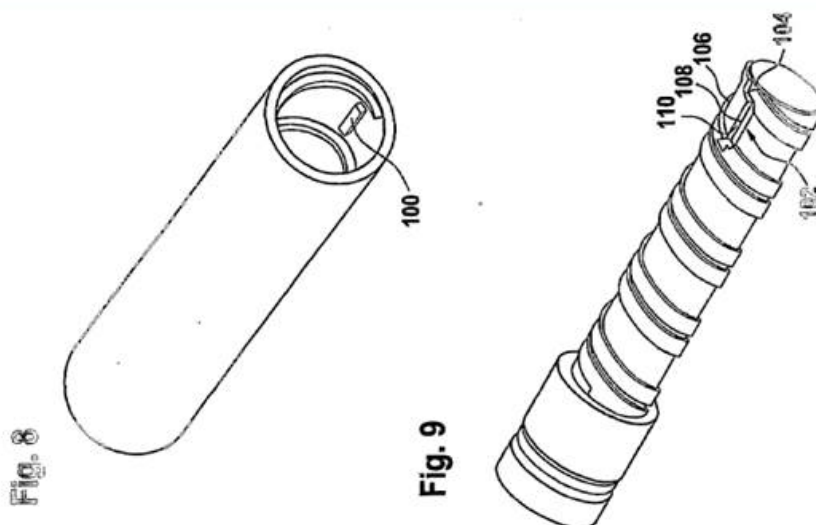
For instance, drawing sheets 1/6 and 5/6 as originally filed look as follows:





The corresponding drawing sheets 1/6 and 5/6 of the patent as granted and according to the main request look as follows:





The opponent considered that the drawing sheets of the patent as granted showed many more details than the drawing sheets as originally filed. Hence, they contained much more information. Moreover, the corrected figures contained mistakes which contradicted the description as filed. For that reason alone, Article 100(c) EPC prejudiced the maintenance of the patent on the basis of the main request.

It seems self-evident, as can be seen on the drawing sheets depicted above, that the figures shown in the drawing sheets according to the main request are close to technical drawings whereas in the originally filed figures it was not possible to guess any limit or element within the black zones. Therefore, the Board agrees with the opponent that the figures according to the main request show many more details, i.e. much more information not apparent in the figures as originally filed.

The patent proprietor submitted that the figures had to be considered as schematic figures because they indicated no dimensions and that for the person skilled

in the art they contained no more information than what was already disclosed by the description. The person skilled in the art would also identify possible mistakes in the figures and correct them.

The Board does not share this opinion. Since all figures have been replaced, it is not possible to comment on each figure and on each detail in each figure. The Board will take two examples which are considered typical of the problems encountered.

According to the description of the patent, column 4, lines 12 to 16, "*Figure 8 shows a perspective view of a dose dial sleeve for use in conjunction [sic] with the present invention;*" and "*Figure 9 shows a perspective view of an insert for use with the dose dial sleeve of Figure 8.*" The detailed description of the dose dial sleeve shown in Figure 8 and the insert shown in Figure 9 is given in paragraph [0063] of the patent in suit (identical to the same paragraph of the application as filed).

As can be seen in Figure 9 of the patent as granted, the helical thread on the insert is a double thread. Such a double thread is not described in paragraph [0063], nor is it described elsewhere in the description. In the same figure, it can also be seen that close to the end opposite groove 102 there is a circular kind of groove not described in the description. Moreover, even if the precise dimensions of groove 102 are not mentioned, at least the proportions between its size and the size of the insert are shown.

None of these details can be seen in Figure 9 as originally filed. Since none of the details mentioned

are present in the description, the description alone does not directly and unambiguously disclose these details to the person skilled in the art.

The same is true for Figure 1. Many details present in Figure 1 of the patent as granted are not present in Figure 1 as originally filed. Figure 1 of the patent as granted illustrates that housing 2 has a cylindrical part with a smaller diameter, that the different parts of the insert have specific lengths with respect to the whole length of the injector pen and that the walls of these parts have a certain thickness relative to each other. None of these details can be seen in Figure 1 as originally filed. These details do not appear in the description (Figure 1 is described starting paragraph [0028]). And the person skilled in the art would not necessarily draw such proportions on the basis of the information in the description alone.

The same kind of analysis can be made with the other figures with the same kind of result, i.e. that many details of the figures cannot be inferred from the description.

The fact that mistakes may be present in the drawings does not change the above since in any case there is more information present than in the application as filed.

Thus, many details present in the figures of the patent as granted are not disclosed directly and unambiguously by the application as originally filed.

Hence, Article 100(c) EPC prejudices the maintenance of the patent on the basis of the main request.

3. Admissibility of the auxiliary requests 9 to 17.

The opponent considered that these requests could have been introduced earlier because the discussion about the presence of amended drawings had already started in the first-instance proceedings. Moreover, at this late stage, it was not easy for the opponent to take a position on the various objections possible.

Considering that the discussion had already started in the first-instance proceedings, the Board is of the opinion that the opponent was not confronted with a fresh case. Moreover, the provisional opinion of the Board expressed in its communication in accordance with Article 15(1) RPBA on the allowability of the amended drawings was contrary to the Opposition Division's opinion in the impugned decision.

Therefore, the Board admits the auxiliary requests in the appeal proceedings pursuant to Article 13(1) RPBA.

4. Auxiliary request 9 - extension of protection

4.1 The documents of auxiliary request 9 correspond to the documents of the main request in which all drawing sheets have been deleted and all references to the figures in the description and claims have been deleted as well.

In accordance with G 9/91, point 19 of the Reasons (OJ EPO 1993, 408), the amended documents have to be fully examined as to their compatibility with the requirements of the EPC, in particular Article 123(2) and (3) EPC.

The requirements of Article 123(3) EPC are dealt with first.

4.2 Preliminary remarks

The wording of Article 123(3) EPC is not identical to the wording of Article 123(3) EPC 1973. The latter addresses the amendments of claims (it reads "*The claims of the European patent may not be amended during the opposition proceedings in such a way as to extend the protection conferred.*"). However, the case law on Article 123(3) EPC 1973 makes it clear that amendments in the description and drawings can have an influence on the way the claims must be read (see below). The wording of Article 123(3) EPC is only a clarification in that respect (OJ EPO 2007, Special Edition 4, page 144). For this reason, the basic principles analysed in the case law on Article 123(3) EPC 1973 are applicable to Article 123(3) EPC as well.

The same is true for the change in the wording of Article 69(1) EPC, which has been clarified by deletion of the concept of "the terms" of the claims present in the wording of Article 69(1) EPC 1973 (OJ EPO 2007, Special Edition 4, pages 68 and 69).

In the EPC 2000, the Protocol on the interpretation of the Article 69 EPC has been completed by Article 2, which is specifically dedicated to the importance of equivalents (OJ EPO 2007, Special Edition 4, pages 70, 71) and reads as follows:

"For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims."

- 4.3 Paragraph (3) of Article 123 EPC concerns amendments made to the patent and specifies that "The European patent may not be amended in such a way as to extend the protection it confers."

The grant of a patent marks a point defining the rights of the patent proprietor over third parties. In this context, Article 123(3) EPC has the aim of protecting third parties by forbidding the proprietor from extending the protection of the patent by amendment to cover subject-matter which was not protected when the patent was granted. There should be certainty for third parties that the protection conferred by the patent can only be restricted but not extended, in different words, that a product not infringing the patent as granted does not infringe any amended version of the patent during the whole protection period.

The fundamental question in the present case is thus whether the deletion of the drawings and references thereto in the description has a broadening effect on the extent of protection conferred.

- 4.4 The extent of the protection conferred by a patent is defined in Article 69 EPC and the Protocol on its interpretation. This was, for instance, confirmed early on by decision G 2/88 (OJ EPO 1990, page 93, point 3.3 of the Reasons) of the Enlarged Board of Appeal about the considerations to be taken into account having regard to Article 123(3) EPC 1973 when deciding on the admissibility of a change of claim category: "*In this connection, Article 69 EPC and its Protocol are to be applied, both in proceedings before the EPO and in proceedings within the Contracting States, whenever it is necessary to determine the protection which is conferred.*"

This statement of the Enlarged Board of Appeal that *"whenever it is necessary to determine the protection which is conferred"* confirms that throughout the life of the patent, whenever an opposition, revocation, nullity or infringement action is filed, the principles enshrined in Article 69 EPC and the Protocol on its interpretation must be applied. In the Board's opinion, since it is not possible to know if and when any such action will be started and which feature of the granted claims will be critical, when read together with Article 123(3) EPC, the above statement has the direct consequence that the basis for interpretation as present in the patent as granted must remain unchanged after the grant, or if changed, must not allow for more general interpretations of the claims, i.e. an extension of the protection conferred.

Under point 4.1 of the Reasons of the same decision G 2/88, the Enlarged Board of Appeal gave some indication as to when an extension may be present: *"In the case of a change in the technical features of the invention, if the technical features of the claimed invention after amendment are more narrowly defined, the extent of the protection conferred is less; and if such technical features are less narrowly defined as a result of amendment, the protection conferred is therefore extended."*

4.5 Article 69(1) EPC reads as follows:

"The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims."

Article 1 of the Protocol on its interpretation reads as follows:

"Article 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties."

As can be seen from its wording and from the wording of Article 1 of the Protocol, Article 69(1) EPC prescribes that the description and the drawings shall be used to interpret the claims when determining the protection conferred (e.g. "Europäisches Patentübereinkommen" Singer-Stauder 7.Edition 2016, Article 69 EPC, point 26). This means that even if, after the claims have been read taken alone, no clarification seems necessary, it cannot be excluded that the description and drawings will be necessary to interpret the claims, i.e. to determine the extent of the protection conferred. To the Board, this appears logical. A patent is a teaching on how a problem existing in the state of the art can be solved. Hence, as a rule, the vocabulary used in a patent is unitary and dependent on the technical field of the invention and on the writer's own preferences. The description and drawings generally include explicit or implicit definitions of terms used in the claims, e.g. explanations as to the functions of

the claimed features, the aims to be achieved by the invention, etc. Moreover, particularly in the mechanical field, the function of a claimed mechanical element and the way this function is embodied frequently only appear in the description and/or drawings (e.g. Visser's annotated European Patent Convention, 2018, page 153, Article 69(1) EPC). Concentrating exclusively on the wording of the claim would mean that from the point of view of the extent of protection, the whole description and the drawings of the patent could be deleted, in which case, the intentions of the inventor would be completely ignored.

The above considerations imply that any change in the description or drawings may have an influence on the understanding of a claimed feature, in particular when it has to be considered ambiguous in view of a piece of prior art or an allegedly infringing product, and may thus lead to a broadening of the extent of the protection conferred.

4.6 In decision G 1/93 (OJ EPO 1994, page 541), in analysing the potential conflicting requirements of paragraphs (2) and (3) of Article 123 EPC, the Enlarged Board of Appeal explained under point 11 of the Reasons:

"...

Such added matters may be generalisations of specific features or embodiments and the introduction of new alternatives. In principle, it does not matter whether the addition concerns the claims, the description or the drawings, since the protection conferred by the patent has to be determined by all these elements in accordance with Article 69 EPC and the Protocol on the interpretation of this provision."

This confirms that generalisations of both the description and the drawings potentially extend the protection conferred by the patent.

This was, for instance, applied in T 142/05, in which the board considered that the deletion in the description of the indication of the desired thermal resistance of the tubing according to the invention over that of the prior art extended the protection conferred even though the wording of the claim remained unchanged.

- 4.7 In the present case, as explained below, the deletion of the drawings and any reference to them in the description leads not only to a generalisation of the teaching of the patent but also to a more general interpretation of the claim.

Throughout the description of the patent as granted, references to the drawings were present. These references were deleted in the description according to auxiliary request 9.

Some of the deletions are as follows (strikethroughs show the deleted terms):

Paragraph [0028]: "*Referring first to ~~Figures 1 to 5~~ there may be seen an injector in accordance with a first embodiment of the present invention....*"

Paragraph [0029]: "...*A temporary covering ~~is shown~~ in this position in the ~~Figures~~...*"

Paragraph [0039]: "...*As can be seen* this means there is no direct route from outside the injector to the working surfaces of the helical thread..."

Paragraph [0041]: "...A first end of the first part is located within the first channel 28 of the insert 14 in the position shown in Figure 1...."

Paragraph [0049]: "Once a desired dose has been set ~~(as shown for example in Figure 2)~~,... .. have returned to their initial positions ~~(Figure 3)~~."

Paragraph [0050]: "~~It can be seen that~~ the dose selecting means and the dose expelling means extend beyond a second end of the housing 2 as the dose is selected and are returned within the housing 2 as the selected dose is expelled."

Paragraph [0053]: "~~The piston rod 32' shown in Figure 6~~ has a dual start thread. ... ~~As can be seen~~ the structure of the insert 14' has been revised..."

Paragraph [0057]: "...~~When, as in Figure 6,~~ the dose dial sleeve 50' and the drive sleeve 60' are not in engagement the dose dial sleeve 50' is able to rotate with respect to the drive sleeve 60'...."

Paragraph [0058]: "~~It will be seen that the structure of the drive sleeve 60'~~ has also been modified."

Paragraph [0060]: "~~In a~~ further embodiment of the button 70" and the dose dial sleeve 50" ~~can be seen in Figure 7. Again like reference numerals are used to refer to like parts. In the embodiment of Figure 7, the overall length of the device may be reduced still further...."~~

Paragraph [0062]: "~~In each of Figures 6 and 7,~~ there is a further modification to each of the dose dial sleeve

~~and the insert. This may be seen more clearly with reference to Figures 8 and 9."~~

Paragraph [0064]: "~~...when the dose dial sleeve is wound from the initial position shown in any of Figures 1, 6 or 7~~ to a fully extended position..."

Paragraph [0066]: "~~As can be seen~~ the structure of the insert ~~14"~~ has been revised..."

The above passages clearly demonstrate the interdependence between the description and the detailed drawings present in the patent as granted, the description constantly referring to specific details shown in the drawings. The description and the drawings were thus meant to be complementary, i.e. both part of the teaching of the patent as a whole. This is no longer the case in the documents according to auxiliary request 9, not to mention the other details in the drawings not described in the description which are in any case no longer present.

In the present case, this generalisation is accentuated by the deletion of all references to the drawings in the description, including the reference signs, which leads to the fact that not even the different embodiments are clearly distinguishable any longer.

This alone leads to a generalisation of the teaching of the patent.

- 4.8 The patent proprietor considered that the drawings did not give the person skilled in the art more information than it would be able to deduce from the description taken alone, and thus the deletion of the drawings did not generalise the teaching of the description or lead

to any different, more general, interpretation of the claims. To support its point of view, the patent proprietor cited T 2259/09, in which the board decided that the deletion of drawings in the patent as granted was allowable under Article 123(3) EPC.

- 4.9 The Board does not share the patent proprietor's view. As explained above, specific ways of embodying the elements described in the description and formerly shown by the constructional details in the drawings are no longer present in these amended patent documents and can therefore also no longer be used for understanding the very details of the invention and/or possibly the features in claim 1, as will be seen below.

In the present case, this has a particular importance since such pen-type injectors able to inject multiple doses include complicated mechanisms allowing the setting of an individual dose, the correction of the dose, the indication of the dose, the injection of the dose, the avoidance of the setting of a dose exceeding the maximum available, etc. To understand how the device works, the interrelationship between the different elements needs to be understood: which elements are movable or fixed, rotatable or slidable; which ones move together when injecting or when setting the dose; which ones are blocked during the different movements and how the device is reset after the emptying of an ampoule, etc. All these functionalities, and the way they are embodied cannot be immediately deduced from the description alone. Drawings, as is demonstrated by the multiple references to them in the patent as granted, are required. The figures are the only place where the relative lengths and diameters are shown, and there is no reason why a person skilled in the art trying to draw a pen corresponding to the

description would choose the proportions and interrelationships between the elements as shown in the figures, as already explained under point 2. above.

Hence, contrary to the opinion of the patent proprietor, the teaching of the description taken alone is more general than the teaching of the description together with the drawings, which, thus, already has an effect on the extent of protection conferred as explained under point 11 of the Reasons of G1/93 (point 4.5 above), since most of the deletions exemplified above concern features mentioned in claim 1 (piston rod, dose dial sleeve, drive sleeve, insert, etc.).

4.10 Moreover, in the present case, not only has the teaching been generalised as explained above, but in contrast to the opinion of the patent proprietor, the wording of several features of claim 1 is very general and may result in ambiguities needing interpretation. These ambiguities in claim 1 are also resolved in a more generalised way in the absence of the drawings (first sentence of the Protocol on the interpretation of Article 69 EPC).

Claim 1, for instance, requires "a button located on the drive sleeve and rotatable with respect to the drive sleeve".

This wording in the claim neither defines the position of the button nor details how it should work. It is not apparent whether the button must be directly on the drive sleeve or whether some intermediate piece may be present, whether it must be aligned with the longitudinal axis of the sleeve or can be to the side on the cylindrical part of the sleeve, etc. While the description, in particular paragraph [0049], gives some

indication, nowhere in the description is there any information about the relative thicknesses of the button when compared to the other parts of the pen. Nor is there any indication that the button forms the proximal end of the pen or that its diameter does not exceed that of the pen housing. This information is only provided in the drawings. While this information may, at a first glance, not seem important when reading the claim alone, it may become important in the life of the patent, e.g. depending on the opposed prior art in validity issues or more generally when determining the protection conferred in proceedings within the Contracting States. This is particularly true here since the button is linked to the aim of the invention mentioned in the patent to reduce the overall length of the device to enable easier expression of the fluid (patent as granted, [0059] last sentence, [0060] third sentence) such that the relative dimensions shown in the drawings give the person skilled in the art an indication of how this is achieved. It is to be noted here that in paragraph [0060] of the patent as granted there is a specific reference to Figure 7 in this context which has been deleted in the present request thus generalising the teaching as already explained (see deletions in paragraph [0060] under point 4.7 above).

Hence, this feature of the button in the claim must be interpreted more generally without the drawings than with the drawings.

Claim 1 further requires "a piston rod having a screw thread".

This wording is fairly general. It simply requires a screw thread to be present on a piston rod. Since

neither this screw thread or its function is mentioned anywhere else in the claim, if this general feature wording were followed, the screw thread could be of any kind, have any length, be anywhere on the rod and serve any purpose, and the rod itself, also not being further defined, could be of any kind, even a multi-piece rod. While the description helps understand the function of the screw thread, only the drawings show the relative thicknesses and lengths of the elements and the presence of a single one-piece rod.

Hence, here again, the interpretation of this claimed feature is more general without the drawings than with the drawings.

The claim also requires the presence of "a housing".

However, nothing more about the housing is mentioned in the claim. What is it for? Does it have continuous or holed walls? What should it look like? Can it be constituted of several parts? In all the embodiments shown in the drawings of the patent as granted, the housing is a one-piece housing forming the exterior wall of the pen. According to the patent, the purpose of this one-piece form of the housing is to increase the robustness of the pen, to make it easier to assemble (as explained in the last three sentences of paragraph [0028]) and to allow a larger ratchet means to be positioned in it (as explained in the last sentence of paragraph [0035]). The drawings are thus the only place in the patent teaching a shape and relative thicknesses and lengths between the housing and the other elements allowing these objectives to be achieved.

Hence, here again, the interpretation of this claimed feature is more general without the drawings than with them.

The Board will not analyse the precise consequence of the deletion of the drawings for each of the features of the claim, but as can easily be understood, for all of them at least the relative dimensions of the elements involved will be missing. These relative dimensions are part of the way the described embodiments of the pen are implemented and at least partly show how the functions of the pen and the aims of the invention were obtained in practice.

In the Board's opinion the absence of this information extends the protection conferred by allowing more embodiments to fall under the claim.

- 4.11 The patent proprietor considered that the situation was the same as in T 2259/09, in which the board allowed the deletion of the drawings.

While admitting that technical information was undoubtedly lost and that amendments to the description and drawings generally had an impact on the extent of protection conferred by the European patent (point 3.2 of the Reasons), the board considered that *"None of the specific features of claim 1 of the granted patent has a different or broader meaning without the drawings than with the drawings."* (point 3.3 of the Reasons). From the above sentence it seems that the board considered that with or without the drawings the wording of the claims would be interpreted the same way, i.e. that the extent of the protection conferred would be the same. This is not so in the present case as explained above.

4.12 Thus, in the present case, the teaching of the description is more general without the drawings, and the ambiguities in the claim are resolved in a more general way without the drawings. This results in an extension of the protection conferred by the patent. Or, using the words of the Enlarged Board in point 4.1 of the Reasons of G 2/88 (point 4.4 above), the "technical features are less narrowly defined as a result of the amendment, the protection conferred is therefore extended."

The question of how much the description and drawings should influence the reading of the claims is disputed in the case law. However, when it comes to deciding if an amended patent fulfils the requirements of Article 123(3) EPC, it must be kept in mind that during the whole life of the patent the extent of protection conferred must be determined again by applying Article 69(1) EPC and the Protocol on its interpretation, both in proceedings before the EPO and within the Contracting States. In other words, the source necessary for interpretation must be kept.

Hence, in view of Article 69(1) EPC which states that the description and the drawings shall be used to interpret the claims when determining the extent of the protection conferred by a European patent, after grant, any information in the description and/or drawings of a patent directly related to a feature of a claim and potentially restricting its interpretation cannot be removed from the patent without infringing Article 123(3) EPC.

Allowing such deletions would go against the very purpose of Article 123(3) EPC since it would allow the

patent proprietor to generalise the teaching of the patent after grant by eliminating the source of a possible restrictive interpretation of the claim which was present in the patent as granted, i.e. when the proprietor's rights were defined.

- 4.13 In this context, the opponent also considered that the drawings could not be deleted because they may be needed for determining equivalency pursuant to Article 2 of the Protocol on the interpretation of Article 69 EPC.

Although Article 2 of the Protocol on the interpretation of Article 69 EPC may play a role when determining the extent of protection conferred, as is apparent from the above, the Board sees no need to examine this question for deciding the present case.

- 4.14 Hence, for the reasons above, auxiliary request 9 does not fulfil the requirements of Article 123(3) EPC.

5. For the same reasons, auxiliary requests 10 to 17 do not fulfil the requirements of Article 123(3) EPC either.

6. Admissibility of the auxiliary requests 18 to 26

During the oral proceedings, the patent proprietor filed auxiliary requests 18 to 26 in which the references to the drawings in the description, the reference signs and the originally filed drawings were reinstated. It also cited decision T 236/12 to demonstrate that in an analogous case the board decided that the drawings of the patent as granted could be replaced by the drawings as originally filed without infringing the requirements of Article 123(3) EPC.

Therefore, the patent proprietor considered that auxiliary requests 18 to 26 had to be admitted into the proceedings.

While the Board agrees that these requests will obviously solve possible deficiencies under Article 123(2) EPC, it is not convinced, *prima facie*, that the requirements of Article 123(3) EPC will be fulfilled as the very details of the drawings which were not visible when the drawings of the patent as granted were deleted are still not visible with the drawings as originally filed.

In case T 236/12, not only were the originally filed drawings already filed as auxiliary request on 31 October 2012 (i.e. long enough before the oral proceedings of 14 November 2014 for the parties and the board to study the possible consequences), in addition, the board found that with the original drawings too the person skilled in the art would still understand how the different technical features defining the extent of protection conferred had to be embodied (point 2.2.3 of the Reasons). This is thus different to the present situation, in which the drawings were filed during oral proceedings, giving no additional time to precisely study the consequences of this reintroduction. Furthermore, as explained above, in addition to the drawings being important for understanding how the device works and the fact that the person skilled in the art would not be able to reproduce the details of the drawings of the patent as granted on the basis of the description, the drawings affect the interpretation of the features of the claim when determining the extent of the protection conferred by the patent.

For the reasons above, the Board decides to not admit auxiliary requests 18 to 26 into the proceedings pursuant to Article 13 RPBA.

7. Since these requests are not admitted into the proceedings, the question of a possible remittal of the case to the department of first instance has no basis.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated