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**Datasheet for the decision
of 20 September 2016**

Case Number: T 1620/13 - 3.3.10

Application Number: 08718993.2

Publication Number: 2142218

IPC: A61L9/20, A61M16/06, A62B18/02

Language of the proceedings: EN

Title of invention:
PROTECTIVE DEVICE

Applicant:
Medi-immune Ltd

Headword:

Relevant legal provisions:
EPC Art. 54, 123(2), 53(c), 111(1)

Keyword:
Main request and auxiliary request 1: novelty (no) - feature depending on how device is used does not necessarily restrict the device per se
Auxiliary request 2: amendments (allowable); method not excluded by Article 53(c) EPC; remittal - fresh case

Decisions cited:

G 0010/93

Catchword:



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Case Number: T 1620/13 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 20 September 2016

Appellant: Medi-immune Ltd
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 22 February
2013 refusing European patent application No.
08718993.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman P. Gryczka
Members: J. Mercey
F. Blumer

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Examining Division to refuse European patent application no. 08718993.2.
- II. *Inter alia* the following document was cited in the examination proceedings:
- (1) US-A-5 165 395
- III. The application was refused on the grounds that the protective device of claim 1 of the then pending main request and of auxiliary requests 1, 2 and 4 was not novel over the disclosure of document (1), and that of claim 1 of auxiliary request 3 was not inventive, document (1) being considered to represent the closest prior art. In addition, the subject-matter of claim 22 of auxiliary request 4 amounted to a method of treatment of the human body by therapy and thus offended against Article 53(c) EPC.
- IV. With letter dated 5 August 2016, the Appellant (Applicant) submitted a main request and auxiliary requests 1 to 8, and at the oral proceedings before the Board held on 20 September 2016, the Appellant submitted an auxiliary request 2, which replaced the previous auxiliary request 2.
- V. Independent claim 1 of the main request reads as follows:
- "A protective device comprising a disinfection chamber wherein the chamber is arranged to disinfect and/or sterilize fluid in the chamber by exposure to a UV source prior to discharge of the fluid from the

chamber, characterised in that the dose of UV radiation delivered to the fluid is in the range of 5-200 J m⁻²."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the characterising portion reads "characterised in that the UV source is configured to deliver UV radiation to the fluid in the range of 5-200 J m⁻²".

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that it relates to a method of operating said device, namely:

"A method of operating a protective device, the device comprising a disinfection chamber wherein the chamber is arranged to disinfect and/or sterilize fluid in the chamber by exposure to a UV source prior to discharge of the fluid from the chamber, characterised in that the dose of UV radiation delivered to the fluid is in the range of 5-200 J m⁻²."

VI. The Appellant submitted that the UV radiation dosage in claim 1 of the main request was a functional feature using "result to be achieved" language which conferred a real restriction on the product claimed. The subject-matter of claim 1 of auxiliary request 1 explicitly stated that the UV source was "configured" to bring about the desired radiation dosage, such that there was no doubt that said feature was a product, and not a process, feature. As such, the protective devices of both of these requests were novel over the germicidal mask of document (1), since a device which delivered a dosage of 5-200 J m⁻² was not disclosed therein.

VII. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis

of the main request, or, subsidiarily, on the basis of any of the first to eighth auxiliary requests, the main request, the first auxiliary request and the third to eighth auxiliary requests as filed with letter dated 5 August 2016, the second auxiliary request as filed during the oral proceedings before the Board.

VIII. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request and auxiliary request 1

2. *Novelty*

2.1 The protective device of claim 1 of the main request and of auxiliary requests 1, 2 and 4 on which the contested decision was based was found not to be novel over the disclosure of document (1). Said document (see Figure 3) undisputedly discloses a protective device comprising a disinfection chamber 3 containing a UV lamp 3c.

2.2 Claim 1 of the present main request and auxiliary request 1 each additionally comprises a feature defining a UV radiation dosage in the range of 5-200 J m⁻². Leaving aside the question of whether or not the feature "characterised in that the dose of UV radiation delivered to the fluid is in the range of 5-200 J m⁻²" in claim 1 of the main request is merely a process feature which may not be suitable for defining an apparatus at all, in claim 1 of auxiliary request 1, the UV source is defined as being "configured" to

deliver UV radiation to the fluid in the range of 5-200 J m⁻², which implies that the UV source is physically capable of delivering the desired UV radiation dosage. Hence, this feature will be examined to determine if it can render the device novel over that of document (1), wherein no dosage is explicitly disclosed. The Appellant argued that in view of the various references in document (1) (see col. 1, lines 9 to 13 and col. 2, lines 23 to 26 and 29 to 34) to the device therein being designed to kill **any** undesirable microorganisms, the device of said document was configured to deliver a dosage of at least 3000 J m⁻², since such a high dosage would be required for killing any undesirable microorganisms, such that the device of claim 1 of both the main request and auxiliary request 1 was novel in view of it delivering a dosage in the range of 5-200 J m⁻².

2.3 However, a dosage expressed in terms of the unit J m⁻² does not necessarily restrict the structure of the device, since the energy unit, joule (J), is equivalent to a watt second (Ws), and thus depends on the time that the device is in use, which, in turn, is dependent on how it is used and not (only) on the structure of the device *per se*. As can be seen, for example, from Table 2 on page 19 of the application as filed, the exact same UV lamp may be suitable for delivering different UV dosages, depending only on the time for which it is switched on. As such, said dosage is not suitable for defining the device *per se* and thus does not necessarily restrict the structure of the device *vis-à-vis* that of document (1).

2.4 For the above reasons, the Board concludes that document (1) discloses a protective device according to

claim 1 of both the main request and auxiliary request 1, such that the subject-matter thereof is not novel.

- 2.5 As a result, the main request and auxiliary request 1 are not allowable as the subject-matter of claim 1 of each of these requests lacks novelty within the meaning of Articles 52(1) and 54(1) and (2) EPC.

Auxiliary request 2

3. *Amendments (Article 123(2) EPC)*

- 3.1 Claim 1 is based on original claim 1, wherein the category has been changed from a protective device *per se* to a method of operating said device. The feature "such that the fluid discharged from the chamber comprises inactive microorganisms" has been deleted from original claim 1, basis for a method of operating the device wherein it is not essential that the fluid discharged from the chamber comprises inactive microorganisms being found on page 14, lines 12 to 18, said feature being described at page 14, lines 19 to 20 as merely preferred. Basis for the dose of UV radiation delivered to the fluid being in the range of $5\text{-}200 \text{ J m}^{-2}$ is found on page 10, line 9 of the application as filed.
- 3.2 Basis for dependent claims 2 and 3 may be found on page 10, line 9 of the application as filed. Dependent claims 4 to 12 are based on original claims 2, 6, 7, 9, 11, 12 and 13, 16, 17 and 18, respectively.
- 3.3 Therefore, the amendments made to the claims do not generate subject-matter extending beyond the content of the application as filed, such that the Board concludes

that the requirements of Article 123(2) EPC are satisfied.

4. *Article 53(c) EPC*

4.1 In contrast to the method claim 22 of auxiliary request 4 before the Examining Division, which called for a method "for use to protect a user from pathogens present in the environment of the user and/or to provide a curative and/or therapeutic benefit to the user", present independent claim 1 relates merely to a method of operating a protective device wherein fluid is disinfected and/or sterilised. Since said method does not involve a method of treatment of the human or animal body by therapy, its subject-matter is not excluded from patentability by the provisions of Article 53(c) EPC.

5. *Remittal*

5.1 This request is restricted to a method of operating a protective device, the Examining Division having, however, not yet ruled on this type of process claim, the decision under appeal being based essentially on lack of novelty or inventive step of the protective device *per se*. Proceedings before the Boards of Appeal in *ex-parte* cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the Reasons), fresh issues normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance. Special circumstances leading to another conclusion were not given in the present case. The Board thus considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit

the case to the Examining Division for further prosecution on the basis of the claims according to auxiliary request 2 filed during the oral proceedings before the Board in order to enable the Examining Division to decide on the outstanding issues.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of the second auxiliary request (claims 1 to 12) as filed during oral proceedings before the Board.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated