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**Datasheet for the decision
of 27 November 2014**

Case Number: T 2290/13 - 3.2.08
Application Number: 11179365.9
Publication Number: 2392298
IPC: A61F7/02, A61F7/12, A61F7/00
Language of the proceedings: EN

Title of invention:
Primary heat exchanger for patient temperature control

Applicant:
ZOLL Circulation, Inc.

Headword:

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

Keyword:
Divisional application - subject-
matter extends beyond content of earlier application (no)
Divisional application - added subject-matter (no) -
after amendment

Decisions cited:

Catchword:



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Case Number: T 2290/13 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 27 November 2014

Appellant: ZOLL Circulation, Inc.
(Applicant) 650 Almanor Avenue
Sunnyvale, CA 94085 (US)

Representative: Roche, Dermot
Tomkins & Co.
5 Dartmouth Road
Dublin 6 (IE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 9 July 2013 refusing European patent application No. 11179365.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman T. Kriner
Members: M. Foulger
D. T. Keeling

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division, dispatched on 9 July 2013, to refuse the European patent application 11179365.9. The Examining Division held that the then valid main request did not comply with Articles 76(1), 84 and 123(2) EPC, and that the first and second auxiliary requests did not meet the requirements of Articles 84 and 123(2) EPC.

The appeal was duly filed and reasoned.

- II. Oral proceedings took place before the Board of Appeal on 27 November 2014.

- III. 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 the third auxiliary request filed with the letter dated 8 October 2014, or the fourth auxiliary request filed during the oral proceedings. The first and second auxiliary requests were withdrawn.

- IV. Claim 1 of the main request reads:
"A heat exchange system, comprising:
a primary heat transfer element (22) through which primary working fluid from a primary heat exchange element (12/18) can flow, the primary heat transfer element (22) being a hollow coil (62) and being disposable within a secondary heat transfer element (24) holding a bath of secondary heat exchange fluid, when disposed within the secondary heat transfer element (24) the hollow coil (62) being in thermal contact with the secondary heat exchange fluid, the coil (62) having straight inlet and outlet tubes (60);

and
primary coolant inlet (52) and outlet conduits (54)
connected to the coil (62) to respectively carry the
primary working fluid to and away from the primary heat
transfer element (22), and
respective first (56) and second (58) fittings
connecting each conduit (52,54) to a respective inlet
and outlet tube (60), the first fitting (56) being
engaged at least with the respective inlet and outlet
tube (60), the second fitting (58) being plastic and
being engaged at least with the first fitting (56)."

Claim 1 of the third auxiliary request is based on
claim 1 of the main request however with the word
"straight" (line 8 of the claim) having been deleted.

Claim 1 of the fourth auxiliary request reads:

"A heat exchange system, comprising:
a primary heat transfer element (22) through which
primary working fluid from a primary heat exchange
element (12/18) can flow, the primary heat transfer
element (22) being a hollow coil (62) and being
disposable within a secondary heat transfer element
(24) holding a bath of secondary heat exchange fluid,
when disposed within the secondary heat transfer
element (24) the hollow coil (62) being in thermal
contact with the secondary heat exchange fluid, the
coil (62) having inlet and outlet tubes (60); and
primary coolant inlet (52) and outlet conduits (54)
connected to the coil (62) to respectively carry the
primary working fluid to and away from the primary heat
transfer element (22) wherein the primary coolant inlet
(52) and outlet conduits (54) are plastic, and
respective first (56) and second (58) fittings
connecting each conduit (52,54) to a respective inlet
and outlet tube (60), the first fitting (56) being

metal and being engaged at least with the respective inlet and outlet tube (60), the second fitting (58) being plastic and being engaged at least with the first fitting (56), wherein a plastic handle (64) is provided to support the inlet (52) and outlet conduits (54) connected to the coil (62)."

V. The appellant argued essentially as follows:

Main request

The requirements of Article 76(1) EPC were met because, in reading the earlier application, the skilled person would recognise that the features of claim 1 were directed to a different problem from that of the earlier application. Moreover in solving this problem the skilled person would recognise that merely the feature of the plastic fittings was essential. Thus the other features relating to the handle could be omitted from the claim without infringing Article 123(2) EPC.

Third auxiliary request

The above argumentation also applied to the third auxiliary request.

Fourth auxiliary request

The fourth auxiliary request included all the features mentioned in the passage relating to the isolation of the catheter from the secondary heat transfer and consequently all the features were disclosed in combination and therefore the requirements of Articles 76(1) and 123(2) EPC were met.

Reasons for the Decision

1. The appeal is admissible.
2. Main request - Article 76(1) EPC
 - 2.1 As the current application is filed as a divisional application, Article 76(1) EPC is applicable. According to Article 76(1) EPC a divisional application may be only filed in respect of subject-matter which does not extend beyond the content of the earlier application as filed.
 - 2.2 In the earlier application according to Article 76(1) EPC, the problem to be solved by the independent claim was to ensure that the secondary fluid bath was grounded when the coil was not in place, see page 2, line 19 - page 3, line 3 of the earlier application. This object was achieved by the provision of a switch which connects the secondary heat transfer element to ground if the primary coolant heat transfer element is not immersed in the bath, see page 3, lines 5-11 of the earlier application. The features relating to the isolation of the coil from the catheter were, on the other hand, presented as solving another problem, i.e. the insulation of the catheter or pad from the secondary heat transfer element, see page 9, lines 8-12 of the earlier application.

Furthermore, the skilled person would recognise that the features relating to the electrical isolation of the coil from the catheter were neither structurally nor functionally connected with the provision of the switch. Thus the features that relate to this electrical isolation are directly and unambiguously

derivable from the parent application as being a separate invention which consequently may be claimed separately.

The requirements of Article 76(1) EPC are therefore fulfilled.

3. Main request - Article 123(2) EPC

3.1 The basis given for the amendments to claim 1 of the main request is the last sentence of paragraph [0021]. This sentence reads "It may now be appreciated that owing to the use of plastic fittings 58 to engage metal fittings 56, and to the use of a plastic handle 64 and plastic upper portions of the conduits 52, 54, electrical isolation is achieved between the catheter or pad and secondary heat transfer element 24 at least when no primary coolant is present in the primary heat transfer element 22." Thus to solve the problem of electrical isolation several elements, i.e. the plastic handle, the plastic portions of the conduits, were presented as being necessary. Thus the skilled person would regard the feature of the plastic handle and plastic conduits as being linked to the use of the plastic fittings in order to solve the problem of electrical isolation.

3.2 The plastic fittings were not disclosed without the other features. The subject-matter of claim 1 therefore is not directly and unambiguously derivable from the application as originally filed. Thus, the main request does not meet the requirements of Article 123(2) EPC.

4. Third auxiliary request - Article 123(2) EPC

4.1 Claim 1 of the third auxiliary request differs from claim 1 of the main request merely in that the feature that the inlet and outlet tubes are straight has been deleted. The above reasoning relating to the main request is therefore directly applicable to the third auxiliary request which consequently also does not comply with Article 123(2) EPC.

5. Fourth auxiliary request

5.1 The subject-matter of claim 1 of the fourth auxiliary request is further restricted over that of the third auxiliary request by the following features:

- i) the primary coolant inlet and outlet conduits are plastic,
- ii) a plastic handle is provided to support the inlet and outlet conduits connected to the coil
- iii) the first fitting is metal.

These features were disclosed in combination in the last sentence of paragraph [0021] of the published present application. Thus this request overcomes the above objection concerning the main request and third auxiliary request.

5.2 As the subject-matter of claim 1 of the fourth auxiliary request is directly and unambiguously derivable from both the earlier application and the application as originally filed then it meets the requirements of Articles 76(1) and 123(2) EPC.

5.3 Moreover, as all the essential features of the invention are included in the claim, the objection under Article 84 EPC in the impugned decision is also overcome.

6. As the Examining Division has not yet decided on the questions of novelty and inventive step then the Board considers that it is appropriate to remit the case in accordance with Article 111(1) EPC to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

The decision under appeal is set aside and the case is remitted to the Examining Division for further prosecution on the basis of the claims of the Fourth Auxiliary Request filed at the oral proceedings.

The Registrar:

The Chairman:



V. Commare

T. Kriner

Decision electronically authenticated