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**Datasheet for the decision
of 1 June 2016**

Case Number: T 2129/14 - 3.2.02

Application Number: 02766098.4

Publication Number: 1418973

IPC: A61M1/00, A61M27/00

Language of the proceedings: EN

Title of invention:

VACUUM ASSISTED TISSUE TREATMENT SYSTEM

Patent Proprietor:

KCI Licensing, Inc.

Opponent:

Smith and Nephew, Inc.

Headword:

Relevant legal provisions:

EPC Art. 21(1), 56, 83, 84, 111(1), 123(2)

EPC R. 80

RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Amendments - added subject-matter - main and first auxiliary request (yes), second auxiliary request (no)
Late-filed request - admitted (yes)
Amendment occasioned by ground for opposition - (yes)
Sufficiency of disclosure - second auxiliary request (yes)
Claims - clarity - second auxiliary request (yes)
Appeal decision - remittal to the department of first instance (no)
Reformatio in peius - exception to the prohibition (yes)
Late-filed evidence - admitted (yes)
Inventive step - second auxiliary request (yes)

Decisions cited:

G 0001/99, T 0789/12, T 0386/89

Catchword:

Exception to the prohibition of the reformatio in peius - conditions established in G 1/99 - order of application - plurality of amendments (point 5.5 of the Reasons).



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Case Number: T 2129/14 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 1 June 2016

Appellant: Smith and Nephew, Inc.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
15 October 2014 concerning maintenance of
European patent No. 1418973 in amended form.**

Composition of the Board:

Chairman E. Dufrasne
Members: D. Ceccarelli
C. Körber

Summary of Facts and Submissions

- I. The opponent has appealed the Opposition Division's decision, dispatched on 15 October 2014, that European patent No. 1 418 973 as amended according to the then pending first auxiliary request complied with the EPC.
- II. The patent was opposed on the grounds of insufficiency of disclosure and lack of inventive step.
- III. The notice of appeal was received on 31 October 2014. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 16 February 2015.
- IV. The respondent (patent proprietor) replied to the statement of grounds by letter dated 23 June 2015.
- V. The appellant filed further written submissions by letter dated 15 October 2015.
- VI. The Board summoned the parties to oral proceedings and set out its provisional opinion in a communication dated 25 February 2016.
- VII. The appellant and the respondent filed further written submissions by letters dated 27 April 2016 and 29 April 2016 respectively.
- VIII. Oral proceedings took place on 1 June 2016.

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

The respondent requested that the appeal be dismissed or, in the alternative, that the decision under appeal be set aside and that the patent be maintained on the basis of one of the first auxiliary request filed with letter dated 29 April 2016, and the second auxiliary request filed during the oral proceedings. The third to fifth auxiliary requests, filed with letter dated 29 April 2016, were withdrawn.

IX. The following documents are referred to in the present decision:

D2: WO-A-00/61206;
D3: US-A-4,976,694;
D14: US-A-6,093,230;
D16: US-A-5,160,334;
D17: US-A-5,894,608;
D18: WO-A-93/09749;
D19: US-A-5,874,052.

X. Claim 1 of the patent as granted reads as follows:

"A system (10) for stimulating the healing of tissue, comprising:

a porous pad (11);
an airtight dressing (13);
a means for connecting a distal end (16b) of a conduit (16) through the dressing (13);
a canister (18) removably connected to a proximal end (16a) of the conduit (16),
means (14) for applying negative pressure to a wound site;
a hydrophobic filter (20) positioned between said canister (18) and said means (14) for applying negative pressure;

a means for varying said negative pressure over a time interval,

characterised in that the system includes an odor vapor filter (23) positioned between said hydrophobic filter (20) and said means (14) for applying negative pressure, and **in that** the system includes a further hydrophobic filter (22) positioned between the hydrophobic filter (20) and said means (14) for applying negative pressure."

XI. Claim 1 of the request found allowable by the Opposition Division, which constitutes the main request, reads as follows:

"A system (10) for stimulating the healing of tissue, comprising:

a porous pad (11);
an airtight dressing (13);
a means for connecting a distal end (16b) of a conduit (16) through the dressing (13);
means (14) for applying negative pressure to a wound site; a means for varying said negative pressure over a time interval,
a canister (18) removably connected to a proximal end (16a) of the conduit (16),
a hydrophobic filter (20) positioned between said canister (18) and said means (14) for applying negative pressure;
an odor vapor filter (23) positioned between said hydrophobic filter (20) and said means (14) for applying negative pressure, and
a further hydrophobic filter (22) positioned between the hydrophobic filter (20) and said means (14) for applying negative pressure,

wherein the hydrophobic filter (20) is attached to the canister (18), the odor vapor filter (23) is attached to the hydrophobic filter (20), and the further hydrophobic filter (22) is attached to the odor vapor filter (23)."

XII. Compared with claim 1 of the main request, claim 1 of the first auxiliary request additionally contains the following feature at the end:

"wherein the odor vapor filter (23) is positioned between the hydrophobic filter (20) and the further hydrophobic filter (22)".

XIII. Claim 1 of the second auxiliary request reads as follows (deletions and underlining as in the text filed by the respondent):

"A system (10) for stimulating the healing of tissue, comprising:

a porous pad (11);
an airtight dressing (13);
a means for connecting a distal end (16b) of a conduit (16) through the dressing (13);
means (14) for applying negative pressure to a wound site;
a means for varying said negative pressure over a time interval;
a canister (18) removably connected to a proximal end (16a) of the conduit (16),
a hydrophobic filter (20) ~~interposed~~ positioned between the said canister (18) and said means (14) for applying negative pressure;

a further hydrophobic filter (22) positioned between the hydrophobic filter (20) and said means (14) for applying reduced pressure, wherein said hydrophobic filter (20) and said further hydrophobic filter (22) are an integral part of said canister (18); and

an odor vapor filter (23) interposed between said first hydrophobic filter (20) and said second hydrophobic filter (22)."

The second auxiliary request includes four claims. Claims 2 to 4 are dependent claims.

XIV. The appellant's arguments may be summarised as follows:

(a) Main request

Added subject-matter - Article 123(2) EPC

In opposition proceedings the patent had been amended so that claim 1 of the main request included the features that "the hydrophobic filter (20) is attached to the canister (18), the odor vapor filter (23) is attached to the hydrophobic filter (20), and the further hydrophobic filter (22) is attached to the odor vapor filter (23)".

Only figure 1 could be considered as a possible basis for this amendment in the application as originally filed.

However, figure 1 provided a basic diagram of the claimed system, from which no details regarding the shown components could be derived. The schematic nature of the figure was even acknowledged in the

description as originally filed, page 5, lines 6 to 7.

The statement made by the appellant in the first-instance proceedings that from figure 1 "it would appear that the three filters are in some way attached or linked to the canister" could not be considered as accepting that there was a basis in the application as filed for the features in question. In particular, the statement did not concern the attachment of the filters to each other. Figure 1 showed that the filters were in proximity to each other. It concerned, if anything, the functionality of the filters, but did not disclose any specific mechanical arrangement. There was no way of telling, from the figure, how the filters were configured. For example, they could be held in a casing, connected by some intermediate tubing or have other layers between them. It followed that the specific attachment of the filters as claimed was not directly and unambiguously derivable from the application as originally filed. As a consequence, claim 1 did not comply with Article 123(2) EPC.

(b) First auxiliary request

The objection under Article 123(2) EPC equally applied to the first auxiliary request, which contained the same problematic features.

(c) Second auxiliary request

Admissibility

Claim 1 of the second auxiliary request differed from claim 1 of a former request filed with letter dated 29 April 2016 only in the definition of the hydrophobic filter (20), claimed to be "positioned" - no longer "interposed" - between said canister (18) and said means (14) for applying negative pressure.

However, this former request had itself been filed late. The appellant's objection concerning added subject-matter of the main request had been in the appeal proceedings since the beginning. The appellant's further submissions filed by letter dated 15 October 2015 had introduced the issue of the prohibition of *reformatio in peius* for a party who did not appeal, in view of decision G 1/99. There had been no reason for the respondent to wait and then file auxiliary requests allegedly addressing these issues only about one month before the oral proceedings.

A late-filed request could only be admissible if it was allowable on a *prima facie* basis. This was not the case for the second auxiliary request. The fact that, in claim 1, the hydrophobic filters were defined as being an integral part of the canister, whereas this was not specified for the odour filter, required that two hydrophobic filters, but not the odour filter, be within the canister. However, the claim further required that the odour filter be interposed between the two hydrophobic filters. These two claim requirements were in

contradiction, resulting *prima facie* in a lack of clarity and added matter. Moreover, in G 1/99 two of the three exceptions under which an amendment by a non-appealing party introducing a *reformatio in peius* could be accepted required an addition of features. However in the second auxiliary request the *reformatio in peius* stemmed from the deletion of features of claim 1 compared to claim 1 of the main request.

It followed that the second auxiliary request should not be admitted into the proceedings. If it was admitted, however, the appellant was not requesting remittal to the department of first instance for consideration of this request.

Amendments not occasioned by a ground for opposition - Rule 80 EPC

The respondent had conceded that the filing of the second auxiliary request during the oral proceedings, replacing a former request and from which it differed only in the substitution of a word - "disposed" instead of "interposed" - was due to a mistake the respondent had made when filing the former request.

It followed that the amendments carried out in the second auxiliary request were not occasioned by a ground for opposition, in contravention of Rule 80 EPC.

Added subject-matter - Article 123(2) EPC

The application as originally filed did not disclose a system in which two hydrophobic filters

were an integral part of the canister and an odour vapour filter was positioned between the hydrophobic filters, whereas the odour vapour filter was not an integral part of the canister, as defined in claim 1 of the second auxiliary request.

The respondent's argument that the original application provided a basis for the system as claimed on page 7 was not correct. On this page two distinct embodiments were disclosed. In this respect it was immaterial that the same reference numerals for the hydrophobic filters were employed. The first embodiment, described in lines 12 to 14, comprised an odour vapour filter interposed between two hydrophobic filters. According to this embodiment, however, the filters were not an integral part of the canister. According to the second embodiment, as described in lines 18 to 22, two hydrophobic filters were an integral part of the canister. However, no odour vapour filter was present.

If followed that the second auxiliary request did not fulfil the requirements of Article 123(2) EPC.

*Lack of clarity and insufficiency of disclosure -
Articles 83 and 84 EPC*

According to claim 1 of the second auxiliary request, the two hydrophobic filters were an integral part of the canister, whereas the odour vapour filter might not be. On the other hand, the claim required that the odour vapour filter be positioned between the hydrophobic filters. In the absence of any more specific definition, for example concerning the fluid flow path in the

system, these were contradictory requirements. The subject-matter of the claim was therefore unclear.

Moreover, the patent did not disclose how a system satisfying both of these requirements could be reproduced.

It followed that the subject-matter of claim 1 of the second auxiliary request contravened both Articles 83 and 84 EPC.

Reformatio in peius

The amendments carried out in claim 1 of the second auxiliary request with respect to the subject-matter of claim 1 of the request found allowable by the Opposition Division did not comply with the principle of prohibition of *reformatio in peius*.

According to decision G 1/99, an amended claim which would put the opponent and sole appellant in a worse situation than if it had not appealed could be allowed only exceptionally, under three sequential conditions. Exceptions should be interpreted narrowly. By deleting the feature that the odour vapour filter was attached to both hydrophobic filters the respondent had gone straight to the third and final condition, thereby unduly extending the protection conferred by the claim to many more mechanical arrangements of the odour vapour filter with respect to the hydrophobic filters. According to decision G 1/99, an amendment satisfying merely the third condition would only be allowed if it was impossible to satisfy the first and second conditions. The respondent had not

explained why an amendment satisfying the first or the second condition was not possible. In the present case an amendment referring directly to figure 1, e.g. a claim reading "a system according to the arrangement of figure 1" would have extended the protection conferred by the claim by a smaller amount and was, therefore, preferable. In these circumstances, the amendment actually carried out by the respondent was not admissible.

Lack of inventive step - Article 56 EPC

A lack of inventive step was argued on the basis of *inter alia* D16, D17, D18 and D19. These four documents had been filed with the statement of grounds of appeal. Their filing was a response to the problem formulated by the Opposition Division in the impugned decision for the assessment of inventive step. Their relevance was derived from the fact that all of these documents related to apparatuses for suctioning fluid and comprising an odour filter. D16 to D18 had been introduced to illustrate the common general knowledge. D19 was even more relevant, since it disclosed an odour vapour filter interposed between two hydrophobic filters. It followed that D16 to D19 should be admitted into the appeal proceedings. Remittal to the Opposition Division to consider these documents was not appropriate.

D2 was the closest prior art for the subject-matter of claim 1 of the second auxiliary request.

D2 disclosed a system of the kind claimed for stimulating the healing of tissue, in particular comprising a canister and two hydrophobic filters.

It did not disclose that the second hydrophobic filter was an integral part of the canister and it did not disclose an odour vapour filter as defined in claim 1.

These two distinguishing features addressed different part-problems.

In particular, arranging the second hydrophobic filter as an integral part of the canister addressed the problem of ensuring that the filters were disposed of at the same time as the canister. In view of this problem it would be obvious for the skilled person, based on common general knowledge, to make the filters inseparable from the canister, i.e. an integral part of it.

As regards the presence of an odour vapour filter, it was submitted that such filters, for example in the form of charcoal filters, were part of common general knowledge. That was confirmed by the disclosure of D3, column 2, lines 57 to 60 and column 3, lines 6 and 7; D16, column 8, lines 23 to 29; D17, column 7, line 64 to column 8, line 1 and column 9, lines 48 to 63; and D18, page 60, lines 3 to 22. The skilled person, wishing to remove odour from the fluid flowing in the system of D2 would immediately implement an odour vapour filter as generally known. Interposing the odour vapour filter between the hydrophobic filters was simply an arbitrary selection, as the specific position of the odour filter was of no apparent advantage.

In any case D3 disclosed that an odour filter could be placed in various locations as convenient. In figure 13 a first charcoal filter 60 was positioned

downstream of pump 62 and a second charcoal filter 74 was positioned upstream of pump 62. Hence, the provision in the system of D2 of an odour vapour filter as claimed was rendered obvious at least by the teaching of D3.

D14 concerned a system for stimulating the healing of tissue of the kind claimed and clearly disclosed in figure 5 two hydrophobic filters separated by a spacer, joined together and placed inside a canister (figures 2 and 3). They were therefore integral with the canister. Moreover, the spacer stopped the transfer of odours to some extent. Hence it could be considered an odour vapour filter. In view of the part-problems formulated the skilled person would combine D14 with D2, thereby arriving at the subject-matter of claim 1 in an obvious way.

Alternatively, the skilled person would consider D19, which showed in figure 1 an arrangement with four filters 11 to 14 that could be used "in surgery and other areas of both invasive and topical therapies" (column 1, lines 20 to 24). As was clear from the description of D19, an odour vapour filter (13) was interposed between two hydrophobic filters (12 and 14). The four filters constituted an integral arrangement. Applying this arrangement to the system of D2 in view of the part-problems formulated was obvious for the skilled person.

The respondent had submitted that the distinguishing features of the subject-matter of claim 1 of the second auxiliary request addressed the problem of providing additional protection for

the pump. However, this problem was already solved by D2, through the provision of a second hydrophobic filter. An odour vapour filter, which was not hydrophobic, would provide no additional protection for the pump. The application as originally filed did not indicate that the odour vapour filter could provide such protection either. It followed that the problem formulated by the respondent was not related to the distinguishing features of the claim and could not be deduced from the application as filed either. Hence, according to the established case law of the boards of appeal, for example decision T 386/89, the problem formulated by the respondent was not appropriate for the assessment of inventive step under the problem-solution approach. A statement by one individual, Mr Chris Locke, provided by the respondent in support of its assertion that an odour vapour filter provided additional protection for the pump, could clearly not be used as a basis for objectively deriving a problem from a distinguishing feature. In any case, the arrangement of four filters as disclosed in D19 also clearly solved the problem formulated by the respondent. Hence the combination of D19 with D2 rendered obvious the subject-matter of claim 1 under any assumption.

As a consequence, the subject-matter of claim 1 of the second auxiliary request lacked inventive step.

XV. The respondent's arguments may be summarised as follows:

(a) Main request

Added subject-matter - Article 123(2) EPC

The feature of claim 1 of the main request that "the hydrophobic filter (20) is attached to the canister (18), the odor vapor filter (23) is attached to the hydrophobic filter (20), and the further hydrophobic filter (22) is attached to the odor vapor filter (23)" was directly and unambiguously disclosed in figure 1 and in the paragraph starting at line 6 of page 7 of the application as originally filed.

Admittedly, that figure 1 did not disclose many details of the system that it depicted. For example, it did not disclose that the filters were located in a casing. However, it disclosed the features necessary for the functioning of the filters. The skilled person would view figure 1 with an open mind desirous of understanding. The only reasonable interpretation of the figure was that the filters were attached as claimed, otherwise they would fall off and the system would disintegrate. Such a non-working system would not be contemplated by the skilled person.

Moreover, the appellant's objection was somewhat surprising, since it had stated during the first-instance proceedings:

"if figure 1 is to be regarded as the basis for the amendment to claim 1 [a previous claim 1, not

including the "attached" requirement...], then it would appear that the three filters are in some way attached or linked to the canister, but not that they are comprised within the canister."

This statement amounted to an acknowledgement that the feature in question did find a basis in the application as filed, in contradiction with the arguments presented in appeal.

Moreover, the disputed feature had been introduced following a suggestion by the Opposition Division, which in the impugned decision had held that the disputed feature found a basis in figure 1 of the original application.

(b) First auxiliary request

As far as the original disclosure of the attachments of the filters was concerned, the arguments in support of the main request applied equally to the first auxiliary request.

(c) Second auxiliary request

Admissibility

Claim 1 of the second auxiliary request had been amended with respect to claim 1 of a former request filed with letter dated 29 April 2016 only in the definition of the hydrophobic filter (20), claimed to be "positioned" - no longer "interposed" - between said canister (18) and said means (14) for applying negative pressure. This very simple amendment had been made to correct a previous mistake, in order to re-introduce the wording used

in claim 1 of the patent as granted, so as to address an objection under Rule 80 EPC.

The former request had been filed in an effort to address the view expressed by the Board in its preliminary opinion and by the appellant in its latest submissions. Moreover, the request was also admissible in view of decision G 1/99, as it fell within the second exception to the prohibition of *reformatio in peius*. For these reasons the second auxiliary request should be admitted into the appeal proceedings.

Amendments not occasioned by a ground for opposition - Rule 80 EPC

The amendment made to the second auxiliary request compared with the former request filed with letter dated 29 April 2016 reinstated the wording used in claim 1 of the patent as granted. Hence, no amendments to the latter not occasioned by a ground for opposition had been carried out.

It followed that Rule 80 EPC was complied with.

Added subject-matter - Article 123(2) EPC

The amendment of claim 1 of the second auxiliary request with respect to claim 1 of the patent as granted was based on figure 1 and on page 7, lines 18 to 23 of the application as originally filed.

In particular, that passage of the original description referred solely to the two hydrophobic filters, while nothing was said in relation to the

odour vapour filter. Hence, it related to a further embodiment only as far as the hydrophobic filters were concerned, whereas the general arrangement of figure 1 was preserved. The odour vapour filter, as well as the remaining features shown in figure 1, were implicitly present in this further embodiment.

For these reasons the second auxiliary request complied with Article 123(2) EPC.

*Lack of clarity and insufficiency of disclosure -
Articles 83 and 84 EPC*

The definition in claim 1 of the second auxiliary request that the two hydrophobic filters were an integral part of the canister, whereas the odour vapour filter might or might not be, together with the requirement that the odour vapour filter be positioned between the hydrophobic filters, was perfectly clear. In particular, the fact that the two hydrophobic filters were an integral part of the canister clearly referred to the physical position of them in relation to the canister, whereas the fact that the odour vapour filter was positioned between the hydrophobic filters referred to its position with respect to the fluid flow in the claimed system. No contradictions arose.

The skilled person, based on the description of the patent and common general knowledge, would have no difficulty in carrying out a system as claimed. There was no need for a specific disclosure in the patent. Moreover, the burden of proof was on the appellant to prove that the skilled person could not carry out the invention as defined in claim 1

of the second auxiliary request. The appellant had not proved its case in this respect.

It followed that the subject-matter of claim 1 of the second auxiliary request was clear and sufficiently disclosed, in compliance with both Articles 83 and 84 EPC.

Reformatio in peius

The amendments made to claim 1 of the second auxiliary request compared with the subject-matter of claim 1 of the request found allowable by the Opposition Division were allowable in view of the exceptions to the prohibition of *reformatio in peius*, as established in decision G 1/99.

More particularly, the amendment specifying that the hydrophobic filters were an integral part of the canister fell within the first exception established in that decision, whereas the definition of the position of the odour filter and the deletion of the requirement of its attachment to the hydrophobic filters fell within the second and the third exceptions respectively. This was allowable in particular in view of decision T 789/12. Concerning the features of the odour vapour filter there was no possibility of overcoming the deficiencies under Article 123(2) EPC by an amendment falling within the first and the first or second exceptions, respectively. Contrary to the appellant's submissions, this would not have been possible by a claim reading "a system according to the arrangement of figure 1" either.

For these reasons, claim 1 of the second auxiliary request was allowable in view of the ruling in decision G 1/99.

Lack of inventive step - Article 56 EPC

Amongst the documents relied on by the appellant in the arguments against inventive step, D16 to D19 should not be admitted into the appeal proceedings. In the proceedings at first instance the appellant had already been allowed to file D14 and D15 late. A further opportunity to file documents late was not justified. Moreover, D16 to D19 were not *prima facie* more relevant than other documents already on file. If the Board decided to admit D16 to D19 then the case should be remitted to the Opposition Division for consideration of these documents, as otherwise the respondent would be deprived of an opportunity to be heard by two instances on this matter.

D2 was the closest prior art for the subject-matter of claim 1 of the second auxiliary request.

It did not disclose a hydrophobic filter that was an integral part of the canister and an odour vapour filter positioned between the two hydrophobic filters.

As also stated by the Opposition Division in the impugned decision, the fact that the hydrophobic filters were an integral part of the canister ensured that the filters were disposed of together with the canister. Moreover, the position of the odour vapour filter between the hydrophobic filters resulted in an increase of protection of the second

hydrophobic filter and the pump from contaminants.

As far as the protection provided by the odour vapour filter was concerned, although this effect was not explicitly mentioned in the description of the patent, it could be derived from it by the person skilled in the art, as confirmed under oath by Mr Chris Locke, an experienced engineer familiar with negative-pressure wound-therapy systems. Decision T 386/89, mentioned by the appellant, made clear that a technical problem could be redefined if such redefinition could be deduced by the skilled person.

Neither common general knowledge nor the documents cited by the appellant prompted the skilled person to modify the system of document D2 and arrive at the subject-matter of claim 1 of the second auxiliary request in an obvious way.

More particularly, common general knowledge clearly provided no motivation to the skilled person to displace the hydrophobic filters in the system of D2, thereby having to redesign the system, and make them an integral part of the canister.

D3 disclosed two filters, one of which was placed upstream and the other downstream of a suction pump.

D14 disclosed a filter assembly with two filter elements. The filter elements were not even disclosed as being hydrophobic, as derivable from column 4, lines 58 to 60 and column 6, lines 36 to 42. They could not be employed for the same purposes as in the system of document D2. Moreover,

D14 did not disclose any odour vapour filter.

D16 concerned a different application, as it related to a smoke filter. It did not even disclose a canister.

D17 concerned yet another application, as it related to a urine filter. As shown in figure 6 and explained in column 7, line 64 to column 8, line 1, an odour filter was disposed in the proximity of a fan assembly and not of a collection canister.

D18 concerned an apparatus for managing waste from an incontinent patient lying in a hospital bed. An odour vapour filter was disclosed, but the filter was disposed downstream of a vacuum pump (page 60, lines 10 to 13 and figure 9).

D19 was of little relevance since it related to a smoke filter comprised of different filter layers. It disclosed neither a canister nor two hydrophobic filters. In particular, filter layer 14 in figure 1, being a "polymer foam adapted to capture any remaining particulate" (column 5, lines 58 to 61), was clearly not hydrophobic within the meaning of claim 1.

For these reasons, the subject-matter of claim 1 of the second auxiliary request was inventive.

Reasons for the Decision

1. The appeal is admissible.
2. The invention

The invention relates to a system for stimulating the healing of tissue at a wound site of a patient by applying negative pressure.

As shown in figure 1 of the patent, reproduced below, such systems generally comprise a porous pad (11) to be inserted into the wound site (12), an airtight dressing (13) for sealing the wound site over the pad, a conduit (16) for connecting the sealed wound site to a source of negative pressure, and the source of negative pressure (14). The claimed system includes a canister (18) removably connected to a proximal end (16a) of the conduit, two hydrophobic filters (20 and 22) and an odour vapour filter (23) disposed between the canister and the source of negative pressure. Wound exudates sucked through the conduit are directed and kept in the canister. They should not reach the source of negative pressure.

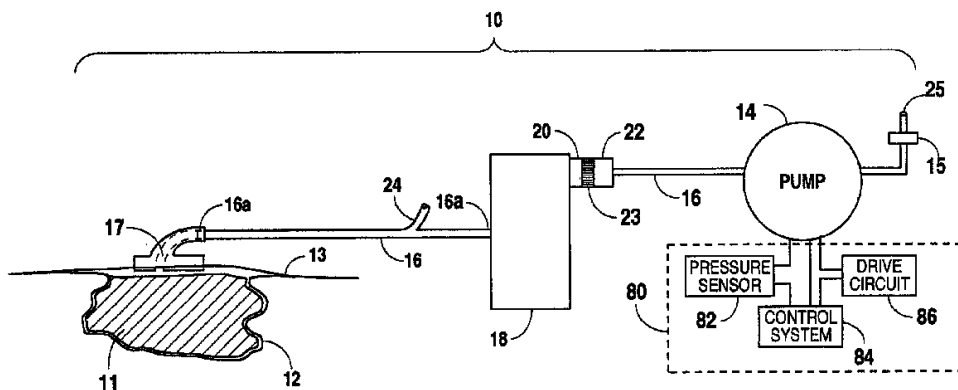


Fig. 1

According to the description of the patent, making the hydrophobic filters an integral part of the canister ensures that the canister and the filters are disposed of together after use. This reduces the exposure of the system to any contaminants that may be trapped by the filters during normal use (column 7, lines 43 to 50).

3. Main request

3.1 *Added subject-matter - Article 123(2) EPC*

3.1.1 The appellant argued that the feature of claim 1 of the main request that "the hydrophobic filter (20) is attached to the canister (18), the odor vapor filter (23) is attached to the hydrophobic filter (20), and the further hydrophobic filter (22) is attached to the odor vapor filter (23)" added subject-matter extending beyond the content of the application as originally filed, in contravention of Article 123(2) EPC.

The respondent submitted that figure 1 and the paragraph starting at line 6 of page 7 of the application as originally filed provided a basis for that feature.

3.1.2 According to the established jurisprudence of the boards, a "direct and unambiguous" disclosure in the original application is required to comply with Article 123(2) EPC.

As the respondent pointed out, it is not excluded that figures, even if schematic in nature, can directly and unambiguously disclose some claimed features. In this case, figure 1 may directly and unambiguously disclose some features illustrating the functioning of the

filters in the system, such as the order of placement of the filters and the canister along the fluid line from the wound site to the vacuum pump.

The Board further agrees with the respondent that the skilled person would view figure 1 of the application as originally filed with an open mind desirous of understanding.

3.1.3 However, the skilled person would also approach claim 1 of the main request with a mind willing to understand its meaning. In particular, when reading the claim, the skilled person would interpret the term "attached" as implying more than somehow maintaining a defined position. Implicitly, there must be a special relationship between the elements attached to each other, e.g. a direct or permanent fastening. If it were not so, the feature objected to in claim 1 of the main request would be meaningless, since several relative positions of the filters and the canister have already been defined previously in the claim.

3.1.4 As the appellant pointed out, figure 1 is schematic in nature, this being explicitly acknowledged in the application as originally filed (page 5, lines 6 to 7). From figure 1 alone it is not directly and unambiguously derivable how the filters and the canister are kept in their respective positions, since no specific means for this purpose are illustrated. The paragraph on page 7, lines 6 to 22 of the original application does not specify any such means either, as it is concerned with the relative positions of the elements of the claimed system. Hence, from the original application it cannot be established whether odour filter 23 is "attached" to the hydrophobic filters within the meaning of the claim or, for

example, simply (removably) held between them, possibly at a certain distance, by spacers or by insertion into a slit of a housing. These latter arrangements, which do not require an attachment as claimed, would clearly prevent the filters from falling off the system, thereby being perfectly reasonable for the skilled person.

- 3.1.5 The appellant's statement in the first-instance proceedings referred to by the respondent in the context of the objection under Article 123(2) EPC is not an implicit admission that the requirements of that article were fulfilled by claim 1 of the main request, at least because it does not concern the claimed attachment of the odour filter to the hydrophobic filters.

Whether the problematic feature was introduced following a suggestion by the Opposition Division, or what the Opposition Division concluded with respect to that feature, is immaterial, because claim drafting is a patentee's duty irrespective of external inputs, and because the Board is not bound by the decision of the Opposition Decision, being instead responsible for the examination of the appeal from that decision (Article 21(1) EPC).

- 3.1.6 For these reasons the Board concludes that the subject-matter of claim 1 of the main request extends beyond the content of the application as originally filed. Hence, the main request does not comply with Article 123(2) EPC and cannot be allowed.

4. First auxiliary request

Since the first auxiliary request contains the same feature found to include subject-matter extending beyond the content of the application as originally filed, this request cannot be allowed in view of Article 123(2) EPC either, for the reasons explained in connection with the main request.

5. Second auxiliary request

5.1 *Admissibility*

5.1.1 According to Article 13(1) RPBA, an amendment to the respondent's case after it has filed its reply to the statement of ground of appeal may be admitted and considered at the Board's discretion. In exercising its discretion, the Board should consider, in particular, the complexity of the subject-matter submitted, the current state of the proceedings and the need for procedural economy. Article 13(3) RPBA prescribes that if such an amendment is sought to be made during the oral proceedings it should not be admitted if it raises issues which the Board or the appellant cannot reasonably be expected to deal with without adjournment of the oral proceedings.

5.1.2 As the appellant too has submitted, the second auxiliary request filed during the oral proceedings differs from a former request filed with letter dated 29 April 2016 only in the definition of the hydrophobic filter (20), claimed to be "positioned" - no longer "interposed" - between said canister (18) and said means (14) for applying negative pressure. The respondent explained that this amendment addressed a previous objection under Rule 80 EPC, by reintroducing

the specific term used in claim 1 of the patent as granted. In the Board's view such an amendment does not change the substance of the subject-matter claimed. Hence, it does not raise any issues which the Board or the appellant cannot reasonably be expected to deal with without adjournment of the oral proceedings. It follows that Article 13(3) RPBA is no bar to its admissibility.

- 5.1.3 Claim 1 of the former second auxiliary request filed with letter dated 29 April 2016 differs from claim 1 of the main request only in the specific definition of the attachment of the filters to the canister and to each other, which was found to contravene Article 123(2) EPC. The distinguishing features do not diverge from the subject-matter alleged to represent the core of the invention according to the main request. Thus, they do not introduce complex subject-matter. Moreover, this request was filed within the period of no later than one month before the oral proceedings mentioned by the Board in the communication accompanying the summons. Lastly, the amendments carried out specifically address the appellant's objections and the Board's preliminary opinion expressed in that communication, especially concerning added subject-matter and the principle of prohibition of *reformatio in peius*, as they remove the non-allowable feature of the main request, partially replacing it with closely related features. For this reason the Board considers the former request as a justified and at least *prima facie* relevant attempt to comply with the EPC.

In view of these circumstances the Board exercises the discretion conferred on it by Article 13(1) RPBA and admits the second auxiliary request into the appeal proceedings.

5.2 *Amendments not occasioned by a ground for opposition - Rule 80 EPC*

Compared to claim 1 of the patent as granted, the amendments made in claim 1 of the second auxiliary request clearly limit the subject-matter claimed, as they define further relations between the filters and the canister of the claimed system. Hence, they are occasioned by the ground for opposition of lack of inventive step, in particular. The relation between the second auxiliary request and a former, already amended, second auxiliary request is of no relevance as far as Rule 80 EPC is concerned.

It follows that the provision of Rule 80 EPC is no bar to admitting the second auxiliary request.

5.3 *Added subject-matter - Article 123(2) EPC*

With respect to claim 1 of the patent as granted, against which the ground for opposition of added subject-matter under Article 100(c) EPC was not raised, claim 1 of the second auxiliary request was amended to further define that the two hydrophobic filters are an integral part of the canister and that the odour vapour filter is interposed between the two hydrophobic filters.

A basis for the feature of the odour vapour filter being interposed between the two hydrophobic filters is derivable from page 7, lines 12 to 14, whereas the feature of the two hydrophobic filters being an integral part of the canister is disclosed on page 7, lines 18 to 22, of the original application.

As the appellant argued, the sentence on page 7, lines 18 to 22 refers to a "further embodiment". However, it does not specify that any features previously described in connection with other embodiments should be excluded from this "further embodiment". There is also no implicit reason to conclude that having the two hydrophobic filters as an integral part of the canister together with an odour vapour filter interposed between them might not be contemplated in the original application. For example, the odour vapour filter could itself be an integral part of the canister or removably insertable between the two hydrophobic filters in a manner easily conceivable by the skilled person. Therefore, in the Board's opinion, and as the respondent submitted, the "further embodiment" mentioned on page 7, lines 18 to 22 differs from the embodiments described before only in what is specified in that sentence.

As a consequence, the amendment in claim 1 of the second auxiliary request complies with Article 123(2) EPC.

5.4 *Lack of clarity and insufficiency of disclosure - Articles 83 and 84 EPC*

As the appellant argued, in a system according to claim 1 of the second auxiliary request the two hydrophobic filters are an integral part of the canister, whereas the odour vapour filter positioned between the two hydrophobic filters might not be. However, the claim also does not exclude that the odour vapour filter may be an integral part of the canister.

The Board sees no contradictory requirements in the claim. In particular, the odour vapour filter could be

made integral with the canister or, for example, insertable in a dedicated slit or housing in the position defined, as generally known. Evidently, such a position is defined with respect to the fluid flow in the system under normal operating conditions, since the very purpose of the filters is to remove particles from that fluid flow. Hence, the skilled person would neither see any lack of clarity nor be confronted with any undue burden in implementing the invention over its whole technically meaningful scope.

It follows that Articles 83 and 84 EPC are complied with.

5.5 *Reformatio in peius*

The appellant argued that the amendments made in claim 1 of the second auxiliary request with respect to the subject-matter of claim 1 of the request found allowable by the Opposition Division (present main request) did not comply with the principle of prohibition of *reformatio in peius*.

The Enlarged Board of Appeal dealt with this principle and its application to a case like the present one, in which the opponent was the sole appellant, in decision G 1/99. In the Order, the Enlarged Board concluded that:

"in principle, an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, must be rejected."

Compared with claim 1 of the request found allowable by the Opposition Division, in claim 1 of the second

auxiliary request the features that "the hydrophobic filter (20) is attached to the canister (18), the odor vapor filter (23) is attached to the hydrophobic filter (20), and the further hydrophobic filter (22) is attached to the odor vapor filter (23)" have been deleted. Instead, the two hydrophobic filters are claimed to be "an integral part of the canister". As a result of these amendments the second auxiliary request confers protection on systems in which, in particular, the odour vapour filter is not attached to the hydrophobic filters. Hence, the protection is extended with respect to that of the request on the basis of which the patent would have been maintained if the opponent and sole appellant had not appealed. Under such circumstances the opponent and sole appellant is in a worse situation than if it had not appealed. Hence, in principle, the conclusion of the Enlarged Board would apply and the patent would have to be revoked.

However, the Enlarged Board went on to state that:

"an exception to this principle may be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision."

The present case falls under these circumstances, since the deleted features objected to by the appellant during the appeal proceedings had been previously introduced by way of amendment during the opposition proceedings and were held allowable by the Opposition

Division in its interlocutory decision.

Lastly, the Enlarged Board laid down the conditions under which the exception may be made:

"in order to overcome the deficiency, the patent proprietor/respondent may be allowed to file requests as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as maintained;

- if such a limitation is not possible, for an amendment introducing one or more originally disclosed features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC;

- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Article 123(3) EPC."

As the appellant pointed out, these three conditions are sequential. In other words, a request satisfying merely the third condition should not be allowed if it was possible to satisfy the first or second one.

In the present case, the inadmissible amendment held allowable by the Opposition Division in its interlocutory decision and then deleted in claim 1 of the second auxiliary request concerned four elements of the claimed system and some relationships between them. These four elements are the two hydrophobic filters, the odour vapour filter and the canister. More

particularly, it was required that:

- the first hydrophobic filter be attached to the canister;

- the odour vapour filter be attached to the first hydrophobic filter;

- the second hydrophobic filter be attached to the odour vapour filter; and, consequently,

- the odour vapour filter be indirectly attached to the canister and the second hydrophobic filter be indirectly attached to the first hydrophobic filter and the canister.

Further, the Board notes that in claim 1 of the second auxiliary request features have been added which also involve some relationships between those four elements of the system, i.e. that the two hydrophobic filters "are an integral part of said canister" and that the odour vapour filter is "interposed between said first hydrophobic filter [...] and said second hydrophobic filter".

In the Board's opinion, each of the requirements lost by deleting the inadmissible amendment has to be considered together with the added features in the light of the conditions established in G 1/99.

As regards the lost requirement that the first hydrophobic filter be attached to the canister, the addition that the first hydrophobic filter is an integral part of the canister is more specific than the two components being merely attached to each other. Hence, as far as this requirement is concerned, the

amendments fall within the first condition for an allowable exception under G 1/99. As a consequence, there is no need to keep in the claim the broader feature that the first hydrophobic filter is attached to the canister.

The addition that the second hydrophobic filter is an integral part of the canister implies an attachment which is more specific than an indirect attachment between the canister and the second hydrophobic filter. Hence, as regards the lost requirement that the canister and the second hydrophobic filter be indirectly attached to each other, the amendments also fall within the first condition for an allowable exception under G 1/99.

Similarly, the additions that the first and second hydrophobic filters are an integral part of the canister imply an attachment between those two filters which is more specific than an indirect attachment. Hence, as regards the lost requirement that the second hydrophobic filter be indirectly attached to the first hydrophobic filter, the amendments also fall within the first condition for an allowable exception under G 1/99.

As regards the lost requirements that the odour vapour filter be attached to the first and second hydrophobic filters and, indirectly, to the canister, the Board considers that in particular the addition of the feature that the odour vapour filter is "interposed between said first hydrophobic filter [...] and said second hydrophobic filter" does not limit the scope of the patent as maintained. The added feature does not imply any form of attachment. Hence, as far as these requirements are concerned, the amendments do not fall

within the first condition for an allowable exception under G 1/99. However, in the Board's view, satisfying the first condition for these requirements is impossible in this case. In the original application no form of attachment of the odour vapour filter to the other elements concerned was disclosed either in general or more specific terms. The addition of the feature that the odour vapour filter is "interposed between said first hydrophobic filter [...] and said second hydrophobic filter" constitutes an introduction of an originally disclosed feature, which however extends the scope of the patent as maintained, but within the limits of Article 123(3) EPC, as far as the relationships between the odour vapour filter and the hydrophobic filters are concerned. Hence, to a certain extent, the amendments are in the direction of the second condition for an allowable exception under G 1/99 as regards the lost requirements that the odour vapour filter be attached to the first and second hydrophobic filters. For the lost requirement of the indirect attachment of the odour vapour filter to the canister, the amendment in claim 1 of the second auxiliary request constitutes a mere deletion, falling within the third condition for an allowable exception under G 1/99. However, for this requirement, neither the first nor the second conditions can be satisfied. The Board is unable to find any part of the original application relating to any form of direct or indirect attachment of the odour vapour filter to the canister. Hence, as regards the lost requirements that the odour vapour filter be attached to the first and second hydrophobic filters and, indirectly, to the canister, the present amendments fall within the second and third conditions for an allowable exception under G 1/99, respectively allowing the deletion of the former

inadmissible amendments, and are therefore allowable.

The appellant's argument that an amendment referring directly to figure 1 would have extended by a smaller amount the protection conferred by the claim is not convincing. Due to its schematic nature, figure 1 as originally filed discloses neither more than the relative position of the odour vapour filter with respect to the hydrophobic filters as defined in claim 1 of the second auxiliary request, nor any form of indirect attachment of the odour vapour filter to the canister. Moreover, a reference to the figure such as "a system according to the arrangement of figure 1" would unduly restrict the claim in other aspects not concerned with the deleted inadmissible amendment and, also due to the schematic nature of the figure, would render the scope of the claim unclear.

For these reasons the Board concludes that the amendments made in claim 1 of the second auxiliary request are allowable in view of the exception to the principle of *reformatio in peius* as established in decision G 1/99.

5.6 *Lack of inventive step - Article 56 EPC*

5.6.1 In its arguments against inventive step of the subject-matter of claim 1 of the second auxiliary request, the appellant relied on documents D16 to D19, filed with the statement of grounds of appeal. The respondent objected to their admission into the appeal proceedings.

According to Article 12(4) RPBA, every relevant element presented by the appellant in the statement of grounds should normally be taken into account by the Board,

which however retains discretion to hold inadmissible evidence which could have been presented in the first-instance proceedings. The Board is satisfied that the filing of D16 to D19, all relating to apparatuses for suctioning fluid and comprising an odour filter and *prima facie* relevant in that context, can be seen as an admissible response to the reasoning on inventive step provided by the Opposition Division in the impugned decision.

Hence, making use of its discretion, the Board admits D16 to D19.

- 5.6.2 The respondent requested that, if D16 to D19 were admitted, the case be remitted to the Opposition Division for further prosecution.

According to Article 111(1) EPC the Board has the discretion to exercise any power within the competence of the department responsible for the decision appealed or to remit the case to that department for further prosecution. In exercising its discretion, the Board should consider several factors, including procedural efficiency and the overall length of first-instance and appeal proceedings. Another factor is the right of a party to have its case heard by two levels of jurisdiction. However, under the EPC the right of a party to have this opportunity is not absolute. In the present case, for reasons of procedural efficiency, the Board decides not to remit the case to the Opposition Division for consideration of these documents.

- 5.6.3 It is not disputed by the parties that D2, which discloses a system for stimulating the healing of tissue by applying negative pressure of the kind defined in claim 1 of the second auxiliary request,

constitutes the closest prior art.

In particular, the system disclosed in D2 comprises a vacuum pump, a canister and two hydrophobic filters. It is also undisputed that D2 does not disclose that both hydrophobic filters are an integral part of the canister and that an odour vapour filter is interposed between the hydrophobic filters.

Providing both hydrophobic filters as an integral part of the canister has the technical effect that the filters and the canister are disposed of at the same time. As also explained in the patent, column 7, lines 43 to 50, this reduces the exposure of the system to any contaminants that may be trapped by the filters.

Providing an odour vapour filter interposed between the hydrophobic filters has at least the technical effect that further fluid contaminants are prevented from reaching the second filter and the vacuum pump. There is no need for the Board to rely on Mr Locke's declaration for establishing this technical effect, which is directly derivable from the very nature of the filter. Hence, a definition of the objective technical problem based on this technical effect deducible from the application as originally filed is not in conflict with the findings in T 386/89 referred to by the appellant.

Both technical effects contribute to increasing the overall safety of a patient treated by the claimed system, as they both reduce the risk of exposure to contaminants. In this respect, the specific position of the odour vapour filter before the second hydrophobic filter is also of importance, as it helps to keep the second hydrophobic filter clean and functional. It

follows that the objective technical problem solved by the distinguishing features of the subject-matter of claim 1 over the disclosure of D2 is how to increase the safety of the system for a patient undergoing treatment.

In this respect, the Board does not accept the part-problems formulated by the appellant, because they contain pointers to the claimed solutions in that they directly express the effects starting from the distinguishing features.

The Board agrees with the appellant that odour vapour filters, for example in the form of charcoal filters, belong to common general knowledge and are known for example from D3, D16, D17 and D18. It is also agreed that the skilled person could manufacture a canister with two integral hydrophobic filters. What has to be established, however, is whether the skilled person would implement the distinguishing features in the system of D2 in an obvious way when faced with the objective technical problem formulated above.

Common general knowledge as such provides no hint to solve the formulated problem in that way.

While D3 discloses odour vapour filters which could be placed in various locations within a system, there is neither a disclosure of the combination of the distinguishing features as far as the relative positions of the filters are concerned, nor a specific teaching to provide this combination in order to solve the problem formulated.

D14 discloses a system for stimulating the healing of tissue by applying negative pressure with a filter

assembly comprising two elements separated by a spacer. Apart from the fact that it is doubtful whether the two elements are disclosed as being hydrophobic and whether the elements of the filter assembly could be interpreted as separate filters, the Board cannot share the appellant's view that the spacer should be considered an odour vapour filter within the meaning of claim 1 of the second auxiliary request. This is simply not what the skilled person would derive from the claim when reading it with a mind willing to understand and with due regard to the description. Hence, D14 does not disclose the combination of the distinguishing features in relation to the formulated problem either.

D19 concerns a system for purifying smoke plume generated from electrocautery and laser surgery in various areas of application (column 1, lines 20 to 24). It is not specifically concerned with the healing of tissue by applying negative pressure. Hence, it does not address the formulated problem. The Board concludes that the skilled person would not consider D19 at all.

As a consequence, none of the arguments presented by the appellant is convincing. There is therefore no reason for the Board to conclude that the subject-matter of claim 1 of the second auxiliary request lacks an inventive step. Hence, the requirements of Article 52(1) in conjunction with Article 56 EPC are fulfilled by claim 1 and, *a fortiori*, by its dependent claims 2 to 4.

5.7 This leads the Board to conclude that the second auxiliary request is allowable.

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 with the order to maintain the patent on the basis of:
 - claims 1 to 4 of the second auxiliary request filed during the oral proceedings;
 - adapted description (columns 1 to 11) filed during the oral proceedings; and
 - figures 1 to 5 of the patent as granted.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated