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**Datasheet for the decision
of 10 November 2016**

Case Number: T 0262/15 - 3.2.06

Application Number: 07733602.2

Publication Number: 2001424

IPC: A61F13/02, A61L15/58,
A61L26/00, C09J7/02

Language of the proceedings: EN

Title of invention:

ADHESIVE LAMINATES AND APPLICATIONS THEREOF

Patent Proprietor:

BRIGHTWAKE LIMITED

Opponents:

Mölnlycke Health Care AB
3M Innovative Properties Co.
Lohmann & Rauscher GmbH & Co. KG
Schmitt-Nilson, Gerhard, / Waibel, Stefan

Headword:

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 12(4)

Keyword:

Amendments - main request, auxiliary requests 1 to 3, added
subject-matter (yes)

Late-filed auxiliary requests, could have been filed before
first instance (yes), admitted (no)

Decisions cited:

T 1906/11, G 0002/10

Catchword:



Beschwerdekammern
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Case Number: T 0262/15 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 10 November 2016

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 December 2014
revoking European patent No. 2001424 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
E. Kossonakou

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (patent proprietor) against the decision of the opposition division revoking European Patent No. 2 001 424 because the subject-matter of claim 1 according to each of a main request, and a first to third auxiliary request failed to meet the requirement of Article 123(2) EPC.
- II. The minutes of the oral proceedings before the opposition division include the following statement:
"After a break, the chairman announced that the OD has reached the conclusion that claim 1 of MR does not fulfil the requirements of A 123(2) EPC, and asked P how he intends to proceed.
P replied that in view of the fact that the lack of compliance to the requirements of A 123(2) EPC seems to be related to the absence of the term 'film' in claim 1, all requests on file will be probably rejected. He indicated that he does not have the intention to submit a new request."
- III. With its grounds of appeal, the appellant requested that the patent be maintained according to the same main request as that before the opposition division or in the alternative according to one of the auxiliary requests 1 to 3 also as decided upon by the opposition division.
- IV. The respondents (OI, OII, OIII and OIV) each requested that the appeal be dismissed.
- V. The following documents were referred to by the parties:

D97 Evaluation of Stresses in a Two-Layer Co-

Extruded LDPE Melt Blown Film, Journal of Plastic Film and Sheeting, April 2005, vol. 21, pages 127 to 144
D98 1996 International Symposium on Bacterial Polyhydroxylalkanoates, Davos, 18 to 23 August 1996

- VI. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the subject-matter of claim 1 of the main request appeared not to meet the requirement of Article 123(2) EPC and that the same applied to the subject-matter of claim 1 of each of the auxiliary requests 1 to 3.
- VII. With letter of 6 October 2016 the appellant filed a further auxiliary request (auxiliary request 4).
- VIII. Oral proceedings were held before the Board on 10 November 2016, during which the appellant submitted documents new to the appeal procedure:

D1 US-B-6 231 872
D54 JP-A-10095072
D100 Print out of a webpage regarding Delnet® films,
www.delstarinc.com/delnet.html

The final requests of the parties were:

The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or one of auxiliary requests 1 to 3, all as filed with the statement setting out the grounds of appeal, or on the basis of auxiliary request 4 filed with the letter of 6 October 2016.

The respondents all requested that the appeal be dismissed.

IX. Claim 1 of the main request and of auxiliary requests 1 and 2 reads as follows:

"A wound dressing comprising a skin contact layer in the form of a releasably adhesive laminate comprising a melt-blown polyurethane structural layer carrying on at least part of one side thereof a hydrophobic silicone gel and carrying on at least part of the other side thereof a pressure-sensitive adhesive."

Claim 1 of auxiliary request 3 reads as follows:

"A method for the manufacture of a wound dressing comprising a skin contact layer in the form of a releasably adhesive laminate comprising a melt-blown polyurethane structural layer carrying on at least part of one side thereof a hydrophobic silicone gel and carrying on at least part of the other side thereof a pressure-sensitive adhesive, which method comprises forming the releasably adhesive laminate by:

- a) providing a preformed pre-laminate comprising the melt-blown polyurethane structural layer and the pressure-sensitive adhesive;
- b) applying to the pre-laminate a curable hydrophobic silicone gel precursor composition;
- c) causing or allowing the gel precursor composition to cure, thereby forming a layer of hydrophobic silicone gel; and
- d) introducing a regular array of perforations into the laminate."

Claim 1 of auxiliary request 4 reads as follows:

"A wound dressing comprising a skin contact layer in the form of a releasably adhesive laminate comprising a

structural layer in the form of a film of melt-blown polyurethane carrying on at least part of one side thereof a hydrophobic silicone gel and carrying on at least part of the other side thereof a pressure-sensitive adhesive."

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

The word 'however' was generally used linguistically to introduce statements that contrasted or contradicted earlier statements. It was thus clear that the features of the final sentence of the paragraph bridging pages 3 and 4 of the application as filed were in contrast with, and not in combination with, the features disclosed earlier in the paragraph. In addition, restriction of claim 1 to the only specific material disclosed for the structural layer did not present any additional technically relevant information to the skilled person not contained in the application as filed. The skilled person would understand 'melt-blown' to refer exclusively to materials produced by the process of melt-blowing. This was a clear, universally understood term. In contrast, films were understood to be structurally distinct from melt-blown materials. It followed that a material could not be both melt-blown and a film; a film was a continuous material and a melt-blown structure did not have to be. The skilled person would thus have reconciled any incompatibility through interpreting the term 'film', when used in the patent, as meaning merely a thin layer. D1 and D54 both provided evidence that a structural layer would be referred to as a film in the present technical field. D100 provided further evidence of the nature of the films disclosed in D1. Thus the structural layer of claim 1 would be considered a film by the skilled

person, thus making the explicit reference to a film in claim 1 superfluous.

If claim 1 of the main request were not allowable under Article 123(2) EPC due to the terminology 'melt-blown polyurethane', the same would apply to claim 1 of auxiliary requests 1 to 3.

As regards the admittance of auxiliary request 4, the actual statement made during oral proceedings was that it 'did not have any requests prepared'. It had also chosen to appeal against the decision, rather than acceding to the finding of the opposition division. The late filing of this request was a reaction to the Board's opinion.

XI. The respondents' arguments relevant to the present decision may be summarised as follows:

Respondent OI

The subject-matter of claim 1 did not meet the requirement of Article 123(2) EPC. Omission of the feature 'film' from claim 1 resulted in an unallowable intermediate generalisation relative to the originally filed disclosure. Claim 4 as filed, claiming a film for the first time, showed that the structural layer of claim 1 did not necessarily have to be a film.

Regarding auxiliary request 4, this should not be admitted under Article 12(4) RPBA since the problem with the foregoing requests and its solution were clearly known in the oral proceedings held before the opposition division.

Respondent OII

D100 was late filed and post-published and so should

not be admitted. The melt-blown polyurethane was consistently disclosed as a film in the application as filed (see particularly page 11, lines 26 to 27); contrary to the appellant's contention, the claimed polyurethane could thus be something other than just a non-woven material.

The filing of auxiliary request 4 at such a late stage should not be allowed. It should and could have been filed far earlier.

Respondent OIII

The arguments of the other respondents on claim 1 of the main request were agreed with. D100 lacked *prima facie* relevance and so should not be admitted. The late filing of auxiliary request 4 was not justified as an opportunity to file this had been present during the oral proceedings before the opposition division.

Respondent OIV

D100 should not be admitted. The last paragraph of page 2 and the first of page 3 of the patent disclosed thin sheets as the thin structure; a film was thus not implicitly included in claim 1 due to the claimed melt-blown polyurethane.

Reasons for the Decision

1. *Main request*
- 1.1 *Admittance of documents D1, D54, D97, D98, D100*
- 1.1.1 As regards D1 and D54 submitted by the appellant during oral proceedings before the Board, the admittance of these documents was not objected to by any of the

respondents. The Board further finds that the arguments forwarded by the appellant on the basis of these documents were not particularly complex such that the admittance of D1 and D54 would not adversely affect procedural economy. The Board thus exercised its discretion under Article 13(1) RPBA to admit D1 and D54.

1.1.2 Conversely, regarding D100, not only was this document post-published with respect to the priority of the patent in suit, but the appellant was unable to provide a *prima facie* link to the terminology in D1 which it was allegedly supposed to support. Despite D100 generally disclosing Delnet® apertured films, which was also the trade name of the film types tested in Table 1 of D1, no clear link between the films of D100 and those in Table 1 was indicated by the appellant. The Board thus considered that D100 lacked relevance, at least *prima facie*, and therefore exercised its discretion not to admit D100 into the proceedings (Article 13(1) RPBA).

1.1.3 The opposition division had exercised its discretion in deciding not to admit D97 and D98 into the opposition proceedings. In such cases, where a department of first instance has exercised its discretion, it is not the function of a Board of Appeal to review all the facts and circumstances of the case as if it were in the place of the first instance department, in order to decide whether or not it would have exercised such discretion in the same way. Rather, its competence should be limited to establishing whether the first instance department has exercised its discretion in accordance with the right principles or that it has exercised its discretion in a reasonable way (see G7/93, point 2.6).

In the present case, the opposition division presented coherent arguments as to why D97 and D98 were not admitted (see point II.4 of the opposition division's decision). The discretion appears to have been exercised both in accordance with the right principles and in a reasonable way. The Board thus confirms the decision of the opposition division, that D97 and D98 are not admitted into the proceedings.

1.2 *Article 123(2) EPC*

According to the appellant, the subject-matter of claim 1 has basis in a combination of claims 1, 2 and 11 as filed with the addition of the feature 'melt-blown polyurethane' taken from page 4, line 3 of the PCT publication. The question to answer is whether the feature 'melt-blown polyurethane' in isolation has a direct and unambiguous basis in the application as filed or whether it is only disclosed in combination with the structural layer having the form of a film.

- 1.2.1 The paragraph of the description in which the feature melt-blown polyurethane is found (page 3, line 32 to page 4, line 3) reads as follows:
- "The structural layer most preferably has the form of a relatively thin film of a synthetic plastics material. A wide variety of plastics may be suitable for use as the structural layer. Examples include polyvinylchloride, polypropylene and regenerated cellulose. However, the currently preferred material for the structural layer is polyurethane, and in particular melt-blown polyurethane."

The structure of the paragraph thus commences with a statement regarding the most preferred form of the

structural layer. It continues with examples of the wide variety of plastics suitable for use as the structural layer before stating that a particularly preferred material is melt-blown polyurethane. Not least through being in the same, short paragraph, the skilled person would read the detail presented therein as being inextricably linked. The linguistic structure of the paragraph also supports this view, with the structural nature of the structural layer first being indicated followed by ever increasing detail as to the preferred material for the structural layer. To separate the disclosure of the relatively thin film from the melt-blown polyurethane is thus held to be a counter-intuitive interpretation of the paragraph's structure and not to reflect its natural reading.

1.2.2 The presence of the word 'however' before the disclosure of the preferred and particularly preferred material for the structural layer is not held to distinguish these from everything that precedes this in the paragraph, as alleged by the appellant in its grounds of appeal. The word 'however' is found between the examples of possible materials for the structural layer and the preferred material therefor, such that the contrast made by this word can also be understood to be between the possible materials and the preferred material. The word 'however' thus, contrary to the contention of the appellant, fails to provide a direct and unambiguous separation of the particularly preferred melt-blown polyurethane material from all the foregoing statements in the paragraph.

1.2.3 The appellant's argument, that restriction of claim 1 to the only specific material disclosed for the structural layer does not convey to the skilled person any technically relevant information not contained in

the application as filed, is not accepted. The concept of 'technically relevant information' with respect to compliance with the requirement of Article 123(2) EPC (see e.g. T1906/11) does not override the so-called 'gold standard' mentioned in G2/10 (Reasons 4.3, referring to G3/89 and G11/91) by which any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively relative to the date of filing, from the whole of the description, claims and drawings as filed. In this respect, and as found in paragraphs 1.2.1 and 1.2.2 above, the melt-blown polyurethane is found to be disclosed to the skilled person only in combination with the structural layer being a film.

- 1.2.4 The appellant offered two lines of argument. Firstly, that the term 'film' was totally distinct from any melt-blown material. Secondly, that the term 'film' merely refers to a thin structural layer.

Taking the first line of argument, the Board does not accept the appellant's argument that a melt-blown material cannot be a film. The embodiment of Fig. 1, discussed from page 11, line 23 onwards of the application, discloses a structural layer 'in the form of a film of melt-blown polyurethane'. Thus, even the application itself discloses the possibility of a melt-blown polyurethane being a film. Merely because the term 'melt-blown' is, at least in the field of so-called nonwoven materials, used with regard to fibres, does not provide a universally accepted principle (as argued by the appellant) that 'melt-blown' implies the presence of a fibrous material and not a film, not least when taking account of what is disclosed in the

application itself.

1.2.5 The appellant's contention in its second line of argument, that the skilled person understood a structural layer as a film such that explicit reference in claim 1 to the film was superfluous, is also not accepted. Whilst it is accepted that D1 (col. 12, lines 46 to 57; Table 1) refers to apertured films and D54 (paragraphs [0009] to [0010]) refers to a base layer as a film, this does not provide an unambiguous basis for a film to be regarded either generally as equivalent to the claimed structural layer or even specifically so in the application as filed. Within the application itself, a film is also differentiated as being something other than just a structural layer. This is evident from claim 4 as filed, which is dependent on claim 1, yet which presents the first indication that the structural layer of claim 1 can be a film; as a consequence the term 'structural layer' must be broader in scope than to encompass just a film. The paragraphs bridging pages 2 and 3 further support this since the polyurethane structural layers disclosed here are thin sheets of polyurethane foam, no mention being made of film (apart from a carrier film). It follows that the claimed structural layer could also be something other than a film, the implicit inclusion of a film in claim 1 not being achieved simply through a structural layer being claimed.

1.2.6 In summary it thus follows that there is no direct and unambiguous basis for the subject-matter of claim 1, particularly regarding the feature 'melt-blown polyurethane' being taken-up into claim 1 in isolation from the feature regarding the structural layer having the form of a film. The subject-matter of claim 1 thus fails to meet the requirement of Article 123(2) EPC.

1.2.7 The main request is therefore not allowable.

2. *Auxiliary requests 1 to 3*

2.1 *Article 123(2) EPC*

Claim 1 of both auxiliary requests 1 and 2 are identical to that of the main request. Claim 1 of auxiliary request 3 also includes all features of claim 1 of the main request. The conclusion under Article 123(2) EPC with respect to the subject-matter of claim 1 of the main request thus applies *mutatis mutandis* to the subject-matter of claim 1 of each of auxiliary requests 1 to 3. At oral proceedings the appellant also offered no further arguments in defence of these requests beyond those already presented with respect to the main request and agreed that the same conclusions would apply. The Board thus sees no reason to reach a different conclusion.

The subject-matter of claim 1 of each of the auxiliary requests 1 to 3 thus fails to meet the requirement of Article 123(2) EPC. Auxiliary requests 1 to 3 are therefore also not allowable.

3. *Auxiliary request 4*

Admittance - Article 12(4), Rules of Procedure of the Boards of Appeal (RPBA)

3.1 During oral proceedings before the opposition division, the subject-matter of claim 1 of the main request and that of each of auxiliary requests 1 to 3 was found not to meet the requirement of Article 123(2) EPC. The sole reason for this was common to all the requests and

concerned the lack, in claim 1, of the feature regarding the claimed structural layer being a film.

- 3.2 The opposition division, as indicated in the relevant portion of the minutes cited under point II above, not only explained the reason for its finding under Article 123(2) EPC but also received an explicit statement from the proprietor that he did not intend to file a new request.
- 3.3 The proprietor's choice not to file any amended or auxiliary request in light of these circumstances is found by the Board to be of importance in considering the admissibility of the present request in the appeal proceedings in accordance with Article 12(4) RPBA.
- 3.4 Article 12(4) RPBA reads as follows:
"(4) Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirement in (2)."
- 3.5 Article 12(4) RPBA thus gives a Board the discretion to hold any request as inadmissible if it could have been presented in the first-instance proceedings. In the present case it is thus necessary to decide whether indeed auxiliary request 4 could have been presented in the first instance proceedings.
- 3.6 As evident from the minutes of the oral proceedings before the opposition division (see point II above), it was clearly indicated during oral proceedings why the opposition division found that the subject-matter of

claim 1 of the main request failed to meet the requirement of Article 123(2) EPC; the absence of the term 'film' from claim 1 was explicitly identified in this respect. It is thus evident that the proprietor had all the information necessary to be able to formulate a claim to overcome the finding regarding Article 123(2) EPC at the oral proceedings.

3.7 Despite this, the proprietor elected not to file a request overcoming the problem at that time. This deliberate choice made by the proprietor, despite being given the opportunity to do so after the objection had been explained, is found by the Board to precisely correspond to the situation envisaged in Article 12(4) RPBA.

3.8 The appellant's argument, that it had actually stated that it 'had no requests prepared' in response to the opposition division's conclusion under Article 123(2) EPC, is not supported by the file nor does it change the Board's finding. First, the appellant did not object to the minutes of oral proceedings before the opposition division in which it had been noted that the proprietor 'does not have the intention to submit a new request'. More importantly, there is no mention in either the minutes or the decision of a request for permission and/or time to prepare a request overcoming the objection under Article 123(2) EPC having been made. The Board is thus compelled to conclude that this was evidently a deliberate choice.

3.9 The further argument of the appellant, that it had chosen to appeal against the decision of the opposition division rather than accede to the Article 123(2) EPC finding, this being indicative of its desire to further defend the opposed patent, is also not persuasive with

respect to admitting auxiliary request 4 in these proceedings. The proprietor is solely responsible for the requests it presents and the timing of their filing. The filing of an appeal is not per se sufficient justification for the admission of any and all requests presented with it or in its course. If a proprietor wishes not to present amended requests before the first instance but rather pursue these in appeal, it must accept that this runs the risk of not having the requests admitted into the appeal proceedings.

- 3.10 The further argument of the appellant that it had filed the request in response to the preliminary opinion of the Board and thus at an appropriate time is not accepted. As indicated above, the appellant had been given precise indications during opposition oral proceedings of how the objection under Article 123(2) EPC could be overcome. The Board considers this to have been the appropriate time at which the appellant could reasonably have attempted to overcome the objection. The Board's communication did not raise new issues or different, perhaps surprising, objections which hence justified a reaction at that stage. It is just such a situation which Article 12(4) RPBA envisages in providing the Board with the discretion not to admit such a request.
- 3.11 In view of all the above, the Board decided to exercise its discretion in not admitting auxiliary request 4 into the proceedings (Article 12(4) RPBA).
4. No further requests for maintenance of the patent were filed by the appellant.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated