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**Datasheet for the decision
of 6 July 2016**

Case Number: T 0675/15 - 3.3.10

Application Number: 10181916.7

Publication Number: 2279767

IPC: A61L29/04, A61L29/14, A61L29/08

Language of the proceedings: EN

Title of invention:
Urinary catheter

Patent Proprietor:
Dentsply IH AB

Opponents:
Coloplast A/S
Hollister Incorporated

Headword:

Relevant legal provisions:
EPC Art. 100 (c), 123 (2)

Keyword:
Added subject-matter (yes) - all requests

Decisions cited:

Catchword:



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Case Number: T 0675/15 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 6 July 2016

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 5 February 2015 revoking European patent No. 2279767 pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: R. Pérez Carlón
C. Schmidt

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division to revoke European patent No. 2 279 767.
- II. Two notices of opposition had been filed, on the grounds of added subject-matter (Article 100(c) EPC), insufficiency of disclosure (Article 100(b) EPC), and lack of novelty and inventive step (Article 100(a) EPC).
- III. The opposition division concluded *inter alia* that claim 1 of the patent as granted contained added subject-matter. Claim 1 of auxiliary request I found a basis in the combination of claims 1, 2 and 9 as originally filed, but the urinary catheter of said claim was not inventive. Claim 1 of the remaining auxiliary requests then pending either contained added subject-matter for the same reasons as the main request, or was not inventive for the same reasons as auxiliary request I.
- IV. Claim 1 of the main request, which corresponds to the claims as granted, reads as follows:

"A urinary catheter comprising a substrate forming an elongate shaft, having on its surface, on at least an insertable part thereof, a hydrophilic surface layer providing low-friction surface character of the medical device when wetted by a wetting fluid, wherein the substrate is made of a polymer blend comprising a polyolefin and a composition having molecules with active hydrogen(s) bound to the molecules via nitrogen, wherein the molecules with active hydrogen(s) are at least one of amides, amines and urethanes."

Auxiliary request I corresponds to that pending during opposition proceedings. Claim 1 of this request reads as follows:

"A urinary catheter comprising a substrate forming an elongate shaft, having on its surface, on at least an insertable part thereof, a hydrophilic surface layer providing low-friction surface character of the medical device when wetted by a wetting fluid, wherein the substrate is made of a polymer blend comprising a polyolefin and a polymer composition having molecules with active hydrogen(s) bound to the polymer via nitrogen, wherein the molecules with active hydrogen(s) are at least one of amides, amines and urethanes."

Claim 1 of auxiliary requests III, V and VII contains, like claim 1 of the main request, the feature *"wherein the substrate is made of a polymer blend comprising a polyolefin and a composition having molecules with active hydrogen(s) bound to the molecules via nitrogen, wherein the molecules with active hydrogen(s) are at least one of amides, amines and urethanes."*

Claim 1 of auxiliary requests II, IV, VI and VIII contains, like claim 1 of auxiliary request I, the feature *"wherein the substrate is made of a polymer blend comprising a polyolefin and a polymer composition having molecules with active hydrogen(s) bound to the polymer via nitrogen, wherein the molecules with active hydrogen(s) are at least one of amides, amines and urethanes."*

V. The arguments of the appellant relevant for the present decision were the following:

Claim 1 of each of the requests on file found a basis

in the passages of the description on page 3, lines 2-6 and 32-34. The first of these passages disclosed molecules having active nitrogen(s) as at least one of amides, amines and urethanes, and that implicitly provided a basis for the features of claim 1 of the main request. The same applied to claim 1 of auxiliary requests II, V and VII.

Claim 1 of auxiliary request I, which required a polymer composition, found a basis on page 3, lines 32-34. That also applied to claim 1 of auxiliary requests III, IV, VI and VIII.

VI. The arguments of the respondents relevant for the present decision were the following:

There was no word-by-word basis for amended claim 1 of the main request, in particular for the feature "molecules with active hydrogen(s) bound to the molecules via nitrogen", and the passages relied upon by the appellant did not provide a basis, either explicit or implicit. For that reason, claim 1 of the main request contained added subject-matter.

With respect to claim 1 of auxiliary request I, there was no basis for the features "a polymer composition" and "a molecule with active hydrogens(s) bound to the polymer via nitrogen" in the application as originally filed. Claim 1 of the remaining auxiliary requests had the same deficiencies as that of the main request or of auxiliary request I. For that reason, all the auxiliary requests on file contained added subject-matter.

VII. Oral proceedings before the board of appeal took place on 6 July 2016.

VIII. The final requests of the parties were the following:

- The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or - alternatively - on the basis of one of auxiliary requests I to VIII, all auxiliary requests having been filed with the letter setting out the grounds of appeal dated 15 June 2015.
- The respondents requested that the appeal be dismissed.

IX. At the end of the oral proceedings, the decision was announced.

Reasons for the Decision

1. The appeal is admissible.

Added subject-matter

2. Main request

2.1 Claim 1 of the main request is directed to a urinary catheter whose substrate is made of a polymer blend comprising a polyolefin and a composition having molecules with active hydrogen(s) bound to the molecules via nitrogen, wherein the molecules with active hydrogen(s) are at least one of amides, amines and urethanes.

The features "bound to the molecules via nitrogen, wherein the molecules with active hydrogen(s) are at least one of amides, amines and urethanes" were not present in claim 1 as originally filed.

The appellant acknowledged that the application as originally filed did not contain a word-by-word basis for that feature, but argued that the passages on page 3, lines 2-6 and 32-34, nevertheless provided the required basis for the amendments made. The passage on page 3, lines 2-6 reads as follows:

"Molecules with active hydrogen(s) are molecules having hydrogen that is prone to react with other substances, and thus to leave its position in the molecule. Examples of such compositions having molecules with active hydrogen groups are alcohols, amides, amines, urethanes and acids."

The passage on page 3, lines 32-34 reads:

"Preferably, the composition having molecules with active hydrogen(s) is a polymer having active hydrogen(s), and most preferably a polymer having active hydrogen(s) bound to the polymer via nitrogen."

By requiring the molecules with active hydrogens to be at least one of amides, amines and urethanes, the requirement that the active hydrogen(s) should be linked to the active molecule via nitrogen was redundant and, for that reason, claim 1 did not contain any added subject-matter.

- 2.2 The features "having active hydrogen(s) bound to the molecules via nitrogen" and "the molecules with active hydrogen(s) are at least one of amides, amines and urethanes" are independent requirements.

Both requirements could be fulfilled simultaneously, for example by a molecule having an amine moiety of the

type R-NH₂. However, an amine, amide or urethane moiety does not necessarily bear a hydrogen. For this reason, despite containing at least one of these functional groups, a molecule may have active hydrogen(s) linked to it at a different part of the molecule, via an atom different from nitrogen. For these reasons, the first of the passages quoted fails to provide the required basis.

2.3 The passage on page 3, lines 32-24, and claim 2 as originally filed disclose a *polymer* having active hydrogen(s). In contrast, claim 1 requires a *molecule* having active hydrogen(s). For this reason, the passage cited and claim 2 as originally filed also fail to provide the required basis for the features of claim 1 of the main request.

2.4 The appellant argued that a polymer blend was, by definition, a mixture of polymers. As claim 1 required a blend, the molecule having active hydrogens was necessarily a polymer.

However, the open wording of claim 1 "comprising" contemplates the presence of components in addition to those it explicitly recites. Thus, it also contemplates polyolefin blends containing non-polymeric components. For that reason, the wording of claim 1 does not necessarily restrict the molecule having active hydrogen(s) to a polymer.

2.5 The main request thus contains added subject-matter, and the ground under Article 100(c) EPC precludes the maintenance of the patent as granted.

3. Auxiliary requests III, V and VII

3.1 The appellant has not disputed that the conclusion on added subject-matter with respect to the main request applies *mutatis mutandis* to claim 1 of auxiliary requests III, V and VII, which are thus not allowable.

4. Auxiliary request I

4.1 Claim 1 of auxiliary request I is directed to a urinary catheter whose substrate is made of a polymer blend comprising a polyolefin and a polymer composition having molecules with active hydrogen(s) bound to the polymer via nitrogen, wherein the molecules with active hydrogen(s) are at least one of amides, amines and urethanes.

4.2 As a basis, the appellant relied on the passages quoted with respect to the main request and on the combination of claims 1, 2, 4 and 9 as originally filed.

However, claim 2 and page 3, lines 32-34, disclose that the composition having molecules with active hydrogen(s) is a polymer wherein the active hydrogen(s) is bound to the polymer via nitrogen.

In contrast, claim 1 of auxiliary request 1 requires a polymer *composition* having *molecules* with active hydrogen(s) bound to the polymer via nitrogen. The feature of claim 1 "hydrogen bound to the polymer via nitrogen" does not limit the molecule containing active hydrogens to a polymer, as an acid hydrogen may, at the same time, be part of a non-polymeric molecule and be linked to a different molecule, such as a polymer, via a hydrogen bond.

4.3 The appellant argued that the feature in claim 1 covered the same subject-matter as claim 2 as

originally filed. As claim 1 required a polymer blend *comprising* a polyolefin, it was irrelevant whether the second component was defined as a polymer composition or as a polymer, as additional components were nevertheless contemplated by both wordings. Thus, claim 1 did not relate to subject-matter not originally disclosed.

However, this argument does not alter the fact that claim 1 requires a polyolefin, a polymer, and a molecule having active hydrogen(s), which may or may not be said polymer, whereas the combination of claim 1 as originally filed with claim 2, or with the embodiment on page 3, lines 32-34, of the description requires a polyolefin and a polymer having active hydrogen(s).

- 4.4 For these reasons, it is concluded that claim 1 of auxiliary request I contains added subject-matter and for that reason is not allowable.
- 5. Auxiliary requests II, IV, VI and VIII
 - 5.1 It is not disputed that the conclusion with respect to added subject-matter reached for auxiliary request I applies *mutatis mutandis* to claim 1 of auxiliary requests II, IV, VI and VIII. For this reason, none of these requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated