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**Datasheet for the decision
of 24 July 2018**

Case Number: T 1692/17 - 3.2.02

Application Number: 10174741.8

Publication Number: 2255837

IPC: A61M1/00, A61F13/00, A61L15/42

Language of the proceedings: EN

Title of invention:
Process for making a porous pad for use in a wound therapy device

Patent Proprietor:
KCI Licensing, Inc.

Opponent:
Paul Hartmann AG

Headword:

Relevant legal provisions:
RPBA Art. 12(4), 13(1), 13(3)
EPC Art. 76(1), 100(c), 111(1), 123(2)

Keyword:

Grounds for opposition - subject-matter of the patent as granted extends beyond content of earlier application (yes)
Late-filed auxiliary requests - admitted (yes)
Auxiliary requests - subject-matter extends beyond content of earlier application - first to third (yes) - fourth (no)
Fourth auxiliary request - extension beyond the content of the application as filed (no)
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

T 0055/17

Catchword:



Beschwerdekammern
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Case Number: T 1692/17 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 24 July 2018

Appellant: KCI Licensing, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 1 June 2017
revoking European patent No. 2255837 pursuant to
Article 101(2) EPC**

Composition of the Board:

Chairman E. Dufrasne
Members: D. Ceccarelli
P. L. P. Weber

Summary of Facts and Submissions

- I. The patent proprietor has appealed against the Opposition Division's decision, dispatched on 1 June 2017, to revoke European patent No. 2 255 837.
- II. The patent is derived from a divisional application of European patent application No. 00 920 207.8. This latter application was the basis for the grant of European patent No. 1 169 071, which is the subject of decision T 55/17.

The Opposition Division held that the patent in suit contained subject-matter extending beyond the content of the parent application as filed. As a consequence, the ground for opposition according to Article 100(c) EPC prejudiced the maintenance of the patent.

- III. The patent was opposed on the grounds of insufficient disclosure (Article 100(b) EPC) and added subject-matter (Article 100(c) EPC).
- IV. Notice of appeal was received on 31 July 2017. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 10 October 2017.
- V. The Board summoned the parties to oral proceedings. Under point 2 of the communication accompanying the summons the Board drew attention to the respondent's objection against the omission of the feature in claim 1 of the patent as granted whereby a surface of the mentioned pad was intended for contact with a surface of the wound.

VI. Oral proceedings took place on 24 July 2018.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or, in the alternative, on the basis of one of the first to third auxiliary requests, filed with letter dated 10 October 2017, and fourth and fifth auxiliary requests, filed with letter dated 22 June 2018.

The respondent requested that the appeal be dismissed.

VII. **Claim 1 of the patent as granted** reads as follows:

"A process for making a porous pad (36) for providing a reduced pressure in a therapeutic apparatus for stimulating the healing of a wound, the process comprising:

providing a porous pad (36) having pores (205) greater than 100 microns in diameter;

reducing a portion of the pores (205) on a surface (203, 204, 206) of the pad to a size of 100 microns or less in diameter, by dipping said portion of the pad in a liquid coating material (201) and permitting the material to dry, wherein the liquid coating material (201) acts as a bulking agent thereby reducing the diameter of the pores (207); and

providing an opening in the pad for receipt of a vacuum tube (37)."

Compared with claim 1 of the patent as granted, **claim 1 of the first auxiliary request** comprises the following

additional wording at the end of the claim:

"wherein the portion of the pad is the portion which is to be placed inside the wound".

Compared with claim 1 of the patent as granted, in **claim 1 of the second auxiliary request** the term "opening" is replaced by the term "incision".

Compared with claim 1 of the patent as granted, **claim 1 of the third auxiliary request** comprises both the amendment according to the first auxiliary request and the amendment according to the second auxiliary request.

Compared with claim 1 of the patent as granted, **claim 1 of the fourth auxiliary request** comprises the following additional wording at the end of the claim:

"wherein the portion of the pad is the portion which is intended for contact with a surface of a wound".

Compared with claim 1 of the patent as granted, **claim 1 of the fifth auxiliary request** comprises both the amendment according to the fourth auxiliary request and the amendment according to the second auxiliary request.

VIII. The appellant's arguments where relevant to the present decision may be summarised as follows:

Patent as granted - added subject-matter

The subject-matter of claim 1 of the patent as granted found a basis mainly on page 8, lines 14 to 21, of the

parent application as originally filed.

Although claim 1 did not recite any specific relation with the wound, the claimed dipping of a portion of the pad in a liquid coating material inherently made that portion suitable for contact with a surface of the wound. Hence, this suitability, expressly stated in claims 1 and 10 of the parent application as filed, was retained in claim 1 of the patent as granted.

It was clear from the description that a part of the pad became suitable for insertion into a wound or for contact with a surface of the wound by virtue of being dipped in the liquid coating material to form a smooth outer surface over that part of the pad. All the pores on the portion of the surface dipped in the liquid would assume the smaller size. The parent application did not teach that that portion of the outer surface had to be a complete side of the pad. Page 8, lines 9 to 14, generally referred to a "portion to be inserted into the wound cavity". Although other features were shown and described in relation to figures 11 and 12, they were neither essential for the claimed invention nor inextricably linked to the claimed features. For example, the reduction of the diameter of the pores on the portion of the surface of the pad dipped in the liquid coating material was clearly independent of the presence of the tube in the pad.

The Opposition Division had been incorrect to conclude that the term "opening" in claim 1 did not find a basis in the parent application as originally filed. The description, for example page 7, lines 11 to 15, and figures 11 and 12 showed a porous pad with a tube within the pad. An incision and an elongated hole as examples of openings for receiving the tube were

mentioned together with several ways of securing the tube within the pad. The presence of the tube was separate from any specific manufacturing technique for providing the opening. The description of figure 11 on page 8, lines 24 to 25, simply stated that a vacuum tube was shown in a side of the pad. That passage made it implicit that there had to be an opening in the pad, but there was no specific disclosure of how that opening had been formed. Furthermore, the specific passage on page 8, lines 14 to 21, on which the subject-matter of claim 1 was mainly based, did not mention any placement of the tube.

It followed that the subject-matter of claim 1 of the patent as granted had a basis in the parent application as originally filed.

Admissibility of the first to fifth auxiliary requests

The first to third auxiliary requests had been filed with the statement of grounds and addressed the objections raised in the impugned decision.

The fourth and fifth auxiliary requests had been filed in response to the communication accompanying the summons to oral proceedings, more than one month before the oral proceedings. The fourth auxiliary request, in particular, was comparable in scope with the first auxiliary request and addressed the Board's remarks under point 2 of the communication. The fifth auxiliary request was comparable in scope with the third auxiliary request, as it comprised the amendments according to the fourth and second auxiliary requests.

All the auxiliary requests should be admitted into the proceedings.

Auxiliary requests - added subject-matter

The amendment carried out in claim 1 of the first auxiliary request was literally based on page 8, lines 14 to 15, of the parent application as originally filed. The suitability of the portion of the pad dipped in the liquid coating material for contact with a surface of the wound was implicitly provided by the other features of the claim. The amendment carried out in claim 1 of the fourth auxiliary request explicitly stipulated that the portion of the pad dipped in the liquid coating material was for contact with the surface of the wound. The term "intended for" was appropriate for the definition of a process, since it specified the portion that had to be dipped in the liquid coating material.

It followed that the subject-matter of claim 1 of all the auxiliary requests had a basis in the parent application as originally filed.

- IX. The respondent's arguments where relevant to the present decision may be summarised as follows:

Patent as granted - added subject-matter

The parent application as originally filed stipulated that the portion of the pad dipped in a liquid coating material was the portion adapted for contact with a wound surface. Claim 1 of the patent as granted did not specify any relationship between the pad and the wound but simply specified that some of the pores on any portion of the surface of the pad were dipped in a liquid coating material and were 100 microns or less in diameter. This resulted in an extension of subject-matter.

The passage mentioning the process for making a porous pad on page 8, lines 14 to 21, could not be read in isolation from figures 11 and 12 and the further description of those figures on page 8, line 22, to page 9, line 13, of the parent application as originally filed. Together, those parts of the disclosure, which related to a specific embodiment, conveyed the information that a complete side of the pad was dipped in the liquid coating material. All the pores on that side had to be 100 microns or less in diameter. Moreover, the subject-matter of claim 1 of the patent as granted did not comprise several other features that were part of that specific embodiment of the parent application as originally filed. For example, according to page 8, lines 25 to 29, the pad was "dipped to approximately 1 millimeter into a liquid coating material [...] held in flat tray"; page 9, lines 4 to 5, explained that the pad had a "varying porosity on one surface (with tube)"; page 8, lines 24 to 25, in conjunction with the figures made it clear that the tube was in the pad when the latter was dipped in the liquid and, more particularly, was in a side of the pad perpendicular to the side that was dipped. The omission of all those features in claim 1 of the patent as granted resulted in a non-allowable intermediate generalisation. In particular, from a technical point of view it was important to have the tube in the pad when the latter was dipped in the liquid coating material because if it had to be inserted into the pad after the dipping, its insertion could cause the closure of some of the pores on the surface and the liquid coating material could obstruct the opening for receiving the tube, which was undesirable.

The embodiment of figures 11 and 12 could not provide a

basis for the feature of "providing an opening in the pad for receipt of a vacuum tube" either. When the pad was dipped in the liquid, the tube was already in place in the pad. The passage on page 7, lines 11 to 23, of the parent application as originally filed did not relate to the embodiment of figures 11 and 12. Moreover, that passage only disclosed the feature of making an incision in the pad together with inserting the end of the tube in that incision, or the presence of an elongated hole for receiving and securing the tube by means of an interference fit. However, no feature relating to any insertion or securement of the tube was present in claim 1 of the patent as granted.

For all these reasons the subject-matter of claim 1 of the patent as granted extended beyond the content of the parent application as originally filed.

Admissibility of the first to fifth auxiliary requests

The first to third auxiliary requests could and should have been filed before the Opposition Division. Moreover, the first and second auxiliary requests defined non-convergent subject-matter, which went against procedural economy. The Board should not admit them under Article 12(4) RPBA.

The same applied to the fourth and fifth auxiliary requests, which had been filed even later and could not be regarded as a reaction to any unexpected development in the appeal proceedings.

Auxiliary requests - added subject-matter

The amendments carried out in the auxiliary requests did not overcome the objections against claim 1 of the

patent as granted.

As far as claim 1 of the fourth auxiliary request was concerned, the definition of the portion of the pad "intended for contact with a surface of a wound" was different in meaning from the definition in claim 1 of the parent application as originally filed according to which an outer surface of the pad was "adapted for contact with a surface of said wound". The latter definition required an adaptation which was not defined in claim 1 of the fourth auxiliary request. Its omission presented the skilled person with information which was not directly and unambiguously derivable from the parent application as originally filed.

Reasons for the Decision

1. The appeal is admissible.
2. The invention

The invention relates to a process for making a porous pad for providing a reduced pressure in a therapeutic apparatus for stimulating the healing of a wound.

According to the description, the apparatus is for the application of negative pressure to an area around the wound in order to promote migration of epithelial and subcutaneous tissue towards the wound.

The process comprises providing a porous pad having pores greater than 100 microns in diameter, reducing a portion of the pores on a surface of the pad to a size of 100 microns or less by dipping the pad in a liquid coating material, and providing an opening in the pad

for receipt of a vacuum tube.

An objective of the invention is to avoid the spread of infection through the pad and the vacuum line. According to the patent, this is achieved by providing a pad having a sufficiently small pore size such that granulation tissue does not migrate into the pad (column 2, lines 19 to 22) and skin regrowth into the pad is also prevented (column 3, lines 9 to 13 and 28 to 34). More particularly, the pad is manufactured with a surface intended, in use, to be in contact with the wound, which has pores 100 microns or less in diameter.

3. Patent as granted - added subject-matter

3.1 The subject-matter of claim 1 of the patent as granted seeks a basis mainly on page 8, lines 14 to 21, of the parent application as originally filed.

As the respondent correctly submitted, this passage is only a part of the detailed description of a specific embodiment of a method for manufacturing a porous pad, presented on page 8, line 14, to page 9, line 13, with reference to figures 11 and 12. The general part of the description of the invention, in particular as far as the features of the pad are concerned, has to apply to this specific embodiment too.

However, this alone cannot support the respondent's argument that, as some of the technical features of that specific embodiment are introduced into claim 1, other features of the embodiment should be introduced too, in order for the subject-matter of the claim not to extend beyond the content of the parent application as originally filed. In the Board's view, what has also to be assessed is whether the skilled person, in view

of the disclosure as a whole, is taught that, from a technical point of view, the introduced features are inextricably linked to other features of the embodiment. In that case leaving the other features out of the claim would convey the new technical information that that link was optional. On the contrary, if there were no technical relationship between the introduced features and other features of the specific embodiment, for example because they serve distinct technical purposes, in the absence of an express teaching to the contrary leaving those other features out of the claim would not present the skilled person with any new technical information. Hence, the claimed subject-matter would not extend beyond the content of the parent application as filed.

- 3.2 Many of the features of the specific embodiment which, in the respondent's view, could not be left out of claim 1 of the patent as granted are not technically inextricably linked to the claimed subject-matter. The latter, as explained above, specifically concerns the reduction of the size of the pores on a surface of a porous pad to be brought into contact with a wound, with the main purpose that granulation tissue does not migrate into the pad and skin regrowth into the pad is prevented. This is done by dipping a portion of the pad in a liquid coating material which "acts as a bulking agent thereby reducing the diameter of the pores". It follows that, contrary to the respondent's view, the claim requires that the pores on the surface of the dipped portion are of a size of 100 microns or less in diameter.

The Board does not see how - and the respondent has not explained why - dipping a complete side of the pad to approximately 1 millimeter into a liquid coating

material held in flat tray, or providing the pad with a varying porosity on the surface with the vacuum tube, or providing the tube in a side of the pad perpendicular to a side dipped in the liquid, would be of any technical relevance for the main purpose of the claimed subject-matter. In particular, the shape of the portion to be dipped depends on the specific wound to be treated (figures 10 and 14A to 16 of the parent application as filed).

The argument that the tube had to be in the pad when the latter was dipped in the liquid coating material in order not to risk, by its later introduction, closing some pores of the surface in which it would be introduced and in order to prevent the obstruction of the opening for receiving the tube by the liquid coating material is not convincing. According to the parent application as originally filed (for example figures 10 to 18), the tube goes through a portion of the surface of the pad which is not to be brought into contact with the wound. This is technically obvious, as otherwise the tube would have to contact the wound surface and possibly hinder the healing process. Hence, closing some pores of that portion of the surface would have no impact on the main purpose of the claimed subject-matter as explained above. Moreover, it would fall under the normal activities of the skilled person to provide the opening for receiving the tube after dipping the pad in the liquid coating material or to protect such opening if there were any risk of obstructing it during the dipping process.

It follows that leaving out of claim 1 of the patent as granted the features mentioned by the respondent and dealt with under this point does not extend the subject-matter of the claim beyond the content of the

parent application as originally filed.

- 3.3 As far as the feature of "providing an opening in the pad for receipt of a vacuum tube" is concerned, the Board does not accept the respondent's argument that the passage on page 7, lines 11 to 23, of the parent application as originally filed does not relate to the embodiment of figures 11 and 12. That passage is not presented as being specific to any method of providing a porous pad with pores of a reduced size on a surface to be brought into contact with a wound, but relates to the provision of a vacuum tube in the pad. How and when the pad, and in particular that surface, are manufactured is technically unrelated to the provision of the tube. Hence, the skilled person recognises that the passage on page 7, lines 11 to 23, also applies to the embodiment of figures 11 and 12.

That passage expressly mentions the provision of an "incision" in the pad for inserting the end of the vacuum tube. It also discloses that the tube could be secured within the pad "using any suitable means", and "preferably" an "elongated hole" could provide an interference fit with the vacuum tube. Hence, the passage discloses some examples of an opening in the pad for receipt of a vacuum tube without giving any particular importance to the nature of the opening itself. The description of figure 11 on page 8, lines 24 and 25, does not give any importance to the nature of the opening either, as it simply states that a vacuum tube is in a side of the pad. Finally, the nature of the opening is unrelated to the main technical purpose of the claimed subject-matter of preventing migration of granulation tissue and skin regrowth into the pad. Hence, the general wording "providing an opening in the pad for receipt of a

vacuum tube" does not introduce any subject-matter extending beyond the content of the parent application as originally filed.

- 3.4 The Board does however agree with the respondent that the parent application as originally filed conveyed the technical information that the portion of the pad surface with smaller pores had to be for contact with a wound surface. This feature, present in all independent claims of the parent application as originally filed and consistently referred to in the description, is also inextricably linked, from a technical point of view, to the claimed pore size reduction: it is the pore size reduction on a portion of the pad surface intended to be, in use, in contact with the wound surface that serves the purpose of preventing migration of granulation tissue and skin regrowth into the pad.

Omitting the feature whereby the portion of the pad dipped in the liquid coating material is for contact with the wound surface presents the skilled person with the new information that such suitability is merely optional and that the invention could, for example, also relate to pads needing some other elements to be interposed between them and the wound surface.

The appellant's argument that the claimed dipping of a portion of the pad in a liquid coating material inherently made that portion suitable for contact with a surface of the wound is not convincing, as such suitability requires further properties, for example in relation to sterility, smoothness and tissue compatibility (page 3, lines 12 to 18, of the parent application as originally filed).

It follows that the subject-matter of claim 1 of the

patent as granted extends beyond the content of the parent application as originally filed. Hence, the ground for opposition according to Article 100(c) EPC prejudices the maintenance of the patent as granted.

4. Admissibility of the first to fifth auxiliary requests

4.1 The appellant's first to third auxiliary requests were filed with its statement of grounds of appeal.

Under Article 12(4) RPBA, everything presented by the appellant in the statement of grounds is to be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements of Article 12(2) RPBA. However, the Board retains discretion to hold inadmissible requests which could have been presented in the first-instance proceedings.

No objection under Article 12(2) RPBA was raised by the respondents against the first to third auxiliary requests, and the Board does not have any either. As the appellant pointed out, compared to claim 1 of the patent as granted, in claim 1 of the first to third auxiliary requests there are features the omission of which was considered a non-allowable generalisation in the impugned decision (points 2.2.2 and 2.2.5 to 2.2.7 of the reasons). For this reason the Board considers those requests an appropriate reaction to the reasons presented in that decision. The amendments carried out do not raise new substantive issues either. The respondent's argument that the first and second auxiliary requests define non-convergent subject-matter going against procedural economy is not accepted, as those requests each deal with a different objection, while the third auxiliary request sums up

the amendments of the previous two. They are therefore rather an attempt to speed up the appeal proceedings. Hence, the Board does not find any convincing reasons for not admitting the first to third auxiliary requests into the proceedings.

- 4.2 The fourth and fifth auxiliary requests constitute amendments to the appellant's case made after it had filed its statement of grounds and after oral proceedings had been arranged.

Under Article 13(1) RPBA the admission of such amendments into the appeal proceedings is at the Board's discretion, which is to be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Under Article 13(3) RPBA such amendments are not to be admitted if they raise issues which the Board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

The Board notes that the fourth and fifth auxiliary requests were presented in response to a specific observation made under point 2 of the annex to the summons to oral proceedings. In particular, compared respectively with the first and third auxiliary requests, the fourth and the fifth auxiliary requests are simply more specific in the definition in claim 1 of the relation between the portion of the pad dipped in the liquid coating material and the wound. The filing of the fourth and fifth auxiliary requests more than one month before the oral proceedings gave the Board and the respondents enough time to consider them, especially in view of the fact that their claims do not constitute complex new subject-matter: they do not

raise new issues for the respondents, as they address objections already present in the first-instance proceedings. In view of these circumstances the Board exercises its discretion under Article 13(1) and (3) RPBA and admits the fourth and fifth auxiliary requests into the proceedings.

4.3 Hence, the first to fifth auxiliary requests are in the proceedings.

5. Auxiliary requests - added subject-matter

5.1 In claim 1 of the first to third auxiliary requests the portion of the pad dipped in the liquid coating material is still not defined as being for contact with the wound surface.

The appellant's argument that the amendment carried out in claim 1 of the first auxiliary request was literally based on page 8, lines 14 to 15, of the parent application as originally filed is of little relevance, since that passage cannot be read in isolation from the rest of the description. In other words, in its context that passage, referring to a "portion of the pad 36 which is to be placed inside the wound", places an additional separate limitation on the pad portion in addition to its suitability for contact with the wound surface. The definition of the suitability for placement inside a wound does not imply suitability for contact with a wound surface, since an element could be interposed between the pad and the wound surface, with the pad still being "inside the wound".

It follows that the patent cannot be maintained on the basis of one of the first to third auxiliary requests, as those requests contain subject-matter which extends

beyond the content of the parent application as originally filed. Hence, they contravene Article 76(1) EPC.

- 5.2 In claim 1 of the fourth auxiliary request the pad portion dipped in the liquid coating material is defined as "intended for contact with a surface of a wound". The respondent considered that in claim 1 of the parent application as originally filed the wording "adapted for contact with a surface of said wound" implied a specific adaptation of the outer surface of the pad, not required by the wording of claim 1 of the fourth auxiliary request. Hence, in the latter some information was lost compared to the parent application as originally filed, which was in contravention of Article 76(1) EPC.

On a technically meaningful contextual reading the Board, in the present case, sees no difference between the expressions "intended for" and "adapted for". It is also noted that the respondent did not explain of what the alleged difference should consist. It follows that the definition of the pad portion dipped in the liquid coating material "intended for contact with a surface of a wound" in claim 1 of the fourth auxiliary request removes the only non-compliance with Article 76(1) EPC.

The subject-matter of claim 1 of the fourth auxiliary request does not extend beyond the content of the application as originally filed either, since this application comprises the same description, figures and claims (drafted as clauses on pages 19 and 20 of the description) of the parent application as originally filed.

5.3 In conclusion, claim 1 of the fourth auxiliary request complies with Articles 76(1) and 123(2) EPC.

Since the impugned decision only considered the ground for opposition under Article 100(c) EPC in relation to claim 1 of the patent as granted, the appeal is allowable insofar as the grounds for that decision do not prejudice the maintenance of the patent on the basis of the present fourth auxiliary request.

6. Remittal

Under Article 111(1) EPC, following the examination as to the allowability of the appeal, the Board retains the discretion to remit the case to the department which was responsible for the decision appealed for further prosecution.

Since in particular the ground for opposition under Article 100(b) EPC was not considered in the first-instance proceedings, and in view of the fact that the parties did not request the Board not to remit, the Board decides to remit the case to the Opposition Division for further prosecution, in order for the parties to have the further objections possibly considered by two instances.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated