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**Datasheet for the decision
of 14 October 2021**

Case Number: T 2252/17 - 3.2.06

Application Number: 11722120.0

Publication Number: 2563308

IPC: A61F13/02

Language of the proceedings: EN

Title of invention:

WOUND DRESSING

Patent Proprietor:

Smith & Nephew PLC

Opponent:

KCI Licensing Inc.

Headword:

Strategic or speculative reasons as to what might possibly please the opposition division, or not, do not justify delaying the filing of such a request until the appeal proceedings (see Reasons 1.1.5)

Relevant legal provisions:

RPBA Art. 12(4)
EPC Art. 123(2), 113(2)
RPBA 2020 Art. 12(2)

Keyword:

Late-filed main request - should have been submitted in first-instance proceedings (yes)

Auxiliary request 1 - amendments - added subject-matter (yes)

Decisions cited:

G 0009/91, G 0010/91

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2252/17 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 14 October 2021

Appellant: Smith & Nephew PLC
(Patent Proprietor) 15 Adam Street
London WC2N 6LA (GB)

Representative: HGF
1 City Walk
Leeds LS11 9DX (GB)

Appellant: KCI Licensing Inc.
(Opponent) P.O. Box 659508
San Antonio , TX 78265 (US)

Representative: Simmons & Simmons
City Point
One Ropemaker Street
London EC2Y 9SS (GB)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
14 August 2017 concerning maintenance of the
European Patent No. 2563308 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: P. Cipriano
J. Hoppe

Summary of Facts and Submissions

- I. In its interlocutory decision dated 14 August 2017 the opposition division found that European patent No. 2 563 308 in an amended form (according to auxiliary request 1, filed on 21 July 2021) met the requirements of the EPC.
- II. With its grounds of appeal, the proprietor (appellant) requested that the patent be maintained on the basis of a new main request or, as an auxiliary measure, that the patent be maintained on the basis of one of auxiliary requests 1 to 7, auxiliary request 2 corresponding to the auxiliary request found to be allowable by the opposition division.
- III. The opponent (appellant) requested with its grounds of appeal and in its reply to the grounds of appeal of the proprietor that the decision under appeal be set aside and the European patent be revoked and that the case be remitted to the opposition division if the main request were to be admitted into the proceedings.
- IV. The following documents are relevant for the present decision:
D1 WO 2009/111657 A2
D4 WO 2009/066105 A1
- V. Since the impugned decision was appealed by both the opponent and the patent proprietor, the Board will refer to the parties as opponent and (patent) proprietor respectively.
- VI. With its reply to the opponent's grounds of appeal, the proprietor first filed new auxiliary requests 3 to 7

that replaced the previous ones and also auxiliary requests 8 to 18. Then, with letter dated 22 January 2021, the proprietor filed auxiliary requests 1 and 2 that replaced all the auxiliary requests on file. Auxiliary request 1 corresponded to the auxiliary request as found allowable by the opposition division, whereas auxiliary request 2 was new.

- VII. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that it was minded to exclude the main request from the proceedings under Article 12(4) RPBA 2007 and that the subject-matter of claim 1 of auxiliary request 1 did not fulfil the requirement of Article 123(2) EPC.
- VIII. With letter dated 12 August 2021, the proprietor withdrew its auxiliary request 2.
- IX. Oral proceedings were held before the Board on 14 October 2021.

The final requests of the parties were as follows:

The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained in amended form based on the main request, filed with the grounds of appeal on 6 December 2017 or as an auxiliary measure to dismiss the opponent's appeal (auxiliary request 1, filed with letter dated 22 January 2021).

The appellant (opponent) requested that the decision under appeal be set aside and the European patent be

revoked and to remit the case to the opposition division if the main request were to be admitted.

- X. Claim 1 of the main request reads as follows:
"Apparatus for dressing a wound for the application of topical negative pressure at a wound site, the apparatus comprising:
a liquid and gas permeable transmission layer;
an absorbent layer for absorbing wound exudate, the absorbent layer overlying the transmission layer;
wherein the absorbent layer includes or is a superabsorbent material, and wherein the absorbent layer extends outwards from a central region of the dressing beyond an edge region of the transmission layer;
a gas impermeable cover layer overlying the absorbent layer and comprising a first orifice, wherein the cover layer is moisture vapour permeable; and
a port sealed to the cover layer around the perimeter of the first orifice."

Claim 1 of auxiliary request 1 reads as follows:
"Apparatus for dressing a wound for the application of topical negative pressure at a wound site, the apparatus comprising:
a liquid and gas permeable transmission layer;
an absorbent layer for absorbing wound exudate, the absorbent layer overlying the transmission layer;
wherein the absorbent layer extends outwards from a central region of the dressing beyond an edge region of the transmission layer and wherein the absorbent layer includes or is a superabsorbent material;
a gas impermeable cover layer overlying the absorbent layer and comprising a first orifice and a port sealed to the cover layer around the perimeter of the first

orifice, wherein the cover layer is moisture vapour permeable,
and wherein the absorbent layer is in contact with the cover layer, and the apparatus further comprises a perforated wound contact layer underlying the transmission layer."

XI. The proprietor's arguments relevant to the decision may be summarised as follows:

Main request - admittance

The main request should not be excluded from the proceedings.

The opponent provided entirely new arguments for the first time at the oral proceedings before the opposition division. The main request was a legitimate response to these new developments which included a new interpretation of the claim.

At the oral proceedings before the opposition division, when faced with the possibility of being able to file a new request, considering that the opposition division usually only allowed the filing of one single request, the proprietor filed auxiliary request 1, where claim 1 was amended to further distinguish it from both D4 and D1 in several ways so as to increase the likelihood of the new claim request being admitted and being found allowable. It should also be considered that the previous main request, as decided upon by the opposition division, was broader than the new main request in appeal proceedings.

The claims of the main request also provided a legitimate response to the opponent's objection under

Article 123(2) EPC to the first auxiliary request in the appeal proceedings.

Moreover, the main request was a legitimate response to the Board's objection under Article 123(2) EPC which went beyond the opponent's arguments.

The main request also fulfilled the requirements of procedural economy as it was convergent, did not introduce complexity and was suitable to address the new arguments.

Auxiliary request 1 - Article 123(2) EPC

The combination of features of claim 1 of auxiliary request 1 including the feature "the absorbent layer is in contact with the cover layer" was directly and unambiguously derivable from the application as originally filed and met the requirement of Article 123(2) EPC.

Since the general effect of vapour transmission was described throughout the description of the application as filed, the skilled person reading the application understood that the feature "the absorbent layer is in contact with the cover layer" enhanced the general effect of vapour transmission of all the possible embodiments and was unambiguously disclosed in combination with an apparatus having the remaining features of claim 1.

The feature requiring the absorbent layer to be in contact with the cover layer (see page 12, line 8, of the original application as filed) was thus a general feature of the invention that was not inextricably linked to the other features in the description,

particularly the one through-hole under the suction port.

Besides the absence of a direct and unambiguous textual link to other features, there was no functional relationship between the absorbent layer being in contact with the cover layer and the features required to establish negative pressure, such as the port or the orifice on the absorbent layer. Page 12, lines 15-19, disclosed that the negative pressure applied had "negligible impact" on the vapour transmission across the cover layer, such that the skilled person understood that this feature also applied to the corresponding layers in other embodiments.

XII. The opponent's main arguments may be summarized as follows:

Main request - admittance

The main request should be excluded from the proceedings.

The proprietor was aware during the oral proceedings before the opposition division of the relevant facts and arguments as to why the main request did not involve an inventive step over D1 and D4 and made a deliberate choice of filing a new (main) request only with its grounds of appeal.

As the minutes of the oral proceedings confirm, there was nothing at the time preventing the proprietor from filing more than one request.

The main request was filed with the grounds of appeal without any justification as to why it could only be

filed at this stage. In comparison to claim 1 of auxiliary request 1, more features than necessary to overcome the objections under Article 123(2) EPC discussed during the opposition and appeal proceedings have been removed; although the opponent had never argued that the addition of the perforated wound contact layer to claim 1 introduced subject-matter which extended beyond the content of the application as filed.

Auxiliary request 1 - Article 123(2) EPC

The subject-matter of claim 1 contravened Article 123(2) EPC.

There was no basis for the amendment made to claim 1. The water transpiration effect was also possible without contact between the layers such that the skilled person would not have considered the contact being applicable to all possible embodiments.

Among other elements of the arrangement, the orifice in the absorbent layer had a relevant effect on the negative pressure system and consequently on the water vapour transpiration effect such that the feature of being in contact was inextricably linked to other features of the dressing and could not be added to claim 1 in isolation.

Reasons for the Decision

1. Main request - admittance

1.1 *Reaction to new arguments*

1.1.1 The main request was filed for the first time with the grounds of appeal of the proprietor. The claimed subject-matter is, however, broader than that of the auxiliary request filed by the proprietor in reaction to the opposition division's new argument during the oral proceedings. Compared to that auxiliary request, the following features have been omitted:

a) "and wherein the absorbent layer is in contact with the cover layer"

b) "and the apparatus further comprises a perforated wound contact layer underlying the transmission layer".

1.1.2 The proprietor argued that the opponent, with regard to the former main request, had provided entirely new arguments for the first time at the oral proceedings before the opposition division concerning the interpretation of the features "a gas impermeable cover layer overlying the absorbent layer and comprising a first orifice, wherein the cover layer is moisture vapour permeable" in relation to D4. According to the proprietor, these arguments could not have been predicted in advance of the oral proceedings and were not merely the opponent pointing to a different layer in D4 that could clearly correspond to the "cover layer". Rather, the nature of the opponent's new arguments involved interpreting claim 1 in an

unexpected way and then applying the interpretation to D4, thus taking the proprietor by surprise.

1.1.3 The Board agrees that under the given circumstances, the proprietor was correct in stating that it needed to be given the possibility of filing a new request. However, the proprietor was given the opportunity to "submit new requests" (see minutes of the oral proceedings before the opposition division point 6) but decided to file only one auxiliary request being more limited than the present main request.

1.1.4 The proprietor argued that it was not reasonable to have filed the claims of the current main request at the oral proceedings, not only due to it being surprised by the new argument but additionally because this had led to the opposition division concluding that the subject-matter of claim 1 of the main request lacked an inventive step starting not only from D1 but also from D4, which it had done during the same break for deliberation. Thus, when faced with the possibility of being able to file a new request and considering that the opposition division usually only allowed the filing of one single request, the proprietor filed auxiliary request 1, where claim 1 was amended to further distinguish it from D4 and D1 in several ways to increase the likelihood of the new claim request being admitted and being found allowable. It also argued that it was not possible at the time, or at least the attempt would not have pleased the opposition division, to file a further request addressing only the problems regarding D4, since the opposition division would not have admitted a request that did not also overcome the objections regarding D1. The practical situation in oral proceedings before an opposition division was such that when offered the possibility to

file new requests, a request was needed that would immediately be perceived as allowable.

- 1.1.5 The Board, however, does not find these arguments persuasive. The last sentence in item 4 of the minutes of the oral proceedings before the opposition division explains that the Chair listed the features of claim 1 which were not disclosed in D1 and D4, such that the proprietor was already aware that the new argument put forward by the opponent had been accepted by the opposition division at the latest by that point in the proceedings. That took place before any discussion of inventive step started. Further, after having indicated that starting from either of D1 or D4, the subject-matter of claim 1 of the main request was not inventive, the Chair asked if the proprietor wanted to submit new requests (plural). From the minutes of the oral proceedings (which have not been contested by the parties) it is therefore not apparent that the opposition division had indicated that there was any restriction on the number of requests that the proprietor could have put forward at the time.

Since claim 1 of the main request is simply broader than claim 1 of auxiliary request 1 that the proprietor elected to file during the oral proceedings before the opposition division, i.e. it simply contains one added feature from the several ones (features a) and b) see point 1.1.1) that were added to claim 1 of auxiliary request 1 filed at that time, the Board believes that this request could and should already have been filed at that point in time.

The Board finds that the proprietor was well aware of both the underlying arguments and this possible solution (noting that the proprietor stated during the

oral proceedings before the Board that it even recognized "some merit" in the objection) but made a deliberate choice not to file that request during the oral proceedings, thus preventing the opposition division from taking a decision on such a request.

According to the principle of party disposition, it is the proprietor who sets the framework of the procedure in regard to the requests upon which it wishes to have a decision. The EPO can only decide upon the European patent in the text submitted to it, or agreed by it (Article 113(2) EPC). Strategic or speculative reasons as to what might possibly please the opposition division, or not, do not justify delaying the filing of such a request until the appeal proceedings. Also, since the proprietor disagreed with the new interpretation of claim 1 and the disclosure of D4 made by the opponent (albeit agreed by the opposition division), it could have filed an appropriate request to take account of that view. If the opposition division had then, possibly, not admitted that request for some reason or not found it allowable, that would result in a different set of circumstances with regard to the appeal proceedings, but again is purely speculative because further requests were simply not filed.

- 1.1.6 The proprietor also argued that it was under pressure to react quickly during the oral proceedings and this should be taken into account. However, while the Board appreciates that a party may well be under pressure due to a perceived unexpected change in an interpretation of the claim, and should the proprietor have considered that the new issues raised could not reasonably have been dealt with during the oral proceedings, it also had the option of requesting an adjournment or

requesting more time for consideration, which it did not do. The oral proceedings finished at 15.00h, so there is also no indication that particular time pressure on considering and filing such requests was an issue.

- 1.1.7 The Board finds that the considered and deliberate choice made by the proprietor not to file a further request beyond the request it did file in oral proceedings before the opposition division, despite being given the opportunity to do so after the objection had been explained, necessarily results in the fact that the opposition division is prevented from issuing a decision on that request during the first instance proceedings, which has the consequence that the Board cannot review this in appeal proceedings. One of the purposes of Article 12(4) RPBA 2007 is to avoid such behaviour. Indeed, the primary purpose of an appeal is to provide the opportunity for a review of the decision of a previous instance, thereby (in *inter partes* proceedings) allowing the losing party to challenge the decision of an opposition division on its merits and to obtain a judicial ruling as to whether the decision of the opposition division is correct (see also G 9/91 and G 10/91 - OJ EPO 1993, 408, 420; Article 12(2) RPBA 2020).

This finding is not changed by the proprietor's argument that the main request, filed during the opposition proceedings, was even broader. It is irrelevant that the main request in opposition comprised all the features of the main request in appeal, since by including an additional particular feature ("a port sealed to the cover layer around the perimeter of the first orifice"), the main request in appeal results in a different combination of features.

1.2 *Response to an objection under Article 123(2) EPC*

- 1.2.1 The proprietor further argued that claim 1 of the main request should be admitted as it provided a legitimate response to the opponent's objection under Article 123(2) EPC made during the opposition proceedings against auxiliary request 1, since the feature "the absorbent layer is in contact with the cover layer" that allegedly contravened Article 123(2) EPC (as the Board also noted in item 2.2 of its preliminary opinion) was simply removed in claim 1 of the main request.
- 1.2.2 Whilst it is true that the deletion of the feature "the absorbent layer is in contact with the cover layer" may have overcome that Article 123(2) EPC objection by the opponent against auxiliary request 1, the proprietor also deleted the feature "the apparatus further comprises a perforated wound contact layer underlying the transmission layer" that was never objected to.
- 1.2.3 The proprietor also argued that Article 12(4) RPBA 2007 did not require that the request be filed at a specific point in time and that item 2.2 of the preliminary opinion of the Board provided a new "nuance" to the arguments put forward by the opponent that seemed to confirm the need for a new request.
- 1.2.4 Irrespective of what the proprietor exactly means by "nuanced", item 2.2 of the preliminary opinion of the Board followed the arguments provided by the opponent on page 2 of its grounds of appeal that "the only disclosure of the layer arrangements is that in Figure 1" and that "the only disclosure of contact is contact in the form shown in Figure 1". The Board therefore did

not introduce any new facts or arguments that would justify the filing of the main request.

From page 2 of the minutes of the oral proceedings and page 5, item 11.2 of the decision, it is clear that the proprietor was aware of the objections of the opponent regarding the superabsorbent material requiring the formation of a reservoir of fluids and being adjacent to the cover layer. If the proprietor had wished to file another suitable request to overcome such a potential problem, it had the opportunity of doing so during the oral proceedings before the opposition division. Indeed, when filing new requests, the proprietor should always be mindful of filing a request that it considers admissible in the sense that it meets all the requirements of the Convention (including Article 123(2) EPC).

- 1.2.5 The proprietor further argued that the feature regarding the perforated wound contact layer was also deleted, because, from the submissions of the opponent and the reasoning given by the opposition division during the opposition proceedings, the proprietor feared that this feature combined with the feature "superabsorbent material" could potentially be the object of a further objection under Article 123(2) EPC.

According to the proprietor, although the feature regarding the perforated wound contact layer was originally disclosed in claim 9 as filed (and was in claim 8 as granted), the proprietor had doubts as to whether this feature would be understood by the Board as being originally disclosed in combination with the other features of claim 1, which came from originally filed claims 1, 2 and 5 as well as the superabsorbent feature coming from page 8, line 15 of the originally

filed description. The proprietor submitted that the opponent had discussed the feature "superabsorbent" during the opposition proceedings as could be seen from page 2, first two paragraphs of the minutes and item 12.2.1 on page 5 of the decision, such that the proprietor considered that adding the wound contact layer feature could potentially lead to a further objection regarding the number of selections to be made to arrive at the combination of features of claim 1.

1.2.6 The proprietor thus, out of caution on its side, decided not to include this feature in claim 1 of the main request filed with its grounds of appeal. However, the appeal proceedings do not have the purpose of starting a new examination of different subject-matter to that considered by an opposition division, in order to preemptively address possible problems. This is so, in particular, in a case such as this, where such subject-matter involves broadening of claims put forward by the proprietor.

1.3 *Procedural economy*

1.3.1 The respondent argued also that the main request was convergent with the previous main request filed during the opposition proceedings and did not extend the scope of discussion nor introduce complexity, since it did not introduce new objections under the EPC and kept the discussion limited to inventive step.

1.3.2 Whilst this might be true, none of these arguments is a relevant criteria under Article 12(4) RPBA 2007, which addresses *inter alia* the need for presenting facts, evidence and requests for the first time at the appeal proceedings and aims to deter the parties from (mis)using the appeal procedure in order to e.g. delay

the outcome of the case or shift the decision to a further instance ("forum shopping").

1.4 The Board therefore exercised its discretion to exclude the main request from the proceedings under Article 12(4) RPBA 2007 (Article 25(2) RPBA 2020).

1.5 Since the request is excluded from the proceedings, the opponent's conditional request for remittal if the main request were to be admitted is moot.

2. Auxiliary request 1 - Article 123(2) EPC

2.1 The proprietor argued that the subject-matter of claim 1 was a combination of originally filed claims 1, 2, 5 and 9 as well as a passage on page 8, line 15 and a passage on page 12, line 8 of the description as originally filed.

2.2 It has not been contested that the feature "the absorbent layer is in contact with the cover layer" is literally disclosed on page 12, line 8 of the description as originally filed. However, this feature is disclosed in the context of the embodiment of Figure 1 in a more specific arrangement between the various layers, e.g. without an extra layer between the absorbent layer and the cover layer.

2.3 The proprietor argued further that the effect of vapour transpiration was described throughout the description of the application as filed, for example, on page 3, lines 4-12, on page 8, lines 13-17, on page 9, lines 1-2 and on page 10, lines 9-14. Because the general effect of vapour transpiration was thus described throughout the description, the skilled person reading the application would have understood that the feature

"the absorbent layer is in contact with the cover layer" enhanced the general effect of vapour transmission of all the possible embodiments and was thus allegedly unambiguously disclosed in combination with an apparatus having the remaining features of claim 1.

- 2.4 The Board is not persuaded by this argument. The skilled person reading the application knows that the effect of transpiration does not necessarily require the absorbent layer to be in contact with the cover layer and that the contact between layers may provide an enhancement of the vapour transpiration depending on the arrangements used. Since the passage on page 12, line 8, is part of the description of the specific embodiment of Figure 1, it is not unambiguously disclosed in an implicit manner that such a contact exists in all the embodiments.
- 2.5 The proprietor also argued that the embodiment shown in the arrangement in Figure 5 disclosed this feature such that it was implicit in the application, but the Board does not agree. Figure 5 does not directly and unambiguously disclose any contact between the absorber layer 110 and the cover layer 140 and only shows a more specific arrangement and two parallel lines representing the corresponding mutually facing surfaces. As explained in the paragraph above, the vapour transpiration effect does not necessarily require the absorbent layer to be in contact with the cover layer and nowhere is it mentioned in the corresponding description of the embodiment of Figure 5 on page 20, lines 19-26, that a contact between the absorbent layer and the cover layer is present.

2.6 The proprietor further argued that the feature did not have a direct link to other features such that there was no functional relationship between the absorbent layer being in contact with the cover layer and the features required to establish negative pressure. According to the proprietor, page 12, lines 15-19, disclosed that the negative pressure applied had "negligible impact" on the vapour transmission across the cover layer, such that the skilled person understood that this feature also applied to the corresponding layers in other embodiments.

2.7 This argument is, however, not persuasive. As explained on page 12, lines 9-11, the exudate is drawn towards the cover layer bringing the water component of the exudate into contact with the cover layer. An orifice in the absorbent layer as described in the embodiment of Figure 1 affects the pressure distribution (as also confirmed on page 12, lines 34 and 35, stating that the absorbent layer inhibits the negative pressure applied) and, consequently, the liquid distribution of the exudate.

It is thus at least not unambiguous for the skilled person that the "negligible impact" on the vapour transmission, described on lines 15-19 of page 12 in the context of the same embodiment pertaining to Figure 1, is not achieved solely for the specific dressing of that corresponding embodiment. The contact between the absorbent layer and cover layer is only one of the factors influencing the rate of vapour transmission and it is thus in a functional relationship with the other features required to establish the negative pressure.

2.8 The Board thus concludes that claim 1 according to auxiliary request 1 introduces subject-matter extending

beyond the content of the application as filed. The requirement of Article 123(2) EPC is hence not fulfilled such that auxiliary request 1 is not allowable.

3. In the absence of any text of the patent complying with the requirements of the EPC, the patent must be revoked (Article 101(3)(b) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated