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**Datasheet for the decision
of 26 April 2022**

Case Number: T 1456/18 - 3.3.10

Application Number: 07812056.5

Publication Number: 2029049

IPC: A61F2/00

Language of the proceedings: EN

Title of invention:

METHODS AND COMPOSITONS FOR TISSUE REPAIR

Applicant:

ISTO Technologies II, LLC

Headword:

Relevant legal provisions:

EPC R. 116

RPBA 2020 Art. 25(2), 11

RPBA Art. 12(4)

Keyword:

Remittal - (yes)

Late-filed request - submitted shortly before oral proceedings
in first instance proceedings - admitted (yes)

Decisions cited:

G 0007/93

Catchword:



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Case Number: T 1456/18 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 26 April 2022

Appellant: ISTO Technologies II, LLC
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Representative: Forrest, Stuart
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 30 November
2017 refusing European patent application No.
07812056.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: A. Zellner
F. Blumer

Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse the European patent application No. 07 812 056.5 on the basis of Article 97(2) EPC.

- II. In the contested decision, the examining division decided to admit neither the applicant's main request, nor auxiliary requests 1 to 3 and 5 into the proceedings under Rules 116(2) and 137(3) EPC. Auxiliary request 4 was admitted, but not considered to be allowable for lack of inventive step of the subject-matter of claim 1 (Article 56 EPC). The examining division stated that the main request and auxiliary requests 1 to 3 and 5 were late filed. As a consequence and since they were not considered to *prima facie* overcome all existing objections they were not admitted into the proceedings. Furthermore, according to the opinion of the examining division, auxiliary requests 1 to 3 did not constitute a convergent development of the subject-matter which had been the subject of examination (Rules 116(2) und 137(3) EPC).

- III. The applicant (appellant) appealed this decision. Referring to decision G 7/93, they argued that the examining division's decision not to admit the requests was incorrect, since the discretion of the division was not exercised in a reasonable way and not in accordance with the right principles.

- IV. The appellant argued in particular that the requests which had been submitted during the examination phase converged on the central theme of the application, namely the claimed composition being in the form of a paste. Furthermore, the requests under consideration

reduced the number of issues to be discussed during oral proceedings before the examining division, in particular with respect to the objections raised under Article 123(2) EPC. Also, the question of inventive step had, in the appellant's opinion, not been addressed adequately during the written procedure prior to the oral proceedings. The appellant argued that their legitimate interest in obtaining a patent was therefore not properly taken into consideration. The appellant also argued that even though the requests were late filed, they implied merely the deletion of dependent claims. The amendments thus led to requests which had already addressed objections under Article 123(2) EPC. As such, the requests did not lead to any new objections. These aspects had, according to the appellant, not been taken into consideration by the examining division.

- V. Following their statement of grounds of appeal, the appellant submitted an additional auxiliary request 6, comprising 4 claims, and provided arguments concerning the admissibility of that request and inventive step of the subject-matter claimed therein.
- VI. The board issued a communication under Article 15(1) RPBA setting out its preliminary opinion regarding the legal and factual issues under dispute.
- VII. The appellant responded to the board's preliminary opinion and filed further remarks concerning the admissibility of the requests on file.
- VIII. Oral proceedings were held on 26 April 2022 in the form of a videoconference.

IX. The appellant's main request contains one independent claim which reads as follows:

"1. A paste comprising a matrix and an aqueous liquid, wherein the matrix comprises a polyester entangled with a polysaccharide."

The request also contains dependent claims 2 to 4, which further define the paste according to claim 1 by features relating to the matrix (claim 2), and to the aqueous liquid (claims 3 and 4).

X. The appellant's requests are that the decision under appeal be set aside and

- that the case be remitted to the examining division for further examination on the basis of the main request as filed with the statement setting out the grounds of appeal or on the basis of any 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 6 as filed with letter dated 14 October 2021;

or

- that a patent be granted on the basis of auxiliary request 4 as filed with the statement setting out the grounds of appeal; or
- that the case be remitted to the examining division for further examination on the basis of auxiliary request 5 as filed with the statement setting out the grounds of appeal.

Reasons for the Decision

Main request

1. The main request had already been filed before the examining division, but was not admitted into the proceedings. It was filed again in appeal proceedings, together with the appellant's statement setting out the grounds of appeal on 10 April 2018, and thus before 1 January 2020. The admissibility of the request is therefore subject to the requirements of Article 12(4) RPBA 2007 (Article 25(2) RPBA).
2. Under Article 12(4) RPBA 2007, requests which were not admitted in the first instance proceedings shall be taken into account by the board if and to the extent they relate to the case under appeal, without prejudice to the power of the board to hold inadmissible such requests.
3. In the board's view, the appellant's main request shall be admitted into the proceedings for the following reasons:
 - 3.1 The request was first filed before the examining division on 20 September 2017 and thus shortly before the oral proceedings on 3 October 2017.

With the summons to attend oral proceedings, the examining division had set the 1 September 2017 as the final date for written submissions and/or amendments under Rule 116 EPC.

The request under consideration was therefore filed after the date set out by the examining division.

- 3.2 Previously the appellant filed within the time limit set by the examining division under Rule 116 EPC, i.e. 1 September 2017, a main request and four auxiliary requests. The main request contained 15 claims.
- 3.3 The four claims of the present main request were part of this earlier main request filed within the time limit set by the examining division. Dependant claims 5 to 15 of the earlier main request were deleted in the current main request.
- 3.4 On 12 September 2017, after having received the appellant's requests of 1 September 2017, the examining division informed by a telephone call the applicant's representative that the oral proceedings were to be maintained since the requests on file could not lead to the grant of a patent. It was further explained that the examining division was not inclined to admit the main request on file at that time due to deficiencies under Article 123(2) EPC (see the Result of consultation of 15 September 2017).
- 3.5 According to the appellant (see under paragraph 3 of the submission of 20 September 2017 and under item 3.4 of the statement setting out the grounds of appeal), the first examiner also pointed out during the telephone interview that claims 1 to 4 of the main request under consideration at the time appeared to fulfill the requirements of Article 123(2) EPC. The deficiencies under Article 123(2) EPC did therefore not relate to claims 1 to 4 of the main request.
- 3.6 The board considers that the filing of the present main request which contains only claims 1 to 4 of the previous main request filed can be seen as the response of the appellant to overcome the deficiencies under

Article 123(2) EPC which they had been made aware of by the examining division shortly before the date of the oral proceedings.

3.7 The board also agrees with the appellant that the request does not introduce additional issues, since all of the claims were already present in the earlier main request as submitted on 1 September 2017 (see point 3.2 of this decision).

3.8 Furthermore, the board also follows the argumentation of the appellant concerning the question of convergence, which was addressed in the decision of the examining division (see points 59, 65 and 68 of the contested decision), for the following reasons:

Independent claims of the various requests filed during the examination phase were directed to:

- "an implant for promoting repair of a tissue" and "a **paste**" (independent claims 1 and 19 as filed on 20 February 2009)
- "a composition for promoting repair of a tissue ... by a process comprising ... to form a **paste** or a viscous liquid capable of injection into the tissue" (independent claims 1 as filed on 14 February 2012, on 17 August 2015 and on 16 March 2016, as well as auxiliary requests 4 filed on 1 September 2017 and on 20 September 2017)
- "a **paste**" (independent claim 1 of the main request and auxiliary requests 1 and 2 as filed on 1 September 2017 and on 20 September 2017, and auxiliary request 3 as filed on 20 September 2017)

- "an injectable **paste**" (independent claim 1 of auxiliary request 3 as filed on 1 September 2017)

Since the beginning of the procedure, independent claims were thus directed to "a paste", "an injectable paste", or a composition "to form a paste". Claim 1 of the present main request also relates to "a paste".

- 3.9 Claim 1 of the main request defines the paste using features different from those used in previous requests. The reason for this approach lies in the objections of the examining division concerning non-compliance with Article 123(2) EPC. According to the examining division, amendments to the independent claims of previous requests led to unallowable intermediate generalisations of the originally disclosed examples (see point 56 of the contested decision). In order to overcome this objection, the applicant has chosen to replace the features objected to with other features, and referred to a basis for these features in the description as filed.

The board considers this approach taken by the appellant to be appropriate in order to pursue the application.

- 3.10 In summary, the board comes to the conclusion that the appellant has, following the information provided by the first examiner during the telephone conversation shortly before the date of the oral proceedings, made a reasonable attempt to overcome the objections raised by the examining division.

- 3.11 The board therefore follows the argumentation of the appellant and admits the main request into the

proceedings (Article 12(4) RPBA 2007).

4. Claim 1 of the main request relates to a paste comprising a matrix and an aqueous liquid. The examining division has so far not provided a detailed analysis - in particular relating to novelty and inventive step - of the subject-matter of claim 1 of the main request. The board considers this a special reason under Article 11 RPBA and remits the case to the examining division for further prosecution.

Further requests

5. Since the board decides to allow the main request of the appellant there is no need for a decision on the appellant's further requests.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the examining division for further examination.

The Registrar:

The Chairman:



B. Atienza Vivancos

P. Gryczka

Decision electronically authenticated