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**Datasheet for the decision  
of 12 October 2022**

**Case Number:** T 2913/19 - 3.2.01

**Application Number:** 13177327.7

**Publication Number:** 2668969

**IPC:** A61M5/20

**Language of the proceedings:** EN

**Title of invention:**

Automatic injection device with trigger lock

**Applicant:**

Cilag GmbH International

**Headword:**

**Relevant legal provisions:**

EPC Art. 52(1), 56, 111, 115, 123(2)  
RPBA 2020 Art. 13(2), 25

**Keyword:**

Inventive step - (yes) - non-obvious combination of known features  
Amendments - allowable (yes)  
Observations by third parties - admissibility (no)  
Appealed decision - set aside (yes)

**Decisions cited:**

T 0923/10

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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Case Number: T 2913/19 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 12 October 2022**

**Appellant:** Cilag GmbH International  
(Applicant) Gubelstrasse 34  
6300 Zug (CH)

**Representative:** Carpmaels & Ransford LLP  
One Southampton Row  
London WC1B 5HA (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 8 May 2019  
refusing European patent application No.  
13177327.7 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** V. Vinci  
S. Fernández de Córdoba

## **Summary of Facts and Submissions**

I. The appeal was filed by the appellant (applicant) against the decision of the examining division to refuse the European patent application No. 13177327.7.

In the decision under appeal the examining division held that the subject-matter of independent claim 1 according to the main request filed at the oral proceedings did not comply with the requirements of Article 123(2) EPC and that the subject-matter of independent claim 1 according to the auxiliary requests 1 to 3 did not involve an inventive step in the meaning of Articles 52(1) and 56 EPC in view of the following prior art:

D1: US 2003/105430 A1

D4: WO 2007/036676 A1

II. With the statement of grounds of appeal the appellant (applicant) requested to set aside the decision of the examining division and to grant an European patent on the basis of the main request underlying the contested decision or, in the alternative, of the auxiliary requests 1 to 3 corresponding to the former main request and auxiliary requests 1 and 2 filed on 01 March 2019 respectively. Oral proceedings pursuant to Article 116 EPC were requested as a further auxiliary measure.

III. With a communication pursuant to Rule 100(2) EPC dated 01 September 2022, the Board informed the appellant (applicant) of its intention to issue a reasoned written decision according to which the decision under appeal was to be set aside and the case remitted to the

examining division with the order to grant an European patent on the basis of the claims according to the main request and a description to be adapted.

With a letter dated 15 September 2022 the appellant (applicant) agreed with the proposal of the Board to decide the case in writing and withdrew their request for oral proceedings.

On 27 September 2022 anonymous third party's observations were received.

IV. Claim 1 according to the main request under consideration reads as follows:

*"An injection device (110) comprising:*

*a housing (112) adapted to receive a syringe (114) having a discharge nozzle (118), the syringe (114) being moveable in the housing (112) on actuation of the injection device (110) along a longitudinal axis from a retracted position in which the discharge nozzle (118) is contained within the housing (112) and an extended position in which the discharge nozzle (118) of the syringe (114) extends from the housing (112) through an exit aperture (128), wherein the exit aperture is defined by a rim (128a) located on an edge of the housing;*

*an actuator (130);*

*a drive (131, 132, 133, 134, 135) adapted to be acted upon by the actuator (130) and in turn act upon the syringe (114) to advance it from its retracted position to its extended position and discharge its contents through the discharge nozzle (128);*

*a locking mechanism comprising a contact surface which is adapted to extend over or around at least a part of the rim, and a sleeve (119) extending from the contact surface into the housing, the sleeve configured to be moveable, from an engaged position of the locking mechanism in a direction into the housing (112) at the exit aperture (128) into a disengaged position of the locking mechanism, wherein the locking mechanism is adapted to prevent actuation of the device when it is in an engaged position and permit actuation of the device when it is in its disengaged position;*

*a syringe carrier (127) for carrying the syringe as it is advanced and restraining its advancement beyond its extended position, wherein the syringe carrier (127) is adapted to support the syringe (114);*

*a latch member (161) adapted to prevent, in an engaged position of the locking mechanism, movement of the syringe carrier (127) relative to the housing (112) and further adapted to permit, in a disengaged position of the locking mechanism, the syringe carrier (127) moving relative to the housing (112); and*

*wherein when the contact surface is spaced from the rim, including when the end of the sleeve can be seen to emerge from the exit aperture, the sleeve can slide from an engaged position to the disengaged position in which the contact surface has been pushed into a position in which it sits adjacent, in contacting juxtaposition, to the rim."*

## Reasons for the Decision

### Main Request

#### Article 123(2) EPC

1. The main request meets the requirements of Article 123(2) EPC.

1.1 The examining division objected that the feature introduced at the end of the amended claim 1 according to the main request, namely that (relevant wording emphasized by the Board):

*"... when the contact surface is spaced from the rim, including when the end of the sleeve can be seen to emerge from the exit aperture, the sleeve can slide from an engaged position to the disengaged position in which the contact surface has been pushed into a position in which it sits adjacent, in contacting juxtaposition, to the rim."*

was not directly and unambiguously derivable from the originally filed application.

1.2 With the statement of grounds of appeal the appellant (applicant) conversely maintained that the contested amendment introduced in claim 1 was directly and unambiguously derivable from the 2nd paragraph on page 6 of the originally filed application reading (relevant wording emphasized by the Board):

*"The sleeve 119 can slide from a locked position in which the flange 119a is spaced from the rim 128a, to an unlocked position (and not "to the unlocked*

*position" as recited in claim 1) in which the flange 119a has been pushed into a position in which it sits adjacent, in contacting juxtaposition, to the rim 128a."*

- 1.3 In view of the use of the indefinite article "an" introducing the feature "engaged position" the examining division construed the wording of the last feature of claim 1 as to mean that the expression "an engaged position" covered not a single and well defined position, for example the starting position of the sleeve when it still fully protrudes from the housing, but any axial position of the sleeve within the axial stroke of the sleeve relative to the housing and in which the contact surface of the sleeve did not contact/abut the rim yet. In other words, in the examining division's view, any position assumed by the contact surface of the sleeve when pushed inwardly into the housing before contacting the rim had to be considered as an "engaged position" in the meaning of claim 1, i.e. a position in which the syringe was still engaged/locked and could not thus be pushed forward toward the patient by the the activation mechanism. At the same time, in view of the use of the definite article "the" introducing the feature "disengaged position" in claim 1, the examining division asserted that the expression "the disengaged position" in the meaning of claim 1 indicated a single and well determined position, namely the sole axial position of the sleeve at which its contact surface contacted/ abutted the rim of the housing at the end of its axial and inward movement relative to the housing. The examining division was hence of the opinion that claim 1 as amended by the introduction of the features presented above defined only one single and distinct "disengaged position" whereas there could be numerous



"engaged positions" (see decision point 11.2), and decided that such a situation, in particular the fact that there was only one "disengaged position" assumed in operation by the sleeve, was not directly and unambiguously derivable from the application as originally filed and in particular from the passage indicated by the appellant (applicant) as the basis for the amendment to claim 1.

1.4 The Board does not share the view of the examining division for the following reasons:

The Board concurs with the interpretation of the last feature of claim 1 provided by the examining division which is also not disputed by the appellant (applicant). However, regarding the definition of the unlocked/disengaged position as it results from the wording of claim 1, the Board agrees with the appellant (applicant) that from the wording of the cited 2nd paragraph on page 6 of the originally filed description the person skilled in the art understands, even though the use of the indefinite article "an" (instead of the definite article "*the*" used in claim 1), that there is only one unlocked/disengaged position, i.e. the position in which the contact surface of the sleeve abuts the rim. In fact, as convincingly argued by the appellant (applicant), there is only one position satisfying this requirement and this is the one in which the sleeve is fully retracted into the housing with its contact surface abutting the rim thereof. The use of the definite article "*the*" in claim 1 instead of the indefinite article "*an*" used in the relevant passage of the description for introducing the unlocked/disengaged position does not thus add any undisclosed information. Regarding the locked/engaged position as defined in the claim, the appellant

(applicant) correctly observed that the relevant wording in the above paragraph of the originally filed description, i.e. "a locked position" corresponds to the technical information provided by the relevant wording of claim 1, i.e. "an engaged position" (wherein it is uncontested that the terms "locked" and "engaged" functionally define the same position). It follows that the passage of the originally filed description which uses as claim 1 the indefinite article "an" for introducing the locked/engaged position supports the interpretation of the claim given by the examining division, namely that there are several "engaged positions", i.e. all the axial positions of the sleeve relative to the housing in which, contrary to the disengaged position, the contact surface of the sleeve does not contact the rim. In other words, according to the original description, the syringe remains restricted in its forward movement until the contact surface of the sleeve contacts the rim thereby achieving the "disengaged position", and this is also what is claimed in claim 1.

1.5 In conclusion the Board is convinced that the contested amendment in claim 1 is indeed directly and unambiguously derivable for a person skilled in the art from the information provided in the 2nd paragraph on page 6 of the originally filed description, whereby, contrary to the conclusion of the examining division, the requirements of Article 123(2) EPC are met. This has the consequence that the decision of the first instance department is to be set aside.

2. In the decision under appeal the main request was dismissed under Article 123(2) EPC only. However, in the "*Obiter dictum*" presented under point IV thereof, the examining division stated that the same objections

under Article 56 EPC as brought forth against claim 1 of the auxiliary request 1 apply to claim 1 of the main request. Therefore, even if lack of inventive step in respect of the main request is not explicitly dealt with in the decision under appeal, the Board is in the position to decide this substantial issue on the basis of the relevant arguments provided by the appellant (applicant) with their statement of grounds of appeal and of the reasoning of the examining division provided in support of the objected lack of inventive step of claim 1 of the auxiliary request 1 underlying the decision under appeal. In view of the above no "*special reason*" in the meaning of Article 11 RPBA justifying remittal of the case to the first instance department for further prosecution, i.e. for assessing inventive step, can be identified. The Board thus considers appropriate to decide inventive step at the appeal proceedings as also agreed by the appellant (applicant) with their letter dated 15 September 2022.

Inventive Step: Articles 52(1) and 54 EPC

3. The subject-matter of claim 1 according to the main request involves an inventive step over the cited prior art in the meaning of Articles 52(1) and 56 EPC.
- 3.1 The examining division objected lack of inventive step in view of document D4 as closest prior art in combination with the teaching of document D1.

In the statement of grounds of appeal the appellant (applicant) asserted that the subject-matter of claim 1 according to the main request differs from the technical content of document D4 in that the locking mechanism comprises:

*"a contact surface which is adapted to extend over or around at least a part of the rim (of the housing)"*

and in that the locking mechanism is in a disengaged position when

*the contact surface has been pushed into a position in which it sits in contacting juxtaposition to the rim.*

3.2 The Board observes that while the first one of the alleged distinguishing features above identified by the appellant (applicant) is identical to the first distinguishing feature of claim 1 of the auxiliary request 1 identified in the decision under appeal, the second one is worded slightly differently compared with the second distinguishing feature identified by the examining division when assessing inventive step of the auxiliary request 1. However, in the Board's view, the technical information implied by the two formulations adopted for defining the disengaged position is identical, whereby the arguments provided by the examining division in respect of lack of inventive step of the auxiliary request 1 underlying the decision under appeal analogously apply to claim 1 of the main request.

3.3 The technical problem solved by the distinguishing features above has to be seen, as correctly assessed by the examining division in respect of the auxiliary request 1 and agreed by the appellant (applicant), in the improvement of the visual feedback to the user regarding the locked/unlocked state of the device when said device is pushed against the skin of a patient.

3.4 The examining division rightly noted that document D1 (see paragraphs [0186] to [0188]) discloses in the

context of the embodiment shown in figures 38 and 39 a sleeve ("*body sensing-unit (302)*") with a flange at the end thereof forming a contacting surface which, at the end of the retraction movement of the sleeve into the housing which takes place when the device is pushed onto the patent's skin, comes into abutment with a rim of the housing. The axial relative position of the element (302) with respect to the housing determines the locked/engaged position (i.e. when the sleeve still protrudes from the housing without contacting the rim thereof) or the unlocked/disengaged position (i.e. when the sleeve abuts the rim of the housing). In particular, in the situation shown in figure 39, the flange of the sleeve (302), by abutting the rim of the housing, defines a position at which the control unit 208 is free to move down when the trigger 24 is activated thereby disengaging the syringe. However the Board, thereby deviating from the assessment of the first instance department, shares the argument of the appellant (applicant) that D1 does not describe that the flange of the sleeve 302 has the functionality of providing a visual indication or feedback to the user that the device has reached the unlocked/disengaged position when it is in contacting juxtaposition with the rim of the housing. In fact, the flange attached to "*body-sensing unit (302)*" is not discussed at all in D1, and so the skilled person is provided with no hint on its purpose or effect. Furthermore, D1 does not mention anywhere the provision of cues (visual or otherwise) to the user on the engaged/disengaged state of a locking mechanism. Therefore, the Board is of the opinion that the reasoning of the examining division alleging that the person skilled in the art would recognize that the flanged design of the sleeve (302) of D1 may solve the technical problem at stake and thus that they would obviously introduce it in the device of

D4 is based on an unallowable "*ex-post facto*" approach based on the foreknowledge of the solution proposed in claim 1. According to well established case law of the Boards of Appeal such a "*ex-post facto*" approach cannot be adopted for convincingly demonstrating lack of inventive step. Therefore the Board, thereby deviating from the view of the examining division expressed in the "*obiter dictum*", concludes that the person skilled in the art starting from D4 has no motivation to adopt the flanged design of the sleeve proposed in D1 for the sleeve of known injection device in order to solve the technical problem addressed by the patent application, whereby the subject-matter of claim 1 according to the main request is not rendered obvious by the combination of these prior art documents.

- 3.5 Nor is the claimed injection device obvious in view of the other documents mentioned in the search report.

### **Third Party's Observations**

- 3.6 Third party's observations under Article 115 EPC were filed at a late stage of the appeal proceedings, i.e. more than 3 years after the filing of the statement of grounds of appeal. According to established case law of the Boards of Appeal third parties filing observations under Article 115 EPC cannot procedurally be put in a better position than an opponent, whereby the Board's discretion not to admit late filed submissions also applies in respect of third party's observations (see for example T923/10, reasons 3). This means that, when exercising their discretion, the Board takes the same criteria into account that they would consider when deciding on the admissibility of submissions by parties to the proceedings that are considered "*late-filed*" in view of Article 114(2) EPC and Articles 12 and 13 RPBA.

In the present case, also in view of the significant delay with which the third party observations were filed, the Board cannot identify any exceptional circumstances justified with cogent reasons in the meaning of Article 13(2) RPBA in the version 2020 which applies to the present appeal pursuant to Article 25 RPBA 2020, nor such exceptional circumstances were alleged by the anonymous third party concerned. For these reasons the Board decided to disregard the third party observations at stake under Article 13(2) RPBA 2020.

## **Order**

### **For these reasons it is decided that:**

1. The decision is set aside.
2. The case is remitted to the first instance department with the order to grant an European patent on the basis of the claims according to the main request and a description to be adapted.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated