

Publication in the Official Journal ~~Yes~~ / No

File Number: T 860/90 - 3.3.2

Application No.: 83 100 214.2

Publication No.: 0 210 281

Title of invention: A method of using a filament for manufacturing a suture or
ligature

Classification: A61L 17/00

D E C I S I O N

of 1 March 1991

Applicant: American Cyanamid Company

Headword: Suture/CYANAMID

EPC Article 76(1)

Keyword: "Added subject-matter - main request (yes) - auxiliary request
(no)"

Headnote



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Patent Office

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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 860/90 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 1 March 1991

Appellant :

American Cyanamid Company
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(US)

Representative :

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Decision under appeal :

Decision of Examining Division 001 of the
European Patent Office dated 15 May 1990 refusing
European patent application No. 83 100 214.2
pursuant to Article 97(1) EPC.

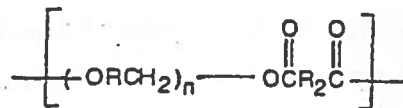
Composition of the Board :

Chairman : A Nuss
Members : I.A. Holliday
R. Schulte

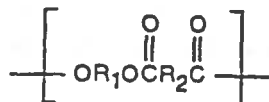
Summary of Facts and Submissions

- I. European patent application No. 83 100 214.2 (publication No. 0 210 281) was refused by a decision of the Examining Division.
- II. The grounds for the refusal were that the present application, which was divided from European patent application No. 79 300 252.8, did not meet the requirements of Article 76(1) EPC insofar as its contents extended beyond the disclosure of the said parent application. The decision was based on the originally filed Claims 1-9. Claim 1 reads as follows:

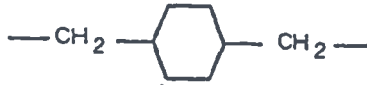
"1. A method of using a filament formed by extrusion of a block copolymer containing polymeric blocks (A) and polymeric blocks (B), wherein the polymeric blocks (A) consist of a polyalkylene ether having a number average molecular weight of from 500-3000 and have the formula:



wherein R is a straight or branched chain alkylene group of from 1 to 9 carbon atoms, R₂ is 1,4-phenylene or cyclohexylene and n is the number of repeating units; and wherein the polymeric blocks (B) are the reaction product of (i) an aromatic dicarboxylic acid or a cycloaliphatic dicarboxylic acid and (ii) a short chain aliphatic or cycloaliphatic diol, and have the formula:



wherein R₁ is a straight or branched chain alkylene group of from 2 to 10 carbon atoms or a cyclic group having the formula:



and R₂ is 1,4-phenylene or cyclohexylene: said polymeric blocks (B) constituting from 30 to 95 percent by weight of said copolymer; for manufacturing a non-absorbable sterile surgical suture or ligature by drawing the filament for adjusting the tensile strength as defined by a straight pull to a value of at least 3515 kg/cm² (50,000 psi) and the flexual modulus to a value of less than 24610 kg/cm² (3.5 x 10⁵ psi)

and by subsequent sterilization and packaging."

According to Claim 1 of the parent application, the polymers used must have a molecular weight of 25 000 to 30 000, the said range being twice mentioned in the description. In the view of the Examining Division, the omission of the said molecular weight range represented an extension beyond the contents of the original disclosure. A corresponding objection under Article 76 was made concerning the introduction of parts by weight in relation to the proportions of units in Claim 1.

III. In the statement of appeal, the Appellant argued that the present divisional application related to a different category of claim to that of the parent, i.e. to a method of using a filament for manufacturing a suture. The molecular weight restriction applied only to the products, i.e. surgical sutures claimed in the parent application now European patent No. 0 008 152. The Appellant argued

that the divisional was based on page 4, line 21 to page 5, line 14 of the original disclosure, which made no reference to the molecular weight. The present application, in the Appellant's view, differed from T 514/88 of 10 October 1989 (not published in OJ EPO) relied upon by the Examining Division wherein the claims of both parent and divisional belonged to the same category.

At the oral proceedings on 1 March 1991, the Appellant based his arguments on a recently published decision, T 331/87 (OJ EPO 1991, 22) which related to the removal of a feature from a claim during the prosecution of an application. Although the case related to mechanical subject-matter, the Appellant argued that the criteria, set out in the decision, which must be fulfilled in order that a feature might be considered inessential applied to the molecular weight range of the present application. The Appellant also argued that the passage on page 6, lines 19-23 of the description, which included a reference to the molecular weight range and which was preceded by the word "generally" applied only to preferred polymer in which the soft segments A were based on a tetramethylene ether glycol (TMEG). The only essential point, according to the Appellant, was that the polymer should be fibre or filament forming. The Appellant placed two references from Ullmanns "Encyclopädie der technischen Chemie" on file to show that different polymers had different molecular weight ranges at which fibres were formed.

At the conclusion of the oral proceedings, the Appellant agreed that the reference to parts by weight of units 'B' in Claim 1 had no basis in the original disclosure and agreed to delete the said reference.

IV. The Appellant's main request was that the case be remitted to the Examining Division to continue the examination on the basis of Claim 1 filed during the oral proceedings, i.e. the claim which appears above except that the words "by weight" have been deleted from line 21.

As auxiliary request the Appellant requested remittal to the Examining Division on the basis of Claim 1 in which the words "said copolymer having a number average molecular weight of from about 25,000 to 30,000" had been added after the word "copolymer" in line 22.

In each request Claims 2-9 were as originally filed.

Reasons for the Decision

1. The appeal is admissible.
2. The question to be decided in this appeal is whether or not the present divisional application complies with the provisions of Article 76(1) EPC, i.e. as to whether new subject-matter has been generated in the divisional application which extends beyond the content of the earlier (parent) application as filed. In order to determine whether Claim 1 of the divisional is supported by the original disclosure, the novelty test or the test for essentiality may be used, since in both cases the relevant question is whether or not the amendment is consistent with the application as originally filed. Accordingly, when carrying out the examination under Article 76(1) EPC, the subject-matter of the divisional application has to be compared with the content of parent application as filed, whereby the content of the application means the total information content of the original disclosure (parent application). This includes

the original statements as to the problem to be solved implying certain aims and effects (see T 514/88 referred to above).

- 2.1 The present application relates to a method of using a filament for the manufacture of a non-absorbable sterile surgical suture.
- 2.2 As is apparent from the original description, the problem to be solved is to be seen in finding a new use for the polyester fibres set out on pages 3 and 4 of the said description. The solution consists in using said filaments for manufacturing a non-absorbable sterile suture or ligature having certain characteristics. In order to be suitable for this use, the filaments must have the qualities of flexibility and handling, characteristics such as knot strength, knot stability and also "throwability", i.e. when the free end is placed in position by the surgeon, it will remain in that position (cf. page 2, lines 8-26).

3. Main Request

The specification of the polymer to be used in the method of the present divisional application, according to the main request, differs from that employed in the parent application No. 79 300 252.8 in two respects.

- 3.1 Firstly, the parameters of tensile strength and molecular weight have been included. This amendment is clearly allowable under Art. 76(1) EPC since there is support on page 5, lines 1-7 of the originally filed description of the parent application.

3.2 The second difference lies in the omission of the molecular weight range of 25 000 to 30 000 specified in Claim 1 of the parent application.

3.2.1 The Appellant argued, especially at the oral proceedings, that the said range of molecular weight could be omitted within the definition of non-essential features set out in decision T 331/87 referred to above:

- (1) the feature was not explained as essential in the disclosure;
- (2) it is not, as such, indispensable in the light of the problem it serves to solve; and
- (3) the replacement or removal requires no real modification of other features to compensate for the change (Reasons, point 6).

The Board agreed with the Appellant that the third criterion was irrelevant in the present case and that only points (1) and (2) need be considered.

3.2.2 As far as point (1) is concerned, Claim 1 and the statement of invention (pages 3-4) of the parent application state unambiguously that the molecular weight must be within the range 25 000 to 30 000. As the Appellant correctly pointed out, the two statements can be taken together since Claim 1 and the corresponding description have exactly the same wording. However, the language used: "and said copolymer having a molecular weight of from 25 000 to 30 000" cannot be taken prima facie to indicate that the said range forms an inessential feature of the copolymer.

3.2.3 A range of 25 - 30 000 which, having regard to the minimum molecular weight requirements of units (A), can only be taken as an abbreviated way of expressing 25 000 to 30 000, is also mentioned on page 6, lines 22-23. This second reference to the said range is preceded by a sentence beginning with the word "Generally" which relates to a preferred embodiment wherein soft segment (A) is derived from TMEG. However, it is by no means clear that the sentence relating to molecular weight applies only to the preferred copolymer. It could equally be construed as an emphasis; i.e. although the TMEG polymers represent the preferred embodiment, the overriding necessity that the molecular weight be in the defined range still applies. In other words, the Board cannot accept that there is any indication whatsoever in the parent application that the molecular weight range is anything other than an essential feature of the block copolymer to be used. Criterion (1) of decision T 331/87 does not therefore apply.

3.2.4 When considering criterion (2) of the cited decision, the underlying problem must be taken into consideration. From for example the citations from Ullmann (1956 Edition, Vol. 7, page 241 and 1987, English edition, Vol. A10, pages 454-5) the skilled man would recognise that different polymers would have differing fibre- or filament-forming molecular weights. However, from the description on page 2 of the parent application mentioned in point 2.2 above, it is apparent that not only must the copolymer be of filament-forming molecular weight but must also yield a filament having the properties specified therein. Having regard to the emphasis placed on molecular weight in the parent application, the Board can only conclude that there is a strong indication that molecular weight does indeed play a role in achieving the said properties. Accordingly, criterion (2) of the cited decision is also not fulfilled.

- 3.3 The Appellant has argued that the divisional application is based on the passage on pages 4-5 identified in point IV above. The Board concedes that the said passage does not specifically refer to molecular weight. However, when referring on page 4, lines 21-21 to "the suture or ligature of this invention", the passage can only be read in association with the preceding description, especially starting at page 3, line 22. The passage must be implicitly associated with the molecular weight range previously mentioned at page 4, lines 8-9.
- 3.4 In the proceedings before the Examining Division (letter dated 9 October 1989) and in oral proceedings before the Board, the Appellant has drawn attention to the prosecution of the equivalent German application, in which the examiner allowed the reference to the molecular weight of the copolymer to be deleted. The Board cannot accept the argument that the German examiner, acting as an expert, recognised that the reference to the molecular weight was erroneous and therefore allowed its deletion. The Boards of Appeal have consistently applied the same strict criteria in relation to added subject-matter which are summarised in point 2 of the Reasons in decision T 514/88 referred to above. These apply both in respect of Articles 123(2) and 76(1) EPC. There are no grounds for a dissenting view in the present case.
- 3.5 In summary, the Board agrees with the view of the Examining Division that the omission of the molecular weight offends Article 76(1) EPC. The Appellant's main request is accordingly rejected.

4. Auxiliary Request

The Appellant's auxiliary request in which a reference to the molecular weight of the copolymer has been included

and in which the references to percentages by weight of polymeric blocks (B) has been deleted removes the grounds on which the application was refused under Articles 97(1) EPC. The said auxiliary request can thus be accepted.

5. Since the examination in respect of novelty and inventive step has not yet been carried out, the Board intends to use the powers conferred by Article 111(1) EPC to remit the case to the Examining Division for the examination to be resumed on the basis of the Appellant's auxiliary request filed at the oral proceedings.

Order

For these reasons, it is decided that:

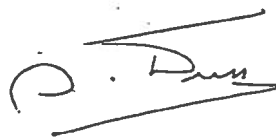
1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of Claim 1 of the auxiliary request filed during oral proceedings and on Claims 2 to 9 as originally filed.

The Registrar:



M. Beer

The Chairman:



A.J. Nuss

Subm 25.3.91



19.10.91

