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D E C I S I O N
of 6 November 1996

Case Number: T 0975/94 - 3.3.4

Application Number: 86304643.9

Publication Number: 0206726

IPC: A61L 27/00

Language of the proceedings: EN

Title of invention:
Periodontal osseous defect repair

Patentee:
THE UNIVERSITY OF FLORIDA

Opponent:
PECHINEY

Headword:
Periodontal repair/UNIVERSITY OF FLORIDA

Relevant legal provisions:
EPC Art. 123(2), (3)

Keyword:
"Amended claims - added subject-matter (no) - broadening of claim(no)"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0975/94 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 6 November 1996

Respondent: (Opponent)
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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office dated 13 October 1994 concerning maintenance of European patent No. 0 206 726 in amended form.**

Composition of the Board:

Chairman: L. Galligani
Members: D. D. Harkness
S. C. Perryman

Summary of Facts and Submissions

I. European patent application No. 86 304 643.9 relating to a composition for the repair of periodontal osseous defects was filed with the following claims *inter alia*:

"1. A composition suitable for the repair of periodontal osseous defects comprising particulate bioactive and biocompatible glass, said particulate glass having a particle size in the range of from about 90 to about 710µm and the following weight percentage composition:

Component	**Weight Percentage**
SiO_2	40-52
CaO	10-50
Na_2O	10-35
P_2O_5	2-8
CaF_2	0-25
B_2O_3	0-10

4. The composition of Claim 1 wherein said particulate glass has a particle size in the range of from about 500 to about 710µm.

5. The composition of Claim 1 comprising a mixture of (1) said particulate glass having a particle size in the range of from about 90 to about 355µm, (2) said particulate glass having a particle size in the range of from about 355 to about 500µm, and (3) said particulate glass having a particle size in the range of from about 500 to about 710µm.

6. The composition of Claim 5 comprising equal weights by thirds of each of said particulate glasses 1), 2) and 3)."

II. On the above application European patent No. 0 206 726 was granted with an independent claim reading as follows:

1. A composition adapted for the repair of periodontal osseous defects when mixed with a liquid, the composition consisting essentially of particular [sic] bioactive and biocompatible glass, said particulate glass consisting of or including a fraction having a particle size in the range of from about 355 to about 710µm and having the following weight percentage composition:

Component	**Weight Percentage**
SiO_2	40-52
CaO	10-50
Na_2O	10-35
P_2O_5	2-8
CaF_2	0-25
B_2O_3	0-10

as well as Claims 2 to 9 directly or indirectly dependent on Claims 1.

III. An opposition was filed against the patent solely on the ground of Article 100(c) EPC that the subject matter of the European patent extended beyond the content of the application as filed.

IV. In the opposition proceedings, maintenance of the patent was requested as main request on the basis of the claims as granted and as auxiliary requests on the basis of claim sets A, B and C filed on 18 January 1993 and set D filed on 30 March 1994.

V. The only independent claim, Claim 1, of claim set B (which later was the sole claim set before the Board of Appeal) read as follows:

"1. A composition suitable for the repair of periodontal osseous defects when mixed with a liquid, the composition consisting essentially of particulate bioactive and biocompatible glass said particulate glass having a particle size in the range of from about 90 to about 710µm and the following weight percentage composition:

Component	**Weight Percentage**
SiO2	40-52
CaO	10-50
Na_2O	10-35
P_2O_5	2-8
CaF_2	0-25
B_2O_3	0-10

and wherein at least a fraction of the said particles have a particle size in the range of from 500 to 710µm."

The only independent claim, Claim 1, of claim set D read as follows:

"1. A composition suitable for the repair of periodontal osseous defects when mixed with liquid, the composition consisting essentially of particulate bioactive and biocompatible glass, said particulate glass having the following weight percentage composition:

Component	Weight Percentage
SiO_2	40-52
CaO	10-50
Na_2O	10-35
P_2O_5	2-8
CaF_2	0-25
B_2O_3	0-10

said particulate glass consisting essentially of a mixture of equal weights by thirds of each of (1) said particulate glass having a particle size in the range of from 90 to 355µm, (2) said particulate glass having a particle size in the range of from 355 to 500µm, and (3) said particulate glass having a particle size in the range of from 500 to 710µm".

VI. The Opposition Division considered that the claims as granted and the sets of claims A, B and C did not comply with Article 123(2) and (3) EPC, but maintained the patent on the basis of claim set D.

VII. The Appellant (Patentee) filed an appeal against this decision, originally on the basis of a main request and three auxiliary requests respectively corresponding to the claims as granted or sets of claims A, B, or C refused by the Opposition Division. During the course of oral proceedings on 6 November 1996 the Appellant restricted himself to a sole request corresponding to the set of claims B before the Opposition Division.

VIII. The reasoning of the Opposition Division insofar as relevant to the refusal of claim set B (the sole set of claims before the Board), was that as filed the application covered only a particle distribution covering the whole range from 90 to 710µm, whereas claim 1 of set B required as essential only a fraction in the range from 500 to 710µm plus possibly other

arbitrary fractions which may or may not have particle sizes falling within this same range. The Opposition Division was of the opinion that it appeared from the original application that a "statistical repartition" (statistical distribution) of particle sizes over the whole range 90 to 710µm was necessary, and that as claim 1 of set B did not require this it did not have a fair basis in the application as filed contrary to the requirement of Article 123(2) EPC. Claim set D however was allowable as its subject-matter was disclosed in the original application.

IX. Oral proceedings were held on 6 November 1996. During the oral proceedings the Appellant filed a new request with an adapted description, the claims of said request corresponding with those of auxiliary request B, all other requests were relinquished.

X. The Appellant argued essentially as follows as regards the sole request maintained:

- The amendments made to claim 1 were of a limiting nature and did not contravene Article 123(2) and (3) EPC, especially as the word "comprising" (see claim 1 as originally filed) had been replaced by the more limiting term "consisting essentially of" and because the new request included the requirement for the glass particles to be of a size within the range from 90 to 710µm whereas claim 1 as granted did not specify this limitation.

- The further requirement of claim 1 that a proportion of the glass particles be of size within the range 500 to 710µm was a restriction relative to both the originally filed claim 1 and claim 1 as granted. It was fairly based on the examples in the description and claim 4 as originally filed.

- The Appellant argued that contrary to the view of the Opposition Division a requirement that there be "statistical repartition" (statistical distribution), Gaussian or otherwise, of glass particle sizes over the whole range 90 to 710µm could not be read into the application as originally filed. This view was inconsistent with the wording of the claims filed with the application, and the examples.

XI. The Respondent (Opponent) argued essentially as follows as regards the sole request maintained:

- A Gaussian distribution of glass particle sizes was a necessary feature of the invention, and this had been confirmed by the decision of the Opposition Division.

- Accordingly the new main claim represented a violation of Article 123(2)(3) EPC because claim 1 as originally filed required a spread of particle sizes over the range 90 to 710µm and the inclusion of the reference to "at least a fraction of particles of specific size range 500 to 710µm" allowed the possibility that only glass particles of this size range in the absence of any other could be used in the composition. This form of claim was not supported by the originally filed application and was a form which extended the protection conferred by the claims as granted.

XII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims and description submitted at the oral proceedings on 6 November 1996.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. *Fair Basis (Article 123(2) EPC)*

1.1 Claim 1 is fairly based on claims 1 and 4 as originally filed. The wording "having a particle size in a range of from about 90 to about 710µm" merely requires the particles to have sizes all falling within this range. It does not mean "having sizes distributed over the whole range". If the applicant had meant this he could have said so. That the most convenient way of fulfilling the requirements is to have a range of particle sizes, does not mean that this is an essential requirement. Furthermore the term "consisting essentially of" is narrower in meaning than is the term "comprising", so that no new subject-matter is introduced by this amendment.

1.2 The originally filed document discloses at page 10, lines 25 to 29 that the ground glass used in the examples was sized with a series of sieves to give three glass particle fractions. The fractions obtained from this process were of size 90 to 355µm, 500 to 710µm and 90 to 710µm. The results from Table 1 on page 9 show that the compositions employing glass particles of the separate given size ranges all exhibited the required cohesive properties. Two of these glass fractions did not contain particles covering the whole range 90 to 710µm. Thus a Gaussian

particle size distribution covering this whole range is demonstrated by these examples as not being necessary. Such a distribution as an essential requirement is also inconsistent with the statement now appearing on page 4 of the patent as granted "However, even the 500-710µm glass powder was still markedly superior in cohesion and manipulation to HA or TCP dry powders". This clearly indicates that it was not intended to limit the invention to powders having particle sizes extending over the whole range, even though these produce an optimum effect. The limited range powder also provides benefits.

1.3 The Board has no evidence before it that particles of uniform size in the claimed range would not work. If this were the case this might found an attack under Article 83 EPC, but no such attack was made in the opposition.

1.4 The Respondent's argument that as originally filed there was a requirement that the composition contain glass particles of sizes which cover the whole of the 90 to 710µm range, which argument found favour with the Opposition Division, derived this "requirement" merely from the described preferred embodiment. Such limitation of the scope of the claims originally filed by reading into them all the details of a preferred embodiment is not justified in this case.

1.5 Accordingly the Board concludes that Claim 1 is fairly based on the application as filed. No separate argument was made in relation to the dependent claims. The set of claims now put forward meets the requirements of Article 123(2) EPC.

2. *Article 123(3) EPC*

2.1 The scope of the present claim 1 is narrower than that of claim 1 as granted as this required a fraction of particles having a size in the range from about 355 to about 710µm to be present, whereas now a fraction of particles with a size in the smaller subrange 500 to 710µm must be present. The scope of the claim 1 now put forward thus falls wholly within the scope of Claim 1 as granted. The other claims are dependent claims of more limited scope than claim 1. Accordingly the whole set of claims now put forward meets the requirements of Article 123(3) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to maintain the patent on the basis of claims and description submitted at the oral proceedings on 6 November 1996.

The Registrar: The Chairman:

D. Spigarelli L. Galligani