BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [X] To Chairmen and Members
(C) [ ] To Chairmen

D E C I S I O N
of 24 March 2000

Case Number: T 0556/96 - 3.2.2

Application Number: 87307359.7

Publication Number: 0256893

IPC: A61F 13/00

Language of the proceedings: EN

Title of invention:
Wound dressing, its preparation and use

Patentee:
Smith & Nephew plc

Opponent:
Johnson & Johnson

Headword:
-

Relevant legal provisions:
EPC Art. 52, 56, 84, 104, 116

Keyword:
"Clarity (yes)"
"Inventive step (no)"
"Apportionment of costs (yes)"

Decisions cited:
T 0930/92

Catchword:

1. The equitable obligation of a party summoned to oral proceedings to inform the EPO that it will not attend (T 930/92) implies that the party reaches a decision and notifies it in good time, i.e. sufficiently in advance of the date of the oral proceedings to allow the Board to reconsider the need for oral proceedings, if necessary after having contacted the other parties summoned, and to give notice to them that the oral proceedings have been cancelled as a consequence.

2. Where a party informs the EPO and/or the other parties of its intention not to attend the oral proceedings so late that cancellation of the oral proceedings is no longer a feasible option, then, for the purposes of apportionment of costs, the party responsible is to be treated as if it had been absent without prior notice.

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0556/96 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 24 March 2000

Appellant: (Proprietor of the patent)
Smith & Nephew plc
2, Temple Place
Victoria Embankment
London WC2R 3BP (GB)

Representative:
Gilholm, Stephen Philip
Corporate Patents Department
Smith & Nephew Group Research Centre
York Science Park
Heslington
York YO1 5DF (GB)

Respondent: (Opponent)
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick
New Jersey 08933-7003 (US)

Representative:
Fisher, Adrian John
Carpmaels & Ransford
43 Bloomsbury Square
London, WC1A 2RA (GB)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 29 April 1996 revoking European patent No. 0 256 893 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: W. D. Weiß

Members: D. Valle
R. T. Menapace

Summary of Facts and Submissions

I. The appellant (proprietor of the patent) lodged an appeal, received on 15 June 1996, against the decision of the Opposition Division of 29 April 1996 to revoke the patent No. 256 893 and paid the appeal fee on the same day. The statement setting out the grounds of appeal was received on 6 September 1996.

II. The Opposition division held that the ground brought forward by the opponent (lack of inventive step) was sufficient to revoke the patent.

The relevant documents of the state of the art upon which the decision was based are:

(D1) EP-A-0 050 514

(D2) US-A-3 292 619.

As direct reaction to the arguments of the appellant, the respondent filed with the reply of 21 March 1997 the following further documents:

(D8) US-A-3 054 148

(D9) product descriptions for Bactigras, Bioclusive, Jelonet, Opsite, Paratulle, Silicone N-A, Sofra-Tulle and Tegaderm dressings

(D10) Lawrence, J. C, Advances in Wound Management, pages 53 to 56, proceedings of the Symposium held in Cardiff on 20 and 21 March 1985.

(D11) DE-U-8 406 128 (also cited in the search report)

With letter of 4 October 1999 the respondent filed further a copy of page 1309 of the Merck Index, 9th Edition.

III. In its statement of grounds the appellant (proprietor of the patent) requested that the decision under appeal be set aside and the patent be maintained on the basis of amended claims 1 and 17 according to the main request and the three auxiliary requests, which were filed together with the statement of grounds and further requested that oral proceedings be held in case that the main request would not be held allowable.

On 21 March 1997 the respondent filed his reply which contained an unconditional request for oral proceedings.

IV. Having obtained the parties' agreement to the envisaged date the Board, on 25 March 1999, issued a summons to oral proceedings together with a communication informing the parties that the main issues to be dealt with during the oral proceedings would be clarity and inventive step of the sets of claims as filed by the appellant together with his statement of grounds. The parties made no further written submissions.

V. On 12 October 1999, that is the day before the oral proceedings, apparently around noon London local time, the appellant sent a facsimile both to the Office under its general fax number in Munich and to the office of the respondent's representative, in which he announced that the appellant did not wish to attend the oral

proceedings and that he was content for the Board to decide the issue on the basis of the documents submitted to date.

The respondent's representative then contacted the Office by telephone, according to his submissions as soon as the content of the appellant's facsimile had been read to him over the telephone after he had already passed through the gate at Heathrow/London to board the aircraft to Munich and queried whether the oral proceedings would actually take place. The Board, at that time, was not in a position to take any measure or decision regarding the scheduled oral proceedings because the facsimile, which had not been sent directly to extension 3014 as specified in the summons of 25 March 1999, had not yet reached the Board. This occurred only at 15.03 local time Munich when, after a previous phone call between the registrar and the appellant, the facsimile was again sent to the Office, this time to the aforementioned extension.

VI. As a consequence the oral proceedings were held as fixed on 13 October 1999 and were only attended by the respondent (opponent), who requested

(1) that the appeal be dismissed and

(2) apportionment of costs for preparation of and travel to today's (13 October 1999) oral proceedings.

In support of the second request he referred to decision T 930/92 and submitted that, had the appellant notified the Board earlier, the Board would have asked

the respondent's representative whether his request for oral proceedings was being maintained, and he would have had the opportunity to withdraw his request and to save the time and costs for preparing and attending the oral proceedings. Therefore, the fact that he had made an earlier unconditional request for oral proceedings was of no relevance.

VII. At the end of the oral proceedings it was announced that the appeal was dismissed and that the decision on the respondent's request for apportionment of costs would be taken in writing.

VIII. In response to the Board's further communication dated 19 October 1999 the appellant submitted in a letter of 21 December 1999 that he did notify his position in advance as soon as he knew that he would not be attending the oral proceedings, without wilful intent to delay matters, and that the message transmitted by telecopy to the office of the respondent's representative was received by him before departure to Munich, and that the other party's unconditional request for oral proceedings covered the eventuality that the other party might not appear.

In his letter of 22 December the respondent's representative pointed out that no details were given as to the circumstances of and reasons for the appellant's decision not to attend the oral proceedings; he reiterated his claim for apportionment of costs.

IX. The amended claim 1 according to the main request as filed with the statement of grounds reads as follows:

"A non-adherent wound dressing comprising a film (2) which contains depressions (3) impressed out of the plane of the film over the operative area of the dressing and contained within the depressions (3) a viscous pharmaceutically acceptable carrier containing a therapeutic amount of at least one antibacterial agent, wherein the dressing does not include an integral layer of absorbent material adjacent said film (2) and is packaged in a bacteria-proof and waterproof pack."

Claim 1 of the first auxiliary request contains the additional feature: "and, optionally, a protector layer placed over one or both surfaces of the film to prevent the carrier from being ejected from the depressions during transportation and storage". Furthermore the disclaimer of the main request: "the dressing does not include..." has been deleted.

Claim 1 of the second auxiliary request contains the additional feature: "which substantially fills the depressions, the land areas of the film between the depressions being substantially free of carrier". Furthermore the disclaimer of the main request has been deleted.

Claim 1 of the third auxiliary request is based on a combination of the main and the second auxiliary request.

X. The appellant argued essentially as follows.

The claims had been clarified by providing that the depressions are impressed out of the plane of the film.

Such feature had the advantage that the dressing could be made from a thin film (column 5, line 48 to 50) whilst the depressions could be much deeper than the thickness of the film (column 3, lines 31 to 34) making the dress more comfortable. Furthermore some carriers may be easily expelled from the depression onto the skin by pressing or smoothing the non-wound-facing side of the dressing.

Applying the ointment manually to a dressing as disclosed in document (D1) would not assure sterile conditions and correct dosing. The absorbent layer in document (D2) would on the other hand absorb at least some components of the antibacterial preparation in particular during long storage periods, reducing the effect of the antibacterial composition and the capacity of absorption of the pad. Paragraphs 8 and 11 of the decision under appeal acknowledged the above advantages of the claimed dressing. Reference was also made to the letter of the patent proprietor of 16 August 1995, page 4, last paragraph and to the submissions made during the oral proceedings in opposition.

The scope of the first auxiliary request was similar to that of the main request and had been presented in order to prevent a possible objection to the disclaimer contained in the main request.

Regarding the second auxiliary request, the advantages had already been highlighted in paragraphs 6 and 7 of the decision under appeal (precise control of the amount of ointment, less messy), see also column 1, lines 52 to 55 and column 2, lines 20 to 24 of the

patent in suit. In this context reference was also made to the arguments put forward during the oral proceedings and to the letter of 16 August 1995, especially pages 3 and 4.

Regarding the third auxiliary request the arguments were the same contained in points 9 and 3 of the statement of grounds.

XI. The respondent argued as follows.

Claim 1 according to the main request did not comply with Article 84 EPC. The expression: "depression impressed out of the plane of the film" was unclear. On the other hand, if it was meant that such plane was that formed by the wound-contacting surface or the medial plane, then also document (D1) disclosed such feature.

The word: "impressed" was a process feature in a product claim which made the claim unclear. The process was also not clear.

The expression: "integral layer of absorbent material adjacent said film" was also unclear. It was in fact not clear whether or not the claim covered a dressing which was packaged with an absorbent layer which was adjacent to the film, but not physically bonded to it.

Regarding inventive step:

It was well known from documents (D1) and (D2) to provide a non-adherent wound dressing comprising a wound-contacting layer formed of a film containing

depressions.

It was also well known to provide viscous pharmaceutical carriers containing antibacterial agent and to apply it to the wound-contacting surface of the wound dressing. This had been conceded by the proprietor, see Mr Gilhom's letter of 16 August 1995, page 3, lines 7 to 9.

Document (D8) disclosed a process for producing a perforated or indented thermoplastic sheet (see lines 41 to 55) which would yield a film having the same general form as disclosed in the drawings of the patent and corresponding to the claimed feature: "impressed out of the plane of the film". Moreover such films were suitable to be used as surgical tapes (column 4, line 59).

Document (D11) disclosed a film containing within depressions a viscous pharmaceutically acceptable carrier containing a medicament which was suitable for wound dressing. The same document (D11) disclosed the use of zincoxide paste, see page 5, line 3, which by the Merck Index is described as an antiseptic. It was obvious to apply such an ointment to a film made by the process of document (D8).

Regarding in particular the claimed feature: "the dressing does not include an integral layer of absorbent material adjacent to the film", a non-adherent wound dressing without absorbent layers was well known in the art, see document (D9): Bactigras and Tegaderm dressings had been available since 1976 and 1984 respectively; Opsite and Bioclusive dressings were

also available before the priority date, see page 54 and 55 of document (D10). Document (D10) discussed also the incorporation of antibacterial agents into the material of the film dressing (fourth paragraph, page 56).

Regarding the claimed feature: "The dressing is packaged in a bacteria-proof and waterproof pack", all the dressings disclosed in document (D9) were so packaged.

The auxiliary requests did not add anything relevant to the main request.

Reasons for the Decision

1. The appeal is admissible.

2. *Clarity (Article 84 EPC)*

Contrary to the statement of the respondent, the words: "depressions impressed out of the plane of the film" do not make claim 1 unclear. According to the specification and drawings, "out of the plane of the film" means that the depth of the depressions is greater than the thickness of the film. The process itself is explained in examples 1 and 2. A process feature in a product claim is also allowable when there are no more precise and concise ways available to define the structural features of the product itself. This is the case here. The words: "(no) integral layer of absorbent material adjacent said film" mean that the garment is delivered without an absorbent layer in

contact with the film, see in particular example 6 and column 7, lines 46 to 54 of the patent specification.

Consequently the claims according to all requests do not contravene the requirements of Article 84 EPC.

3. *Inventive step*

3.1 Document (D11) discloses a non-adherent dressing especially directed to antiphlogistic applications (see examples at page 7), but which is also suitable as a wound dressing (at page 6, line 28, the term: "Pflaster" is used, which refers also to wound dressings, see: Roche, Lexikon der Medizin, 3. Auflage, 1993) comprising a film ("Folie" 1, page 4, lines 12 to 14) containing depressions over the operative area of the dressing and containing within the depressions a viscous pharmaceutically acceptable carrier (page 4, line 26, to page 5, line 7), wherein the dressing does not include an integral layer of absorbent material adjacent said film (2) and is packaged in a bacteria-proof and waterproof pack (page 4, lines 18 to 25, where an air proof pack is disclosed; this implies for a person skilled in the art also a bacteria- and waterproof pack). Furthermore the cited document discloses the feature that the pharmaceutically acceptable carrier contains a therapeutic amount of at least one antibacterial agent. In fact, at page 4, lines 26 to 30, there is disclosed the possibility of using every medical effective substance and among the substances listed there are some (for example "Zinkoxydpaste", page 5, line 3) which appear to be effective also in wound treatment (see: Merck Index) and others ("Paraffin") which are also cited in the

patent in suit (column 6, line 25).

Claim 1 distinguishes therefrom in that the depressions are impressed out of the plane of the film.

Regarding the problem to be solved, the distinguishing feature implies that the material of the dressing is relatively thin, so making the dressing more comfortable to wear.

The distinguishing feature is however a common feature in the field, as it is proved by the consideration of the documents (D2) and (D8).

3.2 Document (D2) discloses a non-adherent wound dressing comprising a flexible film (1) (column 2, line 45) which contains depressions (4) impressed out of the plane of the film over the operative area of the dressing.

Document (D8) discloses a process for producing surgical tape (column 4, line 59) consisting of a non-adherent wound dressing comprising a film which contains depressions impressed out of the plane of the film over the operative area of the dressing wherein the dressing does not include an integral layer of absorbent material adjacent said film (2). The product has a degree of flexibility substantially equivalent to that of woven materials (column 4, line 44) and therefore it is particularly comfortable.

3.3 Nothing inventive can be seen in the combination of the known features in the way of claim 1 of the main request, also because no surprising effect can be seen

on it. Accordingly the subject-matter of claim 1 of the main request does not involve an inventive step.

4. *Auxiliary requests*

4.1 Claim 1 according to auxiliary request 1 contains an additional optional features which does not restrict the scope of the claim.

4.2 The independent claims according to the auxiliary requests 2 and 3 contain the additional feature that the agent substantially fills the depressions, the land areas of the film between the depressions being substantially free of carrier. The feature is disclosed in document (D11), see Figure 3, reference number 6.

4.3 Therefore, the subject-matter of the claims 1 of the auxiliary requests does not involve an inventive step either.

5. *Apportionment of costs*

5.1. According to Article 104(1) EPC, each party to opposition proceedings shall meet the costs it has incurred, unless a different apportionment is ordered for reasons of equity. This means that under the EPC a party's right to defend its case orally (Article 116(1) EPC) does not normally entail bearing the costs which the exercise of this right incurs for the other parties (including the EPO, oral proceedings being free of charge by the EPO); a party deliberately refrains from exercising this right if it decides not to attend the oral proceedings.

5.2 The Board's decision to hold oral proceedings is based, among other considerations, on the assumption that any party to the proceedings will normally make use of the right to argue its case orally if this opportunity is offered to it and, therefore, that it will appear, if summoned. This expectation is not only supported by experience, but also reasonable in view of the Offices' practice of issuing a summons only after the parties have agreed to the envisaged date of the oral proceedings. Therefore, a party's decision not to attend oral proceedings to which it was summoned - a decision it is free to take in that nobody can be forced to appear in proceedings before the EPO - gives rise to a change in respect of one of those circumstances which were relevant, if not causal, for the Board's conclusion that oral proceedings were necessary or appropriate in the given circumstances. Equally, it affects the other parties which make their preparations on the assumption that the oral proceedings will take place and the opposite party will attend them.

5.3 It is because of that legal and factual interrelationship of all those involved in proceedings (including the Board), that, as held in decision T 930/92, there is an equitable obligation upon every party which is summoned to oral proceedings to inform the EPO as soon as it knows that it will not attend as summoned. If the information about a party's intention not to attend oral proceedings comes too late to allow those concerned to react properly to it, they are put into the same situation as if the party were absent without prior notice. Therefore, the aforementioned equitable obligations imply that each party reach a

decision in good time as to whether it will attend the oral proceedings or not.

5.4 "In good time" is an objective criterion to be established by taking into account the time required by those concerned to assess the new situation and to deal with it by taking the necessary and appropriate measures without undue stress and time pressure. As regards the Board, it should be borne in mind that its reaction not only encompasses the reconsideration of whether oral proceedings are still appropriate or mandatory - an assessment requiring the participation of all members and possibly even that of the other parties - but also consequential arrangements (eg in respect of interpreters) and in any event a formal notification to the parties, likewise in good time, in case the Board decides to cancel the oral proceedings in question. Given this, a safety period of about one month, ie the minimum period set by the Office under Rule 71a EPC, seems appropriate for the purpose. It is reasonable and generally accepted that the parties should normally be able to make their preparations for oral proceedings sufficiently early so that new facts and evidence which they wish to have considered in the oral proceedings are presented to the competent body not later than one month before the date of the oral proceedings - see Rule 71a EPC and the relevant practice of the Office. The decision not to attend the oral proceedings is an alternative conclusion to the preparations for oral proceedings.

5.5 Under Article 104(1) EPC the sanctions for a party's non-compliance with its equitable obligations in this context are limited to the costs caused to other

parties. Therefore, immediate information to the other party or its representative in parallel with the notification to the Board is relevant under Article 104(1) EPC, but not automatically exculpating, in that a reasonable reaction time must be left to the other party (or parties) which may need to discuss the matter with its representative and possibly to contact the Board before being in a position to decide what to do; it then has to inform the Board accordingly and to make the ensuing re-arrangements (eg cancelling travel and accommodation reservations). All this is not a matter of hours and, therefore, the "point of no return" in this context is not that point in its literal meaning, ie when the other party or its representative (irrevocably) departs for the oral proceedings.

5.6 In the Board's view it is not compatible with the principle of equity to lay down a general rule as to the length of an appropriate safety period vis-à-vis the other parties, as this depends on the circumstances of the individual case. Nor is it necessary in the present case to establish a precise point in time after which it was too late to communicate the appellant's intention not to attend the oral proceedings, scheduled on 13 October 1999, to the Board and the respondent. It suffices to point out that when the Board received the appellant's telecopy in the afternoon of the previous day, the respondent's representative had already boarded his flight to Munich, so that cancelling the oral proceedings was no longer an option enabling the costs incurred to him to be saved - quite apart from the difficult situation for the Board which was unable to reach the representative and was forced to meet

again to adapt its internal preparations for the proceedings at short notice. As regards the representative, whose office received the appellant's telecopy some hours earlier, he was deprived of the information and time needed to make a sound decision as to whether or not to attend the oral proceedings the next day. This is the relevant aspect, not whether he could still avoid travelling to Munich on learning about the appellant's intention not to appear.

5.7 The argument that timely notice by the appellant would not have had a cost-saving effect for the respondent, had the Board decided to hold the oral proceedings anyway may be relevant for actions in tort. This eventuality does not however exclude an apportionment of costs for reasons of equity in a situation such as the present one, where the real possibility existed that the respondent, upon timely notice by the appellant, would have withdrawn his request for oral proceedings, either on his own initiative or at the suggestion of the Board; this is supported by the immediate reaction of the respondent's representative when he (belatedly) was informed of appellant's decision not to attend which rendered the oral proceedings superfluous, in particular in view of the fact that the appellant had not commented in writing on the Board's communication of 25 March 1999.

5.8 Under the circumstances of the present case the very late notification by the appellant that he would not attend the oral proceedings constituted a breach of his equitable obligations and placed the respondent in the same situation, as if the appellant had been absent without prior notice. Thus it appears equitable under

Article 104(1) EPC that the appellant should meet in full the remuneration and expenses of the respondent's representative for preparing and attending the oral proceedings.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The costs in the appeal procedure shall be apportioned so that the appellant shall pay the respondent the full costs which he incurred as a result of his representative's preparations for and attendance at the oral proceedings.

The Registrar: The Chairman:

V. Commare W. D. Weiß