

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 13 August 2002

Case Number: T 1104/98 - 3.3.2

Application Number: 92302085.3

Publication Number: 0507461

IPC: A61L 2/18

Language of the proceedings: EN

Title of invention:

Office size instrument sterilization system

Patentee:

STERIS CORPORATION

Opponent:

SciCan a Division of Lux and Zwingenberger ltd.

Headword:

-

Relevant legal provisions:

EPC Art. 56

Keyword:

"Inventive step - yes - no hint"

Decisions cited:

-

Catchword:

-



Case Number: T 1104/98 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 13 August 2002

Appellant: STERIS CORPORATION
(Proprietor of the patent) 9450 Pineneedle Drive
Mentor
Ohio 44060 (US)

Representative: Parr, Ronald Edward
R.E. Parr & Co.
Colman House
Station Road
Knowle
Solihull
West Midlands B93 0HL (GB)

Respondent: SciCan
(Opponent) a Division of Lux and Zwingenberger ltd.
1140 Don Mills Road
Toronto
Ontario M3B 3P9 (US)

Representative: Puschmann, Heinz H., Dipl.-Ing. (FH)
Puschmann & Borchert
Patentanwälte
European Patent Attorneys
Sendlinger Strasse 35
D-80331 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 8 October 1998
revoking European patent No. 0 507 461 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
B. J. Schachenmann

Summary of Facts and Submissions

- I. European Patent No. 0 507 461 based on application No. 92 302 085.3 was granted on the basis of 11 claims.

Independent claims 1 and 2 as granted read as follows:

"1. An apparatus for use in microbial decontamination of articles, the apparatus comprising:
a body portion including a face panel (46);
a microbial decontamination chamber (10) to contain articles to be microbially decontaminated, the chamber having an access opening in the face panel;
a chamber (20) to receive an anti-microbial substance, the chamber having an access opening in the face panel and being in fluid communication with said access opening of the microbial decontamination chamber (10);
means to circulate a fluid through the anti-microbial concentrate in the chamber (20) to produce an anti-microbial solution;
a door (B) to close over the access opening of the microbial decontamination chamber (10) and the access opening of the chamber (20), and to define with the face panel (46) a path for the anti-microbial solution;
the face panel (46), door (B) and microbial decontamination chamber (10) being so disposed that, when the apparatus is in its operative position, the face panel and door are substantially vertical and the microbial decontamination chamber is substantially horizontal.

2. A microbial decontamination apparatus including a body portion having a face area (46) that defines an access opening to a microbial decontamination chamber (10) and an access opening to an anti-microbial

concentrate-receiving chamber (20), a door means (B) which closes over at least a portion of the face area (46) which includes a microbial decontamination chamber access opening, and a fluid circulating means (40) for selectively circulating fluid through the anti-microbial concentrative-receiving chamber (20) to form an anti-microbial solution, the anti-microbial solution flowing between the door (B) and face panel (46) and through the microbial decontamination chamber (10), the system characterized in that the face panel (46) and door (B) are generally vertical and the microbial decontamination chamber (10) generally horizontal."

- II. Opposition was filed against the granted patent by the respondent. The patent was opposed under Article 100(a) EPC for lack of inventive step.

For the assessment of inventive step, the following documents were *inter alia* cited during the proceedings before the Opposition Division and the Board of Appeal:

(1) EP-A-0 397 352

(2) EP-A-0 232 170

- III. The decision of the Opposition Division, posted on 8 October 1998 revoked the patent under Article 102(1)EPC for lack of inventive step.

The Opposition Division held that since the only distinguishing feature over document (1), namely the fact that the decontamination chamber and the face panel were perpendicular to each other, did not provide for any surprising effect, said feature could not

substantiate for an inventive step over this closest state of the art.

- IV. The appellant lodged an appeal against the said decision.
- V. Oral proceedings were held before the Board on 13 August 2002.
- VI. The appellant held that the distinguishing feature over the apparatus as disclosed in document (1), ie the geometric disposition of the decontamination chamber and the covering door was in fact of crucial importance. Indeed, this difference provided an outstanding advantage in that it enabled the apparatus of the opposed patent to fit compactly on a countertop.
- VII. The Respondent contested these arguments.

It was of the opinion that the distinguishing feature over document (1) was in fact disclosed in said document in a general wording and that the skilled person could moreover modify the apparatus according to document (1) to arrive at the apparatus as claimed without being inventive.

- VIII. The appellant requested that the decision under appeal be set aside and that the patent be maintained with the claims as granted (main request), or on the basis of one of the auxiliary requests 1 to 5 filed on 9 July 2002 each including only claims 1 and 2 and an indication as to a rearrangement of the dependent claims as granted.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. The claims under consideration are the same as the claims as originally filed and as granted. There are accordingly no objections on the basis of Articles 123(2) and (3) EPC.
3. The only question to be considered in the present decision is whether or not the subject-matter of independent Claims 1 and 2 involves an inventive step within the meaning of Articles 52(1) and 56 EPC.
 - 3.1.1 Document (1) concerns an apparatus for use in microbial decontamination of articles, the apparatus comprising:
 - a body portion including a face panel (see Figure 1);
 - a microbial decontamination chamber (ie a basin) (10) to contain articles to be microbially decontaminated, the chamber having an access opening in the face panel (see Figure 1);
 - a chamber (ie a well) (70) to receive an anti-microbial substance, the chamber having an access opening in the face panel and being in fluid communication with said access opening of the microbial decontamination chamber (10) (see Figure 1,2 and column 4, lines 38 to 57);
 - means to circulate a fluid through the anti-microbial concentrate in the chamber (70) to produce an anti-microbial solution;

a door (ie a lid) (12) to close over the access opening of the microbial decontamination chamber (10) and the access opening of the chamber (70) (see Figure 1), and to define with the face panel a path for the anti-microbial solution (see Figure 1 and column 4, lines 38 to 57 and column 5, lines 32 to 34).

Not disclosed in said document is the particular arrangement according to the patent in suit, namely that the face panel (46), the door (B) and microbial decontamination chamber (10) are so disposed that, when the apparatus is in its operative position, the face panel and door are substantially vertical and the microbial decontamination chamber is substantially horizontal.

In that respect, it is pointed out that the term "substantially" in relation with vertical and horizontal introduces some unclarity. At the present stage, since Article 84 is neither a ground of opposition nor a ground of appeal, these terms can therefore only be understood in the light of the description and the drawings as filed.

As apparent from Figure 3 of the patent in suit, these terms imply that the face panel and the door may have a certain inclination in respect to the vertical and that they are perpendicular to the microbial decontamination chamber, which therefore may also have a certain inclination in respect to the horizontal.

Moreover, having regard to the intended use of the apparatus, namely decontamination of medical equipment such as medical and dental instruments (see column 1, lines 3 to 11), it appears that it is clear to the

skilled person that the horizontal position of the decontamination chamber of the patent in suit refers to its longest dimension.

In fact, as apparent from the drawings of the patent in suit (Figures 2, 3, 8, 9 and 10) as well as from the drawings of the prior art (see (1), Figures 1 and 2), the shape of the decontamination chamber is that of a right-angled parallelepiped having a large bottom. This shape is indeed dictated by the intended use, namely that of receiving a cassette of the same shape arranged for receiving the instruments to be decontaminated in an organized pattern.

Contrary to the contested patent, document (1) discloses an apparatus wherein the door is horizontal in the closed position and opens upwardly (see Figure 1), whereas in the patent in suit the door is substantially vertical and therefor enables a front-loading.

- 3.1.2 The Board agrees with both parties that document (1), which deals with a liquid sterilizing system for decontaminating medical instrument as the patent in suit, represents the closest state of the art (page 2, column 1, lines 4 to 8, page 2, column 2, lines 15 to 17).

In the light of (1), the problem to be solved appears to be the provision of an apparatus suitable to receive a cassette for holding items to be microbially decontaminated and able to fit in a confined space and receive the cassette without interfering with overhead cupboards (see page 3, column 4, lines 47 to 50).

The problem is solved by the claimed apparatus which has the particular geometrical arrangement of the decontamination chamber and face panel and covering door.

Having regard to the description and the drawings, the Board is satisfied that the problem has been plausibly solved.

The question to be answered is thus whether the proposed solution is obvious for the skilled person faced with the problem defined above in the light of the available prior art documents (1) and (2).

The Board notes that (1) is totally silent about any problem relating to the size of the apparatus under operating conditions as well as to any possible change in the mutual arrangement of the face panel, the door and the decontamination chamber which are parallel to each other (see Figure 2).

Document (2) is a document which discloses an apparatus which is structurally very remote from the claimed structure having no front panel, no door and no decontamination chamber.

Accordingly, in the light of the available prior art documents, the Board must conclude that the person skilled in the art would have had no hint towards the claimed specific geometrical arrangement in order to solve the above defined problem.

In view of the above, it must be decided that the subject-matter of claim 1 involves an inventive step.

3.2.1 The respondent's main argument was that the apparatus of the patent in suit could be derived in an obvious way from the disclosure in document (1) alone.

3.2.2 The Board cannot share the respondent's conclusions for the following reasons:

The skilled person trying to solve the problem set out above would possibly consider the arrangement of a laterally slidable door in the apparatus of document (1) as an obvious alternative to the pivotable door. This alternative would however not correspond to the claimed solution.

The skilled person might also consider using the apparatus of document (1) in a vertical position, as suggested by the respondent during the oral proceedings. This would however also not end up with the arrangement as claimed since the door, the face panel and the chamber still remain parallel.

Moreover, the new specific geometrical arrangement of the face panel, door and decontamination chamber implies also different arrangements of the other elements of the decontamination apparatus such as for instance the means for circulating the fluids.

Accordingly claim 1 of the disputed patent is considered to involve an inventive step. The same applies to independent claim 2 which defines the same specific geometrical arrangement and claims 3 to 11 which are dependent on claims 1 or 2.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is maintained unamended.

The Registrar:

The Chairman:

A. Townend

U. Oswald