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D E C I S I O N
of 7 November 2002

Case Number: T 0967/99 - 3.2.6

Application Number: 94902566.2

Publication Number: 0676941

IPC: A61F 5/01

Language of the proceedings: EN

Title of invention:
Knee brace

Patentee:
GENERATION II ORTHOTICS INC.

Opponent:
dj Orthopedics, LLC

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Subject-matter of granted claim supported by the application
as originally filed - yes"
"Remittal to the first instance"

Decisions cited:
-

Catchword:
-



Case Number: T 0967/99 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 7 November 2002

Appellant: GENERATION II ORTHOTICS INC.
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Respondent: dj Orthopedics, LLC
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Representative: Samuels, Lucy Alice
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 July 1999
revoking European patent No. 0 676 941 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Alting Van Geusau
Members: G. C. Kadner
M. J. Vogel

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 676 941 in respect of European patent application No. 94 902 566 filed on 16 December 1993 and claiming a US-priority from 4 January 1993 was published on 7 May 1997. Independent claim 1 reads as follows:

"1. An orthopaedic brace comprising a pair of arms (18, 22) to be secured to a wearer's body and a pivotable joint (24) between said arms (18, 22) to allow pivoting of the knee while supporting the knee; characterised in that each of said arms (18, 22) is rigid and in that the brace further comprises a lockable joint means (44, 64) to allow controlled medial and lateral inclination of each arm (18, 22) relative to the pivotable joint (24) and to lock said inclination at a predetermined, fixed position."

II. Notice of opposition was filed on 9 February 1998 based on the grounds of Article 100(a) and (c) EPC.

III. By decision announced during the oral proceedings on 22 June 1999 and posted on 20 July 1999 the Opposition Division revoked the European patent 0 676 941. The Opposition Division was of the opinion that, since the term "rigid" was not disclosed in the application as filed, granted claim 1 contained subject matter which extended beyond the content of the application as originally filed and therefore violated Article 123(2) EPC.

IV. On 20 September 1999 notice of appeal was lodged against this decision together with payment of the appeal fee.

The statement of grounds of appeal was filed on 24 November 1999.

V. In addition to the documents submitted as evidence during the opposition proceedings the Appellant filed on appeal:

- Declaration of Mr Richard Loomer, and
- Declaration of Mr Fabian Pollo, both filed by facsimile on 7 October 2002;
- EP-A-0 670 152;
- Letter from the Applicant of European patent application 95 300 540.2 corresponding to EP-A-0 670 152 of 18 January 1999 submitted during examination proceedings, and filed by facsimile on 22 October 2002.

The Respondent (Opponent) additionally relied on the following documents:

- Declaration of Mr Richard Earle Gildersleeve, filed by facsimile on 21 October 2002;
- One page with sketches showing the function of knee braces, filed by facsimile on 1 November 2002.

VI. In a communication sent together with the summons to

attend oral proceedings the Board expressed the preliminary opinion that despite the fact that the term "rigid" introduced into granted claim 1 was not disclosed literally in the application as originally filed it appeared to be derivable by a skilled person from the contents of the patent application as a whole.

VII. Oral proceedings were held on 7 November 2002.

The Appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request),

auxiliarily

that the patent be maintained in amended form on the basis of claims 1 (first and second auxiliary request) filed on 22 May 1998 together with the statement of grounds of Appeal,

or on the basis of the documents filed during the oral proceedings (third auxiliary request).

The Respondent (Opponent) requested that the appeal be dismissed.

VIII. The submissions of the Appellant in support of its request are summarized as follows:

Although the term "rigid" was not as such literally mentioned in the application as filed, it was implicitly contained in the description. To a skilled person it was unambiguously clear that the arms could only work in their intended function if they were sufficiently rigid, ie stiff enough to fully support the knee following surgery. Since the knee brace could

be advantageously used instead of a cast giving full support to the knee without using straps the skilled person would clearly recognise that the arms had to be "sufficiently rigid" to achieve such a result. The straps mentioned in the patent were only necessary in order to fix the cuffs to the leg of the wearer whereas the supporting force was completely transmitted by the arms.

Since the meaning of the term "rigid" was clearly and unambiguously derivable from the originally filed documents, its introduction did not contravene Article 100(c) or 123(2) EPC, respectively, and the granted claims were therefore admissible.

IX. The Respondent essentially relied on the following submissions:

The term "rigid" was not disclosed in a manner sufficiently clear enough to define this expression beyond reasonable doubt to indicate its exact meaning in the technical sense. In particular, it was not clear whether "rigid" was to be interpreted in the sense of "completely stiff" or "substantially stiff" or "spring-like" because the description of the functional features indicating support to the knee allowed all of these interpretations.

Thus the skilled person would rather understand "rigid" in the sense of "stiff but flexible". The term "rigid" now used in the sense of "completely stiff" was selected from a range of stiffnesses disclosed by the functional properties of the arms. The expression introduced into claim 1 was not clearly and unambiguously derivable from the application as

originally filed.

Reasons for the Decision

1. The appeal is admissible.
2. *Compliance with the requirements of Article 123(2) EPC*
 - 2.1 Since the term "rigid" introduced into granted claim 1 is neither literally nor by an equivalent expression disclosed in the application as originally filed, it has to be established whether the claim complies with Article 123(2) EPC.

In its decision the Opposition Division took the view that the term "rigid" necessarily had to be understood as meaning that the arms did not deflect upon application of the loads applied during use of the brace, as distinguished from a degree of rigidity which, under the influence of the applied loads, would result in discernible flexing of the arms.

The skilled person faced with the teaching of the original application would not directly and unambiguously understand that the arms must be rigid in this sense and therefore the presence of the term "rigid" in claim 1 offended against Article 123(2) EPC.

- 2.2 It is to be noted that the Opposition Division started from the assumption that the essential function of the arms, as agreed by the parties, was to apply a lateral or medial **load** to the leg of the wearer of the brace and based the above conclusion on this mutual understanding of the **function** of the arms. However, it

is immediately apparent from the patent application as filed that the application of a lateral or medial **load** to the leg of the wearer of the brace by adjustment of the inclination of the arms 18 and 22, in fact only requires a sufficient degree of rigidity of the arms to apply a desired valgus force to the patient's leg (see page 12, lines 20 to 30).

The Board cannot follow the Opposition Division's conclusion according to which such result could only be achieved by arms that did not deflect at all upon application of the loads.

2.3 Consequently the Board comes to the conclusion that the rigidity of the arms disclosed by their functional properties is not to be understood in the sense of totally stiff but rather as having a range of flexibility; i.e. sufficiently stiff to be able to support the knee or to apply a lateral force to the knee of the wearer.

2.4 Since a sufficiently clear meaning of the general term "rigid" used in claim 1 is derivable from the application as a whole as originally filed and from the patent specification, granted claim 1 does not infringe the requirements of Article 100(c) EPC and Article 123(2) EPC. The revocation of the patent by the Opposition Division on the grounds of Article 100(c) EPC was unjustified and therefore examination with respect to novelty and inventive step needs to be carried out. The case therefore is remitted to the department of first instance for further prosecution.

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 for further prosecution.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau