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**Datasheet for the decision
of 13 February 2007**

Case Number: T 0648/05 - 3.2.02

Application Number: 98960364.2

Publication Number: 1042025

IPC: A61M 15/00

Language of the proceedings: EN

Title of invention:

Dry powder inhaler

Applicant:

Valois SAS

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"New subject-matter (yes, main request; no, auxiliary request)"

Decisions cited:

-

Catchword:

-



Case Number: T 0648/05 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 13 February 2007

Appellant: Valois SAS
B.P.G. - Le Prieuré
F-27110 Le Neubourg (FR)

Representative: CAPRI
33, rue de Naples
F-75008 Paris (FR)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 20 December 2004
refusing European application No. 98960364.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: S. Chowdhury
M. Vogel

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dated 20 December 2004 to refuse European patent application No. 98 960 364.2.

The application was refused on the grounds of Article 123(2) EPC because the subject-matter of claim 18 then on file contained new subject-matter. The decision also noted, by way of obiter dictum, that the combination of the subject-matter of claims 1 and 13 was not originally disclosed, nor was the combination of the subject-matter of claims 8 and 13.

II. On 7 February 2005 the appellant lodged an appeal against the decision and paid the prescribed fee on 9 February 2005. On 7 April 2005 a statement of grounds of appeal was filed.

III. Oral proceedings were held on 13 February 2007. The appellant requested that the decision under appeal be set aside and that a patent be granted in the following version:

- claims 1 to 22 filed during the oral proceedings (main request)
- claims 1 to 12 filed during the oral proceedings (first auxiliary request).

An earlier written request for the reimbursement of the appeal fee was withdrawn.

IV. Independent claim 1 and dependent claim 13 of the main request are based on original independent Claims 1 and 22, respectively. Claims 1 and 13 of the main request read as follows:

"1. An inhaler for pharmaceuticals, characterized in that it comprises: a housing (20, 210); a slider (24) on the housing; a ramp (72) on the slider; and a lifter (50) on the housing which moves on the ramp to open a pharmaceutical container as the slider slides out of the housing.

13. The inhaler of any one of claims 1 to 8 comprising: an aerosolizing chamber (224) within the housing (210); a propeller (226) within the chamber; a turbine linked to the propeller, the turbine having an inlet side (242) and an outlet side (245); a turbine shaft (246) extending out of the turbine and into the chamber, with the propeller mounted on the shaft; a first air pathway (236) extending from an air inlet in the housing to an inlet side of the turbine; and a second air pathway (260) extending from the outlet side of the turbine to the chamber."

Claims 2 to 12 and 14 to 22 are dependent claims.

Independent claim 1 of the first auxiliary request re-introduces a feature (an advancing finger) which was present in original claim 1 but omitted from claim 1 of the main request, and claims 13 to 22 have been cancelled in the second auxiliary request.

- V. The appellant argued as follows in the written and oral submissions:

The application first described an inhaler system, but the hub of the present invention was an opening system for the blister disk, i.e. a ramp, slider, etc. The application then described a dispensing system for the medicament, with variants thereof, e.g. a motor with a battery (first embodiment) or a turbine (second embodiment). Moreover, the description also explained that some design and operation details of the operation of the second embodiment were similar to those of the inhalers described in US-A-5 622 166, to which the first embodiment also referred.

The person skilled in the art would understand from the passages on page 12, lines 3 to 4 and page 9, lines 12 to 15 that one could freely combine the different systems described, and in particular combine the dispensing system of the second embodiment with the opening system of the first embodiment. Thus, the combination defined in claim 13 of the main request was properly supported by the application as originally filed.

Reasons for the Decision

1. The appeal is admissible.
2. The application was refused on the grounds that claim 18, a method claim, was objectionable under Article 123(2) EPC and that, were the claim to be amended to meet this objection, the claim would then be

objectionable under Article 52(4) EPC. This trap has been circumvented by cancelling the method claims from the present requests.

3. The decision to refuse also noted that the amended claims defined unallowable combinations of features of the different embodiments. The Board agrees with this objection in respect of the main request.
4. Article 123(2) EPC Main request

Since claim 13 is appended to any one of claims 1 to 7, this claim defines a combination of the features of the first embodiment of the inhaler, described with reference to Figures 1 to 15, and the second embodiment described with reference to Figures 16 to 20.

In particular, claim 13 explicitly combines the slider (24), ramp (72), and lifter (50) of claim 1 and of the first embodiment with the aerosolizing chamber (224), propeller (226), first air pathway (236), second air pathway (260), etc. of the second embodiment, for which combination there is no basis in the application as originally filed. In particular the passages of WO-A-99/27987 cited by the appellant (see V. above) do not provide such basis and the amendment fails the novelty test to be applied in such a situation.

The statement of invention on page 2 and page 12, lines 3 and 4 only states that the turbine of the second embodiment may replace the motor of the first embodiment. Such replacement would merely provide an inhaler as shown in Figures 3A and 3B, for example, but with a turbine, and only the turbine, of the second

embodiment replacing the battery (62) and motor (60) of the first embodiment.

The inhaler of US-A-5 622 166 possesses neither a slider-ramp-lifter combination for opening blisters, nor passageways and chambers as defined in present claim 13. Therefore, the statements in the application, that the present devices may possess some features of the US device, refer to other details such as those of the blisters (see the present application, page 3, lines 21 to 24, and page 7, lines 10 to 12 and 19 to 21). The teaching of the present application is only that the details of the blister device may be common to the first and second embodiments of the application, or that the motor of the first embodiment may be substituted by the turbine of the second embodiment. It does not suggest that other features are also common to these two embodiments.

According to the appellant it is obvious and absolutely clear that the slider, ramp, and lifter are essential features of the invention and thus part of the device of the second embodiment. That this statement is without merit is demonstrated by the fact that in the second embodiment a plunger (234) is used to open blisters and release a drug (page 9, lines 9 and 10) so that the slider-ramp-lifter combination would be superfluous here.

For the above reasons claim 13 defines a combination of features not disclosed in the application as originally filed, and the claim is objectionable under Article 123(2) EPC, accordingly.

4.1 First auxiliary request

Claims 13 to 22 have been cancelled in this request so that the above objections do not apply to this request.

5. Claim 1 of this request is based on claim 1 as originally filed and there is no objection to this claim under Article 123(2) EPC.
6. Since the decision to refuse the application was based only on Article 123(2) EPC, the Board considers it appropriate to remit the case to the department of the 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 on the basis of claims 1 to 12 filed as the first auxiliary request during the oral proceedings.

The Registrar

The Chairman

V. Commare

T. K. H. Kriner