

Internal distribution code:

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

**Datasheet for the decision
of 26 June 2008**

Case Number: T 1562/05 - 3.2.02

Application Number: 92905378.3

Publication Number: 0587567

IPC: A61M 5/145

Language of the proceedings: EN

Title of invention:
Front loading syringe driver

Patentee:
LIEBEL-FLARSHEIM COMPANY

Opponent:
Medrad Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Extended subject-matter (no, after amendments)"

Decisions cited:
T 0135/85, T 0331/87

Catchword:
-



Case Number: T 1562/05 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 26 June 2008

Appellant: LIEBEL-FLARSHEIM COMPANY
(Patent Proprietor) 2111 E. Galbraith Road
Cincinnati
Ohio 45237 (US)

Representative: Findlay, Alice Rosemary
Reddie & Grose
16 Theobalds Road
London
WC1X 8PL (GB)

Respondent: Medrad Inc.
(Opponent) One Medrad Drive
Indianola
PA 15051-0780 (US)

Representative: Zinnecker, Armin
Lorenz-Seidler-Gossel
Widenmayerstrasse 23
D-80538 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 November 2005
revoking European patent No. 0587567 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: M. Noel
M. J. Vogel

Summary of Facts and Submissions

- I. European patent No. 0587567 was revoked by decision of the opposition division dated 2 November 2005 on the basis of Article 123(2) EPC.

The reasons were that some features which were originally contained in the independent claims as filed and which then were omitted in the independent claims 1 and 53 as granted, were regarded by the opposition division as essential so as to result in claimed subject-matter going beyond the content of the application as filed.

- II. The appellant (patentee) lodged an appeal against this decision by notice received on 20 December 2005 and paid the appeal fee on the same day. A statement setting out the grounds of appeal was filed on 13 March 2006.

- III. Oral proceedings were held on 26 June 2008, at the end of which the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or one of the auxiliary requests 1 to 3, all filed on 23 June 2008.

The respondent (opponent) requested that the appeal be dismissed.

- IV. Independent claims 1 and 53 according to the main request read as follows:

1. "A disposable replacement liquid container (32) for a front loadable injector (10, 10A) for injecting the liquid into an animal and which has a pressure jacket, with a liquid container receiving bore and an open front end through which a liquid container is loadable into and unloadable from the bore, the container comprising a hollow elongated tube (55) having a fluid holding cavity (61) at least partially contained therein, a longitudinal axis (41), a front end (58) containing a front wall (57) sealed thereto and a rear end (56) having an opening therein, a plunger (54) snugly slidably mounted within the tube (55) and moveable longitudinally in the tube (55) between the rear end (54) and the front end (58) thereof and forming a fluid tight seal therewith to seal the cavity (61), the plunger (54) having a rearwardly facing coupling (96, 296) thereon, **characterised in that** the container is a syringe (32), the front wall (57) having pressure restraining structure of sufficient strength to support the front wall (57) when pressurised fluid contained within the tube (55) is discharged from the tube by movement of the plunger (54) and a discharge neck (59) extending beyond the front end (58) of the tube (55) with a discharge orifice (60) therethrough centered on the axis (41) and communicating with the cavity (61), and **in that** locking means (86, 200) is exposed exteriorly of the tube (55) and comprises threads lying outwardly of the body of the syringe and formed of thread sections (86, 200) circumferentially positioned around the tube (55) proximate the front end (58) thereof and configured to engage mating thread sections (85, 201) provided on the front end of the injector of pressure jacket (31) to lock the syringe (32) against longitudinal movement when the tube (55)

is inserted in the injector pressure jacket (31) and rotated about its longitudinal axis."

53."A disposable replacement liquid container (32) for a front loadable injector (10, 10A) for injecting liquid into an animal and which has a pressure jacket, with a liquid container receiving bore and an open front end through which a liquid container is loadable into and unloadable from the bore, the container (32) comprising a hollow body (55) having a cylindrical tubular wall, a fluid holding cavity (61) at least partially contained therein, a central longitudinal axis (41), a closed front end (58) containing a front wall (57) sealed thereto, and a rear end (56) having an opening therein, a plunger (54) snugly slidably mounted within the hollow body (55) having a rearwardly facing coupling (96, 296) thereon and movable longitudinally in the tube (55) between the rear end (54) and the front end (58) thereof and forming a fluid tight seal therewith to seal the cavity (61), a flange (203) surrounding and extending outwardly from the hollow body **characterised in that** the container is a syringe (32) the front wall (57) having pressure restraining structure of sufficient strength to support the front wall (57) when pressurised fluid contained within the tube (55) is discharged from the tube by movement of the plunger (54), **in that** means (200) for locking the container (32) to the injector pressure jacket (31) is spaced rearwardly of the flange and comprises outwardly extending thread sections (200) circumferentially spaced around the tube (55) proximate the front end (58) thereof configured to engage mating sections (201) around the opening (35) of the front end of the injector pressure jacket (31) to lock the syringe (32)

thereto upon the rearward longitudinal insertion of the rear end (56) of the syringe (32) into the opening (35) and rotation of the syringe (32) in the opening, and to thereby urge the flange (203) against the opening."

V. The parties presented the following arguments:

(i) The appellant

After the amendments to the independent claims 1 and 53 had been made by way of reintroduction of features regarded as essential, the grounds of opposition raised under Article 123(2) EPC were removed. Therefore, the claims to the main request were acceptable on the formal aspects.

The other features referred to by the respondent as still being missing in the independent claims were not considered as being essential since they were all concerned with constructional details of minor relevance, which had not their place in independent claims.

(ii) The respondent

The features introduced into the independent claims 1 and 53 of the main request still were insufficient to define completely the subject-matter of the present invention. As a matter of fact some features were present in the independent claims 32, 45, 62, 81, 85 of the application as filed, and, for this reason, were to be considered as essential to the invention. Consequently, their omission from the independent claims of the main request resulted in broadening the

scope of protection, contrary to the requirements of Article 123(2) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request - Article 123(2) EPC*
 - 2.1 During the examination proceedings up to the grant of the patent, broadening of a claim is not precluded by Article 123(2) EPC provided that its subject-matter remains within the frame of the application as filed (T 135/85, OJ EPO 1988, 441, points 4 and 5). In particular, the omission of a feature from an independent claim as originally filed is allowable if this feature is not essential to the solution of the problem set and is not presented as such in the application as filed (T 331/87, OJ EPO 1991, 22). The three conditions listed in the headnote of this latter decision actually represent three different aspects of the same criteria related to the essentiality of the omitted feature.
 - 2.2 In the present case, the objection raised by the opposition division under Article 123(2) EPC, which led to the revocation of the European patent, was removed as soon as the subject-matter of the independent claims was completed by a pressure jacket having a liquid container receiving bore and an open front end. As a matter of fact, as reported in the application as filed (see page 2, lines 2 to 19 and page 4, lines 14 to 19), the technical problem underlying the present invention

at its starting point, i.e. in the light of the background presented in the introductory part of the application, was to allow quick and efficient container (syringe) replacement from the front end of the injector unit in the case of high fluid pressure angiographic injectors, i.e. necessarily provided with pressure restraining jackets.

In the Board's view, the other features regarded also as essential by the respondent all refer to constructional details of lesser importance, whose place is more suitable to form the subject-matter of dependent claims.

The alleged omitted features referred to by the respondent with reference to the original claims 32, 45, 62, 81, 85 are related to:

- the pressure jacket having a longitudinal cylindrical internal bore;
- the syringe (container) being surrounded and restrained against radial expansion by the withstanding side wall of the jacket, when filled with a liquid at a predetermined operating pressure, and
- the outer rim of the syringe front wall encircling the front end of the jacket.

These features are all concerned with technical or functional details which are already covered, at least partially, by the present claimed features. For example, claim 1 already states that:

- the pressure jacket has a liquid container receiving bore;
- the container is a syringe and has a front wall having a pressure restraining structure of sufficient strength when pressurised fluid is contained therein; and
- the locking means comprise mating thread sections provided both on the front end of the container and the front end of the pressure jacket.

2.3 Contrary to the respondent's contentions, it matters little whether said alleged omitted features were previously present in various independent claims of the same category. Only the problem-solution approach is suitable to determine what the essential features of the solution are, starting with the technical problem and the state of the art presented at first in the application as filed. As mentioned above, the features related to the pressure jacket which were introduced in independent claims 1 and 53 are sufficient to overcome the objection of the first instance. The further alleged omitted features are not so relevant and can be left aside at this stage of the proceedings without ending in extended subject-matter prohibited by Article 123(2) EPC. In this respect, it is to be noted that the scope of the claimed subject-matter is to be distinguished from the scope (or extent) of protection referred to in Articles 69(2) and 123(3) EPC, which is set after the grant of the patent.

2.4 With respect to the version as granted, the amendments made to claims 1 and 53 are all fairly supported by the application as filed and, therefore, are not open to objection under Article 123(2) EPC. These amendments are identified in the applicant's submissions of 23 June 2008, by the following inserts 1 to 4:

Insert 1 (preamble of claims 1 and 53): "and which has a pressure jacket, with a liquid container receiving bore and an open front end through which a liquid container is loadable into and unloadable from the bore". These features are supported by original claims 32, 45, 62, 81 and by the paragraph bridging the pages 19 and 20 of the application as filed.

Insert 2 (added at the end of claim 1): "and configured to engage mating threads sections (85, 201) provided on the front end of the injector pressure jacket (31) to lock the syringe (32) against longitudinal movement when the tube (55) is inserted in the injector pressure jacket (31) and rotated about its longitudinal axis." These features are supported by the passage from page 23, line 18 to page 24, line 16 and by page 32, lines 20 to 27 of the application as filed.

Insert 3 (preamble of claim 53): "containing a front wall (57) sealed thereto". This feature was added to bring claim 53 into conformity with claim 1 and is also supported by page 20, lines 23 to 27 of the application as filed.

Insert 4 (characterising portion of claim 53): "circumferentially spaced around the tube proximate the front end (58) thereof". These features are derivable

from the embodiment shown in Figure 15 in connection with Figure 5 and more generally from the text referred to on page 38, lines 3 to 7.

Moreover, since the above amendments correspond to a restriction of the claimed subject-matter, the requirements of Article 123(3) EPC are also met.

2.5 As the remaining independent claims 21, 43, 48 of the main request were not objected to and since the present appeal was limited to the ground of opposition under Article 100(c) EPC (Article 123(2) EPC) raised against independent claims 1 and 53 only, now removed, nothing else prejudices the maintenance of the patent in amended form.

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 1 to 53 according to the main request, filed on 23 June 2008, a description to be adapted to these claims, and drawings, Figures 1 to 17, as granted.

The Registrar:

The Chairman:

V. Commare

T. Kriner