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**Datasheet for the decision  
of 19 January 2010**

**Case Number:** T 1438/08 - 3.2.06

**Application Number:** 96909649.4

**Publication Number:** 0762857

**IPC:** A61F 2/78

**Language of the proceedings:** EN

**Title of invention:**

Cushioning liner

**Patentee:**

THE OHIO WILLOW WOOD COMPANY

**Opponents:**

Otto Bock HealthCare IP GmbH & Co. KG  
F.G. Streifeneder KG

**Headword:**

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**Relevant legal provisions:**

EPC Art. 123(2), 84, 54, 111(1)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Amendments - added subject-matter (no)"  
"Claims - parameter range - clearly defined (yes)"  
"Novelty - prior disclosure - implicit features (no)"  
"Remittal (yes)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 1438/08 - 3.2.06

**DECISION**  
of the Technical Board of Appeal 3.2.06  
of 19 January 2010

**Appellant:** THE OHIO WILLOW WOOD COMPANY  
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**Respondent:** Otto Bock HealthCare IP GmbH & Co. KG  
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**Representative:** Lins, Edgar  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 11 July 2008  
revoking European patent No. 0762857 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** G. de Crignis  
R. Menapace

## Summary of Facts and Submissions

- I. European patent No. 0 762 857 granted on application No. 96909649.4, was revoked by the opposition division by decision announced during the oral proceedings on 10 June 2008 and posted on 11 July 2008.

Claim 1 as granted reads as follows:

"A cushion liner for enclosing an amputation stump, said liner comprising a fabric covering having an open end for introduction of said stump and a closed end opposite said open end, characterised in that said fabric is coated on at least the inside thereof with a form-fitting polymeric cushioning material which contacts the skin of the amputation stump when worn by a user to minimise or eliminate air pockets."

- II. The decision of the opposition division was based on the finding that claim 1 of the main request (claims as granted) and claim 1 of the first auxiliary request was not novel with regard to the disclosure in E2 "Orthopädie Technik", 11/1993, Otto Bock Gel-Strumpf "Derma Seal".

The second and third auxiliary requests which were filed during the oral proceedings were not admitted into the proceedings.

- III. On 18 July 2008 the appellant (patent proprietor) filed a notice of appeal against this decision and paid the appeal fee. The statement of grounds of appeal was filed on 21 November 2008 in which the appellant requested a decision that the subject-matter of the main request or one of four new auxiliary requests was

novel and that the Board remits the case to the opposition division to consider the question of inventive step.

Additionally documents

E19 Expert Report of Dominic Hannett

E20 Atlas of Limb Prosthesis, Surgical, Prosthetic, and Rehabilitation Principles, 2nd Edition, Eds. Bowker and Michael, Mosby Year Book, Inc., 1992

E21 Expert Report of Raymond Francis

E22 PEL Supply company Prosthetic Catalog 1994  
(page i - xiii)

were submitted.

With letter of 8 April 2009, respondent OI requested dismissal of the appeal and filed document

E23 Derma Protection

a prospectus demonstrating the characteristics of the articles of this product family.

IV. In a communication in preparation for the oral proceedings according to Article 15(1) of the Rules of Procedure of the Boards of Appeal dated 10 September 2009 the Board gave its preliminary opinion on the case, generally concurring as to the objections underlying the decision under appeal.

V. In reply to this communication, the appellant filed amended third and fourth auxiliary request and submitted documents

E19 Expert Report of Dominic Hannett (signed version)

E24 Project Report 3874; Analysis of Silipos  
Silosheath

VI. Oral proceedings were held on 19 January 2010. The appellant requested eventually that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the set of claims filed during the oral proceedings. The respondent (opponent OII) requested that the appeal be dismissed.

The respondent (opponent OI) was not represented at the oral proceedings as announced with letter of 29 December 2009. In its written submission dated 8 April 2009 he had also requested dismissal of the appeal.

Claim 1 of the set of claims filed during the oral proceedings reads:

"A cushion liner for enclosing an amputation stump, said liner comprising a fabric covering having an open end for introduction of said stump and a closed end opposite said open end, characterised in that *the textile material used to make said fabric has a thickness of from 0.635 mm to 3.175 mm (0.025 inches to 0.125 inches) and said fabric is coated on at least the inside thereof with a form-fitting polymeric cushioning material which contacts the skin of the amputation stump when worn by a user to minimise or eliminate air pockets.*"

(amendments when compared to the granted claim 1 in italics)

VII. In support of his requests the appellant essentially relied upon the following submissions:

The subject-matter of the amended claim 1 was disclosed in the description as originally filed (Article 123(2) EPC) and did not give rise to objections under Article 84 EPC. In particular it was clear for the skilled person that the thickness of the textile material which was used to make the fabric could be determined in the final article as demonstrated by the expert opinion provided in E24.

The amendments of the subject-matter of claim 1 limited the claimed subject-matter to a cushion liner having a specific thickness. The thin nylon "Gel-Strumpf" disclosed in E2 did not anticipate the cushion liner of claim 1. Accordingly, the subject-matter of claim 1 was novel over the disclosure in E2. If the subject-matter of the current claim would be found novel the case should be remitted to the opposition division for the examination of inventive step, because the latter had not been examined at all by the opposition division.

VIII. The respondents essentially argued as follows:

The request was late-filed and included in its claim 1 features which were not clearly and unambiguously disclosed in the presently claimed combination in the description as originally filed (Article 123(2) EPC). Moreover, the (full) paragraph on page 22, lines 3 to 13, of the PCT-application did not disclose how the thickness of the textile material used to make the fabric could be determined in the finished article (Article 84 EPC).

Although E2 is silent on the thickness of the article or its distinct layers, a certain range for the

thickness of the "Nylongewirk" and of the polymeric gel of the Stumpf-Strumpf of E2 must be present to achieve the properties mentioned. In view of the fact that the article is intended for the same use and is made of the same materials, the same range or at least an overlapping range for the thickness was at least implicitly disclosed. Accordingly, E2 anticipated at least part of the claimed range of the thickness. Thus, the subject-matter of claim 1 was not novel over E2.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Amendments*
  - 2.1 Article 123(2)
    - 2.1.1 Current claim 1 differs from claim 1 as granted in that the following additional feature has been included:  
"the textile material used to make said fabric has a thickness of from 0.635 mm to 3.175 mm (0.025 inches to 0.125 inches)".
    - 2.1.2 This feature is disclosed on page 22, lines 3 to 13 of the originally filed PCT-application, where it is expressly stated that "The textile material used to make the invention articles ..." and that "Preferred thicknesses of the invention textile material range from ... preferably 0.025 in to 0.125 in ....".
    - 2.1.3 With respect to the wording concerning the "invention textile material" whereas in the claim the literal



wording is "fabric", it can be derived from the specification that the fabric is made of textile material. The originally filed PCT-application refers with respect to the textile material, in particular on page 20, lines 21 to 26 to a variety of suitable textile materials. Page 20, line 26 to page 21, line 9 disclose that the "fabrics" include woven, knitted and non-woven "textile fabrics". Accordingly, the term "textile material" referred to on page 22 is to be understood as being consistent with the fabrics referred to earlier. The disclosed liner comprises a fabric in addition to a polymeric cushioning material. It is only the fabric which is made of textile material.

2.1.4 There is, thus, an unambiguous disclosure of the claimed ranges in the description as originally filed, so that the subject-matter of current claim 1 does not give rise to objections under Article 123(2) EPC.

## 2.2 Article 84 EPC

2.2.1 The claimed cushion liner is characterised by way of a parameter range. Accordingly, the method and means for measuring the thickness must be known for an unambiguous definition of this range (see also the Guidelines for Examination, C-III, 4.10a).

2.2.2 The appellant submitted E24 in order to demonstrate that a person skilled in the art did not have problems to assess the values of the parameter, which method to employ and how to arrive at reliable results even without any determination method specified in the claim or in the specification.

2.2.3 E24 represents an independent laboratory test report demonstrating the results for the thickness of a sample of "Silipos® Silosheath". "Silipos® Silosheath" represents the US-version of the Gel-Strumpf "Derma Seal" which is referred to in E2. E24 reports that the gel layer was removed from the fabric and tested in accordance with ASTM D2240 (Table 1). Thickness measurements for two sides of the sheath are shown in Table 2.

2.2.4 E24 explains that for this Silosheath product the fabric was so thin that the pressure exerted by the micrometer compressed the fabric too much and therefore, the thickness of the entire part was reported. The thickness of the gel layer varied greatly at different locations along the sheath so the measurements were taken along the length. From Figure 1 and Table 2 of E24 it is deducible that the thickness increases continuously along the length of the chosen sample and that the reported lowest thickness corresponds to the location with the lowest amount of gel layer. Hence, the fabric has to have a thickness which cannot be above this value. This lowest thickness is reported to be either 0.25 mm or 0.33 mm - dependent on the side of measurement.

2.2.5 In the appellant's view the results obtained for this Silosheath product in E24 demonstrate

- (a) that the skilled person knows which determination method should be applied;
- (b) that the determination method is reliably reproducible;

- (c) that the thickness of the fabric which supports the gel layer can be determined to lie below the claimed range; and
- (d) that the advertisement E2 referring to "the second skin for more comfort" was for such a thin "Stumpf-Strumpf".

2.2.6 The Respondent did not provide any evidence to the contrary and so in view of the test data provided by E24, the board accepts the above position of the appellant as well founded. Hence, claim 1 does also not give rise to objections under Article 84 EPC.

### 3. *Novelty*

- 3.1 E2 discloses a Gel-Strumpf for enclosing an amputation stump, said Gel-Strumpf comprising a fabric covering ("Nylongewirk") having an open end for introduction of said stump and a closed end opposite said open end (Figure). The fabric is coated on the inside thereof with a form-fitting cushioning material ("Polymer-Gel-Beschichtung") which contacts the skin of the amputation stump when worn by a user to minimise or eliminate air pockets.
- 3.2 E2 represents an advertisement and does not refer to any dimensions of the Gel-Strumpf. When compared to the content of the advertisement, the subject-matter of claim 1 differs from E2 by the feature that "the textile material used to make said fabric has a thickness of from 0.635 mm to 3.175 mm (0.025 inches to 0.125 inches)".

- 3.3 The respondent argued that considering the article described in that advertisement the skilled person would infer a thickness falling within the claimed range so that the claimed article lacked novelty.
- 3.4 The actual thickness of a very similar article as described in E2, is the subject of the test report E24. As explained earlier, E24 provides data for a sample of "Silipos® Silosheath". The results obtained for this Silosheath product demonstrate that the thickness of the fabric which supports the gel layer is well below the claimed range.
- 3.5 Even considering the disclosure of E24 on its own merit there is no reason to suppose that the skilled person would imply a fabric thickness any thicker than what is found in E24. Looking at the figure showing the relative thicknesses of the polymer gel and its nylon support ("Nylongewirk") and the indication that the Derma Seal stocking concerns a "second skin" ("die zweite Haut") this can only lead to a fabric thickness well below the range claimed in claim 1 under consideration.
- 3.6 Accordingly, the subject-matter of claim 1 is novel also over E2.

4. *Remittal (Article 111(1) EPC)*

E2 was the only document considered in the decision under appeal for novelty although in the written proceedings other documents were also referred to. Moreover, it was not discussed which document should be considered in deciding whether or not the subject-matter claimed was inventive. In view of the

appellant's request and under these circumstances the board exercises its discretion pursuant to Article 111(1) EPC 1973 to remit the case to 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 department of first instance for further prosecution on the basis of the set of 19 claims filed during the oral proceedings before the Board.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau