

Internal distribution code:

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

**Datasheet for the decision
of 5 July 2012**

Case Number: T 1984/08 - 3.3.10
Application Number: 02803343.9
Publication Number: 1448246
IPC: A61L 27/34, A61L 27/40,
A61L 27/54
Language of the proceedings: EN

Title of invention:

Homogeneously coated device having osteoinductive and osteoconductive properties

Patentee:

Scil Technology GmbH

Opponent:

STRYKER CORPORATION

Headword:

Device having osteoinductive and osteoconductive properties/SCIL

Relevant legal provisions:

EPC Art. 123(2)(3), 111(1)

Keyword:

"Main request: Allowability of amendments (yes) - remittal"

Decisions cited:

T 0063/86, T 0047/90

Catchword:

-



Case Number: T 1984/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 5 July 2012

Appellant: Scil Technology GmbH
(Patent Proprietor) Fraunhoferstraße 15
D-82152 Martinsried (DE)

Representative: von Renesse, Dorothea
König Szynka Tilmann von Renesse
Patentanwälte Partnerschaft
Postfach 11 09 46
D-40509 Düsseldorf (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 August 2008
revoking European patent No. 1448246 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: P. Gryczka
Members: C. Komenda
D. S. Rogers

Summary of Facts and Submissions

- I. The Appellant (Patent Proprietor) lodged an appeal against the decision of the Opposition Division which revoked the European patent No. 1 448 246.

Notice of Opposition had been filed by the Opponent requesting revocation of the patent in its entirety *inter alia* on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC).

- II. The Opposition Division found that the amendments made to the claims according to the then pending main request and auxiliary requests I and II did not fulfil the requirements of Article 123(2) EPC. Further, the device according to claim 1 of the then pending auxiliary request III was found not to be novel over the prior art. The device as claimed in claim 1 of the then pending auxiliary request IV was regarded as being novel, but as not involving an inventive step.

- III. At the oral proceedings before the Board held on 5 July 2012 the Appellant submitted a new Main Request (neuer Hauptantrag), replacing all previously filed requests. The wording of claim 1 of this sole request was as follows:

"1. A method for the production of a device having osteoinductive and osteoconductive properties in vivo comprising a carrier containing calcium phosphate and an osteoinductive protein, wherein said osteoinductive protein is either GDF-5 or BMP-2, and wherein said carrier is entirely coated with said osteoinductive protein and wherein essentially identical amounts of

said osteoinductive protein are present in each and every area of said carrier, said method comprising the steps of:

- (a) providing a solution comprising dissolved osteoinductive protein and a buffer containing a weak acid having a pK value between 3 and 7, preferably between 4 and 6, whereas said solution is free of toxic substances, said buffer keeping said protein dissolved for a time sufficient to allow homogenous coating of a carrier containing calcium phosphate when brought into contact with said carrier and said buffer being capable of balancing the increase of pH caused by contacting the buffer solution with the calcium phosphate carrier so that the protein does not immediately precipitate because of said pH increase;
- (b) contacting the solution of step (a) with a carrier containing calcium phosphate;
- (c) allowing homogenous coating of the surface of said carrier with said dissolved protein; and
- (d) drying of the coated carrier obtained in step (c)."

IV. The Appellant argued that the claims according to the sole Main Request no longer related to any devices or to any use thereof, but exclusively to the method for producing the device. Independent claim 1 related to the method for the production of the device based on granted claim 2. The amendments made thereto exclusively concerned combinations of granted claim 1 and the originally filed claims and, thus, no longer offended against Article 123(2) EPC. Consequently, the ground for not allowing the amendments made to the method claims underlying the decision under appeal, which were relevant for the then pending main request,

the first and the second auxiliary request, no longer applied.

- V. The Opponent withdrew its opposition and is thus no longer party to the proceedings.
- VI. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 7 of the Main, and sole, Request ("Neuer Hauptantrag") submitted at the oral proceedings before the Board.
- VII. At the end of the oral proceedings before the Board the decision was announced.

Reasons for the Decision

- 1. The appeal is admissible.

Main Request

- 2. *Amendments (Article 123 EPC)*
 - 2.1 Independent claim 1 of the Main Request is directed to a method for the production of a device based on original claim 2, wherein the former reference to the device of claim 1 has been replaced by incorporation of the wording thereof. The homogeneous distribution of the protein is disclosed on page 5, lines 30 to 32 of the application as filed. Further, the osteoinductive protein has been restricted to "either GDF-5 or BMP-2", based on original claims 14 and 16, respectively. In step (a) of the claimed method the feature that "said

solution is free of toxic substances" has been incorporated, which is based on original claim 17. The buffer is further defined as comprising a weak acid as disclosed on page 8, line 27 of the application as filed. The remaining dependent claims 2 to 7 correspond to original claims 3, 5, 6, 7, 8 and 18, with their respective references being adapted accordingly. Therefore, the Board concludes that the subject matter of claim 1 does not extend beyond the content of the application as filed such that the requirements of Article 123(2) EPC are satisfied.

2.2 These amendments bring about a restriction of the scope of the claims as granted, and therefore of the protection conferred thereby, which is in keeping with the requirements of Article 123(3) EPC.

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

Before the Board for the first time a substantially amended Main Request was presented, which contained only method claims, all claims directed to a product or to a use having been deleted. Further, as the decision under appeal in relation to the method claims dealt only with the requirements of Article 123(2) EPC, the Board concludes that by filing the new Main Request ("Neuer Hauptantrag") which meets the requirements of Article 123(2) EPC, the grounds for rejecting the method claims were overcome.

Having so decided, the Board has not taken a decision on the substantive issues, since the decision under appeal in this respect was solely based on novelty and inventive step of claims of a different category. Thus,

the claims according to the Main Request meet the present objections of the Opposition Division and give rise to issues not yet addressed in opposition proceedings (see e.g. decisions T 63/86, OJ EPO 1988, 224; T 47/90, OJ EPO, 1991, 486). As the Opposition Division has not yet ruled on the requirements for patentability of claims directed exclusively to methods for the production of devices having osteoinductive and osteoconductive properties, the Board considers it appropriate to exercise the power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of claims 1 to 7 according to the Main Request ("Neuer Hauptantrag") filed during Oral proceedings held on 5 July 2012 before the Board.

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 upon the basis of claims 1 to 7 of the Main Request ("Neuer Hauptantrag") submitted at the oral proceedings before the Board.

The Registrar

The Chairman

C. Rodríguez Rodríguez

P. Gryczka