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**Datasheet for the decision  
of 15 March 2016**

**Case Number:** T 0723/10 - 3.2.02

**Application Number:** 01113266.9

**Publication Number:** 1159977

**IPC:** A61M1/36, G06F17/50

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for configuring a blood circuit

**Patent Proprietor:**

JMS Co., Ltd.

**Opponent:**

Fresenius Medical Care Deutschland GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 83, 100(b)

**Keyword:**

Sufficiency of disclosure - (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0723/10 - 3.2.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 15 March 2016**

**Appellant:** JMS Co., Ltd.  
(Patent Proprietor) 12-17, Kakomachi, Naka-ku  
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**Representative:** Bobbert, Cornelius  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 27 January 2010  
revoking European patent No. 1159977 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** E. Dufrasne  
**Members:** C. Körber  
P. L. P. Weber

## **Summary of Facts and Submissions**

- I. On 27 January 2010 the Opposition Division posted its decision to revoke European patent 1159977.
- II. An appeal was lodged against this decision by the patent proprietor by notice received on 26 March 2010, with the appeal fee being paid on the same day. The statement setting out the grounds of appeal was received on 25 May 2010.
- III. By communication of 3 March 2015, the Board forwarded its provisional opinion to the parties and summoned them to oral proceedings.
- IV. With its letter of 7 July 2015, the appellant submitted further observations, second and third auxiliary requests and a document entitled "Comments regarding tem [sic] 4 'Lack of Disclosure'".
- V. With its letter of 9 July 2015, the appellant requested postponement of the oral proceedings scheduled for 14 July 2015. With its letter of 10 July 2015, the appellant further requested to exclude the above-mentioned letter and the attached medical certificate from file inspection.
- VI. Oral proceedings were held on 15 March 2016.

The final requests of the parties were as follows:

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of one of the main request and the auxiliary request, filed with letter of

25 May 2010, and the second and third auxiliary requests, filed with letter dated 7 July 2015.

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

VII. Claim 1 of the main request reads (with the feature denotation proposed by the respondent being indicated at the left margin):

M11 "A method of configuring a blood circuit for medical application, the blood circuit consisting of a plurality of unit sections (A-G) and a plurality of selectable unit components (A-1, A-2, B-1-1, B-1-2, B-2-1, B-2-2, C-1-1, C-1-2, C-2-1, C-2-1, C-2-2, D-1, D-2, D-3, E-1-1, E-1-2, E-1-3, E-2-1, F-1, F-2, G-1, G-2, G-3, G-4) for each unit section (A-G), the method comprising:

M12 using a blood circuit system database in which data with respect to the unit sections (A-G) and the unit components (A-1, A-2, B-1-1, B-1-2, B-2-1, B-2-2, C-1-1, C-1-2, C-2-1, C-2-1, C-2-2, D-1, D-2, D-3, E-1-1, E-1-2, E-1-3, E-2-1, F-1, F-2, G-1, G-2, G-3, G-4) contained in the blood circuit are stored, the unit components (A-1, A-2, B-1-1, B-1-2, B-2-1, B-2-2, C-1-1, C-1-2, C-2-1, C-2-1, C-2-2, D-1, D-2, D-3, E-1-1, E-1-2, E-1-3, E-2-1, F-1, F-2, G-1, G-2, G-3, G-4) being composed of components (1-13, 21-29, 31-34, 41-45, 51-57, 61-67), respectively,

M13 inputting (S 301) conditions including a price with respect to the blood circuit to be configured to the computer,

- M14 extracting (S 303) a predetermined range of candidates of combinations of the unit components (A-1, A-2, B-1-1, B-1-2, B-2-1, B-2-2, C-1-1, C-1-2, C-2-1, C-2-1, C-2-2, D-1, D-2, D-3, E-1-1, E-1-2, E-1-3, E-2-1, F-1, F-2, G-1, G-2, G-3, G-4) from the blood circuit system database by the computer based on the degree of compliance with the input conditions,
- M15 displaying (S 304) a list of the candidates of the combinations of the extracted unit components (A-1, A-2, B-1-1, B-1-2, B-2-1, B-2-2, C-1-1, C-1-2, C-2-1, C-2-1, C-2-2, D-1, D-2, D-3, E-1-1, E-1-2, E-1-3, E-2-1, F-1, F-2, G-1, G-2, G-3, G-4) on a display,
- M16 inputting a selected assignment of one combination selected from the candidates of the displayed combinations to the computer,
- M17 displaying (S 306) an assembly drawing of an entire configuration of the blood circuit obtained by combining the selected unit components and at least one of a full length of the blood circuit or an amount of filled blood on the display in accordance with the input of the selected assignment by the use of the blood circuit system database."

Claim 1 of the auxiliary request corresponds to claim 1 of the main request with the phrase "whereby the contents contained in the data include a shape, size, data related to production costs of each unit component classified in each unit section," added at the end of feature M12.

Claim 1 of the second auxiliary request corresponds to claim 1 of the main request with the step "selecting and assigning (305) one combination of the displayed

conditions" being inserted between features M15 and M16.

Claim 1 of the third auxiliary request is identical to claim 1 of the main request.

VIII. The appellant's arguments, as far as relevant to this decision, are summarised as follows:

Blood circuits were customised for individual users. It was usual practice to determine the composition of a blood circuit based on any criterion when providing a particular blood circuit by using a plurality of components. Since this was well-known practice, a particular reference in the patent specification was not necessary. The conditions for a candidate, such as a price or a length of the circuit, were well-known for an individual user's necessity.

The method of applying simultaneous conditions was also well-known in many fields, such as retrieval of information through the internet. Retrievals using multiple selection decisions were usually carried out and the skilled person could easily understand that the criterion for determining the degree of compliance of the candidate could be performed in a similar manner.

In the present invention it was not necessary to determine a degree of compliance according to the simultaneous conditions because both candidates with simultaneous conditions could be displayed at the same time on a display. Such way of displaying was also usual for an internet retrieval system.

From paragraph [0021] of the patent specification it became clear that when the user entered a desired

length and a desired price, only those unit components were selected and offered by the computer which finally would fulfil the entered conditions. There was no "complex of optimisation problem" to be solved, as stated in the impugned decision. Since such a task had been performed manually according to the conventional medical practice, it was not necessary to disclose a practical example of realisation of this extraction step.

The preferences of the user were input as defined in step M13 of claim 1. From paragraph [0021] of the patent specification it was clear that the computer contained information with respect to shape, size, data related to production costs of each unit component classified in each unit section and thus the computer combined unit components to unit sections and in the end to the blood circuit based on the input price and a possible further condition like the length of the desired blood circuit. The user could express the preferences regarding the blood circuit and these preferences were not a matter of the invention. The examples of factors (conditions) to be applied for expressing the preferences were recited in paragraph [0021] of the specification and the user could express the preferences using those factors.

Conditions such as "the amount of filled blood" and the "length of the circuit" could be appropriately determined depending on the specific individual cases. A proof that this was obvious for those skilled in the art was provided by the patent owner in its "Comments regarding tem [sic] 3 'lack of disclosure'" (submitted during the oral proceedings before the Opposition Division and attached to the impugned decision, submitted again during the appeal procedure with the



somewhat different title "Comments regarding tem [sic] 4 'Lack of Disclosure'"), explaining in detail why applying multiple selection criteria was general knowledge. These comments of the inventors (being the skilled persons) were self-explanatory and easily understandable. Such an additive combination of search criteria was part of the general knowledge.

IX. The respondent's arguments are essentially those on which the following reasons of this decision are based.

### **Reasons for the Decision**

1. The appeal is admissible.

2. Sufficiency of disclosure

2.1 Main request

The method of configuring a blood circuit for medical application according to claim 1 comprises the step of extracting a predetermined range of candidates of combinations of the unit components from the blood circuit system database by the computer based on "the degree of compliance" with the "input conditions" (feature M14). The "input conditions" are defined in the preceding feature M13 as "including a price with respect to the blood circuit to be configured".

With respect to the determination of the "degree of compliance", the patent specification is silent. The term itself is mentioned therein, for instance in paragraph [0024], without, however, any further explanation being given as to how it is to be

determined. There is also no specific embodiment described in detail from which it might be possible to infer a meaning of this term. It follows that it has to be assessed whether, in the context of the claimed invention, the person skilled in the art was able to carry out feature M14 without undue burden, on the basis of its general knowledge.

If the "input condition" is a single value of a parameter such as the price mentioned in feature M13, the Board agrees with appellant's view that it is within the general knowledge of the skilled person to determine a "degree of compliance" with this value. However, feature M13 refers to "input conditions" [emphasis added], and feature M14 defines a "degree of compliance" with a plurality of such "input conditions". Further examples of such "input conditions" are given in paragraph [0023]: necessary quantities, desirable delivery period and specification of the circuit. In its "Comments regarding tem 4 'lack of disclosure'" and in its statement of grounds of appeal, the appellant referred to the length of the blood circuit as another example of an "input condition".

If the "input conditions" comprise another single value of a second parameter in addition to the price, the determination of a "degree of compliance" can no longer be regarded as straightforward and part of the general knowledge of the skilled person. This is particularly the case if entirely different and possibly even conflicting criteria have to be assessed. In such a situation, an algorithm has to be designed which takes account of the individual significance of the parameters, for instance, in terms of weighting

factors. An example of such an algorithm was presented in the "Comments regarding tem 4 'lack of disclosure'".

The Board shares the appellant's view that this algorithm is conclusive and understandable. However, this statement does not carry a date and stems from the inventors themselves. The Board does not share the appellant's view that an inventor can be equated to "the skilled person". What would be required is convincing evidence that such an algorithm was in fact within the general knowledge of the skilled person at or before the filing date of the patent in suit. According to the established jurisprudence of the boards of appeal, cited in section II.C.3.1 of the "Case Law of the Boards of Appeal of the EPO", 7<sup>th</sup> edition 2013, textbooks, monographs or general technical literature are normally recognised as evidence of the common general knowledge of the skilled person at the filing date. Nothing of that kind was submitted by the appellant.

The insufficiency problem becomes even further aggravated if the "input conditions" are not represented by single values of different parameters, but in terms of certain ranges of parameters or the "specification of the circuit", as mentioned in paragraph [0023]. The term "input conditions" in feature M13 is extremely broad and could include a wide variety of not necessarily sharply defined and possibly conflicting criteria. According to the established jurisprudence of the boards of appeal, cited in section II.C.4.4 of the "Case Law of the Boards of Appeal of the EPO", 7<sup>th</sup> edition 2013, one single way of performing an invention (e.g. as presented in the "Comments regarding tem 3 'lack of disclosure'", yet not forming part of the disclosure of the patent in

suit) would only be sufficient if it allowed the invention to be performed in the whole range claimed.

The appellant's allegation that retrieval of information from the internet by applying multiple selection criteria was well-known is rather general. It might apply to the extraction of results that match with a variety of search terms; however, this is to be distinguished from specifically determining "a degree of compliance" with "input conditions" in a method of configuring a blood circuit as claimed and detailed above. Also, it cannot be seen how such a task was performed "manually according to the conventional medical practice", as argued by the appellant. The fact that the user could express its preferences with regard to the conditions to be met by the blood circuit, for instance among those stated in paragraph [0021], does also not answer the question of how a "degree of compliance" with those conditions is to be determined.

Accordingly, the claimed invention is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, as required by Article 83 EPC.

## 2.2 Auxiliary requests

Features M13 and M14 are present in claim 1 of the auxiliary requests, just as they are in claim 1 of the patent as granted. Accordingly, the requirements of Article 83 EPC are also not met for these requests.

## 2.3 Hence, the ground of opposition under Article 100(b) EPC prejudices the maintenance of the patent according to the main request or the auxiliary requests.

3. Under these circumstances there is no need for the Board to further elaborate on any of the other grounds of opposition brought forth thereagainst by the respondent.
4. Documents excluded from file inspection

With its letter of 9 July 2015, the appellant requested postponement of the oral proceedings scheduled for 14 July 2015 for the reason of serious illness of its representative, as further explained in the letter and evidenced by a medical certificate attached thereto.

With its letter of 10 July 2015, the appellant requested that the above-mentioned letter and its attachment be excluded from file inspection. Since this request is credibly motivated by the fact that it concerns a private, medical condition and is considered to be prejudicial to the legitimate personal interest of the representative, these documents are excluded from file inspection in accordance with the "Decision of the President of the EPO dated 12 July 2007 concerning documents excluded from file inspection" (Special edition No. 3, OJ EPO 2007, J3).

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated