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**Datasheet for the decision
of 12 February 2015**

Case Number: T 0136/12 - 3.3.10

Application Number: 99610028.5

Publication Number: 1020195

IPC: A61L15/00, A61L15/34,
A61L15/58, A61L24/04, A61L26/00

Language of the proceedings: EN

Title of invention:
Wound dressing

Patent Proprietor:
Jentec, Inc.

Opponent:
HOLLISTER INCORPORATED

Headword:

Relevant legal provisions:
EPC Art. 123(2), 123(3), 114(1), 111(1)
EPC 1973 Art. 54(3), 54(4)

Keyword:
Amendments - added subject-matter (yes) main request -
broadening of claim (yes) first auxiliary request
Remittal to the opposition division - second auxiliary request

Decisions cited:
G 0001/03, G 0002/03, T 0532/08

Catchword:



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 0136/12 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 12 February 2015

Appellant: Jentec, Inc.
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Representative: Christensen, Bent
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 4 November 2011
revoking European patent No. 1020195 pursuant to
Article 101(3)(b) EPC.

Composition of the Board:

Chairman P. Gryczka
Members: R. Pérez Carlón
C. Schmidt

Summary of Facts and Submissions

I. The patent proprietor lodged an appeal against the decision of the opposition division to revoke European patent No. 1 020 195.

II. An opposition had been filed on the grounds of added subject-matter (Article 100(c) EPC), insufficiency of disclosure (Article 100(b) EPC), and lack of novelty and inventive step (Article 100(a) EPC).

The opposition was withdrawn during these appeal proceedings.

III. The opposition division considered that the disclaimers in claim 1 of the then pending main request and auxiliary request 1 removed from the subject-matter of claim 1 more than was necessary in order to restore novelty over document D5 (WO 99/45977), which constituted prior art under Article 54(3) and (4) EPC 1973, so that none of these requests fulfilled the requirements of Article 123(2) EPC.

IV. With the statement setting out the grounds of appeal, the appellant filed a main request and first and second auxiliary requests.

Claim 1 of the main request reads as follows:

"A wound dressing composition comprising:

10 to 35 weight percent of an elastomer, based on the total weight of the composition wherein the elastomer is a styrene-olefin-styrene block copolymer;

25 to 55 weight percent of a hydrocarbon resin in
[sic] tackifier, based on the total weight of the
composition;

2 to 60 weight percent of a non-polar oily
extender, based on the total weight of the
composition;

no more than 0.1 weight percent of an antioxidant,
based on the total weight of the composition, and

20 to 60 weight percent of a hydrocolloid,

wherein the composition does not comprise [sic] a
hydrocolloid adhesive mass useful for medical purposes,
which comprises

- (a) 0.2 - 5 parts by weight of an [sic] ethoxylated
sorbitan fatty acid ester,
- (b) 20 to 50 parts by weight of a hydrocolloid,
- (c) 32 to 120 parts by weight of an adhesive matrix
made up of

one or more polymers selected from poly(styrene/
olefin/styrene) blockcopolymers, low-molecular
weight polyisobutylenes and high-molecular weight
polyisobutylenes, and

one or more compounds selected from sticky or
tackifying resins, plasticizers, polybutenes,
anti-oxidants, ethylene and vinyl acetate
copolymers, butyl rubbers and ethylene-propylene
block copolymers, and

- (d) *0-15 parts by weight of an acrylate polymer with a glass transition temperature below -20°C".*

The disclaimer in claim 1 of the first auxiliary request reads:

"wherein the composition does not comprises [sic] a hydrocolloid adhesive mass useful for medical purposes, which comprises

- (a) *0,2 - 5 parts by weight of a an [sic] ethoxylated sorbitan fatty acid ester,*

- (b) *20 to 50 parts by weight of a hydrocolloid,*

- (c) *an adhesive matrix consisting of*

10 to 35 parts by weight of a poly(styrene/olefin/styrene) block copolymer, particularly poly(styrene/isoprene/styrene);

2 to 25 parts by weight of a plasticizer, especially a plasticizing oil;

*0,1 to 2 by weight of at least one antioxidant;
and*

*20 to 50 parts by weight of a tackifying resin,
and*

- (d) *0-15 parts by weight of an acrylate polymer with a glass transition temperature below -20°C."*

Lastly, claim 1 of the second auxiliary request reads:

"A wound dressing composition consisting of:

10 to 35 weight percent of an elastomer, based on the total weight of the composition wherein the elastomer is a styrene-olefin-styrene block copolymer;

25 to 55 weight percent of a hydrocarbon resin [sic] tackifier, based on the total weight of the composition;

2 to 60 weight percent of a non-polar oily extender, based on the total weight of the composition;

no more than 0.1 weight percent of an antioxidant, based on the total weight of the composition, and

20 to 60 weight percent of a hydrocolloid."

- V. The arguments of the appellant relevant for the present decision were the following:

Document D5 validly claimed the right to priority and was for this reason prior art under Article 54(3) and (4) EPC 1973. Although the wording of the disclaimer could not be explicitly found in the priority document, the passages on page 5, lines 19-28, page 7, lines 5-9 and its examples clearly indicated that the adhesive matrix disclosed in that previous application necessarily contained more than one compound, and that these compounds were to be selected from the lists as in claim 1 of document D5. Document D5 thus represented prior art according to Article 54(3) and(4) EPC 1973 for claim 1 of the main request and its subject-matter could be disclaimed. The main request thus fulfilled the requirements of Article 123(2) EPC.

Claim 1 of the first auxiliary request contained a disclaimer whose scope was narrower than that in claim 1 of the patent as granted. The scope of protection was thus broader than that of the patent as granted. However, a disclaimer had to be seen solely as a legal issue, which should not be taken into account when determining the scope of protection. For this reason the first auxiliary request did not contravene the requirements of Article 123(3) EPC.

Lastly, claim 1 of the second auxiliary request was drafted using the wording "consisting of", which made the disclaimer redundant and the subject-matter novel over document D5, irrespective of whether or not D5 represented prior art for the claimed invention.

- VI. Oral proceedings before the board of appeal took place on 12 February 2015.
- VII. The final requests of the appellant were that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or on the basis of one of auxiliary requests 1 or 2, all requests filed with letter dated 14 March 2012.
- VIII. At the end of the oral proceedings, the decision was announced.

Reasons for the Decision

- 1. The appeal is admissible.

Main request: Amendments, Article 123(2) EPC:

2. Claim 1 of the main request contains a disclaimer which was introduced in order to delimit the subject-matter of claim 1 against document D5, which could only constitute prior art for the patent in suit under Article 54(3)(4) EPC 1973.

It has not been disputed that the wound dressing composition subject-matter of claim 1 of the main request, disclaimer excluded, validly claims a priority date of 1 January 1999 (Article 87(1) EPC).

Document D5, filed after the priority date of the patent in suit, claims the right of priority from FR 98 03043, filed on 12 March 1998. It has not been disputed that only those elements of document D5 which validly claimed the right to priority from the earlier application can constitute prior art under Article 54(3)(4) EPC 1973 for the claimed invention and thus be potentially novelty-destroying for the claimed subject-matter.

3. The disclaimer in claim 1 of the main request corresponds, word for word, to claim 1 of document D5. However, the exact wording of claim 1 of D5 cannot be found in its priority document. The appellant has not contested this finding.

The differences in the wording of claim 1 of D5 and claim 1 of the earlier application from which it claims priority are to be found in the definition of component (c):

Claim 1 of D5 requires a

"matrice adhésive constituée à partir de

un ou plusieurs polymères choisis parmi les copolymères séquencés poly(styrène-oléfine-styrène), les polyisobutylènes de bas poids moléculaire, les polyisobutylène de haut poids moléculaire, et

un ou plusieurs composés choisis parmi les résines poisseuses dites tackifiantes, les plastifiants, les polybutènes, les antioxydants, les copolymères d'éthylène et d'acétate de vinyle, les caoutchoucs butyle et les copolymères blocs éthylène-propylène",

whereas claim 1 of the claimed priority document requires a

"matrice adhésive constituée à partir de

un ou plusieurs composés choisis parmi les copolymères séquencés poly(styrène-oléfine-styrène), les polyisobutylènes de bas poids moléculaire, les polyisobutylène de haut poids moléculaire, les résines poisseuses dites tackifiantes, les plastifiants, les polybutènes, les antioxydants, les copolymères d'éthylène et d'acétate de vinyle, les caoutchoucs butyle et les copolymères blocs éthylène-propylène".

Thus, although the components which could form part of the adhesive matrix are the same in both cases, the adhesive compositions disclosed in the priority document require an adhesive matrix containing at least one of said components, whereas those according to claim 1 of D5 require an adhesive matrix having at least two of these components, selected from two different lists.

4. The appellant relied on the passage on page 5, lines 19-28 to show that the earlier application taught that

the adhesive matrix should contain at least one elastomer (page 5, line 21) combined with a member selected from a second list of components.

However, this passage discloses an adhesive matrix comprising at least one elastomer, whereas claim 1 of D5 requires, instead, poly(styrene-isoprene-styrene) or polyisobutylenes, which do not necessarily have to be elastomers.

In addition, the passage on page 5, lines 19-28 of the earlier application does not mention the component "copolymers block ethylene-propylene" in claim 1 of D5, which component could be included in the second of the lists, as was the case in claim 1 of D5, but could also have been part of the first list of polymeric compounds.

5. The appellant also relied on the disclosure on page 7, lines 5-9 of the earlier application, which taught that the adhesive matrixes required by claim 1 included an elastomeric copolymer of the type poly(styrene-olefin-styrene). An elastomer alone was not suitable for forming an adhesive matrix unless combined, as disclosed in that passage, with further components such as plasticisers or antioxidants in order to achieve the required properties.

However, as in the previous case, even though this passage could provide a basis for an adhesive matrix comprising at least two components selected from two different lists, neither of these lists is identical to any of the lists required by claim 1 of D5.

6. The appellant further mentioned that all the examples of the earlier application, which were identical to

those of D5, contained an adhesive matrix having more than one component. These examples taught the skilled reader that the compositions of D5 required an adhesive matrix containing more than one component.

However, even though the skilled reader could find in the examples of the earlier application the teaching that the required adhesive matrix should contain more than one component, said examples still fail to disclose that these components must be selected from the specific lists of claim 1 of D5.

7. The appellant further argued that an adhesive matrix could not consist of an antioxidant, since the presence of an elastomer would always be required, but this was, nevertheless, an embodiment within the subject-matter of claim 1 of the earlier application. The skilled person, confronted with claim 1 of the earlier application, would thus consider the presence of a further component to be implicitly disclosed.

However, even if the adhesive matrix of the earlier application needed to include more than one component, there is no information therein that said components need to be chosen from the lists required by claim 1 of D5.

8. The board thus concludes that although the earlier application from which D5 claims the right of priority discloses compositions whose adhesive matrix contains more than one component, it fails to teach that each of them should be selected from the lists required by claim 1 of D5. Claim 1 of D5 thus does not validly claim the right of priority from 12 March 1998.

9. For these reasons, the subject-matter of claim 1 of D5, disclaimed from claim 1 of the main request, does not validly claim the right of priority from 12 March 1998 but has, instead, an effective date of filing of 12 March 1999, i.e. after the effective filing date of claim 1 of the main request, disclaimer excluded, which validly claimed priority from 1 January 1999. The subject-matter of claim 1 of document D5 thus cannot be novelty destroying for the claimed subject-matter since it is not prior art for the claimed invention.

Since claim 1 of D5 does not constitute prior art in the sense of Article 54(3) and (4) EPC 1973, the disclaimer introduced into claim 1 of the main request does not meet the conditions set out in G1/03 and G2/03 for a disclaimer to be allowable under Article 123(2) EPC. Claim 1 contains for this reason added subject-matter. The main request must therefore be refused.

First auxiliary request, Article 123(3) EPC:

10. It has not been contested that claim 1 of the first auxiliary request contains a disclaimer which is narrower in scope than the disclaimer present in claim 1 of the patent as granted.

Since, in the present case, the amended disclaimer is narrower than the disclaimer in claim 1 of the patent as granted, whilst the positive features thereof remain the same, claim 1 of the first auxiliary request extends the scope of protection conferred by the patent as granted and, thus, contravenes the requirements of Article 123(3) EPC.

11. The appellant argued that, nevertheless, only the positive features of claim 1 defining the claimed

invention should be taken into account for determining the scope of protection. A disclaimer was a legal means for *inter alia* restoring novelty and had no technical significance. For this reason disclaimers should not be taken into account for the purpose of determining the scope of protection.

This argument must however be rejected since it is in contradiction with the well-established case law, which has consistently taken disclaimers into account when examining whether a claim amended by introducing, modifying or deleting a disclaimer fulfils the requirements of Article 123(3) EPC (see for example T 532/08).

Second auxiliary request:

12. Claim 1 of the second auxiliary request is directed to a composition "consisting of" the components required by claim 1 as granted, which was drafted using the word "comprising".
13. Since all embodiments of the application as originally filed referred to compositions which did not contain components other than those listed in claim 1, it implicitly discloses a wound dressing composition "consisting of" those components. Claim 1 of the second auxiliary request thus finds a basis in the application as originally filed, as required by Article 123(2) EPC.
14. Claim 1 of the second auxiliary request restricts the scope of protection conferred by the patent as granted, as required by Article 123(3) EPC. The disclaimers in the patent as granted and in the previous requests were intended to exclude compositions which necessarily contained further components, such as an acrylate

polymer with a defined glass transition temperature. Such a disclaimer becomes superfluous in claim 1 of the second auxiliary request, since said compositions are excluded by means of positive features due to the wording "consisting of".

15. For the same reason, claim 1 of the second auxiliary request is novel over document D5, irrespective of whether or not it constitutes prior art under Article 54(3) (4) EPC 1973, since D5 discloses compositions which are not encompassed by the subject-matter of claim 1 due to the wording "consisting of", as they always contain additional components.
16. The board has only decided on added subject-matter under Article 123(2) EPC of claim 1 of the second auxiliary request, on Article 123(3) EPC in respect of said request, and on the novelty of the claimed subject-matter over document D5.
17. According to Article 111(1) EPC, a board may either exercise any power within the competence of the department which was responsible for the appealed decision, i.e. decide on all issues, or it may remit the case to the first instance for further prosecution.

In the present case, the opposition division only decided on the issue of added subject-matter. Although the opposition against the patent in suit has been withdrawn, the opponent relied on further grounds of opposition and the opposition division could consider it necessary to continue the examination of the case of its own motion (Article 114(1) EPC).

Under these circumstances, the board considers it

appropriate to remit the case to the opposition division 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 opposition division for further prosecution on the basis of the second auxiliary request, filed with letter dated 14 March 2012.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated