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**Datasheet for the decision
of 13 April 2016**

Case Number: T 1103/12 - 3.3.10

Application Number: 05254971.4

Publication Number: 1625860

IPC: A61L29/12, A61L29/16

Language of the proceedings: EN

Title of invention:

Kit for applying drug coating to a medical device with a latex emulsion

Applicant:

Cordis Corporation

Headword:

Kit for applying drug coating to a medical device/CORDIS

Relevant legal provisions:

EPC Art. 54, 111(1)

Keyword:

Novelty - (yes)
remittal to the department of first instance (yes)

Decisions cited:

Catchword:



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Case Number: T 1103/12 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 13 April 2016

Appellant: Cordis Corporation
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Miami Lakes,
Florida 33014 (US)

Representative: Mercer, Christopher Paul
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 23 December
2011 refusing European patent application No.
05254971.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: J.-C. Schmid
T. Bokor

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division refusing European patent application No. 05254971.4.
- II. According to the Examining Division, claim 1 of the then pending main request did not comply with the requirement of Article 123(2) EPC, while the kit of claim 1 according to then pending auxiliary requests 1 to 3 lacked novelty over document (1). According to the Examining Division, the conclusion reached in decision T 9/81 did not apply to the present claimed kit, since in the absence of a joint effect between the emulsion and the medical device, the kit could not be considered as a true combination of components. Therefore, the only technical feature which were to be considered when assessing novelty of the claimed kit was the presence of its components, i.e. an aqueous latex polymeric emulsion and a medical device. Document (1) disclosed a process where a medical device was dipped into a aqueous latex polymeric emulsion. The claimed kit was thus anticipated by the disclosure of document (1).
- III. In a communication dated 23 November 2015 accompanying summons for oral proceedings, the Board informed the Appellant that claims 1 to 7 of auxiliary request 2 appeared to meet the requirements of Article 123(2) EPC and that their subject-matter seemed to be novel over document (1).
- IV. With a letter dated 3 February 2016, the Appellant withdrew its former requests and filed a new main request corresponding to the previous auxiliary request 2 except that claim 8 has been deleted. The Appellant also agreed with cancelation of the scheduled oral

proceedings if the Board was minded to remit the case to the first instance on the basis of the newly filed main request.

Claim 1 of the main request reads as follows:

"1. A kit for customizing the coating of a medical device for medical treatment for an individual patient comprising:

an aqueous latex polymeric emulsion; and
a medical device."

- V. The Appellant requested the decision under appeal be set aside and the case be remitted to the Examining Division for further prosecution on the basis of claims 1 to 7 of the main request filed the letter dated 3 February 2016.

Reasons for the Decision

1. The appeal is admissible.
2. Claim 1 of the main request is supported by claim 1 and page 17, lines 6 to 13 of the application as filed. Dependent claims 2 and 4 to 7 are backed up by claims 2 to 6 of the application as filed, respectively. Claim 3 is based on page 17, lines 11 and 12 of the application as filed. Accordingly, claims 1 to 7 satisfy the requirement of Article 123(2) EPC.
3. *Novelty over document (1)*

Claim 1 is directed to a kit for customizing the coating of a medical device for medical treatment. It comprises an aqueous latex polymeric emulsion and a medical device.

The Examining Division considered in its decision that claim 1 only required the presence of two components, i.e. the aqueous latex polymeric emulsion and a medical device. However, the application consistently requires that these two components are comprised in a kit. Accordingly, this feature cannot simply be neglected.

A kit generally consists of at least two components that are put up together by physical means such as for example a packaging. In the context of the present application (see page 1, lines 11 20, figure 5), the skilled man would understand that the claimed kit is a system where the medical device and the emulsion are put up together in order to be transported together at the place where a customized coating will be performed.

Document (1) discloses a process where a medical device is dipped into an aqueous latex polymeric emulsion. It thus discloses only two components required by the claimed kit, namely the emulsion and the medical device. However, it does not disclose additional means necessary for these two components to be considered as a kit, such as for example a packaging.

Accordingly the subject-matter of claims 1 and of dependent claims 2 to 7 is novel over the disclosure of document (1).

4. The essential function of an appeal is to consider whether the decision issued by the first-instance department is correct. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not decided by the department of first instance. The examination of requirements of patentability not dealt

with in the appealed decision normally being left to the examining division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance. In particular, remittal is considered by the boards in cases where the examining division rejects an application solely upon a particular issue, which leaves other essential issues outstanding.

Thus, under the present circumstances the Board finds it appropriate to remit the case to the first instance for further prosecution on the basis of claims 1 to 7 filed as the main request with a letter dated 3 February 2016.

Order

For these reasons it is decided that:

1. The appeal under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of claims 1 to 7 of the main request with a letter dated 3 February 2016.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated