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**Datasheet for the decision
of 11 October 2016**

Case Number: T 1986/14 - 3.3.10

Application Number: 07796930.1

Publication Number: 2046409

IPC: A61L31/08, A61B19/04

Language of the proceedings: EN

Title of invention:

NONAQUEOUS COATING COMPOSITION FOR ELASTOMERIC ARTICLES AND
ARTICLES CONTAINING THE SAME

Applicant:

Allegiance Corporation

Headword:

Relevant legal provisions:

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

Keyword:

Amendments - allowable (no) - main request and auxiliary
requests 1-5 - allowable (yes) - auxiliary request 6
Appeal decision - remittal to the department of first instance
(yes) - auxiliary request 6

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 1986/14 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 11 October 2016

Appellant: Allegiance Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 April 2014
refusing European patent application No.
07796930.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: R. Pérez Carlón
F. Blumer

Summary of Facts and Submissions

- I. The appellant lodged an appeal against the decision of the examining division to refuse European patent application No. 07 796 930.1.
- II. The examining division concluded that the claims of the main request and of auxiliary requests 1- were not clear, and that the claims of all the requests then pending contained added subject-matter.
- III. In response to a communication of the board, the appellant filed with a letter dated 4 July 2016 a main request and auxiliary requests 1-5 replacing every request then pending. Auxiliary request 6 was filed during the oral proceedings before the board, which took place on 11 October 2016.
- IV. All requests contain four independent claims directed to a non-aqueous therapeutic composition (claims 1, 6, 10 and 14), four directed to an elastomeric article (claims 5, 9, 13 and 15) and four to a process for the production of an elastomeric article (claims 16-19).

Independent composition claim 6 of the main request reads as follows:

"6. A nonaqueous therapeutic coating composition for the skin-contacting surface of an elastomeric article, said coating composition comprising:

glycerin in an amount ranging from 50% to 90% by weight of the composition;

sorbitol in at least 0.1% by weight of the composition;

and

a transferable film-forming polymer;

wherein said composition is essentially water free and transferable upon contact with skin."

Claim 6 of auxiliary requests 1, 3 and 4 contains, like claim 6 of the main request, the feature "glycerin in an amount ranging from 50% to 90% by weight of the composition".

Claims 6 of auxiliary request 2 contains, like claim 6 of the main request, the feature "sorbitol in at least 0.1% by weight of the composition".

Claims 18 and 19 of auxiliary request 5 read as follows:

"18. A process for the production of an elastomeric article, said process comprising contacting at least one surface of said elastomeric article with a nonaqueous coating composition according to claim 10.

19. A process for the production of an elastomeric article, said process comprising contacting at least one surface of said elastomeric article with a nonaqueous coating composition according to claim 14."

The independent claims of auxiliary request 6 directed to a non-aqueous therapeutic coating composition read as follows:

*"1. A nonaqueous therapeutic coating composition for the skin-contacting surface of an elastomeric article, said coating composition comprising:
glycerin in an amount ranging from 50.00% to 90.00% by weight of the composition; and
sorbitol in an amount ranging from 0.1% to 6.0% by weight of the composition;*

wherein said composition is essentially water-free and transfers upon contact with skin.

6. A nonaqueous therapeutic coating composition for the skin-contacting surface of an elastomeric article, said coating composition comprising:

glycerin in an amount ranging from 50.00% to 90.00% by weight of the composition;

sorbitol in an amount ranging from 0.1% to 6.0% by weight of the composition; and

a transferable film-forming polymer;

wherein said composition is essentially water-free and transferable upon contact with skin.

10. A nonaqueous therapeutic coating composition for the skin-contacting surface of an elastomeric article, said coating composition comprising:

glycerin in an amount ranging from 50.00% to 90.00% by weight of the composition;

sorbitol in an amount ranging from 0.1% to 6.0% by weight of the composition; and

an exfoliant;

wherein said composition is essentially water-free and transferable upon contact with skin.

14. A nonaqueous therapeutic coating composition for the skin-contacting surface of an elastomeric article, said coating composition comprising:

glycerin in an amount ranging from 50.00% to 90.00% by weight of the composition;

sorbitol in an amount ranging from 0.1% to 6.0% by weight of the composition; and

microporous particles;

wherein said composition is essentially water-free and transferable upon contact with skin."

Claims 18 and 19 of auxiliary request 6, directed to a process for the production of an elastomeric article, require contacting "the skin contacting surface" with a therapeutic composition according to claim 10 or claim 14 respectively.

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

The feature "glycerin in an amount ranging from 50% to 90% by weight of the composition" found a basis on page 9, lines 17-19, of the application as originally filed, which disclosed "from about 50.00% to 90.00% by weight". The term "about" indicated to the skilled reader that four significant figures were not required.

The feature "sorbitol in at least 0.1% by weight of the composition" found a basis in claim 1 as originally filed.

Lastly, the amendments to claims 18 and 19 of auxiliary request 5 had been made to ensure that their wording was consistent with remaining process claims 16 and 17, and did not introduce any added subject-matter.

VI. The final requests of the appellant were that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution on the basis of the main request or any of auxiliary requests 1 to 5, all as filed with letter dated 4 July 2016, or on the basis of auxiliary request 6 as filed during oral proceedings before the

board.

VII. At the end of the oral proceedings, the decision was announced.

Reasons for the Decision

1. The appeal is admissible.

Amendments:

2. Main request

2.1 Claim 6 of the main request was amended by including the features *"glycerin in an amount ranging from 50% to 90% by weight of the composition"* and *"sorbitol in at least 0.1% by weight of the composition"*.

2.2 *Glycerin in an amount ranging from 50% to 90% by weight of the composition*

The appellant argued that the amount of glycerin in claim 6 found a basis in the passage on page 9, lines 17-19, of the application as originally filed, which read *"glycerin moisturizer can be present individually in an amount ranging from about 50.00% to about 90.00% by weight"*.

It was undisputed that 50% and 50.00% differ in their accuracy. For this reason, 50.00%/90.00%, on their own, cannot not provide a basis for the features 50% or 90%.

The applicant argued, however, that the use of the term "about" in the passage mentioned above indicated that it was not intended to restrict the claimed amount to ranges defined by end-points with four significant

figures.

The feature "about 50.00% to about 90.00%" discloses a range with two end-points, namely 50.00% and 90.00%, and an area of undefined boundaries around them. No other end-point, such as 50% or 50.0%, is either implicitly or explicitly disclosed. For this reason, the passage cited cannot provide a basis for the aforementioned feature.

2.3 *Sorbitol in at least 0.1% by weight of the composition*

It is not disputed that this feature, without any upper limit, can only be found in claim 1 as originally filed. Said claim relates to a composition which "transfers upon contact with skin", whereas claim 6 of the main request requires said composition to be "transferable upon contact with skin". Thus, the amount of sorbitol "at least 0.1% by weight of the composition" is disclosed in the application as originally filed only in combination with the requirement that the claimed non-aqueous therapeutic coating composition transfers whenever it comes in contact with skin, whereas claim 6 merely requires that it is transferable, i.e. it can be transferred under some conditions but not necessarily always.

As the feature "sorbitol in at least 0.1% by weight of the composition" has only been disclosed in combination with the feature "transfers upon contact with skin", which is not required by amended claim 6, it is concluded that the latter contains added subject-matter.

2.4 For these reasons, the main request contains subject-matter extending beyond that of the application as

originally filed, with the consequence that it is not allowable (Article 123(2) EPC).

3. Auxiliary requests 1, 3 and 4

3.1 Claim 6 of these requests contains the feature "glycerin in an amount ranging from 50% to 90%" in the same context as claim 6 of the main request. Therefore, the objection explained under point 2.2 above also applies to these requests. Thus, auxiliary requests 1, 3 and 4 are not allowable (Article 123(2) EPC).

4. Auxiliary request 2

4.1 The objection explained under point 2.3 above applies in the same manner to claim 6 of auxiliary request 2, as it contains the feature "sorbitol in at least 0.1% by weight of the polymer" in the same context as claim 6 of the main request. For this reason, auxiliary request 2 is not allowable (Article 123(2) EPC).

5. Auxiliary request 5

5.1 Claims 18 and 19 of auxiliary request 5 contain the feature "contacting at least one surface of said elastomeric article" with a non-aqueous therapeutic coating composition according to claim 10 or claim 14 respectively. In contrast, claims 18 and 19 as originally filed required "contacting the skin contacting surface" with said compositions.

The description of the application refers only to applying the claimed coating compositions to the skin-contacting surface of an elastomeric article.

The appellant has not disputed that there is no word-

for-word basis for these claims in the application as originally filed. It argued, however, that they had been amended for consistency with remaining process claims 16 and 17.

The application as originally filed contained four independent claims directed to a process for the production of an elastomeric article (claims 16 to 19). Each of them involved the use of a different non-aqueous therapeutic coating composition. Claims 16 and 17 require contacting at least one surface of the article with a composition according to claims 1 or 6, respectively. In contrast, claims 18 and 19 require contacting the skin contacting surface of the article with a composition according to claims 10 or 14.

The description discloses different compositions, and different types of elastomeric articles. Some articles are intended to be worn for short periods of time, such as examination gloves (page 5, lines 3-4), and the compositions concerned do not require prolonged surface moisturisers. Other articles are intended for extended wear (paragraph bridging pages 14 and 15), such as for example a surgical glove; compositions suitable for these articles preferably contain a film-forming polymer. Thus, the description discloses different types of elastomeric articles containing different types of coatings.

Processes for the production of different types of elastomeric articles with different types of coating compositions must not necessarily be identical. Already for this reason, claims 16 and 17 as originally filed cannot provide an implicit basis for claims 18 and 19.

Claims 18 and 19 of auxiliary request 5 thus contain

added subject-matter, with the consequence that this request is not allowable.

6. Auxiliary request 6

6.1 Claim 1 finds a basis in the combination of claim 1 as originally filed and the passages of the description which, in the context of moisturisers, disclose that "preferably, a combination of glycerin and sorbitol is used" (page 9, line 10), that "glycerin moisturizer can be present individually in an amount ranging from about 50.00% and 90.00% by weight" (page 9, lines 17-19) and that "sorbitol as a moisturizer can be present individually in an amount ranging from about 0.1% to about 6.00% [...] by weight" (page 9, lines 20-21).

The feature "*nonaqueous* coating composition" finds a basis on page 1, line 7 of the description. The wording "water free" in claim 1 has been replaced by "water-free".

6.2 Independent claim 6 finds a basis in claim 6 as originally filed, in the passages mentioned above with respect to claim 1, and in the passage on page 15, line 17 "water should not be present in any significant amount".

6.3 Independent claims 10 and 14 find a basis in claims 10 and 14 as originally filed and the passages mentioned with respect to claim 6.

6.4 Dependent claim 2 has been amended by introducing the term "composition" in the context "the therapeutic coating composition according to claim 1 ...", for consistency with the corresponding independent claim.

Claim 3, which requires a specific hydration promoter, has been made dependent on claim 2, which requires a hydration promoter in general.

Claim 4 has been amended by introducing the word "which" to make it read more easily.

Independent claims 13 and 15 have been amended by introducing the word "coating" in the context "an elastomeric article comprising the therapeutic coating composition of claim 10 / claim 14", for consistency with the wording of the claim they refer to.

Claims 16 and 17 include the word "said" before "elastomeric article". Claims 16-19 include the feature "a nonaqueous therapeutic coating according to claim ..." which was not originally present but which matches the wording of the claims to which they refer.

6.5 The remaining claims find a basis in the respective claims of the application as originally filed, combined with the passages already mentioned.

6.6 Therefore, claims 1-19 of auxiliary request 6 fulfil the requirements of Article 123(2) EPC.

Remittal

7. 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 examining division had refused the application due to non-compliance with Article

123(2) EPC, and lack of clarity arising from features which no longer appear in the claims of auxiliary request 6. The objections raised by the board during the written appeal proceedings no longer apply to the claims of auxiliary request 6.

The appellant requested that, if any of the sets of claims on file were considered not to contain added subject-matter, the case be remitted to the examining division for further prosecution. Under these circumstances, the board considers it appropriate to remit the case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of auxiliary request 6 as filed during oral proceedings before the board.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated