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**Datasheet for the decision
of 23 March 2021**

Case Number: T 1052/16 - 3.2.02

Application Number: 09759409.7

Publication Number: 2280744

IPC: A61M1/00

Language of the proceedings: EN

Title of invention:

Reduced-pressure, liquid-collection canister with multi-orientation filter

Patent Proprietor:

KCI Licensing, Inc.

Opponent:

Smith and Nephew, Inc.

Headword:

Relevant legal provisions:

EPC Art. 54, 56, 83

RPBA Art. 12(4)

Keyword:

Novelty - (yes)
Inventive step - (yes)
Sufficiency of disclosure - (yes)
Late-filed facts - admitted (no)
Late-filed evidence - admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1052/16 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 23 March 2021

Appellant: Smith and Nephew, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 February
2016 rejecting the opposition filed against
European patent No. 2280744 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: S. Böttcher
N. Obrovski

Summary of Facts and Submissions

- I. The opponent lodged an appeal against the decision of the Opposition Division to reject the opposition.
- II. Oral proceedings took place on 23 March 2021.
- III. The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed, i.e. that the patent be maintained as granted, or, alternatively, that the patent be maintained in amended form on the basis of one of the first to third auxiliary requests as filed with the reply to the statement of grounds of appeal.

Should neither the main request nor the first auxiliary request be granted, the respondent requested that the case be remitted to the Opposition Division.

The respondent further requested that the objections based on documents VP05 and VP08 not be admitted into the appeal proceedings. Should either of these objections be admitted, the respondent requested that the case be remitted to the Opposition Division and that costs be apportioned.

- IV. The following documents are referred to by the parties:

VP05: WO 2008/100438

VP06: US 2004/0025693

VP07: US 4,465,485

VP08: WO 2009/019496

V. Claim 1 of the main request reads as follows:

"A liquid-collection canister for collecting liquid from a tissue site to which reduced pressure treatment is applied, the canister comprising:
a first space configured to collect the liquid from the tissue site; and
a filter disposed on a wall of the canister, the filter having a first chamber extending from the wall of the canister and including an opening at an end of the first chamber opposite the wall, the filter having a second chamber extending from the wall of the canister and including an opening at an end of the second chamber opposite the wall, the opening of the first chamber allowing communication between the first space and the first chamber, the opening of the second chamber allowing communication between the first space and the second chamber, a distance from the opening of the first chamber to the wall being greater than a distance from the opening of the second chamber to the wall;
a first filter element positioned over the opening of the first chamber; and
a second filter element positioned over the opening of the second chamber."

VI. The arguments of the appellant, as far as relevant for the decision, can be summarised as follows:

Sufficiency of disclosure

The patent did not enable the person skilled in the art to carry out the invention over the whole scope of claim 1. In particular, the feature that the distance

from the opening of the first chamber to the wall was greater than the distance from the opening of the second chamber to the wall could not guarantee that the advantages mentioned in column 14, lines 13 to 24, of the description were achieved, namely, that the liquid collection was permitted in any particular orientation of the canister, and even if the canister was more than half full. Rather, it would be necessary to define further geometrical parameters of the canister, which were not disclosed in the patent.

Admittance of the objections based on VP05 and VP08

The opponent realized only during the oral proceedings before the Opposition Division that solely the embodiment of Figures 9 and 10 represented the invention as defined in the claims as granted. Since this embodiment was not present in the application from which the priority was claimed, it was noted that VP05 was not only prior art under Article 54(3) EPC but also under Article 54(2) EPC.

VP05 disclosed in Figure 2 a canister comprising a filter having, at least implicitly, two concentric chambers, defined by dotted lines 236 and 238, and filter elements 231 and 234. Hence, the subject-matter of claim 1 lacked novelty or at least inventive step over VP05.

VP08 was not filed earlier during the opposition proceedings also for the reason that only after the oral proceedings the opponent had realized that the priority claim was not valid. Due to the invalidity of the priority claim, VP08, which was published after the priority date, but before the filing date of the contested patent, became relevant for assessing

inventive step.

VP08 disclosed in Figure 9 a canister comprising a filter 288 having two chambers. The first chamber was defined by the filter element 284 and the thickness of the wall 286, and the second chamber was defined by the filter element 284 and the thickness of the wall 288. The subject-matter of claim 1 prima facie lacked novelty and inventive step over VP08.

Novelty in view of VP06

The canister of VP06 required no modification to be used as a liquid-collection canister as claimed.

Since paragraph [0027] mentioned a "first" tube, it was clear that a second tube could be provided. Paragraph [0084] disclosed that any of the different venting tubes 2, 20, 200 and 400 shown in Figures 2 to 5 could be positioned in the chamber 502. Hence, VP06 at least implicitly disclosed the use of two venting tubes which could be regarded as chambers in the sense of claim 1.

Alternatively, Figure 6 of VP06 disclosed a filter (the venting tube) having two chambers as claimed in claim 1. In particular, the sections denoted with reference sign 32 could be regarded as chambers, wherein the volume of the chambers was defined by the thickness of the wall. The opening of the chambers was represented by the two-dimensional plane constituting one end of the chamber.

Since claim 1 only referred to "a distance" from the opening of the chambers to the wall, instead of "the distance" in the sense of "the shortest distance", the feature concerning the distances could also be derived

from VP06. In fact, the distance from any point on the wall 512 to the opening of one of the chambers was greater than the distance from the same point to the opening of the other chamber.

Hence, the subject-matter of claim 1 lacked novelty over VP06.

Inventive step in view of VP06

Even if it was concluded that VP06 disclosed only one venting tube in the canister, there could not be seen an inventive step in providing a second venting tube. VP06 included a clear hint that two venting tubes could be used.

Inventive step in view of VP07

Figure 7 showed a canister having a filter element 40a wrapped around vertically extending bars 71 which formed the periphery of an open frame, drum-like structure (column 8, line 63, to column 9, line 11). Two of the spaces 72 between the bars could be regarded as two chambers in the sense of claim 1 of the patent.

Although there was a channel (post 25a) between the wall of the canister and the chamber, the two chambers extended (at least indirectly) from the wall.

The arguments as to the distances put forward with regard to VP06 applied also to the embodiment of Figure 7 of VP07. Hence, the claimed distances could be derived from VP07, too.

The only distinguishing feature was the presence of two filter elements instead of a filter element in VP07.

The provision of two filter elements for providing more flexibility was obvious for the person skilled in the art since each filter element could be replaced individually.

Hence, the subject-matter of claim 1 lacked an inventive step over VP07 combined with the common general knowledge of the person skilled in the art.

VII. The arguments of the respondent, as far as relevant for the decision, can be summarised as follows:

Sufficiency of disclosure

The decision of the Opposition Division was correct and should be maintained.

Article 83 EPC did not require that every embodiment falling within the scope of the claim provided every advantage noted in the specification.

There was no doubt that the skilled person could implement the apparatus according to claim 1. Thus, the patent was in conformity with Article 83 EPC.

Admittance of the objections based on VP05 and VP08

The argumentation as to novelty and inventive step based on VP05 should not be admitted into the proceedings since this document was never discussed during the opposition proceedings and, accordingly, the contested decision did not deal with this document.

Furthermore, VP05 did not disclose first and second chambers of a filter extending from a wall of a canister.

VP08 should not be admitted into the proceedings since it was late filed and its late submission was not justified. VP08 disclosed a filter having only one chamber. The alleged second chamber was merely the canister outlet, which was not within the canister.

Novelty in view of VP06

VP06 did not disclose a canister having two venting tubes. The "second tube" mentioned in paragraph [0034] was not a venting tube. Furthermore, paragraph [0084] stated that "any one of the venting tubes 2, 20, 200 and 400 (...) may be positioned within the chamber 502". It was therefore explicitly disclosed that a single venting tube was used in the canister.

Moreover, the spaces within the holes in the wall of the venting tube in Figure 6 could not be regarded as chambers. Such an interpretation was based on hindsight knowledge of the claim. The regions within the holes did not extend from a wall of the canister, and they did not have openings as required by claim 1.

When selecting consistent points on the wall and on the openings and measuring and comparing the distances using those points, VP06 did not disclose the distance requirements of claim 1.

The subject-matter of claim 1 was therefore novel over VP06.

Inventive step in view of VP07

Figure 7 disclosed a single filter element wrapped around a frame of vertical bars (column 9, lines 2 to

11). The frame did not disclose first and second chambers extending from the wall of the canister.

The objective technical problem suggested by the appellant did not account for the scope of differences to VP07. Notwithstanding that, the prior art did not suggest the use of two filter elements instead of one.

The subject-matter of claim 1 was therefore inventive.

Reasons for the Decision

1. Subject-matter of the invention

The invention relates to a canister for collecting liquid from a tissue site. The claimed embodiment is shown in Figures 9 and 10 and described in paragraphs [0059] to [0063] of the patent.

The canister is used in a system for vacuum (or reduced pressure) treatment of a wound. Wound exudate or other liquids from the tissue site are collected in the claimed canister. To prevent the liquids from reaching the reduced pressure source, the canister includes a filter (926) disposed on a wall (922) of the canister. The filter has a first chamber (932) and a second chamber (936). Each chamber extends from the wall and has an opening (938, 940) which is covered by a filter

element (950, 954). A distance from the opening of the first chamber to the wall is greater than a distance from the opening of the second chamber to the wall (Figure 10). The filter has an outlet (not claimed) that may be fluidly connected to a reduced pressure source.

Due to the spaced and multiplanar positioning of the filter elements the filter allows the canister to continue to transmit reduced pressure even when the level of liquid within the catheter rises to and beyond the interior space being half full of liquid, and irrespective of the particular orientation of the canister (column 14, lines 13 to 24).

2. Sufficiency of disclosure

The invention is sufficiently disclosed to be carried out by the person skilled in the art. As correctly stated by the Opposition Division (appealed decision, point 4.1.1), the patent discloses one way of putting the invention into practice, namely in form of the embodiment of Figures 9 and 10 and paragraphs [0059] to [0063].

There is no evidence that the skilled person is not enabled to prepare all embodiments falling under the scope of the claim. Whether all those embodiments provide a certain advantage is not decisive. Hence, the Board considers that the invention can be put into practice over the whole scope of claim 1.

3. Admittance of the objections based on VP05 and VP08

3.1 VP05 was cited in the notice of opposition as a document belonging to the state of the art pursuant to

Article 54(3) EPC. However, the appellant did not put forward any substantiated objection based on this document, which was never discussed during the opposition proceedings. Accordingly, the contested decision did not deal with it.

Since a document representing prior art under Article 54(3) can be used in an objection as to lack of novelty, the appellant could and should have presented the argumentation as to novelty based on VP05 already during the opposition proceedings.

The Board acknowledges that VP05 would belong to the state of the art pursuant to Article 54(2) EPC if the priority of the subject-matter of claim 1 (represented by the embodiments of Figures 9 and 10) was not validly claimed. However, the validity of the priority claim could have been checked earlier in the opposition proceedings. Hence, also the objection as to lack of inventive step could and should have been raised during the opposition proceedings.

Moreover, VP05 neither discloses first and second chambers of a filter extending from a wall of a canister, nor renders these two chambers obvious. The dotted lines in Figure 2 do not suggest that the filters 231 and 234 can be positioned in a spaced arrangement to build the respective chambers.

In view of these considerations, the Board decided not to admit said late-filed objections based on VP05 into the appeal proceedings (Article 12(4) RPBA 2007).

- 3.2 VP08 was filed with the statement of grounds of appeal. It represents prior art under Article 54(2) EPC only if the priority of the subject-matter of claim 1 is not

validly claimed. Since the validity of the priority could have been checked already in the opposition proceedings, the document could and should have been filed then.

Furthermore, VP08 discloses a canister having a filter 286 defining only one chamber (Figure 9). The exit port 268 cannot be regarded as a further chamber of the filter because it is outside of the filter chamber. Thus, VP08 does not disclose a second chamber, and consequently no second opening or second filter element.

In view of these considerations, the Board decided not to admit VP08, and the objections based on it, into the appeal proceedings (Article 12(4) RPBA 2007).

4. Novelty in view of VP06

4.1 VP06 relates to an apparatus for venting a gas from a liquid delivery system (for introducing medicaments, supplements or blood into the body). The apparatus (shown in Figure 6) has a chamber in which a venting tube 20 is arranged (paragraphs [0083] and [0084]). The venting tube has openings 32 covered by a gas-permeable, but liquid-impermeable membrane 36. The membrane may vent gas from the liquid in the chamber into the venting tube and further through the venting holes 26 (paragraphs [0070] and [0071]).

4.2 VP06 does not disclose a filter having two chambers. In particular, there is no disclosure of a chamber having more than one venting tube. The Board agrees with the appellant, that the "first tube" mentioned in paragraph [0027] can be regarded as a filter having a chamber including an opening and a first filter element as

defined in claim 1. However, the "second tube" referred to in paragraph [0034] is not a venting tube. It is rather a piece of tube 606 connected to the liquid exit port (Figure 7).

The appellant also referred to paragraph [0084], stating that any one of the venting tubes 2, 20, 200, 400 may be positioned in the container. In the Board's view, this means that the type of venting tube may be varied, but that still only one venting tube is arranged in the container.

4.3 Furthermore, the spaces 32 within the holes in the wall of the venting tube in Figure 6 cannot be regarded as two chambers of a filter. The person skilled in the art would not identify these spaces as chambers. The venting tube 20, if it is considered as a filter in the sense of claim 1, rather has one chamber 22 with two openings 32 (paragraph [0070]). Moreover, the two openings cannot be chambers according to claim 1 since they do not extend from the wall of the canister.

4.4 Since VP06 does not disclose two chambers in a filter, the question whether the distance requirements for the two chambers are met does not need to be addressed.

4.5 It follows that the subject-matter of claim 1 is novel over VP06.

Moreover, since VP06 discloses only one venting tube (see point 4.2 above) and does not contain any indication that two venting tubes could be used, the subject-matter of claim 1 also involves an inventive step over this document.

5. Inventive step in view of VP07

5.1 VP07 relates to a suction canister used for withdrawing and collecting body fluids from a patient. Figure 7 shows a filter housing including an open frame, drum-like structure formed by vertically extending bars 71. A filter element 40a is wrapped around the periphery defined by the bars (column 8, line 63, to column 9, line 11).

5.2 Contrary to the appellant, the Board does not consider the spaces between two respective bars as chambers in the sense of claim 1, in particular since they do not extend from the wall of the canister. VP08 therefore does not disclose two chambers in a filter, extending each from a wall of the canister and having each a filter element positioned over an opening. Hence, the objective technical problem formulated by the appellant is not based on a correct assessment of the distinguishing features.

5.3 The person skilled in the art would not be motivated to modify the filter housing of Figure 7 such that it includes two chambers as defined in claim 1. This would require a significant change in the device of VP07. Thus, the subject-matter of claim 1 involves an inventive step when starting from VP07.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated